Intellectual property and private international law heading for the future

Josef Drexl and Annette Kur (editors).



Studies in Industrial Property and Copyright Law

Josef Drexl and Annette Kur (editors)

Intellectual Property and Private International Law – Heading for the Future

### Hart Publishing Oxford and Portland, Oregon

Published in North America (US and Canada) by Hart Publishing c/o International Specialized Book Services 5804 NE Hassalo Street Portland, Oregon 97213-3644 USA

#### © Hart Publishing 2005

The authors and editors have asserted their right under the Copyright, Designs and Patents Act 1988, to be identified as the authors of this work

Hart Publishing is a specialist legal publisher based in Oxford, England.

To order further copies of this book or to request a list of other publications please write to:

Hart Publishing, Salter's Boatyard, Folly Bridge,
Abingdon Road, Oxford OX1 4LB
Telephone: +44 (0)1865 245533 or Fax: +44 (0)1865 794882
e-mail: mail@hartpub.co.uk
WEBSITE: http://www.hartpub.co.uk

British Library Cataloguing in Publication Data
Data Available
ISBN 1-84113-539-9 (paperback)

Typeset by Hope Services (Abingdon) Ltd.

Printed and bound in Great Britain on acid-free paper by

Page Bros Ltd

#### **Preface**

The relationship between intellectual property and private international law, fascinating and multi-faceted as it may be, is loaded with a peculiar tension. Both fields have similar features; they are markedly different from general civil law and civil procedural law, and each of them has become the domain of specialists cultivating their own terminology and patterns of thinking. Both are also inherently international. While this is obvious in the case of private international law, it also applies to intellectual property, which, on account of its ubiquity and the problems resulting therefrom with regard to protection of rights in foreign countries, has always figured among those legal areas where international protection systems and multilateral harmonisation efforts have been considered as factors of key importance.

Whereas the existence of conflicts ensuing from the unauthorised use of protected subject-matter abroad has always been witness to the fact that an area of common interest exists between private international law and intellectual property, the relationship between the two fields has long been tense, or was even neglected. This is due not least to the high degree of specialisation referred to above; it is not easy for the specialists in each field to communicate with each other in a language that is precise and sophisticated enough to express the relevant nuances, yet at the same time is understandable to both sides. Nevertheless, in view of the exponential increase in conflicts involving trans-border elements that have arisen in a world characterised by global trade and borderless communication structures, it has become essential to enhance one's ability to understand and employ the other discipline's tools and structures, not least with a view to probing their appropriateness for mastering the challenges of the future.

The meeting arranged under the title Jurisdiction and Choice of Law in Intellectual Property Matters—Perspectives for the Future (Europe and World-Wide) in July 2003 by the Max Planck Institute for Intellectual Property, Competition and Tax Law, of which the contributions compiled in this volume are the fruit, represents one of the many steps that have to be taken on the long journey towards a better understanding between private international law and intellectual property, with the ultimate aim to devise a future system of international and regional jurisdiction and applicable law that is better adapted to the increasingly supranational character of exploitation and conflicts of rights than are traditional schemes. Among other things, the meeting marked the culmination of a project concerned with the elaboration of draft provisions on jurisdiction and enforcement of foreign judgements in intellectual property matters that had been conducted at the Max Planck Institute since spring 2001. The solutions endorsed by the Max Planck working group were presented and discussed

at the meeting, the topic being complemented by information on the activities by the Hague Conference for Private International Law as well as on the jurisdiction chapter in the project adopted in 2001 by the American Law Institute. As jurisdiction cannot be regulated properly in an international context without addressing choice-of-law issues, the perspectives for development of international rules in the latter field featured as another focal point in the meeting. Framed by these two elements—international jurisdiction on the one hand and perspectives for harmonised choice of law rules in an international context on the other—specific European themes were addressed, namely, jurisdiction, the establishment of a European judiciary in the patent field and its potential relevance for IP in general, the relationship between regional (European) systems and an international jurisdiction convention, and, in the context of choice-of-law issues, the recent proposal for a Regulation on applicable law in non-contractual relationships (Rome II). Furthermore, in order to underline the international perspectives, a special contribution was dedicated to recent developments

In the one year that has passed since the meeting, things have developed further, without a breakthrough having been achieved in any of the areas treated in this volume. The authors have to some extent been able to update their written papers, which, however, still reflect the views presented and the thoughts discussed during the lively and most animated sessions that took place in the beautiful surroundings and inspiring atmosphere of the convent of Frauenwörth on the island of Frauenchiemsee in Bavaria.

Josef Drexl Annette Kur Munich August 2004

#### **Abbreviations**

(7th, 9th) Cir. Court of Appeal for the (7th, 9th) Circuit

AJP Aktuelle Juristische Praxis

ALAI Association Littéraire et Artistique Internationale

ALI American Law Institute
All E.R. All England Law Reports

AMI Tijdschrift voor Auteurs- Media en

Inforamtierecht

Art. Article

Aw Auteurswet 1912 (Dutch Copyright Act)

BB Betriebs-Berater

BC Berne Convention on the Protection of Literary

and Artistic Works

Berk. J. Int'l Law Berkeley Journal of International Law

BGB Bürgerliches Gesetzbuch (German Civil Code)

BGH Bundesgerichtshof

BMM bulletin Bulletin van de Beneluxvereniging voor Merken-

en Modellenrecht

BNA Bureau of National Affairs
BT-Drs. Bundestags-Drucksache

BYIL British Yearbook of International Law

CA Cour d'Appel/Court of Appeal

Cal.L.Rev. Californian Law Review

Case W.Res.J.Int'l L Case Western Reserve Journal of International

Law

Cass. Cour de Cassation

Cass.Civ. Arrêt de la Chambre civil de la Cour de Cassation

cf. confer chambre

Ch.D. High Court, Chancery Division

Chicago-Kent L.Rev. Chicago-Kent Law Review

cl. clause

Colum. J. L. & Arts Columbia Journal of Law and the Arts (since

2001)

Colum.-VLA J.L. Columbia Journal of Law and the Arts (until 2001)

& Arts

COM EU Commission documents
CPC Community Patent Court

CR Computer und Recht

CRi Computer Law Review International

<b>x</b>	Abbreviations				
CTMR	Community Trademark Regulation				
CRCP	(Proposal for a) Council Regulation on the				
	Community Patent				
DGD	Dreyfuss/Ginsburg Draft (Draft Convention on				
	Jurisdiction and Recognition of Judgments in				
	Intellectual Property Matters)				
DHCC	Draft Hague Choice of Court Convention				
DHJC	Draft Hague Jurisdiction Convention				
Doc.	Document				
Dw	Databankenwet 1999 (Dutch Database Act 1999)				
E.g.	for example				
EC	European Community, (Maastricht) Treaty estab-				
	lishing the European Community				
ECHR	European Convention on Human Rights				
ECJ	European Court of Justice				
ECR,	Reports of Cases decided by the European Court				
_	of Justice				
ed., eds.	editor, editors				
EEC	European Economic Community				
EFTA	European Free Trade Area				
EGBGB	Einführungsgesetz zum Bürgerlichen Gesetzbuch				
	(Introductory Act to the German Civil				
	Code)				
Einl.MarkenG	Einleitung zum Markengesetz				
E.I.P.R.	European Intellectual Property Review				
EPA, EPO	Europäisches Patentamt, European Patent				
	Organisation				
FDC	E				

EPC European Patent Convention EPJ European Patent Judiciary

EPLA European Patent Litigation Agreement

et seq. and others and following

EuGVÜ Europäisches Gerichtsstands- und

Vollstreckungsübereinkommen in Zivil- und

Handelssachen (Brussels Convention)

EuZW Europäische Zeitschrift für Wirtschaftsrecht

F (2d, 3d) Federal Reporter (2nd, 3rd series)
F.Supp. Federal Reporter, Supplement

Fordham Int'l Intell. Fordham International Intellectual Property Law

Prop.L. & Pol'y and Policy

F.S.R. Fleet Street Reports

GRUR Int. Gewerblicher Rechtsschutz und Urheberecht,

Internationaler Teil

GRUR Gewerblicher Rechtsschutz und Urheberrecht

**ICANN** Internet Corporation for Assigned Names and Numbers i.e. that is IIC International Review of Industrial Property and Copyright Int'l IP International Intellectual Property IPL International Public Law **IPQ** Intellectual Property Quarterly **IPR** Internationales Privatrecht (Private International Law) **IPR** Intellectual Property Rights **IPRax** Praxis des internationalen Privat- und Verfahrensrechts ITInformation Technology **IZPR** Internationales Zivilprozessrecht (International Law of Civil Procedure) **ICP** Juris Classeur Périodique IDI Iournal du Droit International J.Int'l.Arb. Journal of International Arbitration TWIP ' Journal of World Intellectual Property IZ**Juristenzeitung** Law & Contemp. Law and Contemporary Problems Probs. L.Ed. Lawyer's Edition lit. littera LugÜ Lugano-Übereinkommen (Lugano Agreement) Mich.J.Int.L. Michigan Journal of International Law Mitt. Mitteilungen der deutschen Patentanwälte MMR Multimedia und Recht N.D. III United States District Court Northern District of NIW Neue Juristische Wochenschrift no. number footnote note OJ EC Official Journal of the European Communities (L or C series) op.cit. pre-cited Or.L.Rev. Oregon Law Review page, pages p., pp. paragraph para.

PCT Patent Cooperation Treaty PIL Private International Law Prel.Doc. Preliminary Document

point pt.

Rabels Z Rabels Zeitschrift für ausländisches und

internationales Privatrecht

Rev.cr.dr.int.pr. Revue critique du droit international privé
RIDA Revue internationale du droit d'auteur

R.P.C. Reports of Patent, Design and Trade Mark Cases

SCT WIPO Standing Committee on the Law of

Trademarks, Industrial Designs and Geographical

Indications

S.Ct. Supreme Court

Sec. Section

sic! Zeitschrift für Immaterialgüter-, Informations-

und Wettbewerbsrecht

SJ La Semaine Judiciaire

SJZ Schweizer Juristen-Zeitung

SZW Schweizerische Zeitschrift für Wirtschaftsrecht
SZIER Schweizerische Zeitschrift für Internationales und

Europäisches Recht

TDG Teledienstleistungsgesetz (German Act on

telecommunication services)

TRIPS Trade Related Aspects of Intellectual Property

Rights

UFITA Archiv für Urheber-, Film-, Funk- und

Theaterrecht

U.Ill.L.Rev. University of Illinois Law Review

U.S.C. United States Code

U.S.P.Q United States Patent Law Quarterly

UNIDROIT International Institute for the Unification of

Private Law

USPTO United States Patents and Trademarks Office

v. versus

Va.J.Int'l.L. Virginia Journal of International Law

Vol. Volume

WIPO World Intellectual Property Organisation

WIPR World Intellectual Property Review W.L.R. Weekly Law Reports

WM Wertpapier Mitteilungen

WPNR Weekblad voor Privatrecht, Notariaat en

Registratie

WRP Wettbewerb in Recht und Praxis

ZEuP Zeitschrift für Europäisches Privatrecht
ZUM Zeitschrift für Urheber- und Medienrecht

ZVglRWiss Zeitschrift für Vergleichende Rechtswissenschaft

ZZP Zeitschrift für Zivilprozess

## Contents

II. European	Issues
--------------	--------

The Proposed Rome II Regulation: European Choice of Law in the Field of Intellectual Property Josef Drexl
Comments: The Rome II Regulation Proposal and its Relation to the European Country-of-Origin Principle Matthias Leistner 177
Choice-of-Law Rules in the EU - Special Issues with Respect to Community Rights - Infringement of Community Trade Marks and Applicable Law Eike Schaper
Community Rights & Conflict of Laws: Community Trademark, Community Design, Community Patent – Applicable Law for Claims of Damages Axel Metzger
III. International Issues
Recent Judgments in Japan on Intellectual Property Rights, Conflict of Laws and International Jurisdiction Toshiyuki Kono
Choice of Law in the Digital Environment – Problems and Possible Solutions Ansgar Ohly
The Joint Recommendation Concerning Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet Johannes Christian Wichard
Who Decides on the Colours of Films on the Internet? Drafting of Choice-of-Law Rules for the Determination of Initial Ownership of Film Works vis-à-vis Global Acts of Exploitation on the Internet Dorothee Thum
Alternatives to the lex protectionis as the Choice-of-Law Rule for Initial Ownership of Copyright Mireille van Eechoud
Annex
I. General Directions       .308         II. The MPI Proposal       .309         III. The Hague Conference Project       .335         a) Draft Hague Jurisdiction Convention, 1999       .335         b) Relevant Articles of the Summary of the Outcome of the
Discussion in Commission I of the First Part of the Diplomatic  Conference 6–20 June 2001
V. The Proposed Rome II Regulation

# **Part One**Jurisdiction

•		 

# The Proposed Hague Convention



# The Hague Conference Project for a Global Convention on Jurisdiction, Recognition and Enforcement in Civil and Commercial Matters – An Update\*

Andrea Schulz\*\*

# I. The History of the Hague Judgments Project

Following some preparatory work which had been carried out within the framework of the Hague Conference on Private International Law between 1992 and 1996,<sup>1</sup> the Member States represented at the Diplomatic Conference that concluded the Eighteenth Session of the Conference in 1996 decided "to include in the Agenda of the Nineteenth Session the question of jurisdiction, and recognition and enforcement of foreign judgments in civil and commercial matters".<sup>2</sup>

In accordance with this decision, the Permanent Bureau of the Hague Conference established a Special Commission, which held five meetings of one or more weeks between June 1997 and October 1999. At the meeting in October 1999, which was supposed to be the last meeting of the Special Commission,<sup>3</sup> a "Preliminary Draft Convention<sup>4</sup> on Jurisdiction and

- \* This article is based on the paper given at the workshop organised by the Max Planck Institute for Intellectual Property, Competition and Tax Law at Frauenchiemsee on 20-22 July 2003. It takes into account subsequent developments up to 30 September 2003.
- \*\* Dr.iur., LLM, since 1 January 2002 First Secretary at the Hague Conference on Private International Law and responsible for the Judgments Project. Between 1998 and 2001, the author (then working with the German Federal Ministry of Justice in the sections on private international law (PIL) (until June 1999) and copyright (from June 1999 until December 2002)) was a member of the German delegation to the Hague negotiations on the Judgments Project. She can be reached at as@hcch.nl.
- <sup>1</sup> For further details, see Nygh & Pocar, Report on the Preliminary Draft Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters adopted by the Special Commission, Hague Conference (HC) Prel.Doc. No. 11, at 25 et seq. (also available at www.hcch.net under "Work in Progress"). Whenever reference is made to the website of the Hague Conference in this paper, only the top-level address will be indicated due to current changes in the Hague Conference website format that may affect the location of individual documents.
- <sup>2</sup> Final Act of the Eighteenth Session, Part B, No. 1. Hague Conference on private international law, Proceedings of the Eighteenth Session, Tome I, 1999, p. 47.
- <sup>3</sup> According to the working methods of the Hague Conference, each session lasts roughly four years and is concluded by a Diplomatic Conference, which normally adopts (1) the main elements of the work programme for the four years to follow, in particular the next convention project, and (2) the text of a "Draft Convention", which has been elaborated by a Special Commission during the four years preceding the Diplomatic Conference.

Foreign Judgments in Civil and Commercial Matters"<sup>5</sup> was adopted. This was done by vote on the individual provisions, as provided by the Rules of Procedure of the Hague Conference.

Both the structure and the content of the text adopted in 1999 very much resembled the Brussels Convention of 27 September 1968 on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters<sup>6</sup> and the Lugarno Convention of 16 September 1988 on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters.7 The text contained rules on jurisdiction as well as on the recognition and enforcement of judgments rendered on the basis of Convention-based jurisdiction in a Contracting State. The chapter on jurisdiction provided for a general defendant's forum (in the defendant's state of habitual residence; Art. 3), where all actions against a particular defendant could be brought, as long as they fell within the scope of the Convention (Art. 1) and were not subject to exclusive jurisdiction under the Convention. Equally open to all actions, independent of the subject matter, were for based on a choice-of-court agreement (Art. 4), on appearance and submission by the defendant (Art. 5). on a joinder of actions against multiple defendants (Art. 14), counter-claims (Art. 15) and third party claims (Art. 16). In addition, there were rules on specific jurisdiction for certain subject matters - some exclusive (Art. 12), but most of them not (Arts. 6-11).

As far as intellectual property rights are concerned, Art. 12(4)–(6) provided as follows:

<sup>&</sup>lt;sup>4</sup> The Special Commission constituted for each project will normally end its work about one to one-and-a-half years before the envisaged date of the Diplomatic Conference with the adoption of a "Preliminary Draft Convention", thereby leaving time for consultations on the text in the Member States of the Conference and other states participating in the negotiations. The final text then adopted during the Diplomatic Conference, as mentioned above, is called "Draft Convention" as long as it has not been signed by any state entitled to do so. Normally, the Draft Convention is opened for signature on the closing day of the Diplomatic Conference, when the Final Act is signed by all delegations and the text thereby approved as being the result of their negotiations. The first signature by a state entitled to do so then promotes the "Draft Convention" to a "Convention" which will subsequently bear the date of the first signature.

<sup>&</sup>lt;sup>5</sup> The text of the Preliminary Draft Convention and its Explanatory Report by Nygh (Australia) & Pocar (Italy) have been published in HC Prel.Doc. No. 11 (supra note 1).

<sup>&</sup>lt;sup>6</sup> OJ EC 1998 No. C 27/1. On 1 March 2002, the Brussels Convention was replaced by Regulation (EC) No. 44/2001 on Jurisdiction and the Recognition and Enforcement of Judgments in Civil and Commercial Matters of 22 December 2000 (OJ EC 2001 L 12/1) (the Brussels I Regulation) for 14 of the 15 EU Member States. The Convention is, however, still in force between the 14 EU Member States, now bound by the Regulation, and Denmark. In this paper, the Conventions of Brussels and Lugano, together with the Brussels I Regulation, will be referred to as "the European instruments".

<sup>&</sup>lt;sup>7</sup> OJ EC 1988 L 319/9.