



Report Q224

Committee on Enforcement

Names and Functions of Committee Members

Chairman	Janusz Fiolka	(Poland)
Co-Chairman	Kenneth Adamo	(USA)
Secretary	Andrea Giussani	(Italy)
Members	Mary Padbury	(Australia)
	Carlos Pérez de la Sierra	(Mexico)
	Wouter Pors	(Netherland)
	Reiko Ito	(Japan)
	Gustavo de Freitas Morais	(Brazil)
	Cornelis Schüller	(Switzerland)
	Anton Koval	(Ukraine)
	Christina Berggren	(Sweden)
Christof Augenstein	(Germany)	
Responsible Reporter	Sara Ulfsdotter	(Sweden)

A. Report for EXCO / Forum Helsinki 2013

2. Summary

- 2.1. The Q224 *Enforcement* Committee is consolidating its work on the report regarding the application of provisions of Convention Abolishing the Requirement of Legalization for Foreign Public Documents (Concluded 5 October 1961 in Hague) to the enforcement of IP rights in foreign countries. SC Q224 is also representing AIPPI in the meetings of WIPO Advisory Committee on Enforcement, which are held in Geneva. From up today discussions it is emerging that AIPPI should recommend point of view that in process of enforcement of IP rights in foreign countries the presenting original of Power of Attorney should not be required. Also the owner of IP rights should not be forced to present to the court excerpt from company register indicating that the person, who signed POA was in legal capacity to represent the company.

2.2. Current and future issues

The Q224 Enforcement is studying the question of application of provisions of Convention Abolishing the Requirement of Legalization for Foreign Public Documents (Concluded 5 October 1961 in Hague) to the enforcement of IP rights in foreign countries. The working problem is to what extent the *Apostille* and other formalities are required to start IP infringement/enforcement proceedings in foreign country. Another interesting questions are: composition of court, qualification of judges especially in technical aspects of the case. Last but not the least the Committee should perhaps in the future look closer to the proceedings regulating execution of Court decisions on IP infringement in foreign countries especially in less developed countries, where some serious problems are emerging.

The text of the Hague Convention can be found on the following web page:
http://www.hcch.net/index_en.php?act=conventions.text&cid=41

The SC Q224 is observing developments regarding enforcement such as activities of *Observatory on IP Infringement* in OHIM, works of *WIPO Advisory Committee on Enforcement*, EUROPEAN COMMISSION Directorate General Internal Market and Services *public consultation on the efficiency of proceedings and accessibility of measures regarding Civil enforcement of intellectual property rights*.

2.3. Action recommended

The SC Q224 will held its next meeting during ExCo in Helsinki, where detailed programme of future work will be discussed. The SC Q224 should participate in the Consultation on Rules of Procedure of the Unified Patent Court (UPC) to which AIPPI was invited. The Members of SC Q224 are ready to organize Webinar, when such possibility will emerge in AIPPI.

3. Introduction

Enforcement of intellectual property rights in foreign countries extend beyond traditional understanding of intellectual property based on Paris and Berne conventions and conventions and treaties which emerged from these conventions, like PCT, TRIPS, EPC and so on. Enforcement goes deep into civil court procedure related with international enforcement proceedings. Many problems within this sphere were regulated in different conventions belonging to area of private international law, in which there are many relevant conventions regulating international legal co-operation and litigation, jurisdiction and enforcement of judgement. These conventions were concluded under auspices of the Hague Conference on Private International Law, an intergovernmental organisation.

One of these convention is Convention Abolishing the Requirement of Legalization for Foreign Public Documents (Concluded 5 October 1961 in Hague). This Convention has 102 contracting states.

To start IP infringement/enforcement procedures in a foreign country a company is usually required to hire legal representative (attorney at law or patent attorney), who should present at court power of attorney and extract from commercial register or other register evidencing that the person who signed power of attorney has the right to represent that company. As the Convention applies to public documents than extract from company register should be with *Apostille*.

Lack of proper power of attorney may result in some countries, like for instance Italy, or Poland, in nullifying whole proceedings. So the Committee should investigate what

is the current practice in different countries regarding power of attorney and what can be recommended to harmonize and simplify the enforcement proceedings of IP rights in foreign countries.

Future issues, which should investigate the Committee are perhaps what the evidence of infringement of IP rights, especially evidence collected from internet. In this respect the question is how this evidence should be presented and what legal value such evidence should have.

4. Report of Committee's activities

The SC Q224 is working on its report and hopefully this report will be discussed during the Helsinki ExCo meeting.

The main topic of the Q224 work, namely obligation for presenting POA and excerpt from register of given party stamp with Apostille was discussed within the SC Q224. It appeared that in most countries, like the United States, Sweden, Germany and the Netherlands an attorney representing the party in court is not required to have written POA. In some other countries like Poland, and Ukraine such document is required and lack of proper POA document may result in declaration that proceeding were null and void. So the regulation and practice in this respect is divided and should be harmonized.

Member of the SC Q224 Wouter Pors informed that he was nominated to the Trade Secrets Commission of the Dutch Group of AIPPI and sent us a very interesting Report on Trade Secrets for the European Commission prepared by Hogan Lovells International LLP ordered by European Commission. This report shows that it is not certain if EU *Enforcement Directive applies to Trade Secrets*. He has informed that the European Commission had commissioned a new survey, which is carried out by Baker McKenzie. The Commission needs to decide in due course whether the protection of trade secrets should be incorporated in the update of the Enforcement Directive, since they are in TRIPs.

In the discussion it was agreed that Q224 is interested in organizing open Webinars, when such possibility will emerge. Also it is possible to organize meeting of the Q224 in some locations in the intervals between AIPPI Congresses and Forums. Details will be discussed.

On behalf of the Committee on Enforcement:

Dr. Janusz Fiolka, Chair of the Committee