HCCH Work in relation to the Enforcement of IP Rights

12th Session of Advisory Committee on Enforcement
Geneva, Switzerland
4-6 September 2017

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• Hague Conference on Private International Law (HCCH)

• Private international law (PIL) and IP law

• HCCH work in relation to enforcement of IP rights

• Co-operation and joint initiatives
What is the HCCH?

- An **intergovernmental organisation** with a **legislative function**, dating from **1893**

- Works towards the “**progressive unification of the rules of private international law**”

- Develops and adopts **Hague Conventions and Protocols** (currently **38 + 1 soft law instrument**), dealing with:
  1. **Int’l Legal Co-operation & Litigation**
  2. **Int’l Commercial Law & Finance Law**
  3. **Int’l Family Law & Child Protection**
150 States “Connected” with HCCH

A “Connected” State is either a **Member State** (incl. candidate and admitted States) or a **Contracting State** to one or more of the Hague Conventions

- **Member State “Connected” State**
- **Non-Member “Connected” State**

NB: Boundaries on this map are based upon those used by the UN Cartographic Section. The number of States reflects the Parties as recorded by the Depositary (NL MFA). Neither should be taken to imply official endorsement or acceptance.
PIL in the context of IP

**Jurisdiction**

**Applicable Law**

**Recognition & Enforcement**

**Legal Co-operation**

PIL issues are involved both before and after disputes on IP arise.
HCCH work relating to IP

Negotiation

- Applicable law
- Jurisdiction
- Hague Principles
  - Choice of Court Convention

Performance

- Legalisation of documents
- Apostille Convention
- Service Convention
- Evidence Convention
- Choice of Court Convention
- Judgments Project

Court adjudication

- Collecting evidence abroad
- Establishing jurisdiction

Service the defendant abroad

Establishing jurisdiction

Recognition and enforcement of foreign judgments
The Hague Principles
Principles on Choice of Law in International Commercial Contracts

• Approved on 19 March 2015
• First HCCH soft law instrument
• Include international contracts concerning IP rights
• Affirm party autonomy in international commercial contracts, giving the parties’ chosen law the widest scope of application, but subject to balanced boundaries
• Strengthen legal certainty and predictability
• May be considered an international code of current best practice in relation to party autonomy in international commercial contracts
• Endorsed by UNCITRAL and the International Chamber of Commerce, implemented by Paraguay
The Apostille Convention

Hague Convention of 5 October 1961
Abolishing the Requirement of Legalisation for Foreign Public Documents

- Replaces legalisation with a simple, one-step procedure (does not create a requirement for Apostille where there is a simpler method available)
- 114 Contracting Parties (most widely ratified/acceded to Hague Convention)
- One single, universal system – instead of 6,441 bilateral treaties...
- Used several millions of times every year – Direct impact on people’s lives / commercial operators’ transactions
- Strongly supported by a number of international organisations, such as the World Bank Group (IFC), International Chamber of Commerce, and APEC
- Facilitates cross-border trade, commerce, and investment
- Alleviates pressure on consular officials
The Apostille Convention (cont’d)

• Scope: covering only “public documents”, including
  • Grants of patents or other IP rights
  • Extracts from IP registers
  • Grants of license

• Excluding:
  • Administrative documents dealing directly with commercial or customs operations
  • Assignment contracts (documents created in a private capacity)

Note: Patents/trademarks issued by the EPO and EUIPO are not directly addressed under the Convention.
(A HCCH Working Group will meet on 1 December 2017 in The Hague to discuss the applicability of the Convention to such documents.)
The Service Convention & the Evidence Convention

Hague Convention of 15 November 1965 on the Service Abroad of Judicial and Extrajudicial Documents in Civil or Commercial Matters

- 73 Contracting States
- Simplified and expedited methods of transmission of documents for service
- 1 Convention instead of... 2,628 bilateral agreements
- Over 40,000 applications a year – 75% executed in less than 2 months (some within 48 hours!)

Hague Convention of 18 March 1970 on the Taking of Evidence Abroad in Civil or Commercial Matters

- 61 Contracting States
- Means to overcome differences between legal systems with respect to the taking of evidence
- 1 Convention instead of... 1,830 bilateral agreements
- Approx 5,000 applications a year – 55% executed in less than 4 months

- Alleviates pressure on consular officials
- Contribute to international standards of legal co-operation
The Choice of Court Convention
Hague Convention of 30 June 2005 on Choice of Court Agreements

- Provides **legal certainty and predictability** in international commercial transactions, and allows for effective planning of possible litigation (alleviates the risk of parallel proceedings and conflicting judgments)

- Chosen court **must** hear the dispute – **no other court** in a Contracting State may hear the dispute – judgment of the chosen court is **recognised** and **enforced** in the other Contracting States

- Entered into force between the EU (excl. Denmark) and Mexico on 1 October 2015, Singapore ratified in June 2016

- 29 States and 1 REIO (EU) bound by the Convention

- Offers real **alternative to arbitration**
The Choice of Court Convention and IP Rights

The Convention distinguishes between:

**Copyright and related rights**

- **completely covered** by the Convention – this applies even to questions of validity, but only as between the parties, not *in rem*

  (because the judgment is enforceable under the Convention only as against persons bound by the choice of court agreement)

**Other IP rights (patents, trademarks and designs)**

**validity:**
- if raised as an object of proceedings, **excluded**
  (because generally the State under the law of which the right was created claims exclusive jurisdiction, and party autonomy is not admitted)

- if raised as a preliminary question, **included**
  (the preliminary ruling on validity of patents, however, will not be given any effect under the Convention in other Contracting States)

**infringement:** **excluded**
(except when they are brought (or could have been brought) pursuant to a contract (scope of license/payment of royalties))
The Judgments Project

Objectives

- To develop a commonly accepted international standard on the recognition and enforcement of foreign judgments
- To enhance foreseeability of international litigation to improve access to justice, including in cross-border dealings
- To provide more legal certainty, which facilitates cross-border trade and investment

Status

- At the stage of States level negotiation: two Special Commissions have been convened;
- 3rd meeting will take place in November 2017, to continue its work on the February 2017 draft Convention, including IP;
- Possible Diplomatic Session in late 2018 for the adoption of the Convention.
- Current text deals with the treatment of IP judgments and upholds IP “territoriality” principle.
Co-operation with IP stakeholders

• The HCCH works in close co-operation with WIPO and other IP stakeholders

• The HCCH welcomes further joint initiatives for the benefit of better IP enforcement
Thank you!

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