

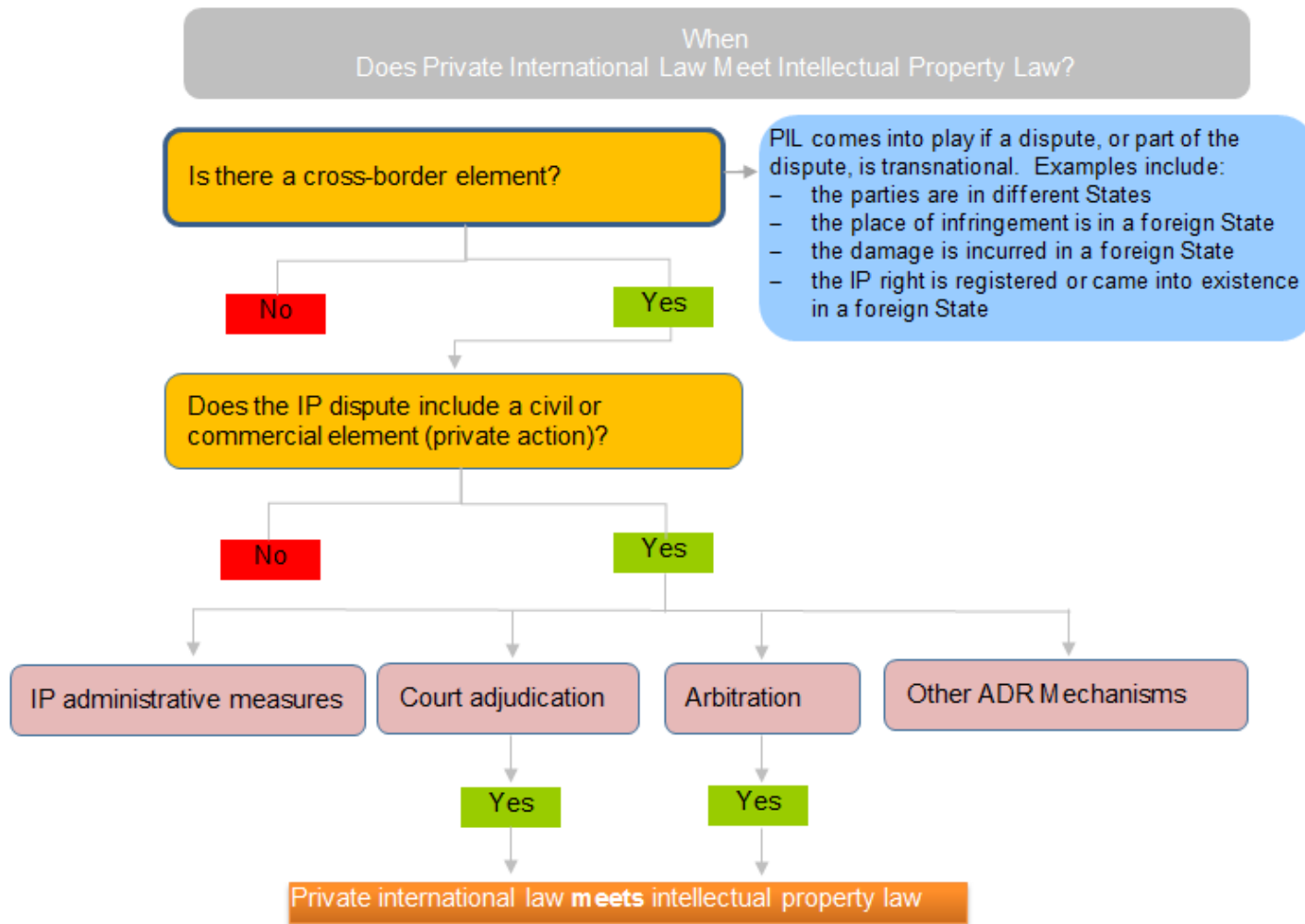
The Intersection between Intellectual Property Law and Private International Law

Draft WIPO-HCCH Guide

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Ch I: When Does Private International Law Meet Intellectual Property Law?



Why a Guide on IP and Private International Law?

- IP-specific concerns in private international law
- Tension between territoriality of IP and IP transactions with cross-border elements
- IP disputes involving e.g. foreign location of: one or both parties; the protected IP right; the IP infringing activity; or the effect of or damage caused by the infringing activity.



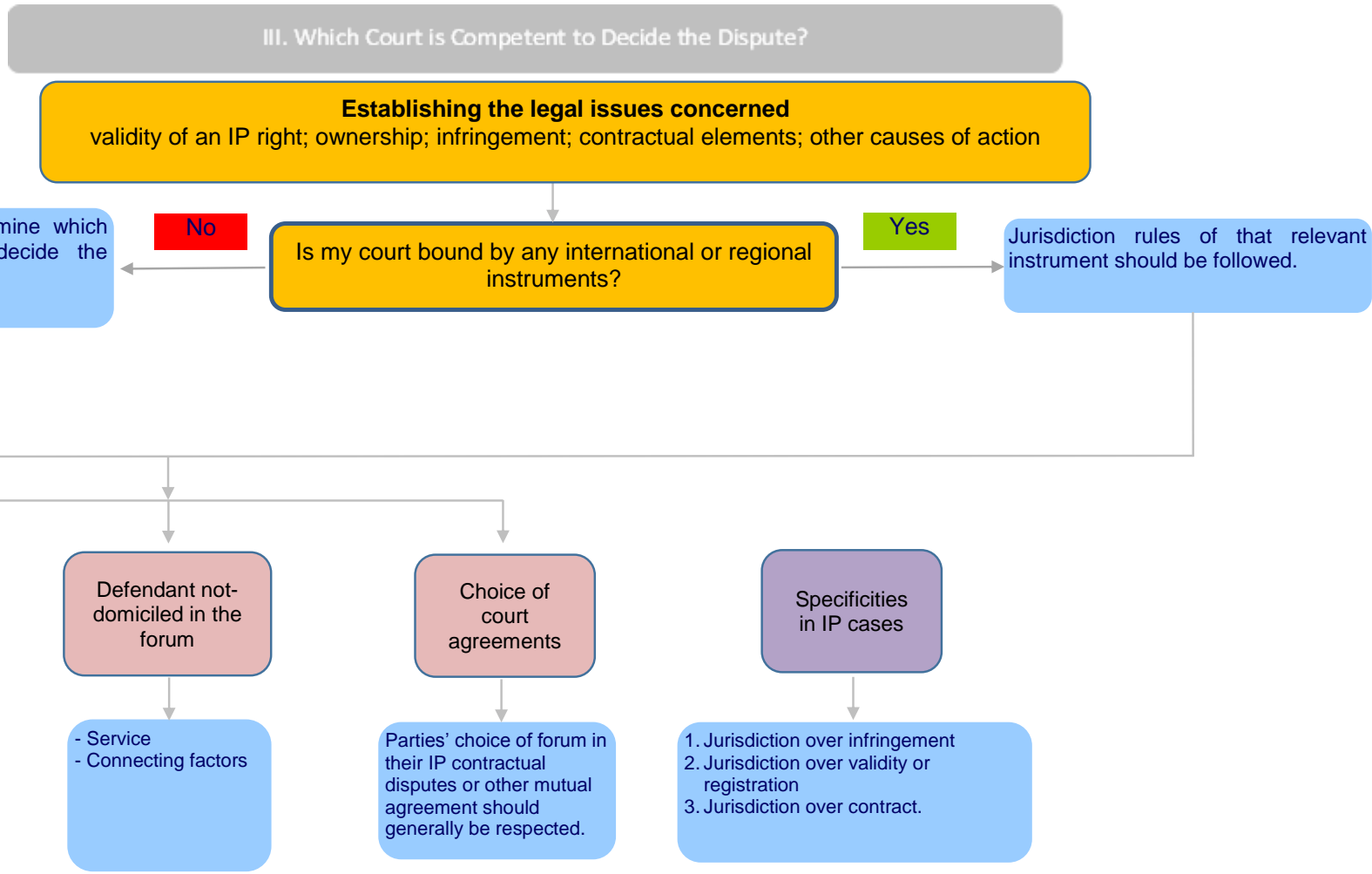
Objective of the Guide

- These issues will likely be the subject of statute, regulation or rules of court, to a greater or lesser degree in different States
- The draft Guide
 - does not advocate any particular approach
 - is not an exhaustive discussion of all of the factors that may be taken into account by a court in relation to IP and PIL
 - highlights some of the issues that may be encountered
 - points to existing international agreements that may affect different jurisdictions and to national provisions that may be used to apply the principles contained therein, if permissible in a specific jurisdiction, and if the court chooses to do so
 - indicates some of the complexities in this area which may arise and which have not yet, as at the date of writing, been resolved
- DRAFT Guide: Comments are welcome

Ch. II: How is the Intersection between Private International Law and Intellectual Property Regulated under Various Legal Frameworks?

- PIL rules governing IP relationships
 - E.g. Hague Convention on Choice of Court Agreements, Hague Principles on Choice of Law in International Commercial Contracts, EU Brussels Regime
- PIL rules in IP instruments
 - E.g. Article 5(2) of the Berne Convention

Ch. III: Which Court Is Competent to Decide the Dispute?



Can the foreign defendant be served or has the foreign defendant submitted to the jurisdiction?



Does an exception to personal jurisdiction apply?

Is the proceeding of a type that is connected to the court's jurisdiction?

Should the court in its discretion decline to decide the dispute?

- Is the court a non-convenient forum (*forum non conveniens*)?

Leave to serve granted or leave to proceed given.

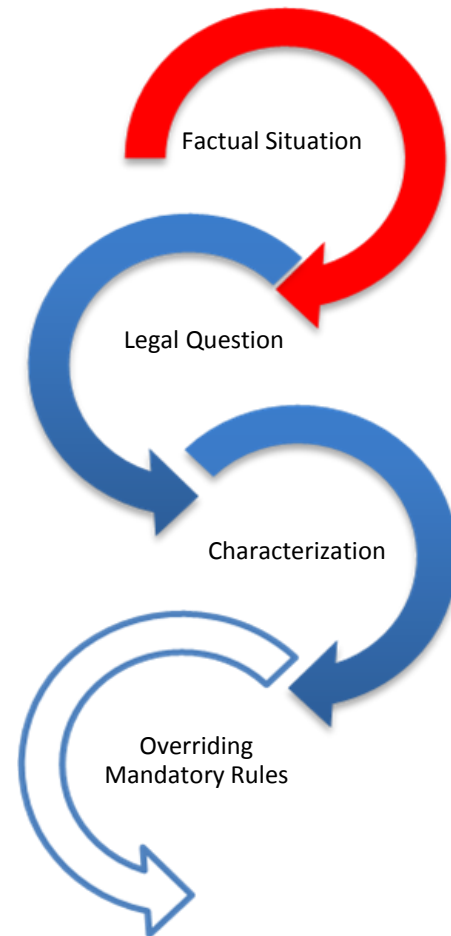
- Defendant must be served in accordance with the relevant rules.

Jurisdiction – Specificities in IP Cases

- Jurisdiction over infringement
- Jurisdiction over validity or registration
- Jurisdiction over contract

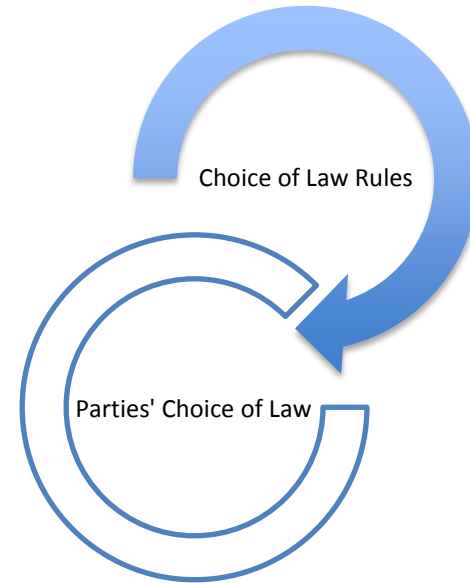
Ch. IV: Which Laws Does the Court Apply?

1. Translating the factual situation to a legal question
2. Choice of law characterization
3. Overriding mandatory rules and identification of choice of law rules



Ch. IV: Which Laws Does the Court Apply?

4. Parties' choice of law



Characterization = Copyright Law

Choice of Law Rules indicate the law of the creator's principal home as applicable

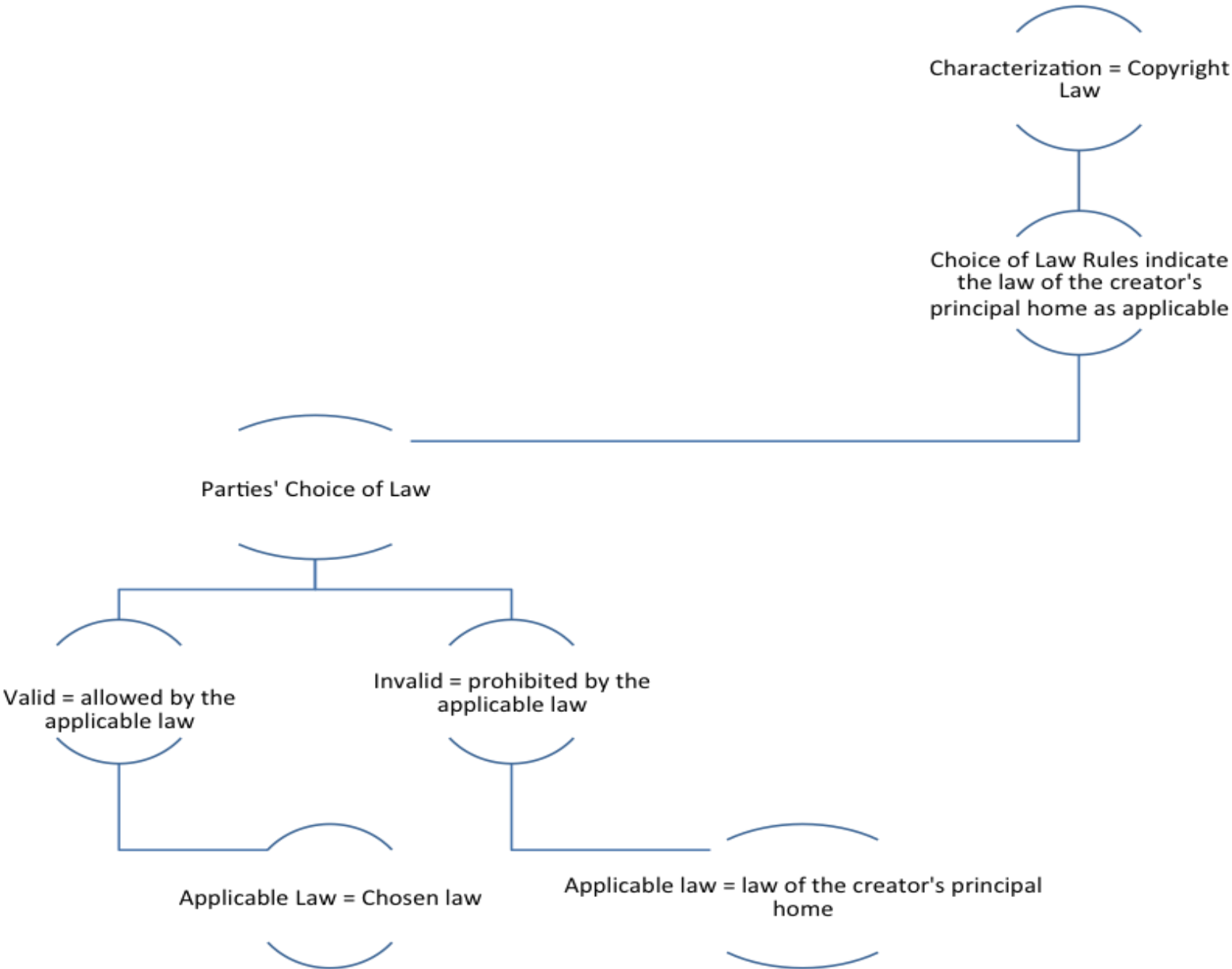
Parties' Choice of Law

Valid = allowed by the applicable law

Invalid = prohibited by the applicable law

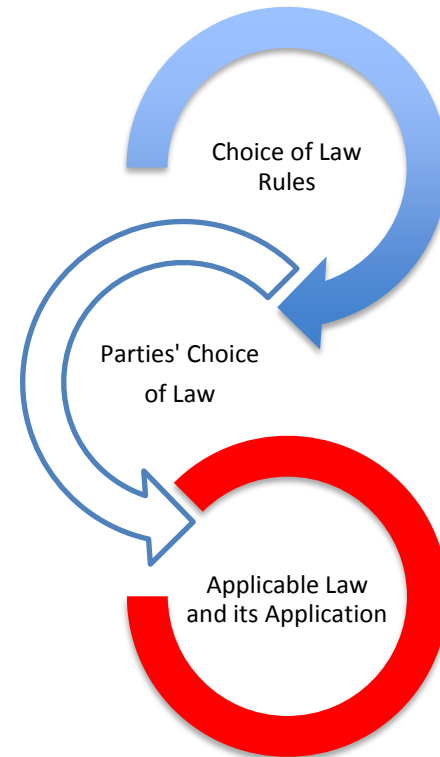
Applicable Law = Chosen law

Applicable law = law of the creator's principal home



Ch. IV: Which Laws Does the Court Apply?

5. Application of the applicable law



Issues in the application of PIL to IP regarding the applicable law

Ch. V: How can a Judgment Be Recognized and Enforced in Another State?

V. How Can a Judgment Be Recognized and Enforced in Another State?

Is my court bound by any international or regional instruments?

No

Yes

In the absence of an international or regional instrument, national rules will determine whether or not a foreign judgment may be recognized or enforced.

Rules on recognition or enforcement of that relevant instrument should be followed.

Does the judgment fulfill the requirements for the recognition or enforcement of the requested court?

No

Yes

Recognition or enforcement will be refused

Has the judgment met one of the grounds for refusal?

Yes

No

Recognition or enforcement will be executed

Ch. V: How can a Judgment Be Recognized and Enforced in Another State?

- Recognition and enforcement of foreign judgments
- Requirements for the recognition and enforcement
 - Reciprocity, including the statutory approach and registration of foreign judgments
 - Grounds for refusal
 - International or regional instruments

Ch. VI: Issues relating to administrative or judicial cooperation

- Collecting evidence abroad
- Admission of foreign documents
- Service of documents abroad
- Cooperation and coordination among courts