



Report Q224

Enforcement

by Dr. Janusz Fiolka, Chairman

Names and Functions of Committee Members

Chairman	Janusz Fiolka	(Poland)
Co-Chairman	Ken Adamo	(USA)
Secretary	Andrea Giussani	(Italy)
Members	Mary Padbury Wouter Pours Reiko Ito Anton Koval Christina Berggren Gustavo de Freitas Moras Cornelis Schöller	(Australia) (The Netherlands) (Japan) (Ukraine) (Sweden) (Brazil) (Switzerland)
Responsible Reporter	John Osha	(United States of America)

A. Report for EXCO / Forum Hyderabad 2011

2. Summary

- 2.1. The Q224 *Enforcement* Committee is *in statu nascendi*. The Chairman was nominated in June 2011, and the additional members have only recently been approved by the Bureau.
- 2.2. Current and future issues
The Q224 Enforcement will initially address 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 a foreign country. Other 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

2.3. Action recommended

The Bureau should define and approve the Mandate of the Q224 Committee, including co-ordination of the activities of Q224 Enforcement with those of Q165 *Optional protocol of the EPC with regard to Litigation concerning European and Community Patents* chaired by Dr. Jochen Pagenberg. Both Committees to some extent deal with similar problems, but perhaps on different geographical platforms.

3. Introduction

Q224 *Enforcement* replaces previous Q185 *Enforcement of IP Rights*. The mandate of Q185 was limited to the EU, which was not practical, as most of the enforcement problems do not only emerge on a EU level. That is why new Q224 Committee was created and its name was changed to *Enforcement*.

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, including PCT, TRIPS, and EPC, among others. 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 conventions is the 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 by a company usually requires hiring a legal representative (attorney at law or patent attorney), who should present at court a power of attorney and extract from the commercial register or other register evidencing that the person who signed the power of attorney has the right to represent that company. As the Convention applies to public documents than extract from company register should be apostilled.

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

Future issues, which should be investigated by the Committee are perhaps 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 Chairman of the Committee since its nomination has participated in many international events regarding the scope of the activity of the Committee, such as two

meetings in Munich, namely the Max Planck Alumni Meeting and the conference *The National Patent Jurisdiction in Europe* organized by the German Federal Patent Court to commemorate the 50th Anniversary of its Foundation. The Chairman also established working contacts with government officials, who are responsible for works on intellectual property during the Polish Presidency in EU. In this respect on 23 September 2011 in Warsaw the Polish Ministry of Economy and Academy of European Law organized in the framework of the Polish EU Presidency the conference on "*The future unified patent litigation system in the European Union*". The conference shall provide the platform for discussion on the new draft agreement on a Unified Patent Court presented by the Hungarian Presidency on 14 June 2011. The aim of the conference is to analyse how the issues raised by the Court of Justice of EU in its Opinion 1/09 on the previous version of the agreement regarding compatibility with EU law should be addressed, as well as to promote an exchange of views between courts and practitioners on the functioning of the European Patent Court. The Chairman took part in this conference.