Preliminary List of Implementation Deficiencies: Guatemala
(Based on available translated laws*)

Patents and Data Protection

1. Article 15.10, Data Protection (Decree 30-2005):
   a. Amended Article 177 or implementing regulations (perhaps those referred to in Article 8 of Decree 30-2005, which we did not receive) should set out the circumstances under which the authority requires information to issue a market approval. In addition, amended Article 177 does not spell out which products of third parties shall not be approved (e.g., those third party products that rely on another company=s information or market approval).
   b. 5-year Acap® should only apply in cases of third party reliance, not in-country reliance (i.e., CAFTA Article 15.10.1(a), not 15.10.1(b)).
   c. Amended Article 177 (b) should refer to approval in AGuatemala®, as does 177(b).
   d. There is no prohibition on disclosure, and no provision that information that is disclosed by authorities cannot be relied upon by third parties (Article 15.10.1(d)).
   e. Exception to possibly implied non-disclosure requirement includes protection for plants, animals and environment, which goes beyond Anecessary to protect the public®, which is the only exception permitted by CAFTA Article 15.10.
   f. Amended Article 177 Ater® includes exceptions to data protection, which are not permitted under CAFTA.
   g. Particular exceptions under Amended Article 177 Ater® undercut data protection obligation and should be modified, or better, deleted:
      i. It is unclear what subparagraph (a) means, but, as an Aexception@ it appears to provide some leeway to limit the availability of data protection; if Ano longer enjoys protection@ means only data protection, there would be a conflict with the Alinkage® obligation of CAFTA Article 15.10.2(a).
      ii. Subparagraph (b) would appear to limit data protection in third party reliance situations to the period remaining in the country of first approval, which will generally be less than 5 years. Not clear why the provision refers to Aapproval® periods.
      iii. Subparagraph (d) is also confusing, but appears to inappropriately limit data protection, e.g., by imposing the 5-year cap requirement on companies submitting their own data to Guatemala and not relying on third countries.
      iv. Subparagraph (e) is too broad, allowing exceptions to data protection for any company engaging in anti-competitive behavior, instead of limiting exceptions to measures necessary to prevent anti-competitive practices.
   h. Amended Article 177 Aquinques® requires various verifications concerning the product (e.g., not protected by patent, not Ainternationally® protected), without
spelling out the consequences of the verification: availability of data protection should not be limited based on whether there is international protection (other than in areas legitimately covered by the 5-year cap) or whether there is a patent on the product.

i. There are no measures to prevent the issuance of market approval to third parties when the original product is covered by a patent, i.e., ALinkage® (CAFTA Article 15.10.2(a)).

j. There is no provision that the owner of the patent be informed when a third party requests approval to enter the market during the patent term (CAFTA Article 15.10.2(b)).

k. To the extent that the Article 177 quinquies Averifications® are intended to lay the groundwork for ALinkage® (CAFTA Article 15.10.2), the reference to patents should include patents covering an approved use of the product, in addition to patents covering the product.

l. We do not believe we received the necessary implementing regulations referred to in Article 8 of Decree 30-2005.

2. Article 15.1.5(a): If Guatemala does not intend to accede to UPOV (1991), it must provide effective patent protection for plants. Can Guatemala show that it has issued patent protection for plants or plant inventions?

3. CAFTA Article 15.2.3: Well-known marks: Decree 89-2002, Article 24, by referring to the grant of a well-known mark, indicates that such marks must be formally registered to receive protection; provision should be amended to clarify that this is not the case.

4. Decree 57-2000 contains numerous trademark licence recordal provisions, contrary to CAFTA Article 15.2.10, including Articles 27, 45, and 46.

3. Trademarks

Copyright and Related Rights and Enforcement.

5. Under CAFTA Article 15.5.2, it should be made clear in Articles 53 and 58 that the right of reproduction for temporary copies applies to performers and producers.

6. CAFTA Article 15.5.7 (Technological Protection Measures ATPMs®): Did not find required civil remedies (see CAFTA Article 15.11.14). CAFTA 15.5.7 strictly limits exceptions: please confirm that there are NO exceptions under Guatemalan law; if there are, please identify them. To clarify that there are no exceptions to requirement or to liability; urge that TPM rules be set out separately. Comment applies equally to Rights Management Information (CAFTA 15.15.8).

7. In Penal Code, Article 274 chapeau, confirm that there are no Aexceptional cases® that would limit criminal sanctions in the case of intellectual property rights.

8. Decree 33-98, Article 53 should provide for a Amaking available® and distribution right for performers (CAFTA Article 15.5.2).

9. Decree 33-98, Article 50 should be amended so that it does not establish a hierarchy between copyrights and related rights.
10. There are numerous Articles of Decree 33-98, e.g., Articles 72 - 103, that limit the ability to freely and separately transfer economic rights (e.g., Article 79, which permits the author to ask a judge to change the remuneration agreed to in the contract (with certain exceptions laid out in Article 80), and Article 74, which prohibits the author from transferring certain economic rights, e.g., with respect to future technologies.)

11. Article 6 of Decree 33-98 establishes a presumption as to who the author is, but does not establish a presumption as to who the right holder is. Also, there is no presumption for performers, producers or publishers. Finally, there is no presumption of subsistence in works, performances, and phonograms. All of these are required by CAFTA Article 15.11.5.

12. Did not see any laws or regulations that fulfill CAFTA Article 15.11.3 (written judicial and administrative decisions).

13. Guatemalan provisions for civil damages in the case of copyright and related rights infringement do not track the obligations of CAFTA Article 15.11.7.

14. Article 133 bis of the Copyright Law should include the standard in CAFTA Article 15.11.18 that the security be reasonable and not deter recourse to such procedures.

15. Article 187(b) of the Industrial Property Law should include authority to seize documentary evidence for trademark counterfeiting, and should eliminate the requirement that seized implements have been primarily used in infringing activity. This “primarily” requirement should also be eliminated from Article 185(b) of the Industrial Property Law.

16. Article 134 bis(a) of the Copyright Law should provide that donation of goods to charity may be made with the consent of the rightholder, under CAFTA Article 15.11.11.

17. Article 134 bis(b) of the Copyright Law should provide authority for the destruction of implements and materials (it currently only allows these items to be “withdrawn from trade”). The gravity of the offense, as well as the interests of third parties holding ownership, possessory, contractual, or secured interest should be considered by the judge in the request for the destruction of materials and implements. See CAFTA 15.11.11 (b).

18. Article 185 (b) of the Industrial Property Law should provide for the following considerations by the judge in considering requests for destruction of materials and implements: the gravity of the offense, as well as the interests of third parties holding ownership, possessory, contractual, or secured interest should be considered by the judge in the request for the destruction of materials and implements. See CAFTA 15.11.11 (b).

19. Article 185 of the Industrial Property Law should provide for the destruction of implements and materials, as required by CAFTA Article 15.11.11 (subparagraph (b) only provides for the seizure of those materials/implements). Further, subparagraph (a) appears to limit the destruction of infringing goods “primarily” to cases “when they affect or could affect the health or life of persons”, among other situations, contrary to CAFTA Article 15.11.11. Finally, please confirm that Article 185 actually confers the listed authorities; the title suggests that this is only a requirement concerning what should be in the judicial decision.

20. Article 185(b) should require that, after the removal of the mark (as opposed to “distinctive designs”), the good no longer be identifiable with the removed trademark (see CAFTA Article 15.11.11(c)).
21. CAFTA Article 15.11.26 contains several requirements concerning criminal procedures and remedies, including, e.g., that judicial authorities have the authority to order seizure of goods, materials, implements, and assets traceable to the offence. Articles 274 and 275 of the Penal Code simply provide for fines and prison sentences, but not for the other requirements of CAFTA Article 15.11.26. Those Articles should be amended, or additional provisions added.

* Translations to date include: Ley de Propiedad Industrial (Decreto 57-2000): Articles 45-47; 91-102; 185-188; and 216; Reglamento de la Ley de Propiedad Industrial: Articles 22-27; Ley de Derechos de Autor y Derechos Conexos (Decreto 33-98): Articles 6; 50-61; 73-83; and 127-134; Decreto Numero 30-2005: full document; and Codigo Penal: Articles 274-275.