

STUDIES IN PRIVATE INTERNATIONAL LAW

INTELLECTUAL
PROPERTY
AND PRIVATE
INTERNATIONAL
LAW

Comparative Perspectives

Edited by
Toshiyuki Kono



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INTELLECTUAL PROPERTY AND PRIVATE INTERNATIONAL LAW

Intellectual property and private international law was one of the subjects discussed at the 18th International Congress of Comparative Law held in Washington (July 2010). This volume contains the General Report and 20 National Reports covering Canada, the United States, Japan, Korea, India and a number of European countries (Austria, France, Germany, the United Kingdom, Spain etc). The General Report was prepared on the basis of the National Reports.

The national reporters not only describe the existing legal framework, but also provide answers for up to 12 hypothetical cases concerning international jurisdiction, choice-of-law, and recognition and enforcement of foreign judgments in multi-state IP disputes. Based on their answers, the main differences between legal systems as well as the shortcomings of the cross-border enforcement of IP rights are outlined in the General Report.

The Reports in this volume analyse relevant court decisions as well as recent legislative proposals (such as the ALI, CLIP, Transparency, Waseda and Korean Principles). This book is therefore a significant contribution to the existing debate in the field and will be a valuable source of reference in shaping future developments in the cross-border enforcement of IP rights in a global context.

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SERIES EDITORS' PREFACE

The relationship between intellectual property and private international law has attracted attention amongst academics, legislators and practitioners around the world in recent years. The problems which can arise in this field can be very challenging, given the complex interaction between principles of property law, contract and tort law and the traditionally territorial nature of disputes relating to intellectual property rights. They can be especially acute where it is necessary to reconcile national traditions and the approaches to be taken in interpreting and applying international conventions and regulations; and, of course, the advent of new forms of technology tends to de-localise the focus on the location of property rights and the occurrence of events.

Against this background, this book offers a valuable and timely resource. It contains the General and National Reports arising from the 18th International Congress of Comparative Law. As such, rather than focusing on one, or a small number of legal systems, it offers a comparative law perspective on a range of core issues spanning more than 20 countries across North America, Europe (include both EU and non-EU states) and Asia. These states have divergent legal traditions and, often, widely divergent legal rules for regulating the private international law aspects of intellectual property. The reports, authored by experts in the various legal systems, explain the legal regimes in force in those jurisdictions and relevant case law based on a questionnaire which sought information on the national legal rules and international instruments to which the State in question was party. Respondents were also asked to consider a number of hypothetical case studies. The authors were asked to explain the position in respect of copyrights, patents, trademarks and other intellectual property rights. In this way, and under the skilled editorship of Professor Toshiyuki Kono, a renowned expert in this field, the reader is able to see clearly the differences between the various regimes, both in theory and in practice.

The topics covered in this book range from issues of personal and subject-matter jurisdiction to provisional and protective measures; from contractual rights (including those created in the course of employment) to the law applicable to the creation and transfer of intellectual property rights and their infringement; and from the problems raised by parallel and concurrent proceedings to the recognition and enforcement of foreign judgments. Along the way, provisions considered include the CLIP proposals, the ALI Principles, the reform of the Brussels I Regulation and the potential impact of the Hague Choice of Court Convention, as well as recent national reforms in various jurisdictions, including Japan. The book begins with a fascinating, detailed and rigorous general report which skilfully reviews the law in these various jurisdictions, analyses the results of the questionnaires and provides an invaluable resource for understanding the application of the law in this field at both national and international levels and for reflecting upon its possible reform.

We believe that *Intellectual Property and Private International Law* makes a very important contribution to comparative law learning in the field and are delighted to welcome it to the *Studies in Private International Law* series.

Paul Beaumont (University of Aberdeen)
Jonathan Harris (King's College, London)

CONTENTS

Series Editors' Preface	v
General Report	1
<i>Toshiyuki Kono and Paulius Jurčys</i>	
Austria	217
<i>Thomas Petz</i>	
Belgium	347
<i>Marie-Christine Janssens</i>	
Canada	425
<i>Joost Blom</i>	
Croatia	477
<i>Ivana Kunda</i>	
France	525
<i>Marie-Elodie Ancel</i>	
Germany	581
<i>Axel Metzger</i>	
Greece	619
<i>Anastasia Grammaticaki-Alexiou and Tatiana Synodinou</i>	
Hungary	637
<i>Levente Tattay</i>	
India	681
<i>Vandana Singh</i>	
Italy	707
<i>Nerina Boschiero and Benedetta Ubertazzi</i>	
Japan	763
<i>Dai Yokomizo</i>	
Korea	793
<i>Gyoocho Lee</i>	
Netherlands	851
<i>Dick van Engelen</i>	
Portugal	877
<i>Alexandre Dias Pereira</i>	

Slovenia	941
<i>Damjan Možina</i>	
Spain	975
<i>Pedro A de Miguel Asensio</i>	
Sweden	1023
<i>Ulf Maunsbach</i>	
Switzerland	1051
<i>Amélie Charbon and Iris Sidler</i>	
United Kingdom	1061
<i>Christopher Wadlow</i>	
United States	1103
<i>Howard B Abrams</i>	
Appendix I	1123
Appendix II	1129
Index	1131

General Report

TOSHIYUKI KONO* and PAULIUS JURČYS**

Contents

Introduction	6
Part I General Overview	8
1 Intellectual Property and Private International Law: Legal and Institutional Background	8
1.1 IP and Private International Law: Legal Framework in Different States	8
1.2 The Hague Judgments Convention and Legislative Proposals	11
1.2.1 The ALI Principles	11
1.2.2 The CLIP Principles	12
1.2.3 The Transparency Principles and Joint Japanese–Korean Proposal (Waseda Principles)	12
1.3 Institutional Framework of Cross-Border Enforcement of IP Rights	13
1.3.1 Canada and the United States	13
1.3.2 European States	13
1.3.3 Asian States	14
2 The Principle of Territoriality of IP Rights and the <i>Lex Protectionis</i>	15
2.1 Main Principles of the Paris Convention	15
2.2 The Principle of the Protecting Country in the Berne Convention	16
2.3 Current Discussion concerning the Appropriateness of the Territoriality Principle	18
Part II Jurisdiction over Disputes Concerning Intellectual Property Rights	
3 Personal Jurisdiction in IP Cases	19
3.1 Personal Jurisdiction in the Hague Judgments Convention	19
3.2 Personal Jurisdiction in North America	20
3.2.1 Canadian and US Law	20
3.2.2 Personal Jurisdiction in the ALI Principles	22
3.3 Personal Jurisdiction in European Countries	23
3.3.1 Defendant's Domicile as the General Ground of Jurisdiction according to the Brussels/Lugano Regime	24
3.3.2 Jurisdiction based upon the Defendant's Domicile in IP-Related Disputes	24
3.3.3 Third-Country Situations	26
3.3.4 Brussels I Reform Proposals	27

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3.4	Asian Countries	27
3.4.1	General Grounds of Jurisdiction in India and Taiwan	27
3.4.2	The Main Principles of the Exercise of International Jurisdiction in Japan.....	28
3.4.3	Personal Jurisdiction in Korea	32
3.5	Comparative Observations	33
4	Exclusive/Subject-Matter Jurisdiction	33
4.1	Exclusive Jurisdiction Rules in the 2001 Draft of the Hague Judgments Convention.....	33
4.2	North American States	35
4.2.1	Subject-Matter Jurisdiction of Canadian and US Courts	35
4.2.2	Subject-Matter Jurisdiction in the ALI Principles	36
4.3	European States	37
4.3.1	Brussels/Lugano Regime: General Considerations.....	37
4.3.2	The ECJ Decision in the Case of <i>GAT v LuK</i>	39
4.3.3	Third-Country Situations	42
4.3.4	Exclusive Jurisdiction Rules in Commission Proposal (2010) and the CLIP Principles.....	43
4.4	Exclusive Jurisdiction in IP Disputes in Asian States.....	43
4.4.1	Exclusive Jurisdiction Rules in India and Taiwan	43
4.4.2	Exclusive Jurisdiction over IP Disputes in Japan	44
4.4.3	Exclusive Jurisdiction in IP Disputes according to Korean Law	47
4.5	Comparative Observations	48
5	Jurisdiction in IP Infringement Disputes	48
5.1	Infringement Jurisdiction in the 2001 Draft of the Hague Judgments Convention.....	49
5.2	Jurisdiction over IP Infringements in North American Countries.....	50
5.2.1	Jurisdiction over IP Infringement Disputes of Canadian Courts	50
5.2.2	Jurisdiction of US Courts over Claims concerning IP Infringements.....	51
5.2.3	Jurisdiction over IP Infringements according to the ALI Principles.....	52
5.3	Jurisdiction over IP Infringement Disputes in Europe.....	53
5.3.1	Brussels/Lugano Regime: Infringement Jurisdiction.....	53
5.3.2	Application of Article 5(3) to Infringements of IP Rights	55
5.3.3	Jurisdiction over Internet-Related Infringements	56
5.3.4	Third-Country Situations	57
5.3.5	Infringement Jurisdiction in the CLIP Principles.....	58
5.4	Asian Countries	59
5.4.1	India and Taiwan	59
5.4.2	Jurisdiction over IP Infringements according to Japanese Law and Latest Legislative Proposals.....	59
5.4.3	Infringement Jurisdiction in Korea	61
5.5	Comparative Observations	62
6	Jurisdiction in Contract-Related Disputes	62
6.1	The 2001 Draft of Hague Judgments Convention.....	62
6.2	Jurisdiction in Contract Disputes in the ALI Principles	63
6.3	European Countries	63
6.3.1	The Brussels/Lugano Regime.....	63
6.3.2	The CLIP Principles	68
6.4	Asian Countries	68
6.4.1	Jurisdiction over Contractual Disputes according to Japanese Law	68
6.4.2	Legislative Proposals.....	69
6.5	Comparative Observations	70

7	Consolidation of Proceedings.....	71
7.1	Consolidation of Claims in the 1999 Draft of the Hague Convention.....	71
7.2	North American Countries.....	72
7.2.1	Canadian Approach to the Consolidation of Claims	72
7.2.2	Consolidation of Claims in the United States.....	73
7.2.3	Claims against Multiple Parties and Other Possibilities of Consolidation in the ALI Principles	74
7.3	Consolidation of Claims in European States	74
7.3.1	Brussels/Lugano Regime: General Considerations	74
7.3.2	The Early Practice of Domestic Courts in IP Infringement Cases.....	76
7.3.3	'Roche Nederland' and its Aftermath	78
7.3.4	Third-Country Situations	81
7.3.5	Consolidation Possibilities according to the CLIP Principles	83
7.3.6	European Patent Litigation Scheme	83
7.4	Asian Countries	85
7.4.1	Consolidation of Claims in India and Taiwan	85
7.4.2	Consolidation of Claims according to Japanese Law.....	85
7.4.3	Consolidation of Proceedings in Korea.....	90
7.5	Comparative Observations	91
8	Parallel Proceedings in IP Disputes	92
8.1	Parallel Proceedings in the 2001 Draft of the Hague Judgments Convention	93
8.2	North American Countries	95
8.2.1	Parallel Proceedings According to Canadian Law.....	95
8.2.2	Parallel Proceedings in US law and the ALI Principles.....	96
8.3	European Countries	98
8.3.1	Parallel and Related Proceedings	98
8.3.2	IP Litigation Strategies	100
8.3.3	Third-Country Situations	103
8.3.4	Review of the Brussels I Regulation: Parallel Proceedings in the Commission Proposal and the CLIP Principles.....	106
8.4	Asian Countries.....	108
8.4.1	Parallel Proceedings according to the Laws of India and Taiwan	108
8.4.2	Parallel Proceedings according to Japanese Law and Recent Asian Legislative Proposals.....	108
8.5	Comparative Observations	111
9	Jurisdiction to Order Provisional or Protective Measures in IP Disputes	112
9.1	Provisional and Protective Measures in the 2001 Draft of the Hague Judgments Convention	112
9.2	Jurisdiction to Grant Provisional Measures and Interim Injunctions under the Laws of North American Countries	113
9.2.1	Legal Situation in Canada	113
9.2.2	Provisional and Protective Measures in the ALI Principles.....	114
9.3	Provisional and Protective Measures in the European Countries.....	114
9.3.1	Brussels/Lugano Regime	114
9.3.2	Provisional Measures and IP-Related Issues	116
9.3.3	Third State Situations.....	119
9.3.4	Provisional and Protective Measures in European Reform Proposals.....	119
9.4	Jurisdiction to Order Provisional and Protective Measures in Asian States.....	120
9.4.1	India and Taiwan	120
9.4.2	Japan.....	121
9.4.3	Korea	122
9.5	Comparative Observations	123

10	Choice of Court Agreements in Cross-Border IP Disputes.....	123
10.1	The 2005 Hague Choice of Court Convention.....	124
10.1.1	General Principles of the Hague Convention.....	124
10.1.2	Choice of Court Agreements in IP Disputes.....	125
10.2	Choice of Court Agreements in North American Countries.....	126
10.2.1	Canada.....	126
10.2.2	Choice of Court Agreements according to the ALI Principles.....	127
10.3	European Countries.....	128
10.3.1	Choice of Court Agreements according to the Brussels/Lugano Regime.....	128
10.3.2	Choice of Court Agreements in IP Disputes.....	129
10.3.3	Choice of Court Agreements according to the CLIP Principles.....	131
10.4	Choice of Court Agreements in Asian Countries.....	132
10.4.1	Choice of Court Agreements in India and Taiwan.....	132
10.4.2	Choice of Court Agreements in IP Disputes according to Japanese Law and other Asian Legislative Proposals.....	132
10.5	Comparative Observations.....	135
	Part III Choice-of-Law Issues in Intellectual Property Disputes.....	135
11	Applicable Law to Proprietary Matters of IP Rights.....	135
11.1	Applicable Law to Proprietary Aspects of IP Rights in North American Countries.....	136
11.1.1	The United States.....	136
11.1.2	The ALI Principles.....	136
11.2	European Countries.....	137
11.2.1	Early European Proposals.....	137
11.2.2	European States.....	138
11.2.3	The CLIP Principles.....	141
11.3	Applicable Law to Proprietary Aspects of IP Rights in Asian Countries.....	142
11.3.1	India and Taiwan.....	142
11.3.2	Japan.....	142
11.3.3	Korea.....	143
11.4	Comparative Observations.....	144
12	Applicable Law to Infringement of IP rights.....	145
12.1	North American Countries.....	145
12.1.1	Applicable Law to Infringements of IP Rights in Canada.....	145
12.1.2	Applicable Law to Infringements of IP Rights in the United States.....	146
12.1.3	Applicable Law to Infringements of IP Rights in the ALI Principles.....	148
12.2	European Countries.....	149
12.2.1	Rome II Regulation on the Law Applicable to Non-Contractual Obligations: General Rules.....	149
12.2.2	Special Choice-of-law Rules for Infringements of IP Rights (Art 8).....	150
12.2.3	Prohibition of the Choice of Law.....	152
12.2.4	Ubiquitous Infringements.....	153
12.2.5	Law Governing the Liability of ISP.....	154
12.2.6	Infringements of IP Rights according to Swiss and Croatian Laws.....	155
12.2.7	The CLIP Principles.....	156
12.3	Asian Countries.....	157
12.3.1	India and Taiwan.....	157
12.3.2	Japan.....	158
12.3.3	Korea.....	162
12.4	Comparative Observations.....	163

13	Applicable Law to the Contracts for the Transfer of IP Rights	164
13.1	North American Countries.....	164
13.1.1	Canadian Law	164
13.1.2	The United States.....	165
13.1.3	Law Governing Transfers of Title and Grants of Licenses under the ALI Principles.....	167
13.2	European Countries	168
13.2.1	Rome I Regulation: General Principles	168
13.2.2	Problems Related to IP-Contracts	170
13.2.3	Law Governing Contractual Obligations according to Swiss and Croatian Law	174
13.2.4	Applicable Law to Contracts according to the CLIP Principles	175
13.3	Asian Countries.....	177
13.3.1	Applicable Law to IP Transfer Agreements in India and Taiwan	177
13.3.2	Japan.....	177
13.3.3	Korea	179
13.4	Comparative Observations	179
14	Applicable Law to IP Rights Created in the Course of Employment Relationship.....	180
14.1	North American Countries.....	180
14.1.1	Canada	180
14.1.2	The ALI Principles.....	181
14.2	European Countries	182
14.2.1	Overview of the Law in Different Countries.....	182
14.2.2	The CLIP Principles	183
14.3	Asian Countries.....	184
14.3.1	Japan.....	184
14.3.2	Korea	185
14.4	Comparative Observations	186
15	Applicable law to Securities in IP.....	186
16	Recognition and Enforcement of Foreign Judgments	188
16.1	Recognition and Enforcement in the 2001 Draft of the Hague Judgments Convention	189
16.2	North American Countries.....	191
16.2.1	Recognition and Enforcement of Foreign Judgments in IP Disputes according to Canadian and US Law.....	191
16.2.2	Recognition and Enforcement of Foreign Judgments in the ALI Principles.....	194
16.3	European Countries	196
16.3.1	Recognition and Enforcement of Foreign Judgments according to the Brussels/Lugano Regime	196
16.3.2	The Recognition and Enforcement of Third-country Judgments	199
16.3.3	Brussels I Reform Proposals.....	201
16.4	Asian Countries.....	203
16.4.1	Recognition and Enforcement of Foreign Judgments in Taiwan.....	203
16.4.2	Recognition and Enforcement of Foreign Judgments in Japan	204
16.4.3	Recognition and Enforcement of Foreign Judgments in Korea	210
16.5	Comparative Observations	210
	CONCLUDING OBSERVATIONS	211

Introduction

The emergence and development of global business activities, and the inception of the Internet have resulted in the creation of a new field of legal studies concerning cross-border enforcement of intellectual property (IP) rights. This novel area of law is known as *private international law and intellectual property*. It has attracted much attention from lawyers within the fields of both private international law and intellectual property law. Several landmark decisions have caught the interest of legal practitioners as well as scholars engaged in deeper research activities. So far, several edited books¹ have been published, and a greater amount of legal articles have been written on the subject.

The object of private international law and intellectual property is mainly related to the private enforcement of intellectual property rights. In this context, 'private' enforcement is understood to mean legal measures taken by private parties (eg, proprietors of IP rights, persons exploiting IP rights with or without authorisation). Such legal measures taken by private parties would usually be determined by the law of the country where the protection is sought. In this report the private enforcement of IP rights refers to legal actions brought before national judicial or administrative authorities. Hence, public administrative acts upon which certain preventive acts are taken (eg, customs control, seizure of counterfeited goods etc) are not analysed here. Private international law and intellectual property could also be considered a special area of private international law dealing particularly with the enforcement of IP rights. Accordingly, legal problems which arise in the course of the enforcement of IP rights are mainly related to the exercise of international jurisdiction of the court seised, the applicable laws, and the recognition and enforcement of foreign court judgments rendered in disputes over IP rights.

This General Report draws upon 21 national reports received from countries with very divergent legal traditions. National reports were collated from three continents: North America (Canada and the United States), Europe (14 EU Member States, Switzerland and Croatia) and Asia (India, Taiwan, Korea and Japan). The national reports were drafted on the basis of a questionnaire² containing two main sections. The first section required national reporters to provide a general legal and institutional framework concerning the enforcement of IP rights in their respective countries. National reporters were then asked to indicate: a) international and regional legal instruments which have been ratified or are applicable in their countries, and b) national statutory instruments pertaining to the enforcement of IP rights.

The second section of the questionnaire was based on hypothetical cases. Instead of providing a list of questions asking for a description of certain legal matters, it was decided to incorporate those questions into hypothetical cases in order to provide a better illustration of their legal situation. Such methodology, whereby the questionnaire is partly based on

¹ JJ Fawcett and P Torremans, *Intellectual Property and Private International Law*, 2nd edn (Oxford, Oxford University Press, 2011); J Drexel and A Kur (eds), *Intellectual Property and Private International Law: Heading for Future* (Oxford, Hart Publishing, 2005); J Basedow, J Drexel, A Kur, and A Metzger (eds), *Intellectual Property in the Conflict of Laws* (Tübingen, Mohr Siebeck, 2005); A Nuyts (ed), *International Intellectual Property and Information Technology* (Alphen aan den Rijn, Kluwer Law International, 2008); S Leible and A Ohly (eds), *Intellectual Property and Private International Law* (Tübingen, Mohr Siebeck, 2009); J Basedow, T Kono, and A Metzger (eds), *Intellectual Property in the Global Arena: Jurisdiction, Applicable Law, and the Recognition of Judgments in Europe, Japan and the US* (Tübingen, Mohr Siebeck, 2010).

² See Appendix I.

hypothetical cases, was inspired by the recent initiatives to draft the European Civil Code (eg security rights in immovable property or condominiums in European private law). However, given that the scope of the project is related to international aspects of IP, national reporters were asked to consider these hypothetical cases as mere examples, so as to not restrict possible answers to questions posed. Hence, reporters were encouraged to provide further analysis of any issues not covered in the hypothetical case. In the same vein, national reporters were also asked to provide analysis of IP rights other than those addressed in a particular hypothetical case (eg, if the hypothetical case concerned copyright, the national reporters were asked to indicate whether, and if so, how the answers would differ in disputes related to other IP rights such as patents, trade marks, etc). Furthermore, national reporters were asked to structure their answers into two sections: operative rules and descriptive formants.

In October 2009, due to certain logistic considerations and with the objective to receive national reports from as many legal jurisdictions as possible, a shorter version of the questionnaire³ was created (national reports of Switzerland and the United States were prepared on the basis of the shorter version of the questionnaire). Therefore, although the form of the national reports might differ, from a substantive point of view they cover identical legal issues as they were in the summer of 2010.

The General Report consists of four main parts. Parts I and II provide a brief overview of private enforcement of IP rights as well as the related institutional framework. Part III deals with various jurisdictional issues which arise in cross-border IP litigation and provides an analysis of the jurisdictional approaches which exist in the countries covered. More specifically, Part II deals with jurisdiction over parties, jurisdiction in contractual and non-contractual disputes, subject-matter (exclusive) jurisdiction, available possibilities for consolidating multiple claims/proceedings, treatment of international parallel proceedings, and choice of court agreements in IP disputes. Part IV is mainly devoted to analysing various choice-of-law problems that arise in cross-border IP disputes. Namely, it provides an overview and analysis of the approaches concerning the applicable law to the proprietary aspects of IP rights, choice-of-law problems arising in IP infringement cases and contracts for the transfer of IP rights. A further aim of Part III is to depict choice-of-law problems which arise in the context of IP finance. Lastly, Part V focuses on the recognition and enforcement of foreign judgments rendered in IP-related disputes. An Epilogue concludes.

Parts III, IV and V were drafted on the basis of the national reports and are structured geographically: each chapter begins with an introduction outlining the main problems subject to discussion. The analysis commences with an overview of the law in two North American countries – Canada and the United States – and deals with the approach established in the ALI Principles on Intellectual Property. Then the current legal situation in the European Union and several other countries (namely, Switzerland and Croatia) is introduced in conjunction with an analysis of the legislative proposals made by the CLIP working group and other legislative initiatives concerning the modification of the Brussels I Regulation. Finally, an overview of the law in four Asian countries (India, Taiwan, Korea and Japan) is provided. Further attention is given to recent legislation in Asian countries (for example, Japan's Act amending its Code of Civil Procedure (2011), as well as several legislative proposals such as Transparency and Waseda Principles. In addition, the Korean proposal which was drafted together with the Waseda working group is briefly introduced.

³ See Appendix II.

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Part I General Overview

1. Intellectual Property and Private International Law: Legal and Institutional Background

1.1 IP and Private International Law: Legal Framework in Different States

All 21 states from which the national reports were assembled belong to the World Trade Organization. This means that these countries are bound by the TRIPS (Trade-Related Aspects of Intellectual Property Rights) Agreement⁴ which entered into force in 1995. The states had ratified many international conventions concerning the protection of IP rights before the establishment of the WTO (namely, Paris Convention for the Protection of Industrial Property (1883)⁵ and Berne Convention for the Protection of Literary and Artistic Works (1886)⁶). All represented states are also members of the World Intellectual Property Organization and are bound by the WIPO Performances and Phonograms Treaty (WPPT)⁷ and WIPO Copyright Treaty (WCT).⁸ Most of the states participate in international IP protection systems: the Patent Cooperation Treaty,⁹ the Madrid system concerning international trade mark registration, the Hague system concerning international industrial design registration and the Lisbon system concerning international registration of the appellations of origin.¹⁰ These international conventions have significantly influenced the development of national legal regimes for the protection of IP rights.¹¹

Regional economic integration has also facilitated the harmonisation of different aspects of IP rights. This is particularly noticeable in the EU, where the domestic legislation of

⁴ Agreement on Trade-Related Aspects of Intellectual Property Rights, 15 April 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C (1994) 33 *International Law Materials* 1197.

⁵ Paris Convention for the Protection of Industrial Property, as last revised at the Stockholm Revision Conference, 14 July 1967, 828 UNTS 303.

⁶ Berne Convention for the Protection of Literary and Artistic Works, 9 September 1886, as last revised at Paris on 24 July 1971, 1161 UNTS 30.

⁷ (1997) 36 *International Law Materials* 76.

⁸ (1997) 36 *International Law Materials* 65.

⁹ (1970) 9 *International Law Materials* 978.

¹⁰ www.wipo.int/services/en/.

¹¹ For a more detailed overview, the reader is recommended to refer to the national reports of particular countries.

Member States has been to a large extent affected by harmonisation activities at the EU level. Numerous regulations and directives were adopted with the objective of aligning domestic statutes and ascertaining that minimum standards of protection are established. In the area of copyright, these include directives related to the legal protection of computer programs,¹² rules concerning copyright and rights related to copyright applicable to satellite broadcasting and cable retransmission,¹³ legal protection of databases,¹⁴ harmonisation of certain aspects of copyright and related rights in the information society,¹⁵ resale rights¹⁶ as well as the term of protection of copyrights and related rights.¹⁷

Further, many legislative instruments were adopted with regard to industrial property rights in the EU: for example, directives to approximate the laws of the Member States relating to trade marks;¹⁸ legal protection of designs;¹⁹ or the protection of biotechnological inventions.²⁰ On the basis of two legal instruments, Community trade marks²¹ and Community design rights became available.²² As regards patents, the European Patent Convention which entered into force in 1977 laid a solid foundation for the regional protection of patent rights.²³ It is worth noting that negotiations concerning the creation of an 'EU Patent litigation system' are taking place.²⁴ In addition, the following instruments regarding patents have to be mentioned: the Regulation concerning the creation of a supplementary protection certificate for medicinal products,²⁵ and the Regulation concerning the creation of a supplementary protection certificate for plant protection products.²⁶ In 2004 an additional directive was adopted requiring Member States to establish procedures concerning the protection of IP rights.²⁷

Further regional cooperation occurs among a specific number of European states. For instance, the Swedish Report notes that major legislative developments in the area of IP in

¹² Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs, replaced by Directive 2009/24/EC of the European Parliament and of the Council of 23 April 2009 on the legal protection of computer programs (Codified version) [2009] OJ L111/16.

¹³ Council Directive 93/83/EEC of 27 September 1993 on the coordination of certain rules concerning copyright and rights related to copyright applicable to satellite broadcasting and cable retransmission [1993] OJ L248/15.

¹⁴ Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases [1996] OJ L77/20.

¹⁵ Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society [2001] OJ L167/10.

¹⁶ Directive 2001/84/EC of the European Parliament and of the Council of 27 September 2001 on the resale right for the benefit of the author of an original work of art [2001] OJ L 272/32.

¹⁷ Directive 2006/116/EC of the European Parliament and of the Council of 12 December 2006 on the term of protection of copyright and certain related rights (codified version) [2006] OJ L 372/12.

¹⁸ Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks [1989] OJ L40/1.

¹⁹ Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs [1998] OJ L289/28.

²⁰ Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions [1998] OJ L213/13.

²¹ Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark [1994] OJ L11/1.

²² Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs [2002] OJ L3/1.

²³ Convention on the Grant of European Patents (European Patent Convention) of 5 October 1973 as revised by the Act revising Article 63 EPC of 17 December 1991 and the Act revising the EPC of 29 November 2000.

²⁴ Belgian Report, nn 62 and 63.

²⁵ Council Regulation (EEC) No 1768/92 of 18 June 1992 concerning the creation of a supplementary protection certificate for medicinal products [1992] OJ L182/1.

²⁶ Regulation (EC) No 1610/96 of the European Parliament and of the Council of 23 July 1996 concerning the creation of a supplementary protection certificate for plant protection products [1996] OJ L198/30.

²⁷ Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights [2004] OJ 195/16.