



**IDENTIFYING ACTUAL AND PRACTICAL ISSUES OF
PRIVATE INTERNATIONAL LAW
IN CROSS-BORDER INTELLECTUAL PROPERTY DEALINGS**

Report

December 2022

About HCCH and WIPO

Hague Conference on Private International Law (HCCH) The HCCH is an intergovernmental organization, the origin of which dates back to 1893. Its mandate is “the progressive unification of the rules of private international law” at the global level. It is the permanent world organization for cross-border cooperation in civil and commercial matters, with over 90 Members across the globe and approximately 60 more States that are not Members but party to one or more Conventions – a total of 156 States “connected” to its work. The HCCH fulfils its mandate by developing Conventions (treaties) and other instruments in three principal areas: international child protection and family law; transnational litigation and apostille; and international commercial, digital and financial law. These instruments achieve very practical outcomes, directly impacting and benefiting individuals (both adults and children) as well as commercial operators and investors. The work of the HCCH is therefore highly relevant to matters of intellectual property, as these instruments facilitate, through the legal certainty and predictability they establish, international IP transactions, the enforcement of IP rights and the resolution of IP disputes, ultimately providing effective private international law solutions to the international legal framework.

World Intellectual Property Organization (WIPO) WIPO is the global forum for intellectual property services, policy, information and cooperation. It is a self-funding agency of the United Nations with 193 Member States. WIPO’s mission is to lead the development of a balanced and effective international intellectual property system that enables innovation and creativity for the benefit of all. WIPO’s mandate, governing bodies and procedures are set out in the WIPO Convention, which established WIPO in 1967. WIPO helps governments, businesses and society realize the benefits of IP. WIPO provides: a policy forum to shape balanced international IP rules for a changing world; global services to protect IP across borders and to resolve disputes; technical infrastructure to connect IP systems and share knowledge; cooperation and capacity-building programs to enable all countries to use IP for economic, social and cultural development; and a world reference source of IP information.

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Annex Questionnaire

I. Introduction

- 1 This document reports on the findings from the *Questionnaire on the intersection between private international law (PIL) and intellectual property (IP)*, developed by the Hague Conference on Private International Law (HCCH)-World Intellectual Property Organization (WIPO), to collect empirical information on PIL issues that arise in cross-border IP disputes: namely in establishing court jurisdiction, determining and applying the applicable law, and recognizing or enforcing foreign IP-related judgments.
- 2 The intersection of PIL and IP has continued to be explored in different regions and at various levels. HCCH, a global organization mandated to work for the progressive unification of the rules of private international law, has dealt with this intersection in various of its instruments and projects, such as the *HCCH Convention of 30 June 2005 on Choice of Court Agreements* and the *HCCH Principles on Choice of Law in International Commercial Contracts* (adopted on 19 March 2015). In particular, in the negotiations leading to the successful adoption of the *HCCH Convention of 2 July 2019 on the Recognition and Enforcement of Foreign Judgments in Civil or Commercial Matters*, the treatment of IP-related judgments was discussed intensively, leading to a consensus that that the 2019 Judgments Convention would not apply to IP. It was also agreed that further explanation of the treatment of IP-related judgments would be provided in the Explanatory Report¹ to the Convention.
- 3 WIPO, the global forum for intellectual property services, policy, information and cooperation, has worked to raise awareness of the issues arising in the intersection between IP and PIL, including through an empirical study of 56 cases dealing with cross-border online IP infringement.²
- 4 The HCCH and WIPO Secretariats have collaborated over the years to facilitate international discussion in relation to this complex area of private international law questions pertaining to IP relationships. In 2019, HCCH and WIPO jointly published *When Private International Law meets Intellectual Property – A Guide for Judges*, written by A. Bennett and S. Granata.³ The Guide, which is available in the six United Nations languages and aims to raise awareness of the interplay of PIL and IP within the legal society, provides judges and practitioners with an overview on how PIL issues may apply in cross-border IP cases.

II. Questionnaire

- 5 In considering whether, and if so how, work on the intersection of PIL and IP should be further explored and developed by the HCCH, its governing body, *i.e.*, the Council on General Affairs and Policy (CGAP), at its meeting in March 2020, “invited the Permanent Bureau to continue its close cooperation with the International Bureau of WIPO, including on the preparation of a questionnaire, with a view to identifying actual and practical issues of private international law faced by practitioners in cross-border intellectual property dealings.”⁴

¹ Paras 64-65 of the Explanatory Report. The Explanatory Report is available on the HCCH website at www.hcch.net under “Judgments”.

² Andrew F. Christie (2015). *Private International Law Issues in Online Intellectual Property Infringement Disputes with Cross-Border Elements – An Analysis of National Approaches*. Geneva: WIPO, available on the WIPO website at <https://www.wipo.int/publications/en/details.jsp?id=3975&plang=EN>.

³ A. Bennett and S. Granata (2019). *When Private International Law Meets Intellectual Property Law – A Guide for Judges*. The Hague: HCCH; Geneva: WIPO, available at <https://www.wipo.int/publications/en/details.jsp?id=4465>.

⁴ See “Conclusions and Decisions adopted by CGAP (3-6 March 2020)”, C&D No 14, available on the HCCH website at www.hcch.net under “Governance” then “Council on General Affairs and Policy”.

- 6 Against this background, the Permanent Bureau of the HCCH and the International Bureau of WIPO jointly prepared the 2021 Questionnaire, aimed at identifying actual and practical PIL issues in IP disputes. During its preparation, both secretariats identified and consulted 25 experts (including 12 judges from the WIPO Advisory Board of Judges) from Africa, North and South America, the Asia Pacific and Europe, taking into account gender and generational balance, as well as geographical representation.⁵
- 7 The Questionnaire was intended for a wide scope of consultation, including Members of both Organizations, institutions, practitioners, in-house counsel, academics and other private individuals. It was released on WIPO's online platform⁶ between May 21 and June 30, 2021, in the six United Nations languages (English, Arabic, Chinese, French, Spanish and Russian). The complete set of questions is available in Annex 1.
- 8 More than 300 responses to the Questionnaire were received,⁷ from respondents with diverse backgrounds, including officers from National Organs and IP offices, members of the judiciary, representatives of IP associations, practitioners and academics in the field of IP. Out of a total number of 80 complete responses,⁸ representing five continents, 38 HCCH Members provided 71 responses, which included 11 responses from IP offices, 14 from National Organs, 26 from the judiciary, six from other government officials and the remaining 14 from IP associations and private individuals, including academics and lawyers. The Permanent Bureau of the HCCH and the International Bureau of WIPO are grateful to respondents for their participation, and time and efforts dedicated to the Questionnaire.
- 9 The responses varied greatly in the breadth and depth of information provided. Furthermore, while all geographical regions are covered in the responses, there were, for example, 13 responses from EU Member States, 10 from Morocco and six from Mexico. As a result, the information gleaned from the Questionnaire, and the resulting Summary of Responses, is concentrated on the intersection of IP and PIL as borne out in the smaller number of jurisdictions that provided fuller responses.
- 10 Despite these limitations, the information collected through the Questionnaire provides a solid snapshot of the actual and practical PIL issues that arise in cross-border IP dealings in the jurisdictions that responded.
- 11 This Report summarizes the responses, including direct quotes where appropriate. The Report does not provide any form of legal analysis of the individual responses, be it from the comparative law perspective or otherwise. Likewise, the Report does not assume responsibility for the accuracy or quality of the information produced in the responses.
- 12 The findings of the questionnaire were reported to the HCCH CGAP at its March 2022 meeting, where the HCCH CGAP "welcomed the work carried out on the intersection of intellectual property and private international law, including the cooperation between the PB and the International Bureau of WIPO. CGAP mandated the PB, in cooperation with the International

⁵ The 25 experts were from the following States (in alphabetical order): Australia, Brazil, Canada, the People's Republic of China, Germany, Italy, Japan, the Republic of Korea, Morocco, Peru, the Russian Federation, Singapore, South Africa, Switzerland, Thailand, the United Kingdom (UK), and the United States of America (US).

⁶ <https://www.wipo.int/about-ip/en/judiciaries/2021survey.html>.

⁷ It is noted however that many of the responses received were incomplete or were not submitted in their final form.

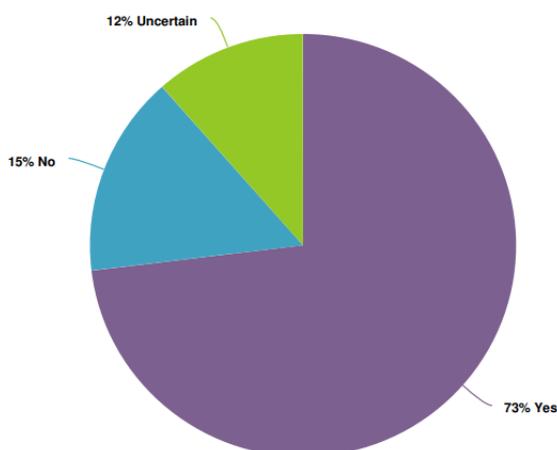
⁸ These were from (in alphabetical order): Albania, Algeria, Argentina, Australia, Bahrain, Brazil, Canada, Chile, China, Dominican Republic, the European Union (EU), France, Germany, Greece, India, Iran, Ireland, Israel, Italy, Japan, Kazakhstan, Kyrgyzstan, Latvia, Lithuania, Madagascar, Mauritania, Mexico, Montenegro, Morocco, Myanmar, Nicaragua, Paraguay, Portugal, the Republic of Moldova, the Russian Federation, Slovenia, South Africa, Spain, Sweden, Thailand, United Arab Emirates, the UK, the US, Uruguay, Uzbekistan, and Viet Nam.

Bureau of WIPO, to continue monitoring developments on the intersection of intellectual property and private international law.”⁹

III. Summary of Responses¹⁰

A. General

1. Does your jurisdiction have statutory provisions or case law addressing, expressly or impliedly, PIL issues (jurisdiction, applicable law, recognition and enforcement of foreign judgments, administrative or judicial international cooperation) in cross-border IP disputes?



Value	Percent	Responses
Yes	73.1%	57
No	15.4%	12
Uncertain	11.5%	9

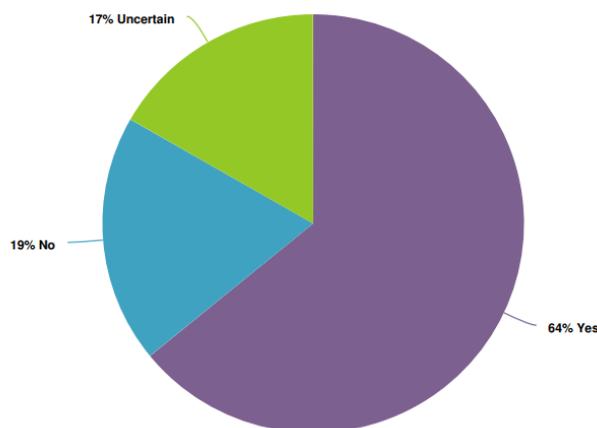
Totals: 78

- 13 While a majority of respondents (73.1%) answered in the affirmative, a considerable number of such rules are of a general character in civil or commercial matters which do not specifically deal with IP. It was stated that in some jurisdictions, such statutory provisions addressing PIL issues are not codified in one single piece of legislation but are dispersed over several pieces.

⁹ See “Conclusions and Decisions adopted by CGAP (28 February – 4 March 2022)”, C&D No 10, available on the HCCH website at www.hcch.net under “Governance” then “Council on General Affairs and Policy”.

¹⁰ Canada and the US replied to some, but not all, of the questions in the Questionnaire via channels other than the WIPO’s online platform. While their main concerns are well noted in this document, they are not included in the statistical calculation of responses under each of the question in this Annex, which only covers responses received via the online platform.

2. Is your jurisdiction bound by any bilateral, regional or multilateral instrument(s) that, expressly or impliedly, govern or contain provisions addressing PIL issues (jurisdiction, applicable law, recognition and enforcement of foreign judgments, administrative or judicial international cooperation) in cross-border IP disputes?



Value	Percent	Responses
Yes	64.1%	50
No	19.2%	15
Uncertain	16.7%	13
Totals: 78		

- 14 Almost two thirds of the respondents (64.1%) indicated that their jurisdictions are bound by bilateral, regional or multilateral instruments that, expressly or impliedly, govern or contain provisions addressing PIL issues in cross-border IP disputes.
- 15 Several multilateral instruments were mentioned in the responses: the *HCCH Convention of 30 June 2005 on Choice of Court Agreements* (HCCH 2005 Choice of Court Convention), the *Paris Convention for the Protection of Industrial Property* (Paris Convention), the *Berne Convention for the Protection of Literary and Artistic Works* (Berne Convention) and the *Agreement on Trade-Related Aspects of Intellectual Property Rights* (TRIPS Agreement).
- 16 As for regional instruments, reference was made to the *Buenos Aires Convention on Literary and Artistic Copyright* (Buenos Aires Convention); the *Inter-American Convention on General Rules of Private International Law* (Montevideo Convention); various mutual legal assistance agreements among countries within the Southern Common Market (MERCOSUR), including the *Protocol on Judicial Cooperation and Assistance in Civil, Commercial, Labor and Administrative Matters* (Las Leñas Protocol); the *Treaty on the Eurasian Economic Union*; the *Convention on Legal Aid and Legal Relations in Civil, Family and Criminal Matters* (Minsk Convention); various regulations and/or directives of the European Union, most notably the Brussels Ia Regulation,¹¹ the Rome I Regulation¹² and the Rome II Regulation;¹³ the *Convention on Jurisdiction and the Recognition and Enforcement of Judgments in Civil and Commercial matters* (Lugano Convention); the *European Patent Convention* (EPC); the

¹¹ Regulation (EU) No 1215/2012 of the European Parliament and of the Council of December 12, 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (recast), OJ L 351/1, 20/12/2012, pp 1-32.

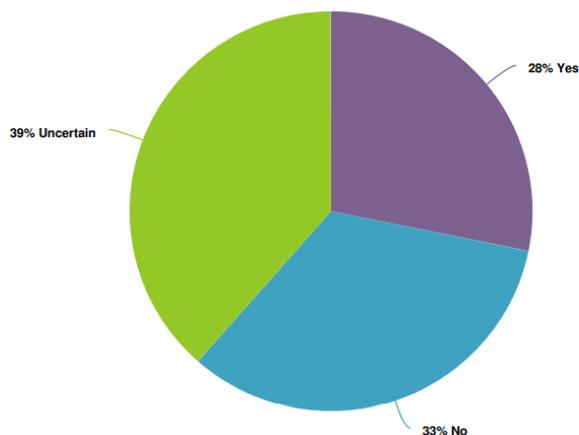
¹² Regulation (EC) No 593/2008 of the European Parliament and of the Council of June 17, 2008 on the law applicable to contractual obligations, OJ L 177/6, 4/7/2008, pp 6-16.

¹³ Regulation (EC) No 864/2007 of the European Parliament and of the Council of July 11, 2007 on the law applicable to non-contractual obligations, OJ L 199/40, 31/7/2007, pp 40-49.

Agreement between the United States of America, the United Mexican States, and Canada (USMCA); and the Regional Comprehensive Economic Partnership (RCEP).

17 A number of responses made reference to existing bilateral agreements on the recognition and enforcement of judgments.

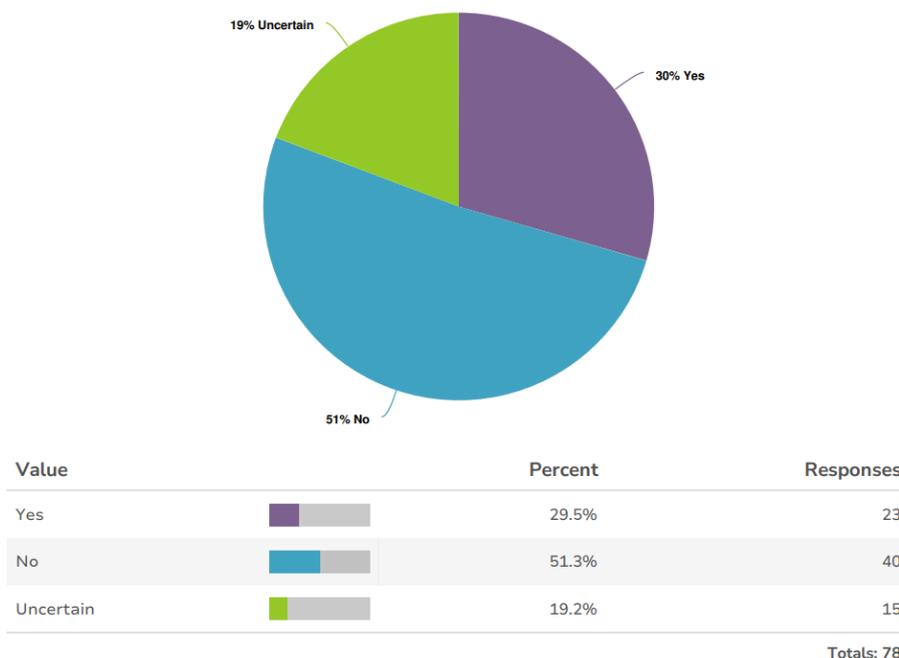
3. **Have the courts of your jurisdiction referred to any policy guidelines or other sources (binding or non-binding) that address PIL issues (jurisdiction, applicable law, recognition and enforcement of foreign judgments, administrative or judicial international cooperation) in cross-border IP disputes?**



Value	Percent	Responses
Yes	28.2%	22
No	33.3%	26
Uncertain	38.5%	30
Totals: 78		

18 Less than one third of the respondents (28.2%) replied in the affirmative. Some of these responses pointed to their domestic guidelines. As for binding instruments, some respondents referred to the Paris Convention, and in particular to Articles 4bis and 6 on the principle of independence of rights. As for non-binding instruments, the *Principles on Conflict of Laws in Intellectual Property* prepared by the European Max Planck Group on Conflict of Laws in Intellectual Property (CLIP) of 2011 and the American Law Institute (ALI) *Intellectual Property Principles Governing Jurisdiction, Choice of Law, and Judgments in Transnational Disputes* of 2008 were mentioned. Some responses indicated that both CLIP and ALI Principles are cited by the United Kingdom Supreme Court in *Lucasfilm v Ainsworth* [2011] UKSC 39.

4. Have you faced any PIL-related challenges in cross-border IP disputes, including any gaps in the current framework or any other practical hurdles?



19 While half of the respondents (51.3%) replied that their jurisdictions do not face any PIL-related challenges in cross-border IP disputes or that they are not aware of any such challenges, 29.5% of the respondents indicated certain gaps and practical hurdles. In particular, several respondents from the judiciary highlighted:

- the difficulties in enforcing a foreign protective order concerning confidential information,
- the difficulties in taking evidence from foreign expert witnesses in patent trials,
- the difficulties in serving foreign litigants not resident (and without legal representation) in the forum state, and
- the “Italian torpedo” actions.¹⁴

20 Other respondents drew attention to the growing impact of the internet on cross-border IP dealings, and raised the following practical concerns, mainly in the areas of identifying defendants, serving defendants and admission of evidence:

- the difficulties in identifying and locating IP infringers (and hence the proper defendant) in the context of IP disputes in an internet environment, especially in jurisdictions where a “John Doe action”¹⁵ is not permitted,

¹⁴ It is observed that a number of academics in the field of private international law refer to the term “Italian torpedo” as a colloquialism for tactical abuse of process in cross-border disputes. A party brings an action in a State which has a reputation for slow or inefficient judicial system with a considerable backlog of cases, even where that jurisdiction has no connection to the claim. The court of another jurisdiction may then have to wait until the resolution of the case by the court first seized. The “torpedoed” victim may be put under pressure to settle in view of the expenses and delay.

¹⁵ For information purposes, a John Doe defendant is an anonymous defendant labeled “John Doe” because the plaintiff does not, at the time of filing suit, know the person’s name. John Doe defendants are common in several situations, as in some copyright-infringement lawsuits where defendants are identified only by Internet addresses (John Doe defendant definition, Black’s Law Dictionary (11th ed. 2019)).

- the difficulties in case management, given that the defendant may have no presence in the forum state,
- the potential (in)admissibility of “information collected from public internet sources (e.g., information on WHOIS websites) as evidence in civil proceedings”.

21 In addition, some of the challenges highlighted related to the interpretation and application of certain European instruments dealing with IP rights, such as:

- the interpretation of “civil and commercial matters” in Article 1 of the Brussels Ia Regulation in the context of an application for recognition and enforcement of court orders in IP infringement cases,
- the relationship between the Brussels I Regulation and the Benelux Convention on Intellectual Property (Trademarks and Designs) for the purposes of establishing jurisdiction,
- “under the Community Design[s] Regulation for the purposes of establishing the applicable law in an intellectual property dispute related to designs, the act giving rise to the alleged infringement is the act of manufacturing the infringing goods”,
- “the extent of the right of redress for an infringement or alleged infringement of a Community design right is governed by the applicable national law of the Member State in which the acts of infringement or threatened infringement have been committed, including its private international law”.

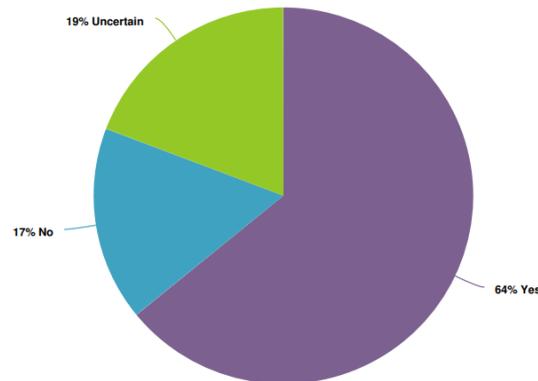
22 Some respondents conveyed considerable legal uncertainty surrounding the use of anti-anti-suit injunctions. They indicated that anti-suit injunctions and anti-anti-suit injunctions or even anti-anti-anti-suit injunctions could lead to a considerable increase in procedural costs for all parties, considerable legal uncertainty and a race to the bottom, which will be detrimental to trade relations in the long term.

5. Please share with us if there is any statistical information regarding IP disputes with private international law issues available in your jurisdiction.

23 The majority of respondents stated that there is no statistical information regarding IP disputes with PIL issues in their jurisdiction.

B. Jurisdiction

6. Are there any practical or legal considerations that are relevant to selecting / establishing / challenging jurisdiction in a dispute arising out of a cross-border IP dealing?

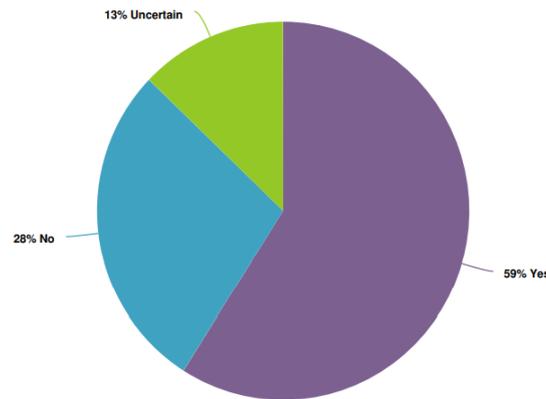


Value	Percent	Responses
Yes	64.1%	50
No	16.7%	13
Uncertain	19.2%	15

Totals: 78

- 24 Almost two thirds of the respondents (64.1%) indicated that there are practical or legal considerations that are relevant to selecting, establishing, or challenging jurisdiction in a dispute arising out of a cross-border IP dealing. The remaining respondents expressed either that there are no such considerations (16.7%), or that they are uncertain (19.2%).
- 25 Among the practical considerations mentioned in the responses, some are of a general nature and are also relevant to other types of disputes: such as the efficiency of the court system, the languages used in the proceedings, the speed and costs of the proceedings, implications for confidential information, the calculation method of damages, the existence of assets of the defendants, the prospects of recognition and enforcement of the judgments, and the availability of mechanisms for transferring or consolidating trials.
- 26 There are several practical considerations specific to IP disputes that are cited in the responses: such as market size, availability of a specialised IP court, availability of injunctions, availability of measures against injunctions, impact on other infringers, possibility of enforcing additional patents, and possibility of obtaining a cross-license agreement.
- 27 In relation to legal considerations, some responses are of a general nature, concerning, for example, statutory rules on jurisdiction, exclusive jurisdiction and choice of court agreements, and exercise of courts' discretion in declining jurisdiction. Some respondents highlighted the application of the principle of independence of IP rights, the importance of the place of registration and the registration authority of registered IP rights, as well as the public policy consideration and potential issues of state sovereignty.

7. Is (habitual) residence / domicile, branch, agency or other establishment of the defendant the principal factor determining jurisdiction in cross-border IP disputes?



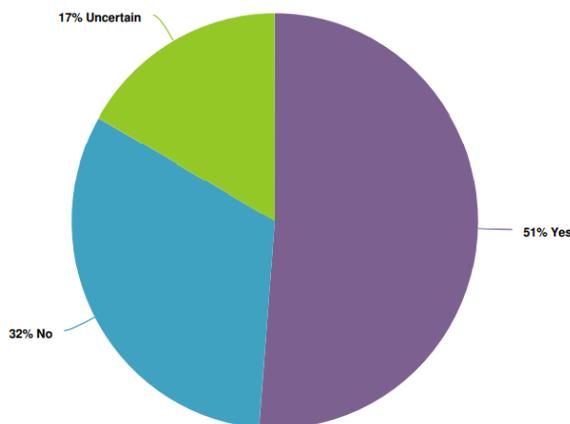
Value	Percent	Responses
Yes	59.0%	46
No	28.2%	22
Uncertain	12.8%	10
Totals: 78		

28 A majority of the respondents (59%) answered the question in the affirmative. Around one third of the respondents (28.2%) disagreed and 12.8% of the respondents replied “uncertain”.

29 Among the respondents who disagreed, several indicated that this factor is not the *principal* factor but *only one* of the possible factors in determining jurisdiction. From these responses, the following alternative factors for determining jurisdiction in cross-border IP disputes were identified:

- the place where the IP rights are registered: a number of respondents reiterated that the court of this place exclusively hears the validity and registration of IP rights, which prevails over the place of the domicile of the defendant,
- the place where the contract was concluded,
- the place where the parties agreed by way of choice of court or jurisdiction clause(s),
- the place where the IP infringement (tort) was committed,
- the place where the IP infringing content can be accessed online (*i.e.*, the “access approach”),
- the place where “the cause of action arises”, and
- the place where “the Defendant has purposefully availed of the jurisdiction of the Court by its conduct, either by making it possible to conclude a commercial transaction in the territorial jurisdiction of the Court or by specifically targeting users in the Court’s jurisdiction”.

8. If the cross-border IP dispute concerns the validity, grant or registration of an IP right, would that require or permit jurisdiction rules to be applied that are different from the principal rule for jurisdiction?



Value	Percent	Responses
Yes	51.3%	40
No	32.1%	25
Uncertain	16.7%	13
Totals: 78		

30 More than half of the respondents (51.3%) answered in the affirmative. Around one third of the respondents (32.1%) replied in the negative and 16.7% “uncertain”.

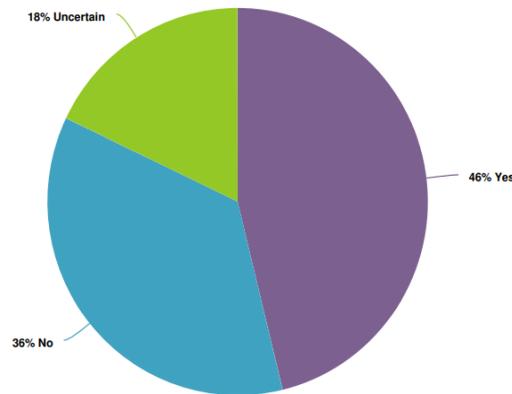
31 A vast number of the affirmative responses referred to the exclusive jurisdiction of the court of the State where registration has taken place. One respondent referred to the *Moçambique* rule¹⁶.

32 Some of these respondents referred to the relevant rules set out in the Lugano Convention, EPC and EPC Protocol on Recognition, and the Brussels Ia Regulation, EU Trade Mark Regulation, and EU CPVR Regulation.

33 Some who replied in the negative to this question highlighted that, in their respective jurisdictions, issues concerning the validity, grant or registration of an IP right are exclusively dealt with by administrative authorities. Recourse to courts can be made through appeal processes challenging the decisions of the administrative authorities.

¹⁶ *British South Africa Co v Companhia de Moçambique* [1893] AC 602 (UK House of Lords). The *Moçambique* rule provides that a court had no jurisdiction to entertain an action for the determination of title to, or the right of possession of, foreign land, or the recovery of damages for trespass to such land.

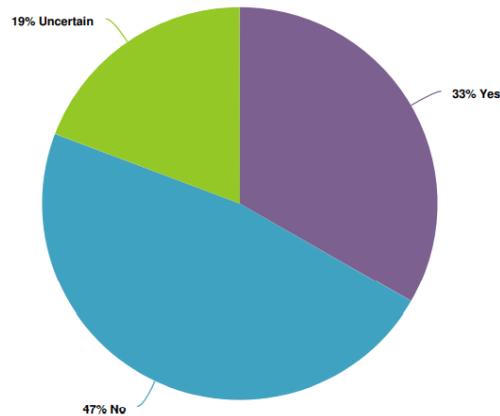
9. If the cross-border IP dispute concerns contractual issues, would that require or permit jurisdiction rules to be applied that are different from the principal rule for jurisdiction?



Value	Percent	Responses
Yes	46.2%	36
No	35.9%	28
Uncertain	17.9%	14
Totals: 78		

- 34 Slightly less than half of the respondents (46.2%) replied in the affirmative, while around one-third (35.9%) replied in the negative, and 17.9% “uncertain”.
- 35 Affirmative answers referred to various jurisdiction rules which are different from the principal rule for jurisdiction, including applying the parties’ choice of court clause (save for the public policy consideration), the place of performance of the contract, the place of performance of the obligation in question, and the “real and substantial connection test”. It was repeatedly mentioned that general jurisdiction rules over contractual obligations are applied, as in their respective jurisdictions there are no jurisdiction rules specifically tailored for IP disputes concerning contractual issues.

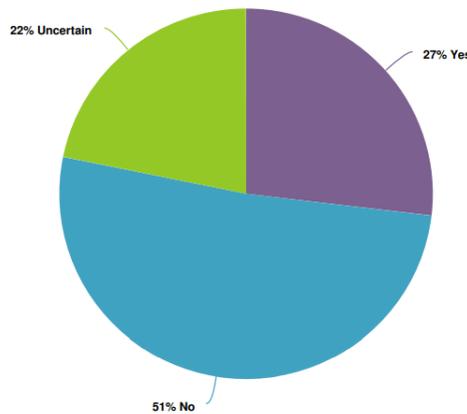
10. If the cross-border IP dispute concerns infringement of an IP right, would that require or permit jurisdiction rules to be applied that are different from the principal rule for jurisdiction?



Value	Percent	Responses
Yes	33.3%	26
No	47.4%	37
Uncertain	19.2%	15
Totals: 78		

- 36 Nearly half of the respondents (47.4%) said no. One third of the respondents (33.3%) replied in the affirmative, and 19.2% “uncertain”.
- 37 Different jurisdiction rules were referred to in affirmative responses. Since infringement of IP rights, in particular rights that do not require registration, is typically treated as a tort action, the general jurisdiction rule on tort, *i.e.*, the place where the infringement occurred or may occur, was mostly referred to, whether under national or regional laws and practice. The place of infringement was interpreted differently: the responses referred to the place where the damage is sustained, or the place where the infringing activity occurred, or both.
- 38 Several respondents referred to the application of the parties’ agreement (save for public policy) or the place where protection of the IP rights is sought.

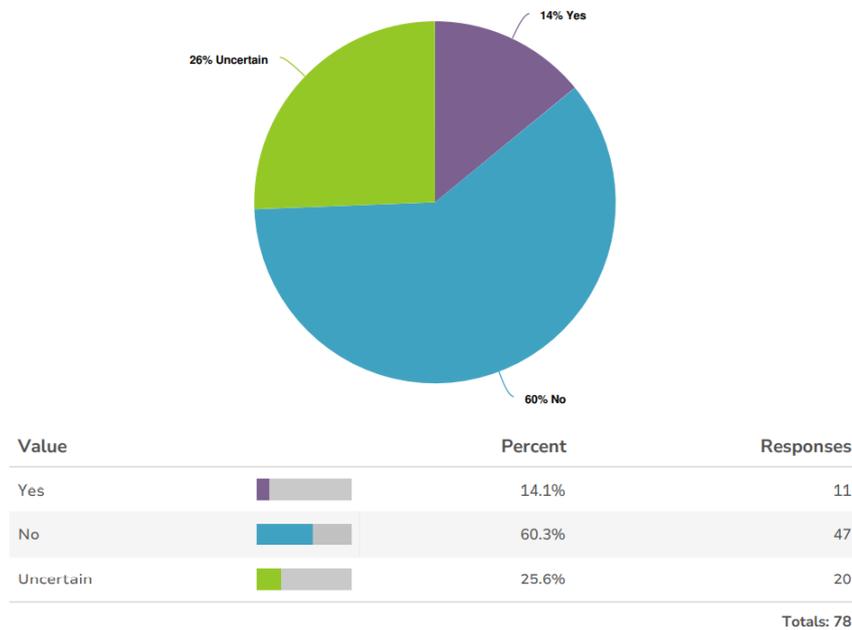
11. If the cross-border IP dispute concerns claims of entitlement to or ownership of an IP right, would that require or permit jurisdiction rules to be applied that are different from the principal rule for jurisdiction?



Value	Percent	Responses
Yes	26.9%	21
No	51.3%	40
Uncertain	21.8%	17
Totals: 78		

- 39 Half of the respondents (51.3%) replied in the negative, 26.9% replied in the affirmative, and 21.8% “uncertain”.
- 40 Some respondents stated that there is no specific set of jurisdictional rules governing cross-border IP disputes concerning entitlement to or ownership of an IP right in that State. As such, the principal rule for jurisdiction would apply, such as domicile of the defendant (see Question 7 above). It was further mentioned that if entitlement to or ownership of an IP right is based on a contract, the jurisdiction rules for contractual disputes would apply. Some respondents clarified that the exclusive jurisdiction rules provided for issues of IP validity and registration, do not apply to questions of entitlement or ownership.
- 41 Some respondents mentioned other general rules of jurisdiction may apply to claims of entitlement to or ownership of an IP right, including establishing jurisdiction if the subject matter of the claim is located within the forum, or if the action is a claim for the payment of monies and the seizable property of the defendant is located in the forum.
- 42 Some respondents noted that certain regional regulations, such as the EU CPVR Regulation, deal with the issue of ownership. In addition, the International Law Association’s Guidelines on Intellectual Property and Private International Law (Kyoto Guidelines) were referred to as proposing a specific ground for establishing jurisdiction in IP entitlement or ownership claims.

12. If the cross-border IP dispute concerns several claims, such as those mentioned in questions 8-11, would the jurisdiction rules or considerations be different than those required or permitted in individual claims?



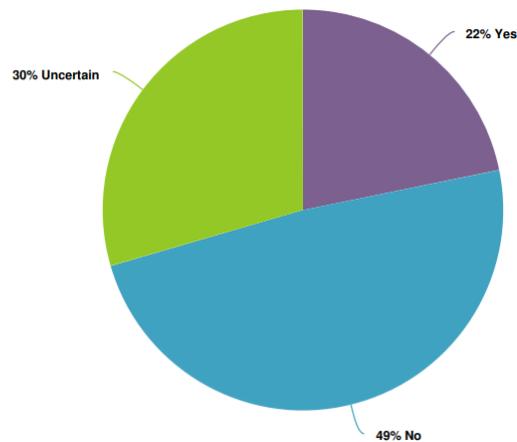
43 The majority of the respondents (60.3%) replied that if an IP dispute concerns several claims, there would be no difference in jurisdiction rules or consideration than those required or permitted in individual claims. Some respondents mentioned that in such cases, in their respective jurisdictions, the court has to have jurisdiction for each of the individual claims and not just one of the claims. In certain jurisdictions, the existence of various claims would be taken into account in deciding whether the court was *forum (non) conveniens*.

44 Only 14.1% answered there would be differences, while 25.6% answered “uncertain”.

45 Certain respondents mentioned that their laws allow several defendants to be sued or multiple claims to be consolidated before one court if certain conditions are met, such as if the defendants are closely connected, or if the subject matters are based on the same factual or statutory causes. It was also mentioned that in their jurisdictions, trademark, design, or unfair competition cases may be brought before the court simultaneously if they are interrelated.

46 One response stated that claims may be combined in a single legal action, if the dispute arises from a contractual legal relationship, as the parties shall have the right to determine jurisdiction independently, in accordance with the principle of freedom of contract or with the law in force (location of the respondent or their property).

13. Would the above considerations be different if they concern an IP right subsisting or registered in another jurisdiction?



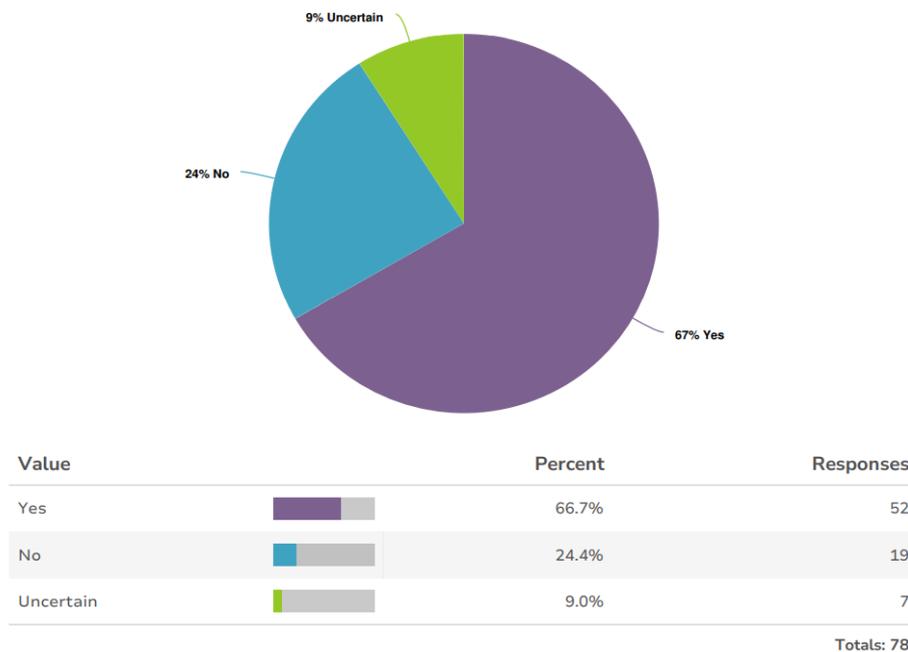
Value	Percent	Responses
Yes	21.8%	17
No	48.7%	38
Uncertain	29.5%	23

Totals: 78

- 47 Nearly half of the respondents (48.7%) replied that the above considerations would not be different when the IP right subsists or is registered in another jurisdiction. Around one third of the respondents (29.5%) replied “uncertain”. The remaining responses (21.8%) suggested that considerations would be different.
- 48 Those who replied that the above considerations would continue to apply explained that the fact that an IP right subsists or is registered in another jurisdiction is not relevant *per se* for the purposes of determining jurisdiction. This was noted as being subject to applicable rules for exclusive jurisdiction, which may confer jurisdiction to their courts irrespective of the domicile of the defendant.
- 49 Responses from States where administrative authorities exclusively deal with issues concerning validity, grant or registration of an IP right, noted that their national jurisdiction rules, in principle, do not prevent their courts from exercising jurisdiction over foreign IP disputes, except disputes concerning the validity of registered IP. Some respondents stated that their courts typically have not assumed jurisdiction to adjudicate foreign registered IP rights, such as trademarks or patent, while another respondent noted that their courts may deal or have dealt with foreign IP rights.

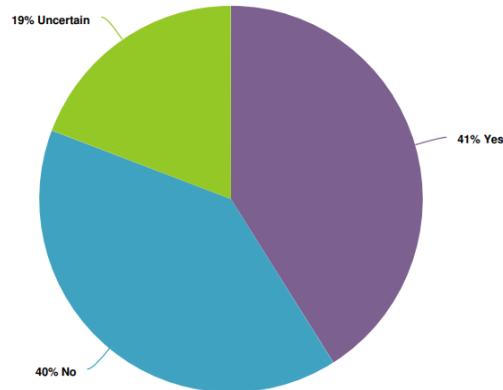
Exclusive jurisdiction

14. Would certain IP matters fall under exclusive jurisdiction of a court of your jurisdiction?



- 50 More than half of the respondents replied in the affirmative (66.7%), 24.4% replied in the negative and only 9% expressed uncertainty.
- 51 The vast majority of respondents who replied in the affirmative referred to their respective exclusive jurisdiction rules for proceedings relating to the registration or validity of patents, trademarks, designs or other similar rights that are deposited or registered in their jurisdictions. A few respondents mentioned also that infringement of IP rights, including copyright, fall under exclusive jurisdiction. One response stated that exclusive jurisdiction can be the result of an exclusive choice of court agreement.
- 52 Several respondents indicated that their courts will exclusively hear appeals made against the administrative decisions in relation to the registration, nullity, validity of IP rights, in particular when the right requires registration or deposit.
- 53 Certain respondents referred to their regional laws and practice in this regard. For example, under EU law, the exclusive jurisdiction rule for proceedings relating to the registration or validity of IP rights under Article 24(4) of the Brussels Ia Regulation applies irrespective of whether the issue is raised by way of an action or as a defence. In addition, there are specific rules concerning (exclusive) jurisdiction for IP rights that are unitary for the whole territory of the EU, e.g., EU trademarks, community designs, and plant variety rights.

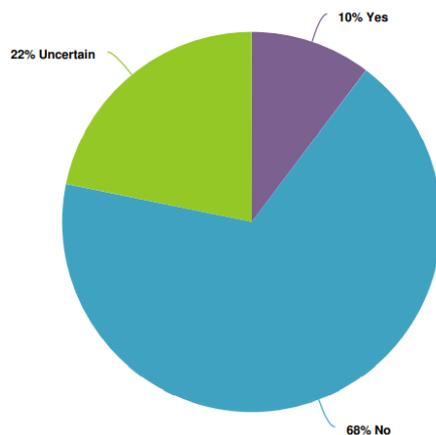
15. Would the above exclusive jurisdiction rules / considerations be different between registered and unregistered IP rights?



Value	Percent	Responses
Yes	41.0%	32
No	39.7%	31
Uncertain	19.2%	15
Totals: 78		

- 54 Responses were divided almost equally between affirmative (41%) and negative (39.7%). Responses in the affirmative indicated that, for example, exclusive jurisdiction concerns only registered IP rights; for unregistered IP rights, general rules apply. Responses in the negative indicated that their laws do not draw such a difference, or that there are no exclusive jurisdiction rules regarding IP matters. 19.2% of the respondents expressed uncertainty.
- 55 Several respondents who answered in the affirmative noted that their exclusive jurisdiction rules apply only to registered or deposited IP rights in proceedings concerned with the registration or validity of patents, trademarks, designs or other similar rights required to be deposited or registered, but not to unregistered IP rights or other IP-related disputes, such as infringement of IP rights.

16. Would the above exclusive jurisdiction rules / considerations be different if the IP issue is raised by way of an action, defence or counterclaim?



Value	Percent	Responses
Yes	10.3%	8
No	67.9%	53
Uncertain	21.8%	17

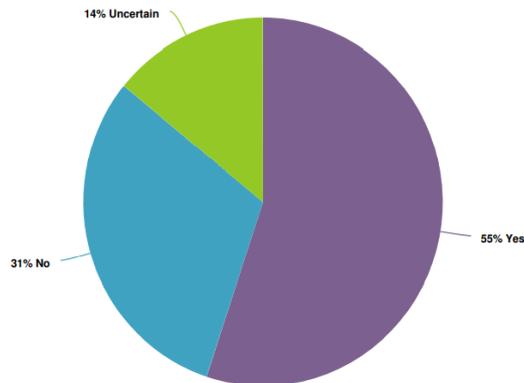
Totals: 78

- 56 Two thirds of the respondents (67.9%) replied in the negative. Only 10.3% of the respondents indicated that the above exclusive jurisdictions rules / considerations would be different, while 21.8% expressed uncertainty.
- 57 Some of the respondents who replied in the negative explained that the fact that an issue arises in a counterclaim does not bring it into the court's jurisdiction if, otherwise, it is outside that jurisdiction. It was also mentioned that, in some jurisdictions, a counterclaim would constitute acceptance of the court's jurisdiction to decide the issue and so preclude any argument that the court lacks personal jurisdiction to adjudicate the claim. If, however, if the court lacks subject matter jurisdiction, the lack of jurisdiction is not cured by the issue being raised by way of a counterclaim.
- 58 EU law (Art. 24(4) of the Brussels Ia Regulation) and practice¹⁷ were cited as confirming that the courts in the country of registration have exclusive jurisdiction even when validity of a registered or deposited IP right only arises as an incidental matter, as a defence or a counterclaim.
- 59 Certain respondents mentioned that, in their jurisdictions, questions relating to validity of registered IP rights are dealt with exclusively by administrative authorities, and courts have no authority to hear those questions. When validity questions are raised as a defence or counterclaim, and treated as incidental issues of the main issue concerning IP rights (ownership, contract, infringement), the ongoing court procedure over the main issue may be suspended. However, the rule on jurisdiction of the main issue will not be affected.

¹⁷ Judgment of 13 July 2006, *GAT v Luk*, C-4/03, EU:C:2006:457.

Prorogation of jurisdiction

17. Are there circumstances where the parties' agreed choice of forum may be denied in the claims raised in questions 8, 11 and 14?

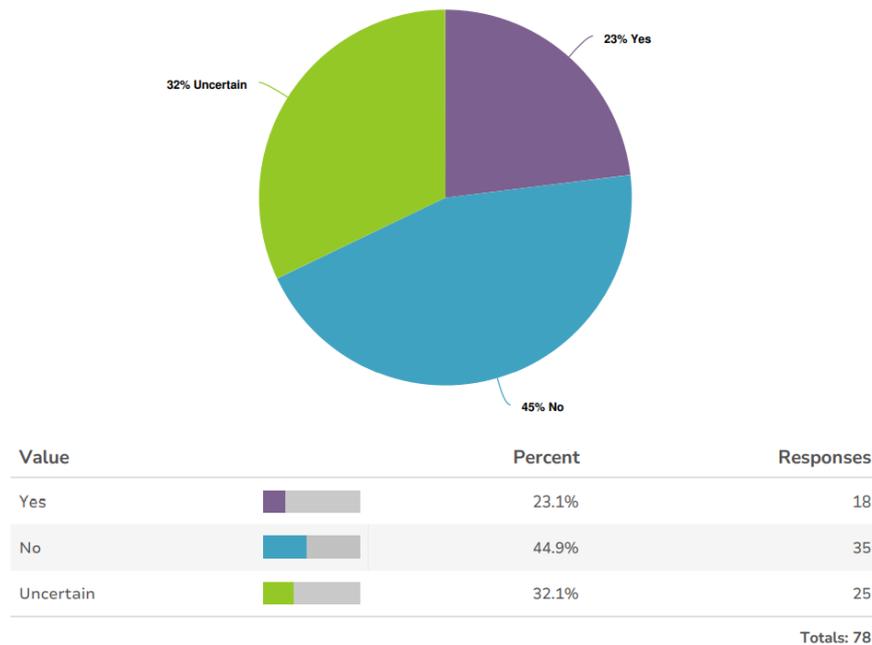


Value	Percent	Responses
Yes	55.1%	43
No	30.8%	24
Uncertain	14.1%	11
Totals: 78		

- 60 More than half of the respondents (55.1%) replied in the affirmative. Slightly less than one third (30.8%) replied in the negative, with 14.1% answering “uncertain”.
- 61 Among those who answered in the affirmative, some of them, especially those from common law jurisdictions, highlighted the general principle that a court has discretion to refuse to give effect to an exclusive jurisdiction clause if there is a strong cause or compelling reason to do so, such as the interests of justice or estoppel. It was further highlighted that, insofar as claims raised in questions 8 and 11 are concerned, the courts would lack subject matter jurisdiction to deal with foreign registered IP rights, even if the parties had agreed on a court to hear their dispute exclusively. As for claims raised in question 14, the court would treat itself as being exclusively competent to deal with IP rights registered in the jurisdiction, even if the parties had agreed to the exclusive jurisdiction of the foreign court. Non-exclusive choice of court agreements are not strictly enforced in common law jurisdiction; they are treated as a factor relevant to the *forum non conveniens* analysis.
- 62 Others who answered in the affirmative, notably those with a civil law background, mentioned that the parties' choice of court agreement should not conflict with exclusive jurisdiction for proceedings concerned with the registration or validity of patents, trademarks, designs, or other similar rights required to be deposited or registered. Choice of court agreements can be denied on the ground of public policy.

Preliminary questions

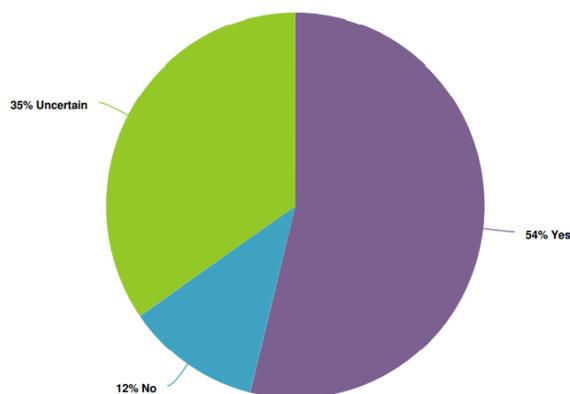
18. **Would a court deal with a matter that falls under the exclusive jurisdiction of a court of another State differently, if the matter is raised as a preliminary question or as the main subject matter of the dispute?**



- 63 Slightly less than half of the respondents (44.9%) replied in the negative. Around a quarter of the responses (23.1%) answered in the affirmative, with almost one third of the respondents (32.1%) expressing their uncertainty.
- 64 National courts may treat a matter that falls under the exclusive jurisdiction of a court of another State differently. A number of responses mentioned that if issues relating to foreign registered IP rights are raised as an incidental rather than as a primary question, for example through a defence, then their national courts may not dismiss the claim. In contrast, courts of some jurisdictions, even when having jurisdiction over an action, may dismiss an action entirely or partially without prejudice, if it finds special circumstances which may result in an inequitable decision, or which may obstruct a fair and speedy trial for either party.
- 65 A number of responses pointed to regional or international laws containing relevant provisions in this regard. In the intra-EU context, if a matter that falls under the exclusive jurisdiction of a court of another State is raised as the main subject matter of the dispute, the court seized has to declare that it has no jurisdiction pursuant to Article 27 of the Brussels Ia Regulation. However, if the matter is raised as a preliminary question, then the court in question can solve that question in order to proceed with the merits of the case.
- 66 It was noted that, in some jurisdictions, it is more common for courts to deal with IP rights registered in other jurisdictions as part of the facts of the case and rarely as the main subject matter of the dispute.

Multiple defendants/Consolidation

19. When there are multiple defendants located in different States that are involved in an IP dispute (e.g., subsidiaries of the same multinational company), can courts in your jurisdiction consolidate proceedings so as to sue all the defendants?



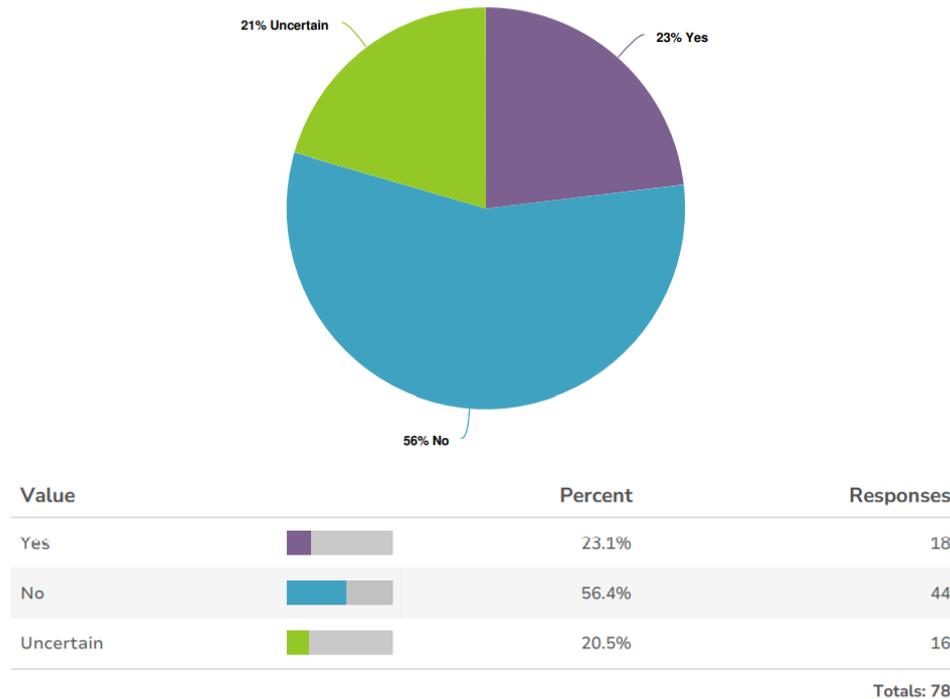
Value	Percent	Responses
Yes	53.8%	42
No	11.5%	9
Uncertain	34.6%	27
		Totals: 78

- 67 More than half of the respondents (53.8%) confirmed the possibility of consolidating proceedings in their respective jurisdictions, with 34.6% replying “uncertain” and 11.5% answering in the negative.
- 68 A number of those who answered that consolidation proceedings are possible mentioned conditions for the consolidation of proceedings. These conditions include, for example, the claims of the proceedings are connected; the proceedings involve a common question of law or fact or arise out of the same transaction. If the required conditions are met, then the court has the power to consolidate the proceedings, to hear them together, to hear one immediately after the other, or to stay proceedings until after determination of any of the other proceedings. It should be highlighted that consolidation is favoured for reasons that are not specific to IP cases, for instance, in the interests of justice, fair trial, efficiency, procedural economy and avoidance of inconsistent, diverging or irreconcilable court rulings. In particular, a number of respondents stressed the importance of irreconcilable rulings by referring to Article 8(1) of the Brussels Ia Regulation and the decisions of the Court of Justice of the European Union (CJEU) in *Freeport plc v Olle Arnoldsson*.¹⁸
- 69 Several respondents noted that consolidation could pose co-ordination and organisational difficulties, and that it would normally be requested by the plaintiff, not by the court. One respondent stated that, in their jurisdiction, courts are reluctant to grant it in practice.

¹⁸ Judgment of 11 October 2007, *Freeport plc v Olle Arnoldsson*, C-98/06, EU:C:2007:595.

Online IP activities

20. Are there specific rules or considerations in determining / establishing / challenging jurisdiction over IP matters relating to the internet, e.g., with regard to ubiquitous infringement?



- 70 While more than half of the respondents (56.4%) replied in the negative, around one fourth of the respondents (23.1%) indicated that they have specific rules, and 20.5% expressed their uncertainty.

- 71 Respondents provided following examples of approaches to determining jurisdiction for online infringement:

- One respondent suggested that mere access by the customer is generally insufficient for establishing jurisdiction. The focus is more on whether the party intended to offer its products in the jurisdiction of the customer.
- Some respondents highlighted the rule that if a website targets the customers of a forum State, which enables customers to transact business through an online medium, the court can exercise jurisdiction under the “part of cause of action” principle irrespective of the residence of the defendant (*i.e.*, the purposeful availment test). Besides, if the computer resource from where the uploading has taken place is residing in the jurisdiction, the court attains the jurisdiction to make global takedown orders.¹⁹ It is mentioned that a recent challenge has been raised in the case of intermediaries who wish to resort to geo-blocking but not global injunctions.

¹⁹ A line of relevant jurisprudence from India provided in the response(s) includes *WWE v. M/S Reshma Collection and Ors.* (FAO(OS) 506/2013, decided on 15 October 2014), *Juggernaut Books Pvt. Ltd. v. Ink Mango Inc. & Ors.* (CS (COMM) 421/2019, decided on 9 August 2019), *HT Media Limited & Anr vs Brainlink International, Inc.* (CS COMM 119/2020, decided on 28 April 2020), *Singh & Singh Law Firm LLP and Anr. v. Singh Singh Lawyers LLP and ors.* (2021 SCC Online Del 3059), and *Swami Ramdev & Anr. v. Facebook & Ors.*, AIR 2020 (NOC 529) 173.

- Another respondent mentioned that under a statutory provision of its jurisdiction²⁰, civil dispute cases involving infringement of the right to information network dissemination are under the jurisdiction of the court of the place where the infringing act was committed or where the defendant is domiciled. The place where the infringing act was committed includes the location of the network server, computer terminal and other equipment which implemented the alleged infringing act. If the place where the infringing act was committed and the defendant's domicile are both difficult to determine or outside the country, the location of the computer terminal and other equipment where the plaintiff found the infringing content may be considered as the place where the infringing act was committed, and thus the court there will have jurisdiction.
- In the context of the Brussels Ia Regulation and Lugano Convention, one respondent explained that the default rule that the defendant could be sued in their place of domicile still applies to online infringement. Nonetheless, there are specific considerations where the special jurisdiction rules concerning the place of harm under the Brussels Ia Regulation and Lugano Convention apply. It was stated that the CJEU has, on multiple occasions, interpreted the place of harm in relation to online activities, and different considerations may apply to different types of IP rights. Examples include:
 - a. *Database rights*: the harmful event occurs at least in the Member State where users are targeted (but this leaves open the possibility of a harmful event also taking place in the location where the content is extracted, or where the content is uploaded).²¹
 - b. *National trademarks*: the CJEU has noted that the place where the damage occurs is where the national mark is registered. The place where the event giving rise to the damage occurs is where the infringer carries out the action giving rise to the infringement. In the context of online keyword advertisement, this was the place where the infringer activates the adverts – the location of the server or the locations where the advertisements would be displayed were not found to be relevant. The court went on to find that the place of establishment of the advertiser is the place where the activation of the display process is decided, since this is a definite and identifiable place, both for the applicant and for the defendant, and is therefore likely to facilitate the taking of evidence and the conduct of the proceedings.²²
 - c. *Copyright*: The CJEU found that copyright infringement proceedings may be brought in any EU Member State where a website is accessible, even if it is not targeted at users there, although only in respect of damage incurred within each jurisdiction.²³ Of note, however, is that targeting may be a factor in determining whether copyright infringement actually took place, as there is a requirement to make the content available to the public and mere accessibility may not be sufficient. The court seized on the basis of the place where the damage occurred only has jurisdiction to rule on the damage caused in the territory of that Member State.²⁴
 - d. *Community rights*: Under the EU regulations governing community rights (EU trademarks and community designs), an action may be brought in the courts of a

²⁰ Art. 15 of the Provisions of the Supreme People's Court on Several Issues Concerning the Application of Law in Hearing Civil Dispute Cases Involving Infringement of the Right to Information Network Dissemination of the People's Republic of China.

²¹ Judgment of 18 October 2012, *Football Dataco Ltd and Others v Sportradar GmbH and Sportradar AG*, C-173/11, EU:C:2012:642.

²² Judgment of 19 April 2012, *Wintersteiger AG v Products 4U Sondermaschinenbau GmbH*, C-523/10, EU:C:2012:220.

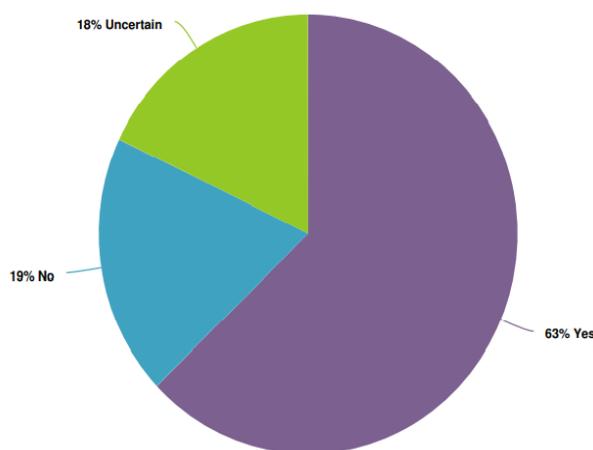
²³ Judgment of 22 January 2015, *Pez Hejduk v EnergieAgentur.NRW GmbH*, C 441/13, EU:C:2015:28.

²⁴ Judgment of 3 April 2014, *Hi Hotel HCF SARL v Uwe Spoering*, C-387/12, EU:C:2014:215.

Member State in which the act of infringement has been committed or threatened. This is worded slightly differently to the “place of harm” under the Brussels Ia Regulation. In *AMS Neve v Heritage Audio*, the CJEU applied Article 97(5) of the European Trade Mark Regulation No 207/2009 “International jurisdiction”, allowing proceedings to be brought in the court of the Member State where the targeted customers reside. The court held that advertising or offering goods for sale are infringing acts which are committed in the territory where the consumers or traders targeted by the advertisement/offer are located. The territory where the advertisement was placed online is not relevant.²⁵

Interim, including protective, measures

21. **Would a court in your jurisdiction be competent to decide or grant interim, including protective, measures in relation to an IP right subsisting or registered in another jurisdiction?**



Value	Percent	Responses
Yes	62.8%	49
No	19.2%	15
Uncertain	17.9%	14

Totals: 78

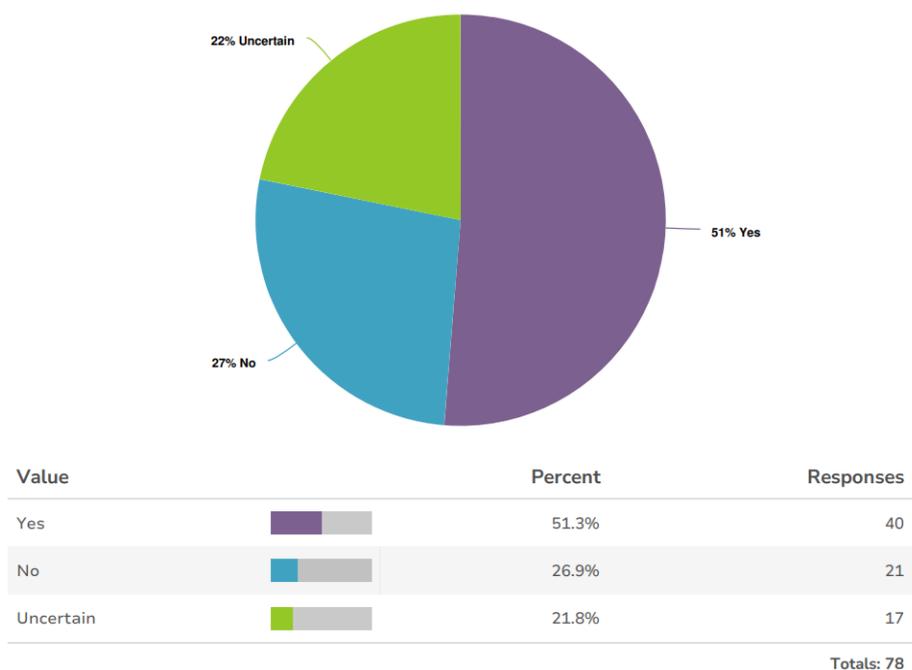
- 72 A majority of the respondents (62.8%) confirmed that courts in their respective jurisdiction are competent to decide or grant interim measures in relation to an IP right subsisting or registered in another jurisdiction, while 19.2% of the respondents said no and 17.9% “uncertain”.
- 73 One respondent explained the conditions for granting interim injunctions or other protective measures in respect of IP rights subsisting or registered in another jurisdiction: the defendant is located within the court's jurisdiction; the court can exercise *in personam* jurisdiction over the defendant; or for some other reason, the court is of the opinion that the cause of action has arisen in its jurisdiction.

²⁵ Judgment of 5 September 2019, *AMS Neve Ltd and Others v Heritage Audio SL and Pedro Rodríguez Arribas*, C-172/18, EU:C:2019:674.

74 Some respondents offered general conditions for granting interim measures, e.g., the court has competence over the substance of the case, or the property to be provisionally seized (or the disputed subject matter) is located within the jurisdiction.

Decline jurisdiction or stay proceedings

22. In cross-border IP disputes, in view of proceedings brought elsewhere, may a court in your jurisdiction stay the proceedings or decline to hear a dispute over which it has jurisdiction?



75 Half of the respondents (51.3%) answered yes. A quarter of the responses (26.9%) replied in the negative, with 21.8% saying “uncertain”.

76 A number of respondents, generally from common law jurisdictions, referred to the *forum non conveniens* doctrine, which in essence dictates that a court with jurisdiction has discretion to decline to exercise that jurisdiction on the basis of an assessment of the appropriateness of possible alternative forums to hear the case. Some of the possible factors that may be considered in such an assessment include which forum has the strongest nexus to the dispute, what are the reasonable expectations of the parties to the dispute with regard to the forum, whether there is an exclusive choice of court agreement, whether the outcome of the foreign proceedings would have bearing on the proceedings in the jurisdiction, and public interest.

77 A number of respondents from civil law jurisdictions referred to *lis pendens*: their courts may stay or decline the proceedings where an earlier proceeding between the same parties and based on the same fact or cause of action is pending in a foreign court. Several respondents also stated that their courts may decline to hear the case if there is a foreign decision on the same dispute, and the decision may be recognised by their courts.

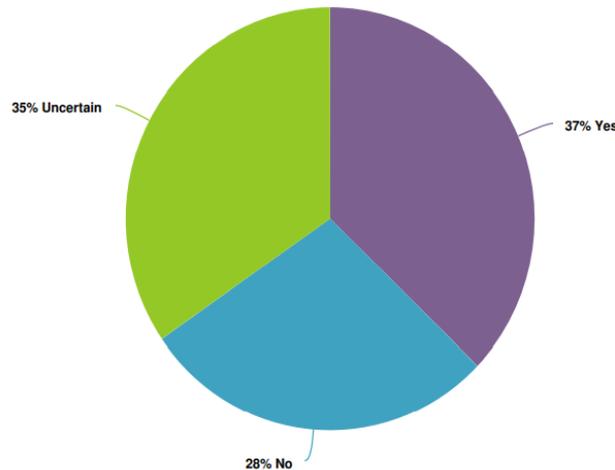
78 Some respondents referred to the Brussels Ia Regulation, according to which a court in the EU may stay proceedings if it is expected that a court in a third State would issue a judgment capable of being recognised and enforced in that EU Member State and such a stay is necessary for the proper administration of justice. However, the EU court may continue

proceedings if the case in the third State is stayed or discontinued, if it appears that the proceedings in the third State are unlikely to be concluded within a reasonable time, or if such continuation is required for the proper administration of justice. The proceedings shall be dismissed if the court in the third State issues a judgment capable of being recognised and enforced in the EU Member States. For IP-related litigation, it is noted that this rule applies only where the jurisdiction of the EU court is based on the place of domicile of the defendant or applies in infringement cases.

79 It is noted that courts would also consider the possible blocking effect of foreign “Italian torpedo” proceedings.

Territorial scope of remedies

23. **Are there circumstances where a remedy granted by a court in your jurisdiction may have extraterritorial legal effect, such as an award of damages incurred in a foreign country or an injunction outside the forum?**



Value	Percent	Responses
Yes	37.2%	29
No	28.2%	22
Uncertain	34.6%	27

Totals: 78

80 The numbers of respondents replying in the affirmative, negative, and “uncertain” were nearly the same.

81 Some respondents indicated the following remedies that could have extraterritorial legal effects, e.g., an injunction to freeze assets located outside the forum, to restrain an entity from exporting infringing goods, to restrain a foreign entity from authorising, procuring, inducing or joining in a common design with a local entity to exploit an invention within the jurisdiction where the patent right is registered. Nevertheless, it is highlighted that an injunction against a foreign entity could be difficult to enforce if the entity has no presence in the jurisdiction, and this may be a factor that courts take into account at the jurisdictional stage. Some respondents

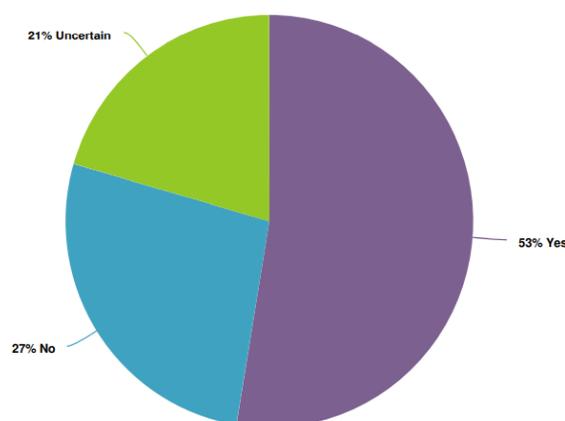
mentioned “global injunction/take down order(s)”, as illustrated in *Swami Ramdev & Anr. v Facebook, Inc. & Ors.*²⁶ and *Google Inc. v Equustek Solutions Inc*²⁷.

82 On the other hand, some of the respondents replying in the negative or expressing their uncertainties highlighted the territoriality principle in relation to IP rights, and the general principle that judgments are valid only within the territory of that jurisdiction, unless the judgments are recognised as valid in another jurisdiction.

Applicable Law

24. Please respond to the applicable law questions below for specific types of disputes, in your jurisdiction:

a) In a validity, grant or registration dispute concerning registered IP rights, would the law of the State in which the registered right is granted or registered be exclusively applicable?



Value	Percent	Responses
Yes	52.6%	41
No	26.9%	21
Uncertain	20.5%	16

Totals: 78

83 Slightly more than half of the respondents (52.6%) indicated that the law of the State in which the IP right is granted or registered would be exclusively applicable in a validity, grant or registration dispute. The respondents referred to the territoriality principle of IP rights when answering this question.

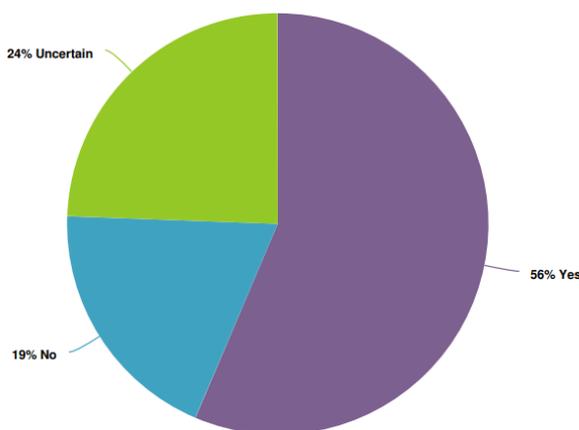
84 Respondents answering in the negative (26.9%) mentioned that various choice of law rules are applicable in such disputes. They are, among others, the law of the forum (*lex fori*), the law of the State in which protection of the IP rights is sought (*lex loci protectionis*), the law of the State in which the infringement took place, and the law determined by the provisions stipulated in international conventions on IP (e.g., the Paris and Berne Conventions) to which the State is a party.

²⁶ *Swami Ramdev & Anr. v Facebook, Inc. & Ors*, AIR 2020 (NOC 529) 173 (23 October 2019) (Delhi High Court).
²⁷ *Google Inc. v Equustek Solutions Inc* [2017] 1 SCR 824 (Supreme Court of Canada).

85 It was also mentioned that for EU unitary IP rights, such as for EU trademarks, designs or plant variety rights, the applicable substantive law is the one adopted in the relevant EU legislation: EU Trade Mark Regulation, EU Community Designs Regulation and EU CPVR Regulation.

86 The rest of the respondents (20.5%) answered that in such disputes, either specific applicable law rules do not exist, or it is uncertain which law will be applicable.

b) In an *offline* infringement dispute, would the law of the place of infringement be applicable?



Value	Percent	Responses
Yes	56.4%	44
No	19.2%	15
Uncertain	24.4%	19
Totals: 78		

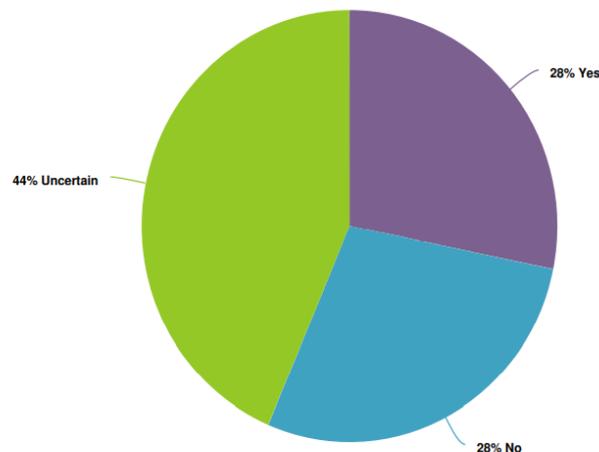
87 Over half of the respondents (56.4%) answered in the affirmative. However, there were diverse views as to what constitutes “the place of infringement”. It can be construed, among other ways, as the following: (a) the place where the damage is sustained, (b) the place where the alleged illicit activity was committed, (c) the place in which both the illegal activity and the damage resulting from such an activity took place, or (d) the place where the direct harm happened.

88 It should also be noted that, in addition to the law of the place of infringement, several respondents stated that the law chosen by the parties, the law of the place where the defendant carries on business, and the law of the residence or domicile of the defendant, could also be applicable to an offline infringement dispute.

89 Reference was made to Article 8 of the Rome II Regulation applicable in the EU in some responses. This provision provides a special regime for the law applicable to non-contractual obligations arising from an infringement of IP rights. Accordingly, (a) the law of the country for which protection is claimed (*lex loci protectionis*) shall apply, and (b) parties have no freedom of choice with regard to the applicable law. The exception to this principle is in the case of infringement of EU unitary IP rights where the applicable law is the law of the country in which the act of infringement occurred.

90 One fourth of the respondents (24.4%) answered “uncertain” to this question.

c) In an *online* infringement dispute, would the law of the place of uploading be applicable?



Value	Percent	Responses
Yes	28.2%	22
No	28.2%	22
Uncertain	43.6%	34

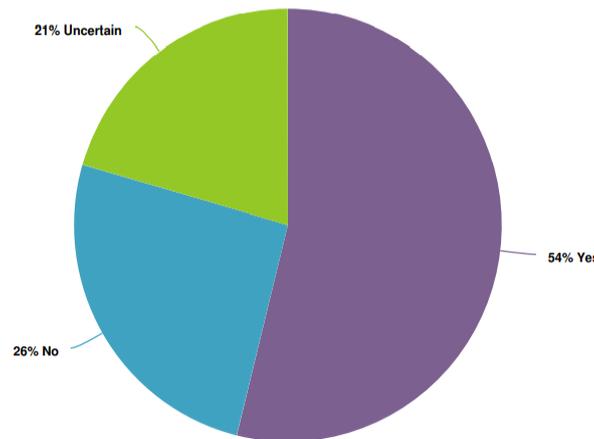
Totals: 78

- 91 Almost half of the respondents (43.6%) answered “uncertain” to this question, with equal numbers of respondents answering in the affirmative and the negative (each account for 28.2%).
- 92 The negative responses reflected diverging approaches towards applicable law in their respective jurisdictions, *e.g.*, (i) the law of the place where the victim came to know about the damage, (ii) the law of the place in which the damage occurred or where the IP rights holder sustained the damage, (iii) the law of the country for which the protection is claimed or sought (*lex loci protectionis*), (iv) the law of the country of registration of the IP rights, (v) the law of the forum (*lex fori*), (vi) the law of the place where intended market customers are located, or (vii) the law of the residence of the defendant.
- 93 Some respondents considered that the law of the country for which the protection is claimed or sought (*lex loci protectionis*) covers the law of the place of uploading. Certain respondents also indicated that the law of the place where the act of infringement was committed, which covers the law of the place of uploading, is applicable if the place where the result of the wrongful act occurred is ordinarily unforeseeable. The law of the place of uploading may also be applicable if the law of the place where the wrongful act occurred cannot be ascertained.
- 94 One respondent stated that the “country in which the act of infringement was committed” within Article 8(2) of the Rome II Regulation refers to the country where the event giving rise to the damage occurred. Where the same defendant is accused of various acts of infringement in various EU Member States, the correct approach for identifying the event giving rise to the damage is not to refer to each alleged act of infringement, but to make an overall assessment

of that defendant’s conduct in order to determine the place where the initial act of infringement at the origin of that conduct was committed or threatened by it.²⁸

95 One respondent mentioned that the place of uploading may be relevant in determining the applicable law in relation to EU unitary IP rights for any question not governed by the relevant EU Regulations. At the same time, the respondent referred to a judgment rendered by the CJEU in the context of online infringement of an EU trademark, where the court found that the place of uploading was not relevant, and that the court must be satisfied that the infringing acts were committed in their territory.²⁹

d) In a contractual dispute relating to an IP right, such as licensing, would the parties’ choice of law always be respected?



Value	Percent	Responses
Yes	53.8%	42
No	25.6%	20
Uncertain	20.5%	16

Totals: 78

96 Over half of the respondents (53.8%) indicated that the parties’ chosen law would be respected in a contractual dispute relating to an IP right. The remaining respondents either answered in the negative to the question (25.6%), or answered “uncertain” (20.5%).

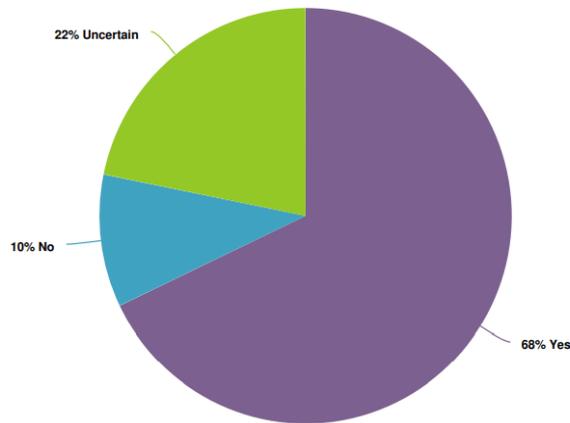
97 Some respondents stated that the parties’ choice of law is subject to statutory limitation. Parties’ choice of law would also be reversed if the application, and consequences of such application, of foreign law are contrary to the mandatory rules and public policy of the forum (or the public policy of the foreign jurisdiction), or if the chosen foreign law cannot be determined. A response deemed “foreign illegality or violation of foreign public policy” a ground for determining a contract unenforceable irrespective of its proper law. Some respondents referred to the Rome I Regulation, which upholds the autonomy of the parties in a contractual dispute relating to an IP right, while providing for certain limitations.

²⁸ Judgment of 27 September 2017, *Nintendo Co. Ltd v BigBen Interactive GmbH and BigBen Interactive SA*, Joined Cases C-24/16 and C-25/16, EU:C:2017:724

²⁹ Judgment of 5 September 2019, *AMS Neve Ltd and Others v Heritage Audio SL and Pedro Rodríguez Arribas*, C-172/18, EU:C:2019:674.

98 One respondent indicated that the law of the country in which the license contract is implemented shall apply in such disputes.

e) **In a contractual dispute relating to an IP right, such as licensing, in the absence of a parties' choice of law or the parties' choice is found to be invalid, would the law governing the contract be the applicable law to the dispute?**



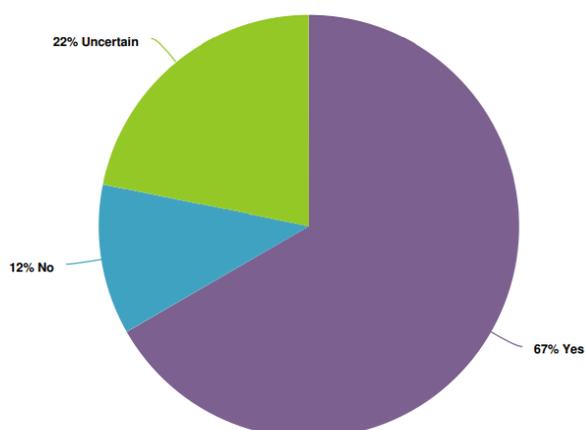
Value	Percent	Responses
Yes	67.9%	53
No	10.3%	8
Uncertain	21.8%	17

Totals: 78

99 The majority (67.9%) of the respondents indicated that the law governing the contract would be applicable to such disputes. Certain respondents referred to the choice of law rules laid down in the Rome I Regulation, in particular Article 4. 21.8% of the respondents answered “uncertain”.

100 A small number of respondents (10.3%) answered in the negative, some noting that the law most closely connected to the dispute would be applicable.

f) In a dispute concerning initial title or ownership, would the law of the State for which protection is sought be the applicable law?

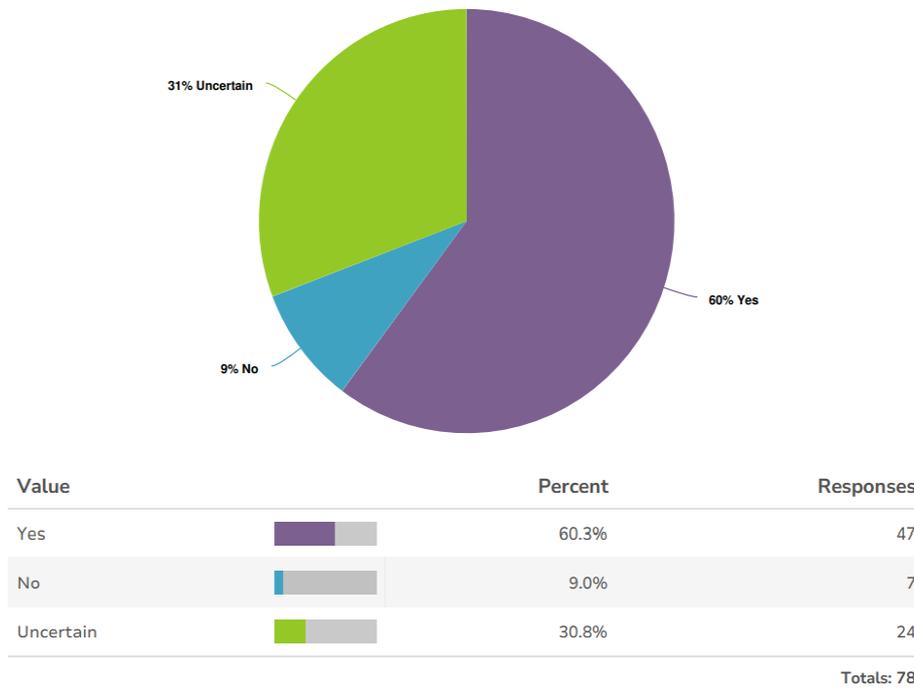


Value	Percent	Responses
Yes	66.7%	52
No	11.5%	9
Uncertain	21.8%	17

Totals: 78

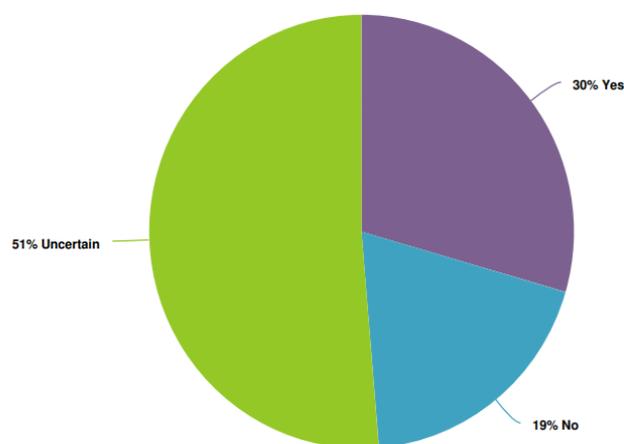
- 101 The majority of (66.7%) respondents answered in the affirmative, and more than one fifth of the respondents (21.8%) answered “uncertain”. Several respondents indicated that the EU regulations do not harmonise applicable law rules as regards disputes concerning the initial title or ownership to IP rights. It is thus for the Member State’s national private international law rules to regulate the matter.
- 102 It was specified by a few respondents (11.5%) answering in the negative that the law of the country where the disputed IP right is registered, or the law of the forum, would be applicable instead.

g) In a dispute concerning transferability, would the law of the State for which protection is sought be the applicable law?



- 103 The majority of respondents (60.3%) confirmed the application of *lex loci protectionis* in IP disputes concerning transferability. However, close to one third of the respondents (30.8%) provided “uncertain” as answer to this question. Certain respondents clarified EU law in this topic: the EU law does not regulate which law is applicable in the absence of a contract regulating the transfer of IP rights, whereas in relation to the three EU unitary IP rights, the European legislator provided that these IP rights, as objects of property, shall be dealt with in their entirety, and for the whole area of the Community. A similar principle is reflected in EU legislation regarding unitary patent protection.
- 104 Only a small number of respondents (9%) indicated different approaches, e.g., the law of the forum, the law specified by international conventions on IP rights, or the law of the place of registration of IP rights.

h) In a dispute concerning security rights in IP, would the law of the State where the grantor has his/her domicile or (habitual) residence at the time of the creation of the security right be applicable?



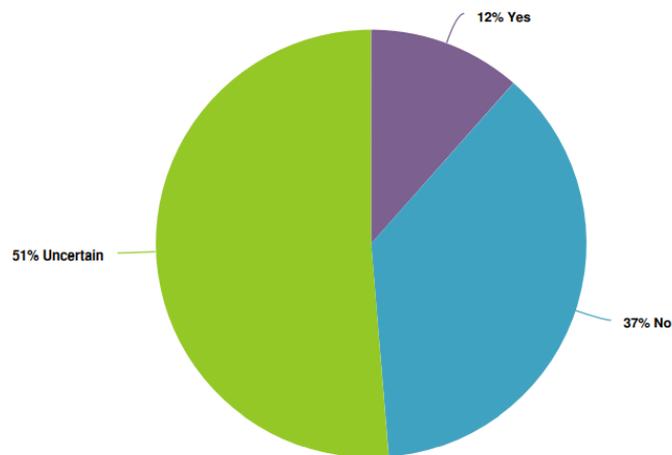
Value	Percent	Responses
Yes	29.5%	23
No	19.2%	15
Uncertain	51.3%	40

Totals: 78

105 Half of the respondents (51.3%) provided “uncertain” as answer to this question. Some of them mentioned that their jurisdictions do not specify any rule dealing with the applicable law on security rights in IP.

106 While more than one fourth of the respondents (29.5%) answered this question affirmatively, one fifth of the respondents (19.2%) replied in the negative and referred to different applicable law rules, *e.g.*, *lex fori*, *lex loci protectionis*, the law of the place of the conclusion of the contract, or the law of the place where the assets subject to the security interest are located or registered.

i) **Are there other types of IP disputes that would encounter applicable law issues?**

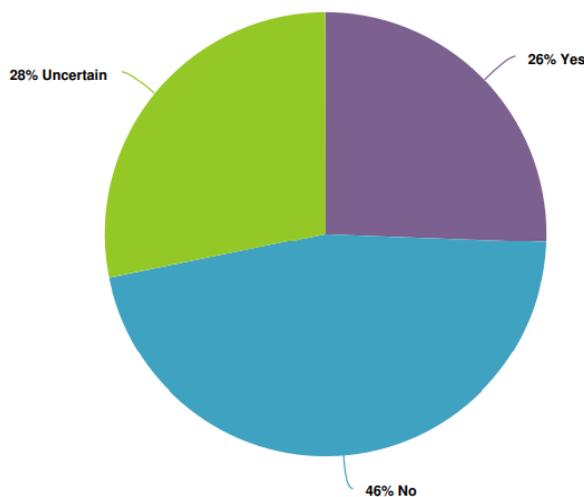


Value	Percent	Responses
Yes	11.5%	9
No	37.2%	29
Uncertain	51.3%	40

Totals: 78

- 107 Half of the respondents (51.3%) were uncertain as to the existence of other types of IP disputes that would encounter applicable law issues. More than one third of the respondents (37.2%) answered in the negative.
- 108 However, a small number of respondents (11.5%) answered in the affirmative and provided the following examples: disputes relating to the performance of international artists; the use of phonograms abroad; disputes involving the rights of broadcasting companies and collecting societies; questions of patentability, in particular in relation to novelty and disclosure in a different country; FRAND disputes; and unfair competition.

25. In cross-border IP disputes, would a court in your jurisdiction apply different laws to different claims in the same suit in relation to the same rights?

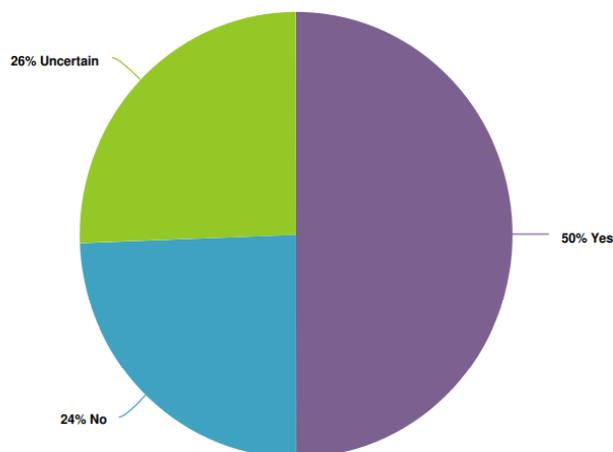


Value	Percent	Responses
Yes	25.6%	20
No	46.2%	36
Uncertain	28.2%	22
Totals: 78		

109 Almost half of the respondents (46.2%) indicated that courts in their jurisdictions would not apply different laws to different claims in the same suit in relation to the same rights. Nearly one quarter (28.2%) of the respondents stated “uncertain” and another quarter (25.6%) answered the question affirmatively.

110 Respondents answering in the affirmative mentioned several reasons in support of their answers. Some respondents highlighted the role of judges in this situation, noting that the ascertainment of the applicable law is decided by judges and that most judges would separate the claims into different suits. In addition, it was noted that complexity and circumstances of each case might demand the application of different laws to different claims. Some respondents mentioned that different laws may be applied if the parties choose so.

26. Can a foreign law chosen by the parties be set aside by a court of your State in cross-border IP cases?

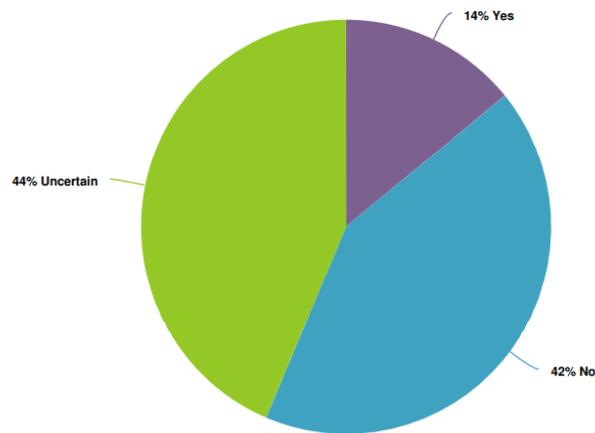


Value	Percent	Responses
Yes	50.0%	39
No	24.4%	19
Uncertain	25.6%	20
Totals: 78		

- 111 Half of the respondents (50%) confirmed that a foreign law chosen by the parties can be set aside by a court of their jurisdiction in cross-border IP cases. Of the other half, an equal number of respondents indicated either “uncertain” or answered negatively to this question.
- 112 Most respondents referred to “public order/policy” and “mandatory rules” of the forum as grounds to set aside the parties’ choice of foreign law. There were also a number of other reasons on the basis of which foreign law may not be given effect in cross-border cases, e.g., (a) the chosen foreign law does not have sufficient connection with the dispute, (b) the party pleading the application of foreign law does not prove the foreign law, (c) the foreign law is not a *bona fide* choice of law, and (d) on account of sovereignty principle that may exclude the application of foreign law by a national court. Some respondents stated that if the contract is concluded in its jurisdiction, the law of that jurisdiction, i.e., *lex fori*, would prevail and a choice of foreign law would not be accepted.
- 113 In relation specifically to IP infringement disputes, it was noted that due to the territoriality principle, certain jurisdictions do not allow parties to choose the applicable law, and as such, a foreign law chosen by the parties would be set aside.

Recognition and Enforcement

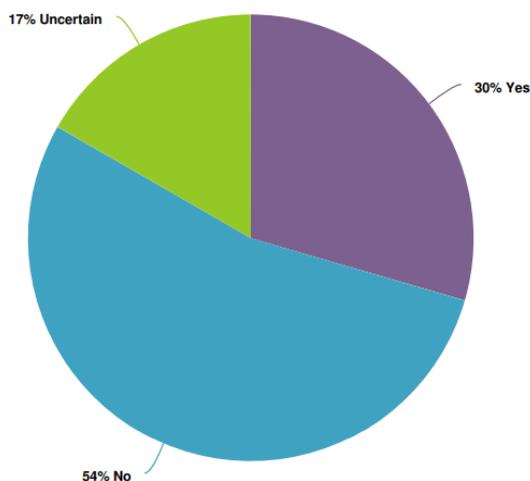
27. Have you experienced difficulties in having an IP-related judgment recognised and / or enforced outside the State where it was given?



Value	Percent	Responses
Yes	14.1%	11
No	42.3%	33
Uncertain	43.6%	34
Totals: 78		

- 114 Only 14.1% of the respondents indicated that they have experienced difficulties, while 42.3% said “no” and 43.6% replied “uncertain”.
- 115 A few respondents stated that recognition and enforcement of foreign IP-related judgments is always complicated and difficult, and provided examples, as in the case of a California Court that refused to apply a decision of the Supreme Court of Canada in *Google v Equustek*. In addition, one respondent noted challenges that arise in patent disputes where injunctions are increasingly being issued, particularly in the area of SEPs. For example, in some cases courts have issued anti-enforcement injunctions prohibiting owners of SEPs from enforcing an injunction order issued abroad.
- 116 One response also noted the potential relevance of the HCCH 2005 Choice of Court Convention in this regard, albeit with limited application to certain aspects of copyright and related rights only.

28. Does your jurisdiction have recognition and enforcement rules specific for foreign IP-related judgments?



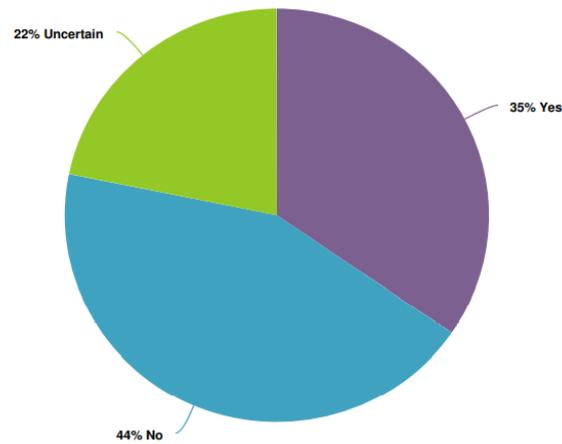
Value	Percent	Responses
Yes	29.5%	23
No	53.8%	42
Uncertain	16.7%	13

Totals: 78

117 More than half of the respondents (53.8%) replied that in their respective jurisdictions there are no specific recognition and enforcement rules for foreign IP-related judgments, with less than one third of the respondents (29.5%) answering in the affirmative, and 16.7% “uncertain”.

118 Some respondents mentioned that general rules on recognition and enforcement are applied to IP-related judgments. A few respondents indicated that there are certain regional frameworks that provide recognition and enforcement rules specific for foreign IP-related judgments, e.g., EU Trade Mark Regulation, EU Community Designs Regulation, EU CPVR Regulation concerning judgments on such community rights, EU Protocol on Recognition providing specific rules on recognition of European patents, and the Arrangement on Mutual Recognition and Enforcement of Judgments in Civil and Commercial Matters by the Courts of the Mainland and the Hong Kong Special Administrative Region.

29. Does your jurisdiction have any specific grounds to refuse the recognition and / or enforcement of a foreign IP judgment?



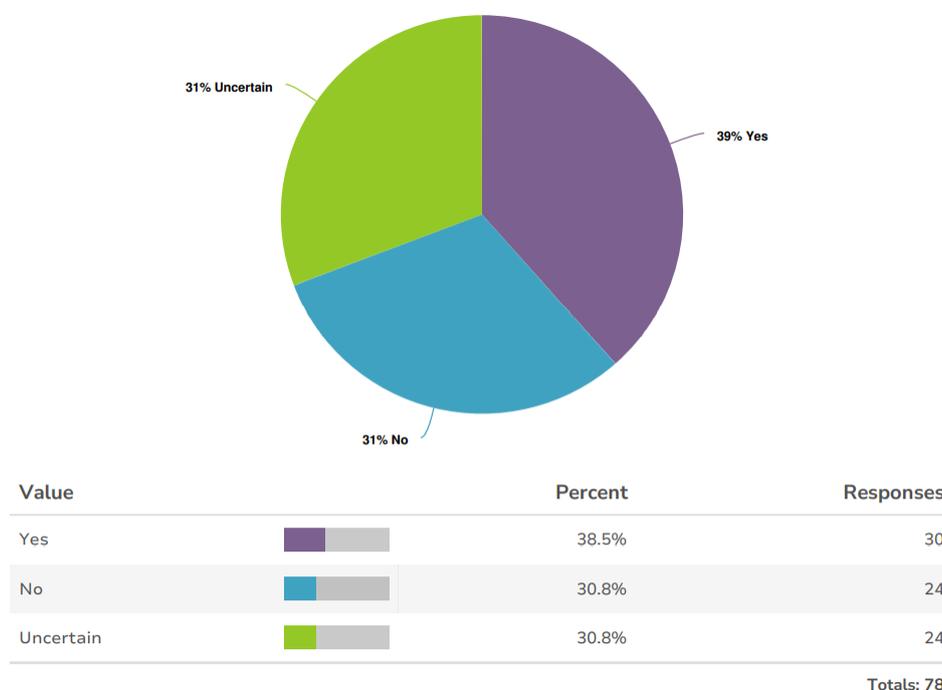
Value	Percent	Responses
Yes	34.6%	27
No	43.6%	34
Uncertain	21.8%	17

Totals: 78

- 119 Almost half of the respondents (43.6%) replied that in their respective jurisdictions there are no specific grounds for refusal in relation to a foreign IP judgment, with one third of the respondents (34.6%) replying in the affirmative, and 21.8% expressing their uncertainty.
- 120 Several responses stressed that interference with exclusive competence of the court in IP cases is an important ground for refusal.

Provisional measures or interim decisions

30. Can provisional measures or interim decisions relating to IP rendered in a foreign State be recognised and / or enforced in your jurisdiction?



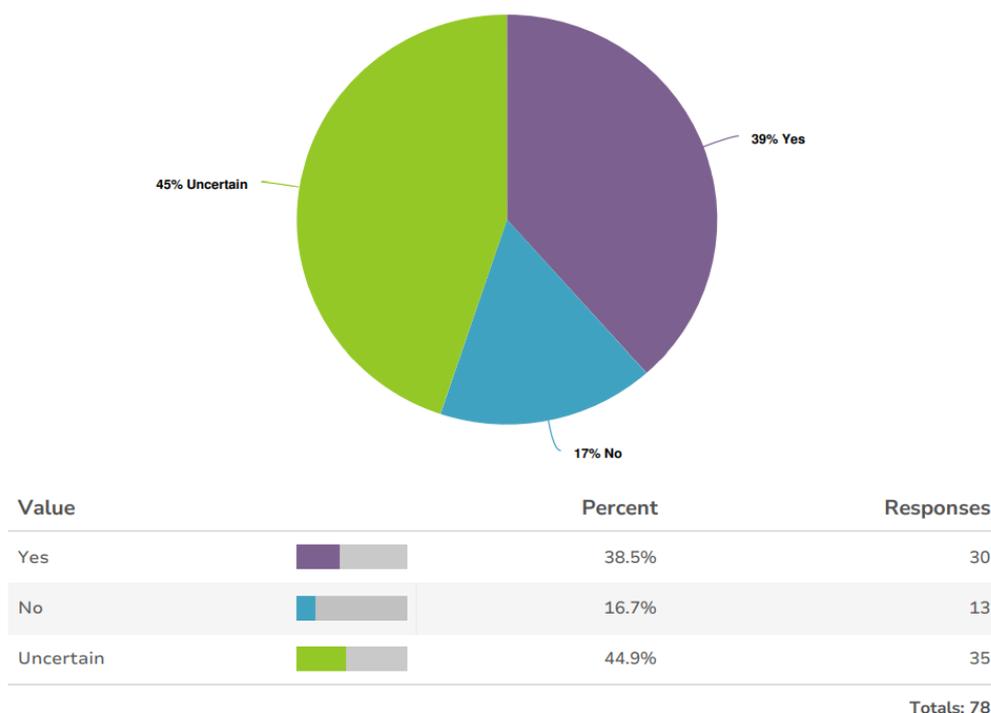
121 The respondents are almost equally divided: more than one third of the respondents (38.5%) replied in the affirmative, stating that provisional measures or interim decisions relating to IP from a foreign State can be recognised and / or enforced in their respective jurisdictions; around one third (30.8%) responding in the negative; and 30.8% of the respondents indicating “uncertain”.

122 Those who replied in the affirmative highlighted that the rules are of a general nature. A number of respondents from common law jurisdiction emphasised that, in principle, for provisional measures or interim decisions to be recognised and enforced in the jurisdiction, they have to be both “final and conclusive” and money (or monetary) judgments. It is noted that in Canada, following the Supreme Court of Canada’s decision in *Pro Swing Inc. v. Elta*³⁰, non-money (or non-monetary) judgments could be enforced, subject to the court’s discretion, but only if they are final.

123 In addition, the Brussels Ia Regulation and the Lugano Convention provide general rules for circulation of provisional, including protective, measures ordered by a court having jurisdiction as to the substance of the matter, with certain limitations. These measures also apply to disputes relating to IP rights. Certain respondents also noted that interim measures may not be recognised or enforced in circumstances where granted IP rights exist in the jurisdiction in which precautionary measures are sought to be recognised or enforced.

³⁰ *Pro Swing Inc. v. Elta Golf Inc.* [2006] 2 SCR 612 (Supreme Court of Canada).

31. If courts in your jurisdiction do recognise or enforce foreign IP-related judgments, do they recognise and/or enforce non-monetary part of the judgments, such as injunctions?



124 Almost half of the respondents indicated “uncertain”. More than one third of the respondents (38.5%) answered that their courts recognised and/or enforced non-monetary part of the judgments, such as injunctions, with 16.7% saying “no”.

125 Some respondents noted that foreign non-monetary judgments could be enforced in certain jurisdictions, such as in Canada, subject to the court’s discretion and if they are final; in Australia, by virtue of the Trans-Tasman Proceedings Act 2010 (Cth) relating to non-pecuniary judgments rendered by courts of New Zealand ; in the EU, by reference to the Brussels Ia Regulation; and in the EU and EFTA, by reference to the Lugano Convention. It was also noted that in the Brussels Ia Regulation, judgment adaptation may be needed when the foreign judgment contains a measure or an order that is unknown in the law of the enforcement State, particularly in non-monetary orders.

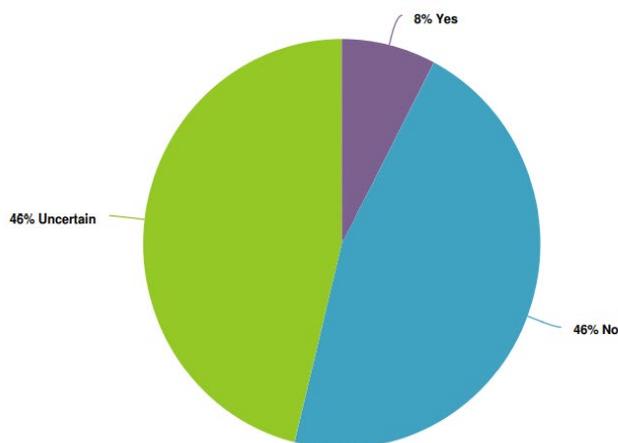
126 It was mentioned that in the EU, courts of a Member State may issue a cross border injunction in case of infringement of any of the unitary IP rights. In addition, the HCCH 2005 Choice of Court Convention covers the recognition and enforcement of non-monetary judgments, but as noted in its Explanatory Report, a Contracting Party is not obliged to enforce a judgment for a non-monetary remedy if this is not possible under its legal system. Nevertheless, it should give the foreign judgment the maximum effect that is possible under its internal law.³¹

127 Certain respondents also noted that in their respective jurisdictions, it would be easier to enforce an injunction if it is part of a settlement agreement, but harder if the order is a result of a default judgment rendered due to one party not appearing in the foreign jurisdiction.

³¹ Note 201 to para. 164 of the Explanatory Report.

C. Others

32. Are there any other PIL issues arising in cross-border IP disputes which are not addressed above?



Value	Percent	Responses
Yes	7.7%	6
No	46.2%	36
Uncertain	46.2%	36

Totals: 78

128 The same number of respondents replied either “no” or “uncertain” to this question (46.2%), leaving only 7.7% of the respondents that replied in the affirmative.

129 Some of those who replied in the affirmative suggested the following possible points for further analysis:

- Open Source License Disputes
 - (a) Global enforcement of open source license terms, including in jurisdictions which do not have full understanding of the foreign law upon which the terms were drafted;
 - (b) Ownership and the right to bring an action cannot be attributed to one or a small number of authors; or the number of authors is so big that challenges arise in the application of the regular procedural rules on ownership or right of action.
- Applicable law in disputes involving collecting societies
- Jurisdiction, applicable law and recognition and enforcement in FRAND disputes, including the setting of a global license rate by one court
- Relationship between choice of law rules on IP and regional integration instruments (e.g., EU unitary rights)
- Law applicable to violation of trade secrets
- Other technical and practical problems, such as techniques of forum shopping, [in]accessibility of remote jurisdictions, lack of regulatory unification, and the effects of AI to IP and particularly to the IP-PIL sector
- Ubiquitous cases, including questions on applying a single law, overcoming denial of justice despite the clash with territoriality, and establishing a *de minimis* rule for jurisdiction and choice of law level (to avoid improper cases being brought and having to be fought in online cases details and examples can be found in the CLIP Principles).

D. Future work

33. In inviting WIPO to cooperate with HCCH on this questionnaire, the governing body of the HCCH recognized the need for further work on the intersection of private international law and IP (Conclusions and Decisions of HCCH Council on General Affairs and Policy 2020). Please share any observations or suggestions that you may have on possible future activities by HCCH and WIPO in relation to the PIL and IP interface, such as greater awareness raising and educational initiatives, enhanced judicial cooperation or coordination, or continued discussion within the HCCH Jurisdiction Project.

130 The responses can be summarised in two main categories:

- The majority of the respondents mentioned the following activities:
 - Greater awareness building: There was general support in favour of future activities in relation to the interface between PIL and IP. In particular, the vast majority of respondents supported the organisation of training courses, conferences, academic seminars, thematic studies, comparative studies or roadshows to deepen the understanding of the interface between PIL and IP. Some suggested organising activities, at regional or international levels, jointly with other institutions such as WIPO, law schools, and other key regional IP institutions. A number of respondents encouraged the engagement of, and knowledge exchange among, IP holders, practitioners, agencies and judges in these activities.
 - Judicial training: A number of respondents highlighted the importance of judicial cooperation and training for judges. The WIPO IP Judges Forum was cited as an example where judges can engage in dialogue and exchange knowledge with one another. It was suggested that national IP rulings should be disseminated more widely,³² and that topics such as technology and online hearings may be worth consideration for trainings.
 - A few respondents suggested developing practical guides on best practices in resolving disputes involving the interface between PIL and IP.
- Certain Members mentioned that cross-border IP dealings do not raise actual and practical issues of PIL that warrant further work by the HCCH or by WIPO. Particularly, one Member considered that, given the dearth of any such issues, any efforts to harmonize any actual or perceived differences in legal approaches to cross-border IP dealings are similarly not warranted.

³² For information, please refer to the Judgments Collection in WIPO Lex at <https://wipo.lex.int/en/main/judgments>.

HCCH-WIPO Questionnaire on Identifying Actual and Practical Issues of Private International Law in Cross-Border Intellectual Property Dealings



Instructions for Completion

1. For the purposes of this Questionnaire, the term “intellectual property” includes the following categories of intellectual property: copyright and related rights; trademarks; geographical indications; industrial designs; protection against unfair competition; patents and utility models; layout-designs (topographies) of integrated circuits; protection of undisclosed information; protection of undisclosed information (trade secrets); and plant breeders’ rights. In addition, the term “cross-border IP disputes” refers to IP disputes that raise private international law questions.
2. When completing the Questionnaire, kindly answer only the questions that you consider relevant in light of your experience in this area, and specify when your response is specific to only certain types of IP rights.
3. Please include or attach any relevant information on domestic, regional, or multilateral instruments and related provisions, actual IP cases (incl. references), and any statistics relating to cross-border IP disputes, as appropriate. Any additional information or material provided is equally welcome.
4. Your cooperation in responding to this Questionnaire is greatly appreciated and will provide invaluable assistance to the Secretariats of HCCH and WIPO.

Name of Member/Institutions/Other: *

Information (for follow-up purposes)

Name and title of contact person: *

Name of Authority / Office, where relevant:

Member State / Organization / Other *

Telephone number: *

E-mail address: *

Questionnaire

1. Does your jurisdiction have statutory provisions or case law addressing, expressly or impliedly, PIL issues (jurisdiction, applicable law, recognition and enforcement of foreign judgments, administrative or judicial international cooperation) in cross-border IP disputes? *

- Yes
- No
- Uncertain

Please describe: *

Please attach relevant provisions or case law:

Browse...

2. Is your jurisdiction bound by any bilateral, regional or multilateral instrument(s) that, expressly or impliedly, govern or contain provisions addressing PIL issues (jurisdiction, applicable law, recognition and enforcement of foreign judgments, administrative or judicial international cooperation) in cross-border IP disputes? *

- Yes
- No
- Uncertain

Please describe: *

Please attach relevant instruments:

Browse...

3. Have the courts of your jurisdiction referred to any policy guidelines or other sources (binding or non-binding) that address PIL issues (jurisdiction, applicable law, recognition and enforcement of foreign judgments, administrative or judicial international cooperation) in cross-border IP disputes? *

- Yes
- No
- Uncertain

Please describe: *

Please attach relevant instruments:

Browse...

4. Have you faced any PIL-related challenges in cross-border IP disputes, including any gaps in the current framework or any other practical hurdles? *

- Yes
- No
- Uncertain

Please explain: *

5. Please share with us if there is any statistical information regarding IP disputes with private international law issues available in your jurisdiction.

Please attach relevant instruments:

[Browse...](#)

Jurisdiction

Please respond to below questions either by reference to an applicable legal framework or to practical considerations.

6. Are there any practical or legal considerations that are relevant to selecting / establishing / challenging jurisdiction in a dispute arising out of a cross-border IP dealing? *

- Yes
 - No
 - Uncertain
-

Please explain the relevant considerations: *

7. Is (habitual) residence / domicile, branch, agency or other establishment of the defendant the principal factor determining jurisdiction in cross-border IP disputes? *

- Yes
 - No
 - Uncertain
-

Please explain: *

8. If the cross-border IP dispute concerns the validity, grant or registration of an IP right, would that require or permit jurisdiction rules to be applied that are different from the principal rule for jurisdiction? *

- Yes
 - No
 - Uncertain
-

Please explain: *

9. If the cross-border IP dispute concerns contractual issues, would that require or permit jurisdiction rules to be applied that are different from the principal rule for jurisdiction? *

- Yes
- No
- Uncertain

Please specify the rules, and explain how these rules are applied in practice: *

10. If the cross-border IP dispute concerns infringement of an IP right, would that require or permit jurisdiction rules to be applied that are different from the principal rule for jurisdiction? *

- Yes
- No
- Uncertain

Please specify the rules, and explain how these rules are applied in practice: *

11. If the cross-border IP dispute concerns claims of entitlement to or ownership of an IP right, would that require or permit jurisdiction rules to be applied that are different from the principal rule for jurisdiction? *

- Yes
 - No
 - Uncertain
-

Please specify the rules, and explain how these rules are applied in practice: *

12. If the cross-border IP dispute concerns several claims, such as those mentioned in questions 8-11, would the jurisdiction rules or considerations be different than those required or permitted in individual claims? *

- Yes
 - No
 - Uncertain
-

Please specify the rules, and how these rules are applied in practice: *

13. Would the above considerations be different if they concern an IP right subsisting or registered in another jurisdiction? *

- Yes
 - No
 - Uncertain
-

Please explain: *

Exclusive jurisdiction

14. Would certain IP matters fall under exclusive jurisdiction of a court of your jurisdiction? *

- Yes
 - No
 - Uncertain
-

Which IP matters? *

15. Would the above exclusive jurisdiction rules / considerations be different between registered and unregistered IP rights? *

- Yes
 - No
 - Uncertain
-

Please explain: *

16. Would the above exclusive jurisdiction rules / considerations be different if the IP issue is raised by way of an action, defence or counterclaim? *

- Yes
 - No
 - Uncertain
-

Please explain: *

Prorogation of jurisdiction

17. Are there circumstances where the parties' agreed choice of forum may be denied in the claims raised in questions 8, 11 and 14? *

- Yes
 - No
 - Uncertain
-

Please explain: *

Preliminary questions

18. Would a court deal with a matter that falls under the exclusive jurisdiction of a court of another State differently, if the matter is raised as a preliminary question or as the main subject matter of the dispute? *

- Yes
 - No
 - Uncertain
-

Please explain: *

19. When there are multiple defendants located in different States that are involved in an IP dispute (e.g., subsidiaries of the same multinational company), can courts in your jurisdiction consolidate proceedings so as to sue all the defendants? *

- Yes
- No
- Uncertain

Please specify the options, conditions and any particular challenges in practice: *

Online IP activities

20. Are there specific rules or considerations in determining / establishing / challenging jurisdiction over IP matters relating to the internet, e.g., with regard to ubiquitous infringement? *

- Yes
- No
- Uncertain

Please elaborate on the different rules or considerations that would apply depending on the nature of the dispute or type of the IP right involved, and any challenges that are faced in applying these rules: *

Interim, including protective, measures

21. Would a court in your jurisdiction be competent to decide or grant interim, including protective, measures in relation to an IP right subsisting or registered in another jurisdiction? *

- Yes
- No
- Uncertain

What are the conditions and / or particular challenges in this regard? Please explain: *

Decline jurisdiction or stay proceedings

22. In cross-border IP disputes, in view of proceedings brought elsewhere, may a court in your jurisdiction stay the proceedings or decline to hear a dispute over which it has jurisdiction? *

- Yes
- No
- Uncertain

Please specify the grounds or the mechanism (by the application of the forum non conveniens doctrine or by the existence of parallel proceedings in a foreign State, or other situations), and the conditions for its declining jurisdiction or staying the proceedings: *

Territorial scope of remedies

23. Are there circumstances where a remedy granted by a court in your jurisdiction may have extraterritorial legal effect, such as an award of damages incurred in a foreign country or an injunction outside the forum? *

- Yes
- No
- Uncertain

Please explain, including any requirements: *

Applicable law

24. Please respond to the applicable law questions below for specific types of disputes, in your jurisdiction:

a) In a validity, grant or registration dispute concerning **registered** IP rights, would the law of the State in which the registered right is granted or registered be exclusively applicable? *

- Yes
- No
- Uncertain

Please explain: *

b) In an **offline** infringement dispute, would the law of the place of infringement be applicable? *

- Yes
- No
- Uncertain

Please specify the place of infringement: the place where the alleged infringing activities occurred, or the place where the damage sustained, or others. *

Please specify the applicable law. *

c) In an **online** infringement dispute, would the law of the place of uploading be applicable? *

- Yes
- No
- Uncertain

Please specify the applicable law. *

d) In a contractual dispute relating to an IP right, such as licensing, would the parties' choice of law always be respected? *

- Yes
 - No
 - Uncertain
-

Please explain: *

e) In a contractual dispute relating to an IP right, such as licensing, in the absence of a parties' choice of law or the parties' choice is found to be invalid, would the law governing the contract be the applicable law to the dispute? *

- Yes
 - No
 - Uncertain
-

Please explain, specifying the applicable law(s): *

f) In a dispute concerning initial title or ownership, would the law of the State for which protection is sought be the applicable law? *

- Yes
 - No
 - Uncertain
-

Please explain, specifying the applicable law(s): *

g) In a dispute concerning transferability, would the law of the State for which protection is sought be the applicable law? *

- Yes
 - No
 - Uncertain
-

Please explain, specifying the applicable law(s). *

h) In a dispute concerning security rights in IP, would the law of the State where the grantor has his/her domicile or (habitual) residence at the time of the creation of the security right be applicable? *

- Yes
 - No
 - Uncertain
-

Please explain, specifying the applicable law(s): *

i) Are there other types of IP disputes that would encounter applicable law issues? *

- Yes
 - No
 - Uncertain
-

Please explain: *

25. In cross-border IP disputes, would a court in your jurisdiction apply different laws to different claims in the same suit in relation to the same rights? *

- Yes
 - No
 - Uncertain
-

Please elaborate. *

26. Can a foreign law chosen by the parties be set aside by a court of your State in cross-border IP cases? *

- Yes
 - No
 - Uncertain
-

On what bases? Please explain: *

Recognition and Enforcement

27. Have you experienced difficulties in having an IP-related judgment recognised and / or enforced outside the State where it was given? *

- Yes
 - No
 - Uncertain
-

Please explain the difficulties: *

28. Does your jurisdiction have recognition and enforcement rules specific for foreign IP-related judgments? *

- Yes
 - No
 - Uncertain
-

Please describe the conditions that must be met for a foreign IP judgment to be recognised and / or enforced in a court of your State. *

29. Does your jurisdiction have any specific grounds to refuse the recognition and / or enforcement of a foreign IP judgment? *

- Yes
 - No
 - Uncertain
-

Please explain: *

Provisional measures or interim decisions

30. Can provisional measures or interim decisions relating to IP rendered in a foreign State be recognised and / or enforced in your jurisdiction? *

- Yes
 - No
 - Uncertain
-

Please explain: *

31. If courts in your jurisdiction do recognise or enforce foreign IP-related judgments, do they recognise and/or enforce non-monetary part of the judgments, such as injunctions? *

- Yes
 - No
 - Uncertain
-

Please explain: *

Others

32. Are there any other PIL issues arising in cross-border IP disputes which are not addressed above? *

- Yes
- No
- Uncertain

Please explain: *

Future work

33. In inviting WIPO to cooperate with HCCH on this questionnaire, the governing body of the HCCH recognized the need for further work on the intersection of private international law and IP (Conclusions and Decisions of HCCH Council on General Affairs and Policy 2020).

Please share any observations or suggestions that you may have on possible future activities by HCCH and WIPO in relation to the PIL and IP interface, such as greater awareness raising and educational initiatives, enhanced judicial cooperation or coordination, or continued discussion within the HCCH Jurisdiction Project.

Thank You!

Thank you for taking our survey. Your response is very important to us.
