

Questionnaire 2

HCCH Judgments Project

Introduction

- 1) An important current project of the Hague Conference on Private International Law (**HCCH**) is the development of a convention on the recognition and enforcement of foreign judgments (**Convention**). This project is referred to as the **Judgments Project**. See [here](#).
- 2) In this questionnaire:
 - a) **judgment** refers, in accordance with art. 3(1)(b) Draft Convention, to “any decision on the merits given by a court, whatever that decision may be called, including a decree or order, and a determination of costs or expenses by the court (including an officer of the court), provided that the determination relates to a decision on the merits which may be recognised or enforced under this Convention. An interim measure of protection is not a judgment.”
 - b) **inter partes judgment** refers to a binding judgment between two or more parties that only binds the parties to that judgment, and does not affect rights *in rem*;
 - c) **in rem judgment** refers to a judgment which affects rights *in rem*, being rights against all, such as patent rights; and
 - d) **res judicata** includes the doctrines of claim and issue preclusion, claim and issue estoppel and any other doctrine which limits the ability of a party to bring new legal proceedings or re-litigate an issue.
- 3) The most recent text of the draft Convention (the **Draft Convention**) is the November 2017 text (the **November 2017 Draft Convention**), which can be found [here](#). Important intellectual property related issues in relation to the November 2017 Draft Convention include whether the Convention should:
 - a) apply to judgments that include only *inter partes* rulings regarding the validity or infringement of intellectual property;
 - b) apply to *in rem* judgments concerning intellectual property, e.g. an order to revoke a patent or an order to limit the claims of a patent;

- c) apply to court decisions only, or also to decisions from other bodies, e.g. an Intellectual Property Office;
 - d) apply just in relation to unregistered intellectual property rights and not registered intellectual property rights;
 - e) inasfar as a judgment rules on infringement, only apply to the extent it concerns monetary remedies (and costs);
 - f) mandate *res judicata* laws, such that issues which have already been finally determined in one court between certain parties cannot be re-litigated between the same parties in another court in the same jurisdiction or a different jurisdiction.
- 4) It is also relevant to note that the Draft Convention includes several provisions with more general relevance that are also relevant for intellectual property decisions, such as those addressing the situation in which a judgment can still be appealed (Article 4(4) of the Draft Convention) and those concerning costs (Article 16 of the Draft Convention). Also, as is clear from the above, the Draft Convention applies to merits decisions only (and not to interim measures of protection). See also Article 5(1)(f).
- 5) In October 2017, AIPPI circulated a first questionnaire (the **First Questionnaire**) based on the February 2017 text of the Draft Convention (the **February 2017 Draft Convention**), which can be found [here](#). The purpose of the First Questionnaire was to ascertain the view of AIPPI's National and Regional Groups (**Groups**) and Independent Members (**IMs**) as to the overall relevance of the Judgments Project. It also aimed to enable AIPPI to take a general position during the Third Meeting on the Special Commission on the Judgments Project, held on November 13-17, 2017, which AIPPI attended as an invited observer.
- 6) The summary report of the First Questionnaire can be found [here](#). The Groups that replied to the First Questionnaire were more or less split on the key question asked whether or not intellectual property rights should be included within the scope of the Convention at all. By reason of the short timeframe in which the First Questionnaire was conducted, some Groups and IMs were unable to respond at all, and others were only able to respond on a preliminary basis.
- 7) This questionnaire concerns the November 2017 Draft Convention (the **Second Questionnaire**). It aims to study the Draft Convention in more detail and give Groups and IMs the opportunity to reply per se and express their views in greater detail, if they so desire.
- 8) This Second Questionnaire has a special focus on the inclusion/exclusion of intellectual property within the scope of the Convention, and also addresses the issue of *res judicata* and its implications.

- 9) The HCCH will hold a further Special Committee Meeting on 24-29 May 2018, which AIPPI will also attend as an invited observer. At this meeting, the intellectual property related discussion is currently envisaged to be limited to "*decisions of competent authorities in relation to the validity of intellectual property rights*" (see Article 8(3) of the Draft Convention). A Diplomatic Conference will likely be held in 2019, during which the remaining intellectual property issues are expected to be discussed as well.
- 10) It is intended that (i) the information obtained from the Second Questionnaire will enable AIPPI to further develop a more detailed position in relation to the Judgments Project and (ii) AIPPI will be able to convey its findings at the Special Committee Meeting in May 2018 (at least in relation to the issue for discussion referred to at paragraph 9) above) and, in due course, at the Diplomatic Conference.
- 11) Further, it is intended that the Judgments Project will be the subject of a Resolution proposed for adoption at the 2018 AIPPI World Congress in Cancun (23-26 September 2018).
- 12) Articles 2(1)(m), 5(3)(a)-(c), 6(a), 7(1)(g), 8(3) and 11 of the November 2017 Draft Convention are particularly relevant to the issues in this Second Questionnaire.

Previous work of AIPPI

- 13) Jurisdiction as such is not part of the Draft Convention. The Draft Convention therefore does not lay down rules for determining which court has jurisdiction. Instead, the Draft Convention proceeds generally on the basis that the court issuing a judgment had jurisdiction to determine the issues before it. However, some Articles (e.g. 6(a)) do restrict the enforcement of judgments to those issued by certain courts only, which implicitly sets out jurisdictional rules that must be complied with for judgments to be enforceable.
- 14) In 2001, AIPPI provided input in relation to the Judgments Project, which primarily focused on jurisdiction and whether courts have jurisdiction to try the relevant issue(s). See the report of Special Committee Q153, [here](#), and the Resolution on Q153 – "Hague Conference on Private International Law" (Melbourne, 2001) (**Resolution Q153**), [here](#).
- 15) In Resolution Q153, AIPPI (i) noted that it has been unable to formulate a Resolution on exclusive jurisdiction in respect of industrial property rights required to be deposited or registered, and therefore (ii) recommended to exclude intellectual property matters from the substantive scope of the envisaged Convention and (iii) called on the Hague Conference on Private International Law to develop a specific protocol on intellectual property to be added to the envisaged Convention at a later point in time. It was envisaged that at a later time, AIPPI would formulate a position on exclusive jurisdiction in respect of industrial property rights required to be deposited or registered.

- 16) The question of exclusive jurisdiction in respect of industrial property rights required to be deposited or registered is touched on in Article 6(a) of the November 2017 Draft Convention. The questions below relating to Article 6(a) allow a further opportunity to progress the work commenced in connection with Resolution Q153.
- 17) It is not proposed at this stage to suggest the addition of a more comprehensive protocol addressing exclusive and non-exclusive jurisdiction to the Draft Convention, since AIPPI is an observer at the Hague Conference, with the primary focus of providing its views on proposals made by participating States.

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Questions

- 1) Relating to Article 2(1)(m) of the November 2017 Draft Convention:

“This Convention shall not apply to the following matters - ... [(m) intellectual property rights [and analogous matters].”

- a) Should any intellectual property rights be included in the scope of the Convention? Please explain why or why not.

It is difficult to answer the question with a simple YES or NO, due to the uncertainty regarding the scope of the decision and its enforcement in another Contracting State. Given the fact that IP rights are territorial rights and in many cases convey a different scope of protection (for example a patent, which has been redrafted and therefore gives a narrower protection in one country, compared to another; or simply because of differences in law, which grant a different scope of protection per se) we do NOT believe that IP rights should be included in the scope of the Convention. The possible negative effects seem to outweigh the positive effects.

Please answer Questions 1)b)-d) even if you have answered NO to Question 1)a) (you may e.g. have views on the definition anyway, for the event intellectual property rights would be included)

- b) Should intellectual property rights be included in the scope of the Convention, what should be included within the concept of “intellectual property”? For example, should the concept of "intellectual property" be limited to the "traditional" intellectual property rights, e.g. patents, designs, trademarks,

copyright? Alternatively, should the concept of "intellectual property" also include related rights, such as rights relating to trade secrets, rights arising from licences, unfair competition, etc.? Please explain and specify why or why not certain types of "intellectual property" should be included or excluded.

In case IP rights are included in the scope of the Convention, they should be limited to the traditional IP rights. The inclusion of "related rights" would cause even more uncertainty in view of the fact that laws around the world are even less harmonized with regard to such rights. Enforcing a decision from country A, which deals with a right, which is not protected, or protected in a different manner and with a different scope in country B would lead to more legal uncertainty, and possibly also to "forum shopping" and even circumventing the protection granted in one country by initiating actions in another.

- c) Do you think the wording "... and analogous matters" is clear enough? Please explain why or why not.

The wording is not very clear because the meaning of the term "analogous" directs to "something having analogy to something else". Again, different laws and jurisprudence around the world may interpret these "analogous" rights differently. A more precise wording is clearly needed.

- d) Please provide any proposals regarding the refinement of the wording of Article 2(1)(m) of the Draft Convention.

We propose the following wording of Article 2(1):
"intellectual property"

By using this wording and excluding the brackets it is made clear that all and any IP rights are excluded from the scope of the Convention. It may be advisable to use a definition in the final provisions of the Convention, in which it is explicitly stated that all IP related rights are included in this term.

- 2) Relating to Article 5(3)(a) of the November 2017 Draft Convention:

"Paragraph 1 does not apply to a judgment that ruled on an intellectual property right or an analogous right. Such a judgment is eligible for recognition and enforcement if one of the following requirements is met –

(a) the judgment ruled on an infringement in the State of origin of an intellectual property right required to be granted or registered and it was given by a court in the State in which the grant or registration of the right concerned has taken place or, under the terms of an international or regional instrument, is deemed to have taken place[, unless the defendant has not acted in that State to initiate or further the infringement, or their activity cannot reasonably be seen as having been targeted at that State;"]

- a) Should a judgment that ruled on the infringement of an intellectual property right required to be granted or registered only be eligible for recognition and enforcement if given by a court of the contracting state in which the

intellectual property right in question was granted or is registered? Please explain why or why not.

Yes, a judgment that ruled on an infringement of intellectual property right required to be granted or registered should be eligible for recognition and enforcement if it is given by a court of a contracting state, the law of which governs the right concerned.

Only the court of the Contracting state, the law of which governs the right in question is competent to interpret said law and apply it.

- b) Should there be an exclusion in the case where the defendant has not acted in that State or their activity cannot reasonably be seen as having been targeted at that State? Please explain why or why not.

No. This question should be for the competent court in the country of origin to interpret when dealing with the initial case/decision according to local law.

- c) Should there be an exclusion in the case of purely inter partes judgments? Please explain why or why not.

No. All matters relating to the matter should be dealt with only by the competent court in the country of origin according to local law without any exceptions.

- 3) Relating to Article 5(3)(b) of the November 2017 Draft Convention:

“Paragraph 1 does not apply to a judgment that ruled on an intellectual property right or an analogous right. Such a judgment is eligible for recognition and enforcement if one of the following requirements is met –

...

- (b) the judgment ruled on an infringement in the State of origin of a copyright or related right, an unregistered trademark or unregistered industrial design, and it was given by a court in the State for which protection was claimed [, unless the defendant has not acted in that State to initiate or further the infringement, or their activity cannot reasonably be seen as having been targeted at that State;”*

- a) Should a judgment that ruled on the infringement of a copyright or related rights, an unregistered trademark or unregistered industrial design, only be eligible for recognition and enforcement if given by a court in the State for which protection is claimed? Please explain why or why not.

Yes, a judgment that ruled on an infringement of a copyright or related right, unregistered trademark or unregistered industrial design should be eligible for recognition and enforcement if it is given by a court of a contracting state, the law of which governs the right concerned. We believe that, for example, the

law, which governs copyright ownership and provides copyright registration, would provide for different grounds for establishment of copyright infringement comparing to the law of another contracting state where copyright is not subject to registration.

Only the court of the Contracting state, the law of which governs the right in question is competent to interpret said law and apply it.

- b) Should there be an exclusion in the case were the defendant has not acted in that State or their activity cannot reasonably be seen as having been targeted at that State? Please explain why or why not.

No. This question should be for the competent court in the country of origin to interpret when dealing with the initial case/decision according to local law.

- c) Should there be a requirement that the infringement in question is actionable in both the State in which the judgment was issued, and in the State in which the judgment is sought to be enforced? Please explain why or why not.¹

No. All matters relating to the matter should be dealt with only by the competent court in the country of origin according to local law without any exceptions.

- 4) Relating to Article 5(3)(c) of the November 2017 Draft Convention:

“Paragraph 1 does not apply to a judgment that ruled on an intellectual property right or an analogous right. Such a judgment is eligible for recognition and enforcement if one of the following requirements is met –

...

(c) the judgment ruled on the validity[, subsistence or ownership] in the State of origin of a copyright or related right, an unregistered trademark or unregistered industrial design, and it was given by a court in the State for which protection was claimed.”

- a) Should a judgment that ruled on the validity, subsistence or ownership of a copyright or related right, an unregistered trademark or unregistered industrial design only be eligible for recognition and enforcement if given by a court in the State for which protection is claimed? Please explain why or why not.

¹ There has been a ‘double actionability’ requirement in the laws of some states. If, for example, the defendant commits acts in state A which amount to a tort in state A but is sued in state B for that tort, does the tort need to be an actionable tort in both states A and B or just in state A? This is especially relevant for territorial rights such as intellectual property rights. In relation to copyright infringement, this question arose in the UK case of *Pearce v Ove Arup Partnership Ltd* [2000] Ch 403, in which the Court of Appeal held that a claim in England for infringement of a Dutch copyright was permitted, and in New Zealand in *KK Sony Computer Entertainment v Van Veen* (2006) 71 IPR 179.

As indicated above we believe that the only competent court should be the court of the State the laws of which govern said rights.

- b) Should there be a requirement that the validity, subsistence or ownership referred to in Article 5(3)(c) is actionable in both the State in which the judgment was issued, and in the State in which the judgment is sought to be enforced? Please explain why or why not.

Such requirement would render the inclusion of this possibility to enforce the decision in another country either useless or too unreliable. This is also one of the reasons why we support not including IP rights in the scope of the Convention at all or, in case where they are included, support including only traditional IP rights.

- 5) See Article 6(a) of the November 2017 Draft Convention; and also Article 8(3) of the November 2017 Draft Convention:

- a) Should a judgment that ruled on the validity of an intellectual property right only be eligible for recognition and enforcement if given by a court of a contracting State in which grant or registration has taken place? Please explain why or why not.

Yes. Only these courts are competent to determine whether or not the respective intellectual property right is indeed valid or not. It should also be considered that in certain jurisdictions there is an administrative body (Patent office, Trademark office etc.), which is competent to rule on these questions.

- b) In your jurisdiction, does the word “validity” subsume “registration”? If not, are they related, and if so, how?

The term “validity” is not used in Bulgarian laws regarding IP matters. In order for a traditional IP right to be valid in Bulgaria, it needs to be registered. There is one exception, where a non-registered trademark gives certain rights to the merchant, who has been using it. The other exception is the non-registered Community Design.

- c) Should there be an exception in the case of purely inter partes validity judgments? For example, if validity is subsidiary to infringement and a finding regarding validity is only effective as between the parties in the infringement case, or if the validity judgment only acquires in rem effect once it has been fully appealed and becomes final. Please explain why or why not.

No, there should not be any exceptions. As pointed out above the only competent court should be the court of the State of origin.

- 6) Should a decision from a body other than a court, such as a branch of government or an Intellectual Property Office, in relation to an intellectual property right required to be granted or registered have the same status under Articles 5(3), 6(a) and 8(3) of the Draft Convention as decisions of a court

(particularly in view of the fact that it is not just courts that can revoke intellectual property rights, but e.g. also national and regional offices)? Please explain why or why not.

Yes. In certain jurisdictions, it is up to administrative bodies to take these decisions. They may or may not be appealable or appealed before a court, therefore they should have the same effect as if rendered by a court.

7) Relating to Article 8(3) of the November 2017 Draft Convention:

“However, in the case of a ruling on the validity of a right referred to in Article 6, paragraph (a), recognition or enforcement of a judgment may be postponed, or refused under the preceding paragraph, only where –

(a) that ruling is inconsistent with a judgment or a decision of a competent authority on that matter given in the State referred to in Article 6, paragraph (a); or

(b) proceedings concerning the validity of that right are pending in that State.

A refusal under sub-paragraph (b) does not prevent a subsequent application for recognition or enforcement of the judgment.”

a) Should the wording of Article 8(3) of the Draft Convention be adjusted, particularly in view of the fact that in intellectual property matters, it is not just courts that can e.g. revoke intellectual property rights (see also above)? Please explain why or why not.

b) Please provide any proposals regarding the refinement of the wording of Article 8(3) of the Draft Convention.

8) Should the application of a law other than the internal law of the State of origin of a judgment ruled on an infringement of an intellectual property right be a ground for refusal for recognition or enforcement? Please explain why or why not.

(see Article 7(1)(g) of the November 2017 Draft Convention)

In case the competent court in the State of origin rightfully applied a law other than the internal law of said State, this should not be grounds to refuse the recognition and enforcement of a judgement.

9) See Article 11 of the November 2017 Draft Convention:

a) Should the Convention only cover judgments ruling on an infringement to the extent that they rule on a monetary remedy in relation to harm suffered in the State of origin (in addition to the enforceability of a cost award, see Article 15 of the Draft Convention)? Please explain why or why not.

Yes, a judgement should only be recognized and enforced to the extent that it rules on a monetary remedy in relation to harm suffered in the State of origin.

- b) Do you agree with the reformulation of Article 11 (previously 12)? Please explain why or why not.

(see also Article 12 of the February 2017 Draft Convention)

Yes, we agree with the redrafted version of Article 11 (previously Article 12). The new wording makes it possible to enforce a decision to the extent that it deals with monetary remedy even if the decision itself deals with other remedies itself. The old drafting seems to exclude as a whole all decisions, which deal with other remedies as well, thereby making it impossible to enforce them even with regard to only monetary remedies.

- c) If you have answered NO to Question 9)b), how could the wording of Article 11 be refined? Please explain why or why not.
- 10) Should there be a rule, such as res judicata, to prevent the re-litigation of issues which have already been determined by the court of a State? Please explain why or why not.

Yes, there should be such a rule. Parties should not be able to re-litigate an issue, which has already been dealt with by a competent court.

- a) If YES, should the rule only apply between the same parties, and in relation to issues that have been finally determined with no possible appeals remaining?

Yes. The court decision needs to be final with no possible appeals remaining and this rule needs to apply to the same parties in relation to the same issue.

- b) If YES, should res judicata only apply in the case of in rem judgments, or also in the case of inter partes judgments? In particular, should a prior inter partes determination of validity prevent the later re-litigation of validity, e.g. if new prior art is found which is said to invalidate a patent?

Res judicata should apply to in rem judgements, as well as to inter partes judgements, however with regard to the latter it should only apply if the issue at hand is identical, between the same parties and based on the same grounds. In case of new grounds (such as new prior art) it should not apply.

- 11) To the extent not yet mentioned above (e.g in your reply to question 1) above) do you have concerns in relation to res judicata rules possibly being applicable (e.g. through national laws) should intellectual property be included within the scope of the Draft Convention? Please explain your concerns and potential ways to address those.

Given the fact that only the court in the State of origin is competent to rule on infringements in this state it is difficult to imagine a situation where res judicata might be an issue when enforcing the decision only with regard to

monetary remedies in a different Member State. Even if there is a decision in the Member State where the decision is to be enforced between the same parties on the same issue (e.g. infringement of the “same” patent), the issue at hand would actually not be the same as patent rights are territorial, infringements are to be dealt with by the national laws of each state and the only competent court is the one in the respective Member State.

- 12) Do you have any other comments (including wording suggestions) in relation to the intellectual property related aspects of the Draft Convention?

Should it be decided that IP rights are to be included in the scope of the Convention it seems reasonable that some Articles would need to be redrafted. Nevertheless we firmly believe that IP rights should not be included in the scope of the Convention, or if included decisions should only be enforceable with regard to the monetary remedies awarded in the Country of origin with regard to the infringement of an IP right in said country.

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