

MOROCCO'S PATENT SYSTEM AND ITS INTERNATIONAL CONNECTION

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I. INTRODUCTION

The globalization of the world economy has prompted countries to adopt new laws congruent with the new reality. Notwithstanding differences in legal background, tradition and culture, the interdependence of legal systems has generated a hybrid protecting rights. With respect to intellectual property law in general and patent law in particular, a number of Islamic countries have adopted and promulgated new laws to meet the recommendations of international institutions. This study purports to monitor the law of some Islamic African countries, with an emphasis on Morocco's new patent law.

In response to the general trend, Morocco promulgated a new industrial property law to meet the so-called international standards of protection of intellectual property rights as provided under the Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPs") of the World Trade Organization ("WTO").¹ Under Morocco's new Industrial Property Act, the following categories are considered industrial properties: patents, layout designs for integrated circuits, industrial designs, trademarks and service marks, trade names, geographical indications (appellation of origin and indication of provenance), and repression of anti-competition.²

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¹ *General Agreement on Tariffs and Trade: Multilateral Trade Negotiations Final Act Embodying the Results of the Uruguay Round of Trade Negotiations, Agreement on Trade-Related Aspects of Intellectual Property Rights* annex 1C (Apr. 15, 1994), 33 I.L.M. 1125, 1197 [hereinafter TRIPs].

² Morocco Industrial Property Act, Act No. 17-97 (Feb. 9, 2000) (published on March 9, 2000) [hereinafter Morocco IP Act].

This paper compares Morocco's new patent law with TRIPs. Since the first purpose of Morocco's new patent law revision has been to bring Moroccan patent law into compliance with TRIPs requirements, this paper will look at whether or not Morocco complies entirely with TRIPs. The background of Morocco's legal system and its new patent law will be examined, then TRIPs' main patent provisions will be outlined. Finally, a comparative analysis of Morocco's new patent law and the TRIPs patent system will be presented.

II. BACKGROUND OF MOROCCO'S LEGAL SYSTEM AND ITS NEW PATENT LAW

A. *Morocco's Legal System*

Geographically located at the northwestern tip of Africa, Morocco displays the following meaningful characteristics: it is an African, Islamic and Arabic country.³ Morocco became a French colony in 1911, with Spain receiving a number of isolated locales. French rule came to an end in 1953, although its cultural influence on Morocco remains evident today. Over the years, Morocco's legal system has been mainly influenced by French civil law. The Kingdom of Morocco is characterized by a mixed system of Muslim Law and Civil Law.⁴ Morocco's Constitution has likewise acknowledged the necessity to bring its laws into accord with international

³ "The Kingdom of Morocco, a Muslim Sovereign State whose official language is Arabic, the Kingdom of Morocco constitutes a part of the Great Arab Maghreb. As an African State, it has among its objectives, the realization of African unity." Morocco Const. preamble (translated by A. Tschentscher, *Morocco – Constitution* <http://www.uni-wuerzburg.de/law/mo00000_.html> (last modified Oct. 31, 2000)).

⁴ The Constitution of Morocco states:

Article 4:

"Law is the supreme expression of the Nation's will. All must submit to it. Law can have no retroactive effect."

Article 6:

"Islam is the religion of the State which guarantees to all freedom of worship."

Article 15:

"(1) The right to own property is guaranteed.

(2) Its extent and use may be restricted by law if the needs of economic and social planning and development require it.

(3) No expropriation can take place except in the cases and forms provided by law."

Morocco Const. arts. 4, 6, 15 (translated by A. Tschentscher, *Morocco – Constitution* <http://www.uni-wuerzburg.de/law/mo00000_.html> (last modified Oct. 31, 2000)).

recommendations.⁵

Morocco is a member country and signatory of a number of international conventions – particularly intellectual property conventions. Morocco has been a party to the Paris Convention for the Protection of Industrial Property since July 30, 1917.⁶ The Paris Convention was initially adopted on March 20, 1883, and has been revised several times since then.⁷ Since August 6, 1971, Morocco has adhered to the Stockholm revision made July 14, 1967.⁸

Morocco has also been a party to the World Trade Organization since January 1, 1995.⁹ As a member country to the WTO, Morocco is obliged to meet the recommendations of the WTO.¹⁰ These recommendations include implementing TRIPs within each member country's national framework. For this reason, Morocco has revised its industrial property law to bring it into compliance with TRIPs.

Initially, the Ministry of Commerce & Industry prepared a draft law that amended Morocco's Industrial Property Laws of 1916 and 1938.¹¹ This draft was adopted by the Council of Ministers, passed through Parliament, and was finally approved by the House of Counselors.¹² In accordance with Article 26 of the Moroccan Constitution,¹³ the King promulgated the new

⁵ Morocco Const. preamble (translated by A. Tschentscher, *Morocco – Constitution* <http://www.uni-wuerzburg.de/law/mo00000_.html> (last modified Oct. 31, 2000)).

Aware of the necessity of setting its action within the context of the international organizations of which it is an active and energetic member, the Kingdom of Morocco subscribes to the principles, rights, and obligations resulting from the charters of the aforesaid organizations and reaffirms its attachment to the Human Rights as they are universally recognized.

Id.

⁶ *Paris Convention for the Protection of Industrial Property* (Mar. 20, 1883, last amended, Oct. 2, 1979), 828 U.N.T.S. 305-88, WIPO Pub. No. 201(E) [hereinafter *Paris Convention*].

⁷ *Id.*

⁸ The Paris Convention was revised at Stockholm on July 14, 1967, and Morocco became a party to the Stockholm revision on August 6, 1971. *Id.*

⁹ *General Agreement on Tariffs and Trade: Multilateral Trade Negotiations Final Act Embodying the Results of the Uruguay Round of Trade Negotiations, Agreement Establishing the World Trade Organization* (Apr. 15, 1994), 33 I.L.M. 1125, 1144.

¹⁰ *Id.* at art II(2), 33 I.L.M. at 1144.

¹¹ Morocco IP Act, *supra* n. 2, at art. 234.

¹² *Id.*

¹³ Article 26 of the Constitution states that the King shall promulgate a definitively adopted law within thirty days following its receipt by the Government. Morocco Const. art. 26.

Industrial Property Law on February 15, 2000.¹⁴ The amendments made to Morocco's industrial property law brings Moroccan law into harmony with TRIPs, and meets the requirements that are needed for global economic development.

Morocco's new patent law was published in the Official Gazette on March 9, 2000.¹⁵ According to Article 234 of the new Industrial Property Act, this law is supposed to enter into effect six months after it is published.¹⁶

Accordingly, Morocco's new patent law took effect on September 9, 2000.¹⁷ This new law abrogated the law of June 23, 1916 pertaining to the Protection of Industrial Property, the law of October 4, 1938 relating to the Protection of Industrial Property in Tanger zone, and the law of August 14, 1940 relating to the Issue of Patents related to national defense.¹⁸

B. Morocco's New Patent Law

Morocco's new patent law addresses the scope of patent protection, rights conferred on the patentee, compulsory licensing and *ex officio* licenses, exhaustion of rights, and enforcement of rights.

1. Scope of Patent Protection

The new law defines protected subject matter, as well as unpatentable subject matter. A patent can be granted for any invention that meets the patentability conditions in all fields of technology.¹⁹ The invention must be new, involve an inventive step, and be industrially applicable.²⁰ However, the law does not define an invention. The subject matter of an invention may be a product, process or new application, or any combination of well-known means (methods) to obtain a new result.²¹ The law expressly stipulates that pharmaceutical processes and products are eligible for patent protection.²²

¹⁴ Morocco IP Act, *supra* n. 2, at preamble.

¹⁵ *Id.*

¹⁶ *Id.* at art. 234.

¹⁷ *Id.*

¹⁸ *Id.*

¹⁹ *Id.* at art. 16.

²⁰ *Id.* at art. 22.

²¹ *Id.* at art. 21(1).

²² *Id.* at art. 21(2).

Under the new law, some subject matter is considered statutorily unpatentable. Discoveries, scientific theories, mathematic theories, plans, principles and intellectual methodology, games, computer programs, esthetical creations, and presentation of information are not deemed to be inventions—therefore, such things are unpatentable.²³ The law states explicitly that computer-related inventions are not deemed inventions under the law.²⁴ Therefore, in Morocco there is no question as to the patentability of computer programs, even if they are new, involve an inventive step, and are industrially applicable—as long as the innovation is defined as a computer program, the present law is not applicable.²⁵

Furthermore, inventions that are contrary to public order and morality are not eligible for patent protection.²⁶ Morality and public order must be interpreted in a broad sense to include morality and public order as taught under Islam in accordance with the Koran.

Plant varieties are also ineligible for patent protection in Morocco. Rather than applying patent protection to plant varieties, Morocco has opted for a *sui generis* system. Therefore, plant varieties are governed by the law pertaining to the protection of plant varieties.²⁷

Additionally, the new law enumerates certain inventions that lack industrial applicability and are, therefore, unpatentable. Therapeutic, diagnostic and surgical methods for the treatment of humans or animals are deemed unpatentable.²⁸ However, this provision is not applicable to products that enable the use of these methods.

Under the new law, the scope of patent protection is determined by the ambit of the claims embodied in the patent.²⁹ Additionally, if the patentable subject matter is a process, protection should be able to be extended to products directly obtained from the protected process.³⁰

The new patent law requires that the invention be sufficiently disclosed at the time of filing.³¹ For national defense reasons, a patent's issuance and subsequent exploitation may be prohibited if the invention may

²³ *Id.* at art. 23.

²⁴ *Id.* at art. 23(3).

²⁵ See generally Tshimanga Kongolo, *Does the Congo's Copyright and Neighboring Rights Law Conflict with the TRIPs Agreement?*, 2 J. World Intell. Prop. 311, 313-15 (1999).

²⁶ Morocco IP Act, *supra* n. 2, at art. 24(a).

²⁷ *Id.* at art 24(b).

²⁸ *Id.* at art. 25.

²⁹ *Id.* at art. 52.

³⁰ *Id.*

³¹ *Id.* at art 34(6).

cause harm to the security of the nation.³² Finally, the new patent law provides for the first-to-file principle,³³ priority rights,³⁴ and a prior use regime.³⁵

2. Rights Conferred on the Patentee

According to the new patent law, exclusive rights are granted to an inventor dating back to the filing date of patent application.³⁶ These rights are protected for twenty years from the filing date of application.³⁷ The law enumerates acts that are prohibited if undertaken without the prior consent of the patentee: making, offering, importing, using, detaining of patented products or processes is prohibited without the consent of the patentee.³⁸ In addition, there is a presumption of bad faith if a protected process is used without the prior consent of the patentee.³⁹ A patentee is entitled to assign or license his exclusive rights.⁴⁰ Any transfer of rights shall be registered in the National Register of Patents.⁴¹

3. Compulsory Licenses

Morocco's new patent law has provided for two types of compulsory licenses: a general compulsory license and *ex officio* license.⁴² A compulsory license may be granted in the following circumstances:

- in a case of non-use or non-working of the patented invention;
- if patented products are not commercialized in sufficient quantity to meet the demand of the Moroccan market; or

³² *Id.* at art. 42.

³³ *Id.* at art. 16.

³⁴ *Id.* at arts. 6-7.

³⁵ *Id.* at art. 55(f).

³⁶ *Id.* at art. 51.

³⁷ *Id.* at art. 17(a).

³⁸ *Id.* at art. 53.

³⁹ *Id.* at art. 53(b).

⁴⁰ *Id.* at art. 56.

⁴¹ *Id.* at art. 58.

⁴² *Id.* at arts. 60 & 67.

- if the exploitation or the commercialization of the patented invention in Morocco has been abandoned for more than three years.⁴³

According to Article 60, any interested person may seek a compulsory licensing if the patentee does not work his invention for three years after the issue of the patent, or four years from the filing date of application.⁴⁴ The law however, does not define the term “working” or “use” of inventions. Therefore, it is questionable whether the use should be associated with the exclusive rights of the patentee.

Similar to TRIPs, under Morocco’s new patent law some conditions must be met before a compulsory license will be granted. The interested party should first try to amicably negotiate a license with the patentee, and the interested party should prove that he has the means to exploit the patented invention to meet the demand of Morocco’s market.⁴⁵ Under Morocco’s new law, the compulsory license shall be granted principally to supply the national market.⁴⁶ The court is competent to grant a compulsory license and fix the amount of royalties emanating therefrom.⁴⁷ When granted, a compulsory license should be non-exclusive.⁴⁸

If the circumstances leading to the granting of a compulsory license cease to exist, the court may suspend or terminate the compulsory license by considering the legitimate interests of the licensee(s) so authorized.⁴⁹ In other words, if the court realizes that the compulsory license is no longer necessary, it may suspend or terminate it. Another motivation for the suspension or termination of a compulsory license may be the failure of the compulsory licensee to meet the requirements and conditions as stipulated by the court prior to the grant.⁵⁰

A compulsory license may be granted to the owner of an improvement patent if that owner fails to reach an agreement with the first patentee under commercially reasonable conditions.⁵¹ Some conditions must be met before a compulsory license will be granted: the second invention (the improvement) must include an important technical achievement as

⁴³ *Id.* at art. 60(a-c).

⁴⁴ *Id.*

⁴⁵ *Id.* at art. 61.

⁴⁶ This is in conformity with TRIPs.

⁴⁷ Morocco IP Act, *supra* n. 2, at art. 61.

⁴⁸ *Id.* at art. 62.

⁴⁹ *Id.* at art. 63.

⁵⁰ *Id.*

⁵¹ *Id.* at art. 66.

compared to the first invention;⁵² the first patentee should be granted a license on the second invention under commercially reasonable terms;⁵³ and the license should be non-transferable, except when the second patent is transferred with the business.⁵⁴

Under Morocco's new patent law, another type of compulsory licensing is provided for—the *ex officio* license.⁵⁵ This type of compulsory license can be requested for a national security (national defense) reason,⁵⁶ for a public health interest,⁵⁷ and/or for a national economic reason.⁵⁸ For example, product and process patents related to medicines may be exploited *ex officio* if the patentee (or rights holder) fails to supply the national market a satisfactory quantity or quality of products, or if the cost of these medicines is unjustifiably high.⁵⁹ Once an administrative act is published, any qualified person may request the grant of the *ex officio* license.⁶⁰ This is an important provision, and is considered by some to be Morocco's response to the well-known conflict between developed and developing countries with respect to the protection of pharmaceuticals.⁶¹ Furthermore, this provision is related to Morocco's national public policy.⁶²

Since the early stages of discussions within the international framework, developing countries have argued that the protection of pharmaceuticals in general, and drugs or pharmaceutical products in particular, is connected to health and should therefore be left to the discretion of each country.⁶³ They argued that since it is a matter of public policy, each country should be free to determine which system is adequate to protect

⁵² *Id.* at art. 66(a).

⁵³ *Id.* at art. 66(b).

⁵⁴ *Id.* at art. 66(c). These conditions are also required by TRIPs. See TRIPs, *supra* n. 1, at art. 31.

⁵⁵ Morocco IP Act, *supra* n. 2, at art. 67.

⁵⁶ *Id.* at art. 75.

⁵⁷ *Id.* at art. 67.

⁵⁸ *Id.* at art. 71.

⁵⁹ *Id.* at art. 67.

⁶⁰ *Id.* at art. 69.

⁶¹ Julio Nogués, *Patents and Pharmaceutical Drugs: Understanding the Pressures on Developing Countries*, 24 J. World Trade 81, 83 (1990); Robert S. Tancer, *The Pharmaceutical Industry in India*, 2 J. World Intell. Prop. 171, 175 (1999).

⁶² Tshimanga Kongolo, *The International Intellectual Property System and Developing Countries Before and After the TRIPs Agreement: A Critical Approach*, 3 Intl. Pub. Policy Stud. 93, 99-116 (1998).

⁶³ *Id.*

pharmaceuticals therein.⁶⁴ Developing countries feared that the cost of pharmaceutical products would increase and the pharmaceutical sector would become controlled by self-interested foreign companies.⁶⁵ Aware of the situation, Morocco's patent law has taken a balanced approach to safeguard the national interest in the safety and health of its people.⁶⁶

Therefore, a competent authority in Morocco may request that a patentee or rights holder exploit their patented invention in a manner that will satisfy the needs of the national economy.⁶⁷ If the request is not followed within one year of notification, and if the lack of exploitation or the insufficiency in quality or quantity is prejudicial to economic development and to public interest, the concerned patents may be exploited *ex officio*.⁶⁸ The one-year period for compliance with the authority's order may be extended if the rights holder asserts a legitimate reason for non-compliance compatible with the national economic interests.⁶⁹

4. Exhaustion of Rights

Once patented products are put into the market (commerce) by, or with the consent of, the patentee/rights holder, any person may use the patented products thereafter without the prior consent of the patentee.⁷⁰ In other words, Morocco's patent law provides for the exhaustion of patent rights after the first sale of patented products.⁷¹ Parallel importation of patented products first put into the stream of commerce by the patentee or with his consent is permitted.⁷²

⁶⁴ *Id.*

⁶⁵ See generally Tshimanga Kongolo, *Towards a More Balanced Coexistence of Traditional Knowledge and Pharmaceuticals Protection in Africa*, 35 J. World Trade 349, 349-61 (2001).

⁶⁶ See generally Tshimanga Kongolo, *The African Intellectual Property Organizations: The Necessity of Adopting One Uniform System for All Africa*, 3 J. World Intell. Prop. 265, 265-88 (2000).

⁶⁷ Morocco IP Act, *supra* n. 2, at art. 71.

⁶⁸ *Id.* at art. 73.

⁶⁹ *Id.*

⁷⁰ Marco C.E.J. Bronckers, *The Exhaustion of Patent Rights under WTO Law*, 32 J. World Trade 137, 141-42 (1998).

⁷¹ Morocco IP Act, *supra* n. 2, at art. 55(d).

⁷² *Id.*

5. Enforcement of Rights

Civil and criminal remedies are available if the patentee's exclusive rights are infringed.⁷³

III. TRIPS AGREEMENT PATENT PROTECTION

Under this section, the background of TRIPs will be highlighted. TRIPs' main innovations in the patent field will then be outlined.

A. Brief Background of TRIPs

The failure to revise the Paris and Berne Conventions urged developed countries to insert TRIPs into the agenda for the Uruguay Round of Multilateral Negotiations within the framework of the General Agreement on Tariffs and Trade ("GATT").⁷⁴ The original GATT Agreement of 1947 hardly mentioned intellectual property at all.⁷⁵ GATT, as it stood after the Tokyo Round, did not deal with the issues of patents, copyrights and other similar intellectual property rights.⁷⁶ However, at the outset of the Uruguay Round in 1986, matters pertaining to the Trade-Related Aspects of Intellectual Property ("TRIPs") were addressed. The United States, with the support of other industrialized countries, sought to include the issue of intellectual property rights in the negotiating agenda.⁷⁷ The result for TRIPs was the Negotiating Objective set out in the Punta del Este Declaration in 1986.⁷⁸

⁷³ Morocco IP Act, *supra* n. 2, at arts. 210-17.

⁷⁴ Emmanuel Opoku Awuku, *How Do the Results of the Uruguay Round Affect the North-South Trade*, 28 J. World Trade 75, 83 (1994).

⁷⁵ Marco C.E.J. Bronckers, *The Impact of TRIPs: Intellectual Property Protection in Developing Countries*, 31 Com. Mkt. L. Rev. 1245, 1245 (1994). However, Article XX(d) of GATT prescribed that under certain conditions the contracting parties would be allowed to restrict trade in goods to protect intellectual property rights. David Hartridge & Arvind Subramanian, *Intellectual Property Rights: The Issues in GATT*, 22 Vand. J. Transnatl. L. 893, 900 (1989).

⁷⁶ John Beath, *Innovation, Intellectual Property Rights and the Uruguay Round*, 13 World Econ. 411, 424-25 (1990).

⁷⁷ Hartridge & Subramanian, *supra* n. 75, at 896.

⁷⁸ *Ministerial Declaration on the Uruguay Round of Multilateral Trade Negotiations* (Sept. 20, 1986), 25 I.L.M. 1623, 1624.

Industrialized countries complained about the state of protection of intellectual property rights in developing countries and advocated strong intellectual property protection.⁷⁹ Accordingly, they proposed the establishment of a set of international minimum standards for protection of intellectual property that would be respected by each member country.⁸⁰

At the earlier stages of discussions, developing countries challenged GATT's authority to deal with matters that were out of its jurisdiction.⁸¹ Developing countries alleged that "WIPO and UNESCO retain exclusive jurisdiction over the issues relating to intellectual property."⁸² In addition, developing countries contended that the minimum standards of protection would likely favor developed countries.⁸³

After several discussions and debates undertaken under the auspices of GATT,⁸⁴ in April 1994, the WTO was created.⁸⁵ The threat of sanctions and the fear of being isolated obliged developing countries to sign the Agreement establishing the WTO.⁸⁶ Once signed, TRIPs came into force in January 1995.⁸⁷

⁷⁹ Claudio R. Frischtak, *Harmonization versus Differentiation in International Property Rights Regimes*, 10 Int. J. Tech. Mgmt. 201, 201-03 (1995).

⁸⁰ Kongolo, *supra* n. 66.

⁸¹ Elizabeth Henderson, *TRIPs and the Third World: The Example of Pharmaceutical Patents in India*, 11 E.I.P.R. 651, 653 (1997).

⁸² Kongolo, *supra* n. 66.

⁸³ *Thought Control. (General Agreement on Tariffs and Trade and Intellectual Property)*, The Economist 68 (July 7, 1990).

Many developing countries are unhappy at [the prospect of minimum standards] They fear that tighter protection for intellectual property rights will strengthen the monopoly power of western multinationals, harm development by reducing technology transfer and hurt consumers who are already poor by raising the prices of essential medicines and other patented goods. . . .

Western arguments that stronger protection of ideas will boost foreign investment and technology transfer by reducing companies' fears of theft have not convinced third-world skeptics.

Id.

⁸⁴ Asif H. Qureshi, *The Role of GATT in the Management of Trade Blocks*, 27 J. World Trade 101, 102 (1993).

⁸⁵ *General Agreement on Tariffs and Trade: Multilateral Trade Negotiations Final Act Embodying the Results of the Uruguay Round of Trade Negotiations, Agreement Establishing the World Trade Organization* (Apr. 15, 1994), 33 I.L.M. 1125, 1144.

⁸⁶ Kongolo, *supra* n. 66.

⁸⁷ TRIPs, *supra* n. 1.

According to Article 2(1) of TRIPs, members shall comply with Articles 1-12 and 19 of the Paris Convention.⁸⁸ In other words, every member country of the WTO is obliged to implement at the domestic level Articles 1-12 and 19 of the Paris Convention, regardless of whether or not the member country is a signatory of the Paris Convention. The simple fact of adhering to the WTO implies a respect for the above-mentioned provisions of the Paris Convention. Under this approach, unless otherwise stipulated, the Paris Convention for the Protection of Industrial Property is an integral part of TRIPs.

Despite this apparent inclusion of the pre-existing system into the new system of intellectual property protection, TRIPs has in most cases strengthened the protection or extended the scope of protection by including new items within the patent protection sphere. In addition, most provisions of TRIPs bind every WTO member country.

B. Innovations of TRIPs in the Patent Field

1. Patentable Inventions

Article 27 of TRIPs sets forth the conditions for, and the scope of, patentability.⁸⁹ Under TRIPs, three conditions for patentability of inventions are required—the invention shall be novel, involve an inventive step, and be capable of industrial application.⁹⁰

An invention may be a product or a process.⁹¹ An invention relating to a product or process that meets all the three required conditions is eligible for a patent.⁹² In addition, the TRIPs agreement has extended the scope of availability for patent to inventions in all fields of technology, and disregards the place of invention and whether products are imported or are produced locally.⁹³ Logically, the obligation (per Article 5A of the Paris Convention) to work patents locally appears overridden by the TRIPs right to supply

⁸⁸ *Id.* at art. 2(1), 33 I.L.M. at 1199.

⁸⁹ *Id.* at art. 27, 33 I.L.M. at 1208. According to Article 27(1), “patents shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application. . . . [P]atents shall be available and patent rights enjoyable without discrimination as to the place of invention, the field of technology and whether products are imported or locally produced.” *Id.*

⁹⁰ *Id.*

⁹¹ *Id.*

⁹² *Id.*

⁹³ *Id.*

imports, at least in principle.⁹⁴ TRIPs encourages countries to grant protection to pharmaceutical products and processes.⁹⁵ However, developing countries consider this area a matter of public policy to be determined by each individual country.⁹⁶

The extension of product patents to inventions relating to pharmaceuticals and agro-chemicals has given rise to several issues. TRIPs maintains that a developing country member must extend product patent protection to areas of technology not protectable in its territory on the date of application of TRIPs, or it may delay the application of the provisions on product patents for an additional period of five years.⁹⁷ Samuel Oddi notes that “there are some preexisting supernatural rights in pharmaceutical and agriculture chemical product inventions that all members are bound to protect, even though this was unrecognized in their positive law.”⁹⁸

2. Unpatentable Inventions

Two TRIPs provisions deal with matters relating to the unpatentability of inventions. In addition to the exclusions from patentability provided by most members of the Paris Convention for the Protection of Industrial Property, TRIPs sets forth some exclusions due to the necessity to protect public order or morality, animal or human health, plant life, and environment.⁹⁹ Under TRIPs, inventions that are contrary to the

⁹⁴ J. H. Reichman, *Compliance with the TRIPs Agreement: Introduction to a Scholarly Debate*, 29 Vand. J. of Transnatl. L. 363, 370 (1996).

⁹⁵ TRIPs, *supra* n. 1, at arts. 27(1), 70(8), 70(9), 33 I.L.M. at 1208, 1224.

⁹⁶ Theresa Beeby Lewis, *Patent Protection for the Pharmaceutical Industry: A Survey of the Patent Laws of Various Countries*, 30 Intl. Law. 835, 858-59 (1996). “Many Indians view intellectual property provisions as ‘economic colonialism’ and find exploitation in the fact that a foreign company could enter a poor country to develop technology and then obtain a patent for the technology and declare the resources private property.” *Id.*

⁹⁷ This so-called “pipeline” provision permits the owner of intellectual property in the concerned area to obtain at least five years of exclusive marketing rights in those countries that did not grant patents in these fields. Samuel Oddi, *TRIPs--Natural Rights and a “Polite Form of Economic Imperialism”*, 29 Vand. J. Transnatl. L. 415, 438 (1996).

⁹⁸ *Id.*

⁹⁹ TRIPs, *supra* n. 1, at art. 27(2), 33 I.L.M. at 1208.

Members may exclude from patentability inventions, the prevention within their territory of the commercial exploitation of which is necessary to protect ordre public or morality, including to protect human, animal or plant life or health or to avoid serious prejudice to the environment, provided that such exclusion is not made merely because the exploitation is prohibited by their domestic law.

public order or morality, or where the exploitation of an invention may impair human health and may cause prejudice to the environment, such inventions may be excluded from patentability.¹⁰⁰

Under TRIPs, each member country has the discretionary authority to determine situations that threaten public order or morality.¹⁰¹ This provision allows states to exclude some inventions from patentability if their exploitation might contravene public order or morality, or which are destructive to human health.

According to Article 27(3):

Members may also exclude from patentability:

(a) diagnostic, therapeutic and surgical methods for the treatment of humans or animals;

(b) plants and animals other than micro-organisms, and essentially biological processes for the production of plants or animals other than non-biological and microbiological processes. However, Members shall provide for the protection of plant varieties either by patents or by an effective *sui generis* system or by any combination thereof. The provisions of this sub-paragraph shall be reviewed four years after the date of entry into force of the WTO Agreement.¹⁰²

Pursuant to the latter paragraph, plants and animals other than micro-organisms, and biological processes other than non-biological and microbiological processes, may be excluded from patentability. However, members are obliged to protect plant varieties either by patents or by an effective *sui generis* system or by any combination thereof.

Furthermore, a computer program is not patentable subject matter, as TRIPs provides for copyright protection of computer programs instead.¹⁰³

3. Rights Conferred

Under TRIPs, the patent owner is entitled to certain exclusive rights: the right to exclude third parties from making, using, offering for sale, selling, or importing for these purposes, the product without his consent.¹⁰⁴ In regard to process patents, the same acts are *mutatis mutandis* recognized as exclusive rights of the patent owner that cannot be undertaken without the

Id.

¹⁰⁰ *Id.*

¹⁰¹ *Id.*

¹⁰² *Id.* at art. 27(3), 33 I.L.M. at 1208.

¹⁰³ *Id.* at art. 10, 33 I.L.M. at 1201.

¹⁰⁴ *Id.* at art. 28(1), 33 I.L.M. at 1208.

process patent owner's consent.¹⁰⁵ This provision is mandatory.¹⁰⁶ Each member country shall comply with this requirement.¹⁰⁷

In addition to the exclusive rights, the owner of patent has the right to enter into license agreement with third parties.¹⁰⁸ The patent owner also the right to assign his patent.¹⁰⁹

In process patent infringement suits, TRIPs has shifted the burden of proof from the plaintiff to the defendant.¹¹⁰ In the absence of proof to the contrary, if the subject matter of the patent is a process for obtaining a product, the presumption will be that the defendant has made the product by the patented process.¹¹¹ It is then up to the defendant to prove otherwise.¹¹² As S. K. Verma has noted, due to the shifting of the burden of proof, a manufacturer will be required to provide the details of its manufacturing process in order to rebut the presumption of infringement of a process patent.¹¹³

TRIPs recommends that member countries require a patent applicant to disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.¹¹⁴ Samuel Oddi has recommended that developing countries take this requirement particularly seriously—noting that developing countries should insist upon complete disclosure so that one may practice the invention in that particular developing country.¹¹⁵

¹⁰⁵ *Id.*

¹⁰⁶ *Id.* (noting that “[a] patent *shall* confer on its owner the following exclusive rights”) (emphasis added).

¹⁰⁷ *Id.*

¹⁰⁸ *Id.* at art. 28(2), 33 I.L.M. at 1208.

¹⁰⁹ *Id.*

¹¹⁰ *Id.* at art. 34(1), 33 I.L.M. at 1211.

¹¹¹ *Id.* More specifically, the burden shifts when: (1) the product obtained by the patented process is new; and (2) there is a substantial likelihood that the product was made by the process and the process patent owner has been unable to determine the process actually used. *Id.*

¹¹² *Id.*

¹¹³ S. K. Verma, *TRIPs and Plant Variety Protection in Developing Countries*, 17 *Eur. Intel. Prop. Rev.* 281, 286 (1995).

¹¹⁴ TRIPs, *supra* n. 1, at art. 29(1), 33 I.L.M. at 1209.

¹¹⁵ Oddi, *supra* n. 97, at 463.

4. Compulsory Licenses

TRIPs has provided some exceptions to the exclusive rights of a patent owner through its compulsory license provisions.¹¹⁶ TRIPs enumerates certain conditions that countries must comply with when ordering a compulsory license.¹¹⁷ The term “compulsory license” is not used in TRIPs; instead the phrases “exceptions to rights conferred”¹¹⁸ and “other use without authorization of the right holder” are used.¹¹⁹

Article 30 sets forth exceptions to rights conferred:

Members may provide limited exceptions to the exclusive rights conferred by a patent, provided that such exceptions do not unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owner, taking account of the legitimate interests of third parties.¹²⁰

Article 31 provides certain conditions that are to be respected while allowing for use of a patent owner’s rights by third parties.¹²¹ Some of these conditions are similar to those provided under the Paris Convention for the Protection of Industrial Property.¹²² The compulsory licensee must first unsuccessfully attempt to enter into a license agreement with the patent owner under commercially reasonable terms.¹²³ The compulsory license shall be non-exclusive,¹²⁴ and shall be granted to an individual entity.¹²⁵ In any case, the right holder shall be paid a fair royalty.¹²⁶ In addition, the need to correct anti-competitive practices may be taken into account to determine the amount of the remuneration.¹²⁷ Furthermore, the compulsory license shall be

¹¹⁶ TRIPs, *supra* n. 1, at arts. 30-31, 33 I.L.M. at 1209-10.

¹¹⁷ *Id.*

¹¹⁸ *Id.* at art. 30, 33 I.L.M. at 1209.

¹¹⁹ *Id.* at art. 31, 33 I.L.M. at 1209.

¹²⁰ *Id.* at art. 30, 33 I.L.M. at 1209.

¹²¹ *Id.* at art. 31, 33 I.L.M. at 1209-10.

¹²² Compare TRIPs, *supra* n. 1, at art. 31, 33 I.L.M. 1209-10 with Paris Convention, *supra* n. 6, at art. 5, 828 U.N.T.S. at 305-88.

¹²³ TRIPs, *supra* n. 1, at art. 31(b), 33 I.L.M. at 1209. This requirement may be waived by a member country in the case of a national emergency, other circumstances of extreme urgency, or in cases of public non-commercial use. *Id.*

¹²⁴ *Id.* at art. 31(d), 33 I.L.M. at 1209.

¹²⁵ *Id.*

¹²⁶ *Id.* at art. 31(h), 33 I.L.M. at 1210.

¹²⁷ *Id.* at art. 31(k), 33 I.L.M. at 1210.

authorized predominantly for the supply of the domestic market of the member country authorizing such use.¹²⁸

In cases where two conflicting patents block each other, the second patentee may be granted a compulsory license over the first patent if the second patent involves an important technical advance of considerable economic significance.¹²⁹ In such cases, the owner of the first patent shall be entitled to a cross-license with reasonable terms to use the invention covered by the second patent.¹³⁰

As per Article 5A of the Paris Convention, the “non-working” or “non-exploitation” of a patented invention may be sufficient grounds for granting a compulsory license under TRIPs.¹³¹

In principle, both the public interest exception and the measures designed to prevent abuse could justify resort to compulsory licensing. Beyond traditional notions of public interest and abuse, TRIPs introduces new and more expansive concepts whose outer limits have yet to be delineated at the international level. In other words, if a patentee or a rights holder: (1) fails to practice the patent locally in due course, (2) refuses to grant licenses on reasonable terms thereby hampering industrial development, (3) does not supply the national market with sufficient quantities of the patented product, or (4) demands excessive prices for such products, then a compulsory license may be granted to a third party.¹³²

However, as prescribed under Article 27 of TRIPs, the importation of patented products by the patentee or the right holder in a country where a patent has been granted shall be deemed to be the “working” of the concerned invention.¹³³ This provision gives rise to several issues in developing countries. “One of the shortcomings of a compulsory license is that it conveys only a ‘naked’ license to practice the patented invention; there

¹²⁸ *Id.* at art. 31(f), 33 I.L.M. at 1210.

¹²⁹ *Id.* at art. 31(l), 33 I.L.M. at 1210.

¹³⁰ *Id.*

Two patents are said to block each other when one patentee has a broad patent on an invention and another has a narrower patent on some improved feature of that invention. . . . [T]he holder of the narrower (‘subservient’) patent cannot practice her invention without a license from the holder of the dominant patent [and vice-versa].

Robert P. Merges & Richard R. Nelson, *On the Complex Economics of Patent Scope*, 90 Colum. L. Rev. 839, 860 (1990).

¹³¹ TRIPs, *supra* n. 1, at art. 31, 33 I.L.M. at 1209; Paris Convention, *supra* n. 6, at art. 5A, 828 U.N.T.S. at 305-88.

¹³² TRIPs, *supra* n. 1, at art. 31, 33 I.L.M. at 1209.

¹³³ *Id.* at art. 27(1), 33 I.L.M. at 1208.

is no requirement that the patent owner transfer the [other] needed information or cooperate in the working of the invention by the licensee.⁷⁷¹³⁴ Therefore, it is feasible that one may not actually be able to practice an invention, even if they obtain a compulsory license.

5. Term of Protection

TRIPs sets the term for the protection of patent rights at twenty years from the filing date of the patent application.¹³⁵

6. Enforcement of Rights

TRIPs requires WTO members to provide enforcement measures and remedies within their national laws.¹³⁶

IV. MOROCCO'S NEW PATENT LAW AND TRIPS

Morocco is now a member country to the WTO.¹³⁷ Consequently, Morocco must comply with TRIPs.¹³⁸ For this reason, and as previously discussed in Part I, Morocco has promulgated a new Industrial Property Act that is supposed to be in compliance with the TRIPs Agreement. The emphasis of the following comparative analysis will be predominantly on the scope of patent protection, rights conferred, compulsory licensing, exhaustion of rights, and enforcement of rights.

A. Scope of Patent Protection

Under TRIPs, a patent shall be available for any invention in all fields of technology, without discrimination as to the place of invention.¹³⁹ In addition, the invention shall meet three conditions to be patentable: the

¹³⁴ A. Samuel Oddi, *The International Patent System and Third World Development: Reality or Myth?*, 1987 Duke L. J. 831, 873 (1987).

¹³⁵ TRIPs, *supra* n. 1, at art. 33, 33 I.L.M. at 1210.

¹³⁶ TRIPs, *supra* n. 1, at art. 41(1), 33 I.L.M. at 1213-14.

¹³⁷ *General Agreement on Tariffs and Trade: Multilateral Trade Negotiations Final Act Embodying the Results of the Uruguay Round of Trade Negotiations, Agreement Establishing the World Trade Organization* (Apr. 15, 1994), 33 I.L.M. 1125, 1144.

¹³⁸ *Id.* at art. II(2), 33 I.L.M. at 1144.

¹³⁹ TRIPs, *supra* n. 1, at art 27(1), 33 I.L.M. at 1208.

invention must be new, involve an inventive step, and be capable of industrial application.¹⁴⁰ Morocco's new patent law provides for the same three conditions for an invention to be eligible for patent protection.¹⁴¹ While the Moroccan law is not explicit as to the protected fields of technology, the language used in the text implies that the law applies to any field of technology.¹⁴² Neither TRIPs nor the Moroccan law has defined what constitutes an invention. In other words, Morocco has leeway in considering what may and may not define an invention in accordance with its socio-economic realities.

Regarding unpatentable inventions, TRIPs stipulates that members may exclude from patentability, plants and animals other than microorganisms, and essentially biological processes for the production of plants or animals other than non-biological and microbiological processes.¹⁴³ Moroccan law, while providing some specific exclusions,¹⁴⁴ is silent as to generally excludable categories. It is surprising that Morocco's law is also silent about the patentability of microorganisms, biological or non-biological inventions.

TRIPs has provided for the protection of computer programs as literary works under copyright law, instead of allowing computer programs to be patented.¹⁴⁵ Moroccan law similarly allows computer programs to be excluded from the scope of patent protection.¹⁴⁶

With respect to plant varieties, TRIPs mandates that WTO member countries provide for the protection of plants varieties either by patents, or by an effective *sui generis* system, or any combination thereof.¹⁴⁷ Moroccan law has opted for the second alternative, the effective *sui generis* system, by allowing plant varieties to be excluded from the scope of patent protection.¹⁴⁸

Furthermore, while providing for the exclusion of inventions that are harmful to the public order and morality,¹⁴⁹ Moroccan law fails to provide for

¹⁴⁰ *Id.*

¹⁴¹ Morocco IP Act, *supra* n. 2, at art. 22.

¹⁴² *Id.* at art. 16.

¹⁴³ TRIPs, *supra* n. 1, art. 27(3)(b), 33 I.L.M. at 1208.

¹⁴⁴ Morocco IP Act, *supra* n. 2, at art. 23-25.

¹⁴⁵ TRIPs, *supra* n. 1, art. 10, 33 I.L.M. at 1201.

¹⁴⁶ Morocco IP Act, *supra* n. 2, at art. 23(3).

¹⁴⁷ TRIPs, *supra* n. 1, art. 27(3)(b), 33 I.L.M. at 1208.

¹⁴⁸ Morocco IP Act, *supra* n. 2, at art. 24(b).

¹⁴⁹ *Id.* at art. 24(a).

the environment exception as stipulated under TRIPs.¹⁵⁰ Morality and public order limitations must be interpreted under Moroccan law in accordance with Islamic law.¹⁵¹

Moroccan law has opted to grant patents for the new use or new application of existing and well-known methods where there is a new and different result.¹⁵² Moreover, under Moroccan patent law, pharmaceutical processes and products are eligible for patent protection.¹⁵³ The Moroccan patent law also stipulates that the term “industry” should be interpreted in its broadest sense to include agriculture (and related inventions).¹⁵⁴ This is all in accordance with TRIPs.¹⁵⁵

In summary, regarding the scope of a patent, Moroccan patent law does not conflict with TRIPs, although the Moroccan law does fail to provide some exclusions from patentability that are permitted under TRIPs.

B. Rights Conferred

Both TRIPs and Moroccan patent law grant the same exclusive rights to the patentee.¹⁵⁶ These exclusive rights are protected under both TRIPs and Moroccan patent law for a period of twenty years from the date the patent application was filed.¹⁵⁷

C. Compulsory Licensing

Moroccan law provides for two types of compulsory licenses, called respectively the “compulsory license” and the “*ex officio* license.”¹⁵⁸ The common denominator is that these licenses are granted to supply the national market.¹⁵⁹ Morocco’s patent law reiterates most of the conditions set out

¹⁵⁰ TRIPs, *supra* n. 1, art. 27(2), 33 I.L.M. at 1208. See also Tshimanga Kongolo, *Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIP’s): New Strategies for Developing Countries*, 3 Intl. Bus. L. J. 345, 350 (2000).

¹⁵¹ Morocco IP Act, *supra* n. 2, at art. 24(a).

¹⁵² *Id.* at art. 21.

¹⁵³ *Id.*

¹⁵⁴ *Id.* at art. 2.

¹⁵⁵ TRIPs, *supra* n. 1, arts. 27(1), 70(8), 70(9), 33 I.L.M. at 1208 and 1224.

¹⁵⁶ *Id.* at art. 28, 33 I.L.M. at 1208; Morocco IP Act, *supra* n. 2, at art. 51.

¹⁵⁷ TRIPs, *supra* n. 1, art. 33, 33 I.L.M. at 1210; Morocco IP Act, *supra* n. 2, at art. 17(a).

¹⁵⁸ Morocco IP Act, *supra* n. 2, at art. 60-67.

¹⁵⁹ *Id.* at art. 60(b).

under TRIPs for the granting of compulsory licenses.¹⁶⁰ However, some differences can be observed. This is mainly in the area of pharmaceuticals where, in Morocco, an *ex officio* license can be granted to a third party when a patent owner fails to supply the local market sufficiently, or when pharmaceutical products are costly and non-affordable by local consumers.¹⁶¹ This provision can be used to fight against the import-monopoly of the patentee.¹⁶² It also safeguards the interest of the nation while providing for the protection of pharmaceuticals as required under TRIPs. This can be considered a response to the widespread conflict regarding the protection of pharmaceuticals in developing countries in general, and in African countries in particular.¹⁶³ The “use” requirement and the supply of national market reasons may be utilized to limit the egotistic rights of a patentee.

As discussed above in Part III.B.4., TRIPs has narrowed the scope of applicability of compulsory licensing. TRIPs sets forth some requirements that must be met before compulsory licensing can be invoked, including:

- (a) authorization . . . shall be considered on its individual merits;
- (b) . . . prior to such use, the proposed user has made efforts to obtain authorization from the right holder on reasonable commercial terms and conditions. . . ;
- (c) the scope and duration of such use shall be limited to the purpose for which it was authorized . . . ;
- (d) such use shall be non-exclusive;
- (e) such use shall be non-assignable, except with that part of the enterprise or goodwill which enjoys such use;
- (f) any such use shall be authorized predominantly for the supply of the domestic market of the Member authorizing such use;
- (g) authorization for such use shall be . . . terminated if and when the circumstances which led to it cease to exist and are unlikely to recur . . . ;
- (h) the right holder shall be paid adequate remuneration in the circumstances of each case, taking into account the economic value of the authorization;
- (i) the legal validity of any decision relating to the authorization of such use shall be subject to judicial review or other independent review by a distinct higher authority in that Member;

¹⁶⁰ Compare Morocco IP Act, *supra* n. 2, at art. 60-67 with TRIPs, *supra* n. 1, at arts. 30-31.

¹⁶¹ Morocco IP Act, *supra* n. 2, at art. 67.

¹⁶² Roberto Mazzoleni & Richard R. Nelson, *The Benefits and Costs of Strong Patent Protection: A Contribution to the Current Debate*, 27 Res. Policy 273, 276 (1998).

¹⁶³ See generally Richard P. Rozek, *The Consequences of Pharmaceutical Product Patenting: A Critique*, 16 World Competition: L. & Econ. Rev. 91, 106 (1993); Arvind Subramanian, *Putting Some Numbers on the TRIPs Pharmaceutical Debate*, 10 Intl. J. Tech. Mgt. 252, 254 (1995).

(j) any decision relating to the remuneration provided in respect of such use shall be subject to judicial review . . . ;

. . . .

(l) where such use is authorized to permit the exploitation of a patent (“the second patent”) which cannot be exploited without infringing another patent (“the first patent”), the following additional conditions shall apply:

(i) the invention claimed in the second patent shall involve an important technical advance of considerable economic significance in relation to the invention claimed in the first patent;

(ii) the owner of the first patent shall be entitled to a cross-license on reasonable terms to use the invention claimed in the second patent . . .¹⁶⁴

Morocco has incorporated all these conditions provided under TRIPs into its new patent law.¹⁶⁵

Moroccan patent law is silent about whether the importation of patented products is considered “use” of patent within the meaning of the patent law. It is known, however, that despite the recommendation of TRIPs to consider the importation of patented products as “working” or “using” the patent, most developing countries still require the domestic or local exploitation of patented inventions.¹⁶⁶

D. Exhaustion of Rights

TRIPs has avoided dealing with matters relating to the exhaustion of rights of intellectual property in general and patents in particular.¹⁶⁷ Unlike TRIPs, Moroccan law expressly acknowledges national exhaustion of intellectual property rights.¹⁶⁸ It remains to be seen whether this will be extended and applied to products that are derived and imported from another country, particularly pharmaceutical products.

¹⁶⁴ TRIPs, *supra* n. 1, at art. 31, 33 I.L.M. at 1209-10.

¹⁶⁵ Morocco IP Act, *supra* n. 2, at art. 60.

¹⁶⁶ See generally Tshimanga Kongolo, *Public Interest versus the Pharmaceutical Industry’s Monopoly in South Africa*, 4 J. World Intell. Prop. 611, 627 (2001).

¹⁶⁷ TRIPs, *supra* n. 1, at art. 6, 33 I.L.M. at 1200.

¹⁶⁸ Morocco IP Act, *supra* n. 2, at art. 55(d).

E. Enforcement of Rights

In accordance with TRIPs, Moroccan patent law has provided for civil and criminal remedies for infringement of a patentee's exclusive rights.¹⁶⁹

V. CONCLUSION

This study has examined the patent system in an Islamic African country—Morocco. The Moroccan legal system is a mixed legal system of Muslim law and civil law. Being a member of the WTO, Morocco is obliged to meet recommendations of the TRIPs Agreement. Therefore, Morocco has enacted a new Industrial Property Act to comply with TRIPs.

Moroccan patent law provides protection to all patented inventions. However, regarding the scope of patent protection, Moroccan patent law has failed to set out some general and commonly utilized exclusions permitted under the so-called international system. These exclusions generally include an environmental safeguard exception, the possibility of non-protection for plants and animals other than microorganisms, and essentially biological processes for the production of plants by other than non-biological and microbiological processes. Moroccan patent law has, however, excluded computer programs and plant varieties from the scope of patentability. Computer programs are protected under the copyright regime, whereas plant varieties are protected under a *sui generis* system.

Furthermore, Moroccan law is silent as to the meaning of “use” or “exploitation” of an invention. Although TRIPs has requested members to acknowledge the importation of patented products as a “use” of an invention, Moroccan law is silent as to whether the importation of patented products is considered a “use” of a patented invention.

Regarding compulsory licensing, Moroccan patent law has almost laid down the same conditions as provided for under TRIPs. In this area, the most substantive innovation of Moroccan patent law has been the introduction of the provision relating to pharmaceuticals. For public health interests, product and process patents related to medicines may be exploited *ex officio* if the patentee (or right holder) fails to supply the domestic, public market in satisfactory quantities or quality of products, or if the cost of these medicines is unjustifiably high.

Moroccan patent law has expressly acknowledged the national exhaustion of rights of the patentee. TRIPs does not deal with matters

¹⁶⁹ Compare TRIPs, *supra* n. 1, at arts. 41-61 with Morocco IP Act, *supra* n. 2, at arts. 210-217.

related to exhaustion of rights. Under both TRIPs and Moroccan patent law, enforcement measures are provided for. In sum, Morocco's new patent law complies with TRIPs standards, despite the existence of some differences.