

Advisory Committee on Enforcement

Tenth Session

Geneva, November 23 to 25, 2015

WIPO FAST-TRACK INTELLECTUAL PROPERTY DISPUTE RESOLUTION PROCEDURE FOR PALEXPO TRADE FAIRS

*prepared by Dr. Thomas Legler, Attorney-at-Law, PESTALOZZI Attorneys at Law, Geneva, Switzerland**

ABSTRACT

The Geneva exhibition organizer Palexpo and the World Intellectual Property Organization Arbitration and Mediation Center (WIPO Center) have developed a special Fast-Track Intellectual Property Dispute Resolution Procedure for Palexpo Trade Fairs (Fast-Track Procedure). The Fast-Track Procedure is a dispute resolution procedure specially designed to protect Exhibitor's and Non-exhibitor's Intellectual Property (IP) rights against infringements at trade fairs organized at Palexpo's premises.

The Fast-Track Procedure grants Exhibitors and Non-exhibitors a cost- and time-efficient legal mechanism to protect their IP rights and related commercial interests at a trade fair within 24 hours. An expert panel with relevant expertise in the substance of the dispute renders a binding decision enforceable with immediate effect at the trade fair. The parties use model forms developed by WIPO enabling a simplified procedure. The proceedings are initiated by a request from the Claimant alleging the infringement of copyright, trademarks, design rights or breach of law on unfair competition under Swiss law. Disputes relating to the alleged infringement of patents may not be submitted to the Fast-Track Procedure.

* The author assisted Palexpo and the WIPO Center in the establishment of the WIPO Fast-Track Intellectual Property Dispute Resolution Procedure for Palexpo Trade Fairs. The views expressed in this document are those of the author alone, and not those of the Secretariat or any of the Member States of WIPO.

The Fast-Track Procedure was used for the first time during the 85th Geneva International Motor Show in March 2015, with the expert panel successfully deciding its first case. It is expected for the future that the Fast-Track Procedure will apply to other exhibitions in the Palexpo premises.

I. BACKGROUND

1. A trade fair provides a company with a great opportunity to promote its products or services directly to potential buyers, establish a brand and realize their potential on the international market. At the same time, companies become exposed to intellectual property conflicts at international trade fairs.

2. In 2008, the Global Association of the Exhibition Industry (UFI), drafted Recommendations for the Protection of IP Rights at Exhibitions. These recommendations are widespread but their application can differ from country to country. In essence, the recommendations provide that (i) before the event, exhibitors should protect and register their IP rights, (ii) trade show organizers should provide exhibitors with information on IP protection, (iii) organizers should draw up a list of local IP attorneys willing to represent exhibitors during the trade show, and (iv) trade show organizers should be able to provide neutral arbitration or a judge to resolve IP disputes.

3. Based on these recommendations, various trade shows have taken action but usually limit their activities in relation to IP issues to recommendations and legal advice in order to build awareness of the issues at stake and to provide information on how to protect the exhibitors' IP rights. Such information-based measures have been taken in France where a Copyright Unit is available at the trade fair "Première Vision" in Paris in order to support any request for information from the exhibitors. German trade fairs equally do not have any specific alternative measures in IP enforcement. The exhibition organizers in Frankfurt and Cologne have limited their intervention on published guidelines, leaving IP enforcement issues to the courts.

4. Only a few organizers of trade exhibition have set up a real alternative dispute resolution mechanism in order to solve intellectual property disputes during the fair.

5. One of the forerunners in this field is Baselworld, the annual globally-leading watch and jewelry show which is held in Basel (Switzerland) and attracts more than 1,800 exhibitors and more than 100,000 visitors from all over the globe. Already in 1985, Baselworld decided to set up a panel as an in-house arbitration court. It deals with complaints about violations of IP rights during the show. The procedure grants the successful applicant temporary legal protection within 24 hours. Since its beginning, the panel has taken decisions in more than 800 cases. The long-term effects of the panel's decisions often go beyond the duration of the show: the decisions may indeed be used as expert opinions by the ordinary courts in Switzerland and abroad¹.

6. Inspired by Baselworld's system, the trade fairs "Macef", "Expocomfort", "Marmomacc" and "Samoter" have set up in the early 2000 a type of arbitration procedure with a specific system of pre-trial evidence collection.

7. Finally, it is worth mentioning that one of the world's largest annual trade fairs, the China Import and Export Fair in Canton has also set up a Complaints Center for handling disputes and thereby protect the legal rights and interests of the exhibitors as well as the owners of IP rights.

¹ See also WIPO/ACE/8/11 on The Fight Against Counterfeiting and Imitations at Trade Fairs: the Panel of BASELWORLD, available at: http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=218403.

8. Based on the experience of the foregoing trade fairs, Palexpo Geneva showed interest in setting up an expert panel for IP disputes during its well-known Geneva International Motor Show. This is a major event in the automobile business as it is the only international motor show recognized by the International Organization of Automobile Constructors (OICA) that takes place every year in Europe. The exhibition brings together not only the largest automobile manufacturers but also provides a stage for smaller constructors, designers, suppliers and preparation specialists. Almost 700,000 visitors come every year to see the exhibition.

9. Palexpo and the WIPO Center drew up Rules for a Fast-Track Procedure which became effective for the 85th Geneva International Motor Show in 2015.

II. THE PALEXPO FAST-TRACK PROCEDURE

A. SCOPE OF APPLICATION

10. A request to commence the Fast-Track Procedure can be filed by exhibitors or non-exhibitors. Non-exhibitors have to submit a Submission Agreement². The dispute must occur during and at the premises of the trade fair. The claimant may file its request alleging the infringement of copyright, trademarks, design rights or breach of law on unfair competition under Swiss law. Disputes relating to the alleged infringement of patents may not be submitted to the expert panel. The decisions of the expert panel are binding and enforceable with immediate effect during and at the premises of the trade fair.

B. COMMENCEMENT OF THE PROCEEDINGS

11. Requests may be filed orally or in writing by using the Model Request from the day before the beginning of the trade fair to the end of opening hours of the next to last day of the trade fair³.

12. The request has to contain the parties' communication details, a statement of facts and legal arguments, the evidence proving the claimant's rights under Swiss law, the relief sought, the documentary evidence on allegedly infringing items shown at the trade fair by respondent and proof of payment of the fees.

C. CONTINUATION OF THE PROCEEDINGS AND ANSWER TO THE REQUEST

13. Upon receipt of the request, the expert panel goes to the respondent's booth, informs the respondent of the request and invites the respondent to provide an answer to the request by using the Model Answer to the Request. Within three business hours of the trade fair following receipt of the request, the respondent has to provide the Expert Panel with its answer⁴.

14. Alternatively, the respondent may sign a cease and desist declaration within one hour after the notification of the request⁵.

² The Fast-Track Procedure, all Model Forms and related information are available at:
<http://www.wipo.int/amc/en/center/specific-sectors/tradefairs/palexpo/>.

³ Article 4 Fast-Track Procedure.

⁴ Article 6 Fast-Track Procedure.

⁵ Article 25 Fast-Track Procedure.

D. THE EXPERT PANEL AND ITS POWERS

15. Upon receipt of a request, the Palexpo case secretariat calls one of the listed experts. The expert has then to sign a statement of acceptance and declaration of impartiality and independence like an arbitrator⁶. The expert has to subsequently go to Palexpo as quickly as possible.

16. The expert may collect evidence (take photos, collect samples), order claimant to be present and record the inspection (signatures from claimant and respondent). The expert can also order the provisional removal of items⁷.

17. Generally, the expert may conduct the Fast-Track Procedure in such a manner as it considers appropriate. However, in all cases, the expert panel shall ensure that the parties are treated with equality and that each party is given an adequate opportunity to present its case. The expert panel has furthermore to ensure that the procedure takes place with due expedition. The expert panel may in addition refuse the admission of complex cases, in particular those involving complex technical matters, and refer the parties to the state courts⁸. It is noteworthy that the expert panel may also take a decision in case of default by the respondent⁹. A settlement is possible and upon joint party request, the expert panel may record the settlement in the form of a consent decision¹⁰.

E. THE EXPERT PANEL'S DECISION

18. The expert panel may take any decision that it considers urgently necessary to preserve the rights of the parties during and at the premises of the trade fair¹¹.

19. The expert panel may make its decisions subject to such conditions it considers appropriate.

20. In particular, the expert panel may order closure of a booth, removal of the disputed items from the booth, stop of sales of the disputed items and performance of other legal obligations by a party during the trade fair.

21. The expert panel has to render its decision within 24 hours of the receipt of the request¹². The decision is in writing, states the reasons and is signed by the expert. Subsequently, it is notified to the parties, Palexpo and WIPO Center¹³.

22. The decision has to be carried out without delay. In case the respondent refuses to comply with the decision, the expert panel may request the organizer to enforce the decision immediately during the trade fair. In such case the expert may also recommend to the organizer not to admit the respondent at future trade fairs¹⁴.

⁶ Articles 10-14 Fast-Track Procedure.

⁷ Articles 7-8 Fast Track Procedure.

⁸ Article 15 Fast Track Procedure.

⁹ Article 17 Fast Track Procedure.

¹⁰ Article 24 Fast Track Procedure.

¹¹ Article 19 Fast Track Procedure.

¹² Article 22 Fast Track Procedure.

¹³ Article 20 Fast Track Procedure.

¹⁴ Article 23 Fast Track Procedure.

23. There is no specific appeal procedure. However, the parties may decide to have their dispute submitted to a WIPO Expedited Arbitration within 30 days after the expert panel's decision has been communicated to the parties¹⁵.

24. It may happen that the parties continue their dispute after the trade fair before the ordinary courts. The decision of the expert panel could in such proceedings be provided as evidence that the contested objects were indeed exhibited during the fair and as a presumption of an infringement of IP rights. Indeed, a decision of the expert panel, which states the infringement, may be an important element in a court file.

[End of document]

¹⁵ Article 26 Fast Track Procedure.