

# Analysis of National Approaches to PIL Issues in Cross-border Online IP Infringement Disputes

Professor Andrew F. Christie  
Chair of Intellectual Property  
Melbourne Law School  
University of Melbourne



# Methodology and Data Set

- Surveyed experts in 21 countries, and reviewed published decisions from four other jurisdictions
- Identified **56** cases, from **19** jurisdictions, concerning **cross-border online IP infringement**:

<b>Surveyed:</b>	Denmark (1)	New Zealand (3)
Australia (2)	India (6)	Switzerland (4)
Belgium (3)	Ireland (2)	<b>Reviewed:</b>
Brazil (3)	Israel (3)	CJEU (2)
Canada (3)	Italy (3)	France (4)
Chile (1)	Korea (3)	UK (3)
China (5)	Netherlands (3)	US (2)

# Fields of Analysis

<b>Facts</b>	type of IPR	fact scenario	cross-border elements	
<b>Claim</b>	civil or criminal	primary or secondary	IPR validity challenge	parallel proceedings
<b>Orders</b>	provisional measures	remedies sought and granted	order for foreign enforcement	
<b>PIL Issues</b>	applicable law	other PIL issues	considerations re online aspect	

# Facts: IPR Type

<b>IPR Type</b>	<b>Activity Prohibited</b>	<b>Occurrence</b>
Registered trademark	Registered trademark infringement	26
Copyright + related rights	Copyright (inc. database right) infringement	21
Right to prevent misleading conduct	Commercial disparagement; Misleading/deceptive conduct; Passing off; Use of personality; Unfair competition; Use of unregistered mark	13
Patent	Patent infringement	2

# Facts: Fact Scenario

<b>Fact type</b>	<b>Description of Legal Claim</b>	<b>Occurrence</b>
Online marketing	Infringement of registered trademark, or engaging in misleading conduct, by use of a mark on a website	29
Online distribution	Infringement of copyright or of related right (inc. database right), by making material available from a website	22
Domain name registration +/-or use	Infringement of registered trademark, or engaging in misleading conduct, by registration and/or use of a domain name containing a mark	14
Other	Infringement of patent by offering, from a website, patent-protected goods	2

# Facts: Cross-border elements

<b>CBE Type</b>	<b>Cross-border Element</b>	<b>Occurrence</b>
Action location	Act of infringement is outside jurisdiction	49
Party location	At least one of parties is outside jurisdiction	48
IPR location	Infringed IPR is outside jurisdiction	7
Damage location	Infringement caused damage outside jurisdiction	4

# Facts: CBE – Party Location

		Plaintiff's domicile	
		Local	Foreign
Defendant's domicile	Local	8	13
	Foreign	33	2

# Typical Cross-border Online IP Infringement

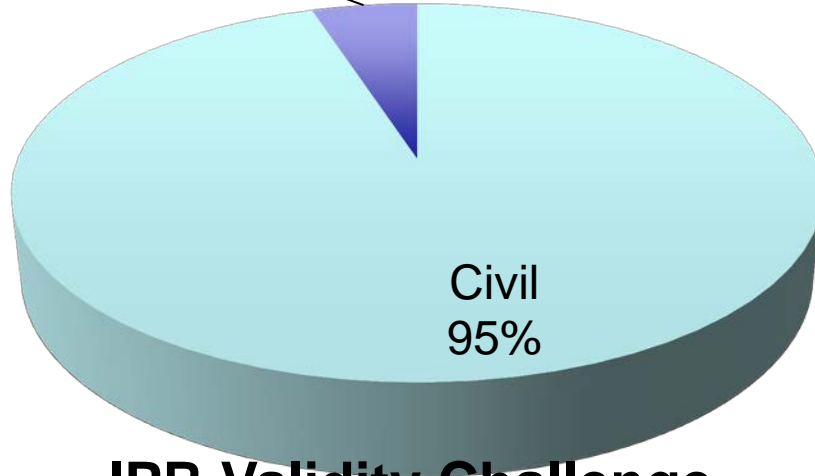
- Concerns:
  - online marketing using a (reg. or unreg.) TM , or
  - online distribution of copyright or related material
- Brought:
  - by local P against foreign D re local IPR
  - re foreign action causing local damage



# Claim

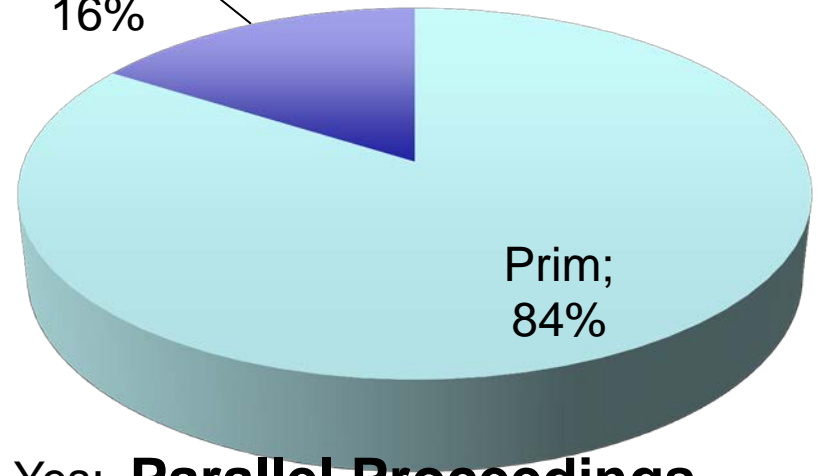
Criminal  
5%

## Civil v Criminal



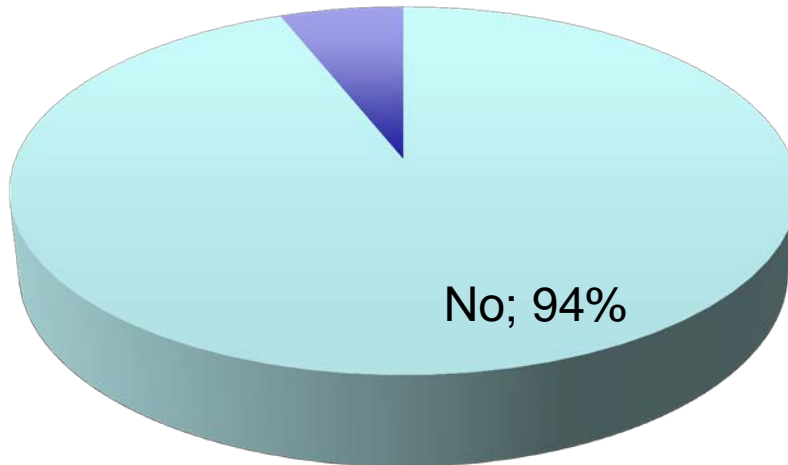
## Primary v Secondary

Secon;  
16%



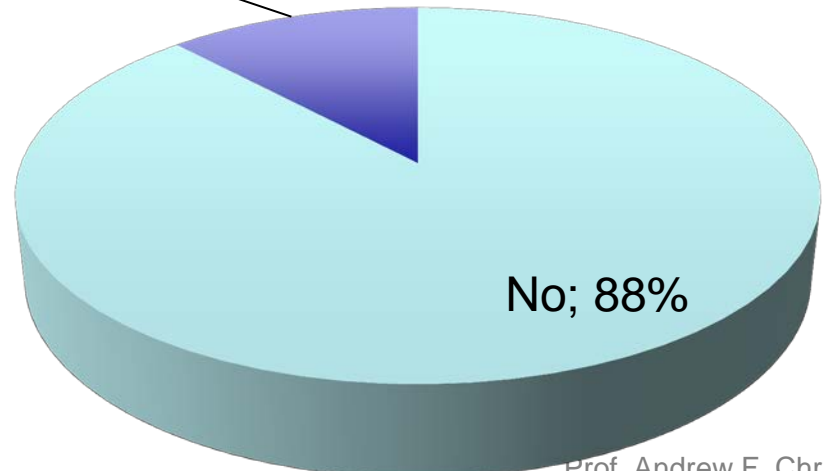
## IPR Validity Challenge

Yes; 6%



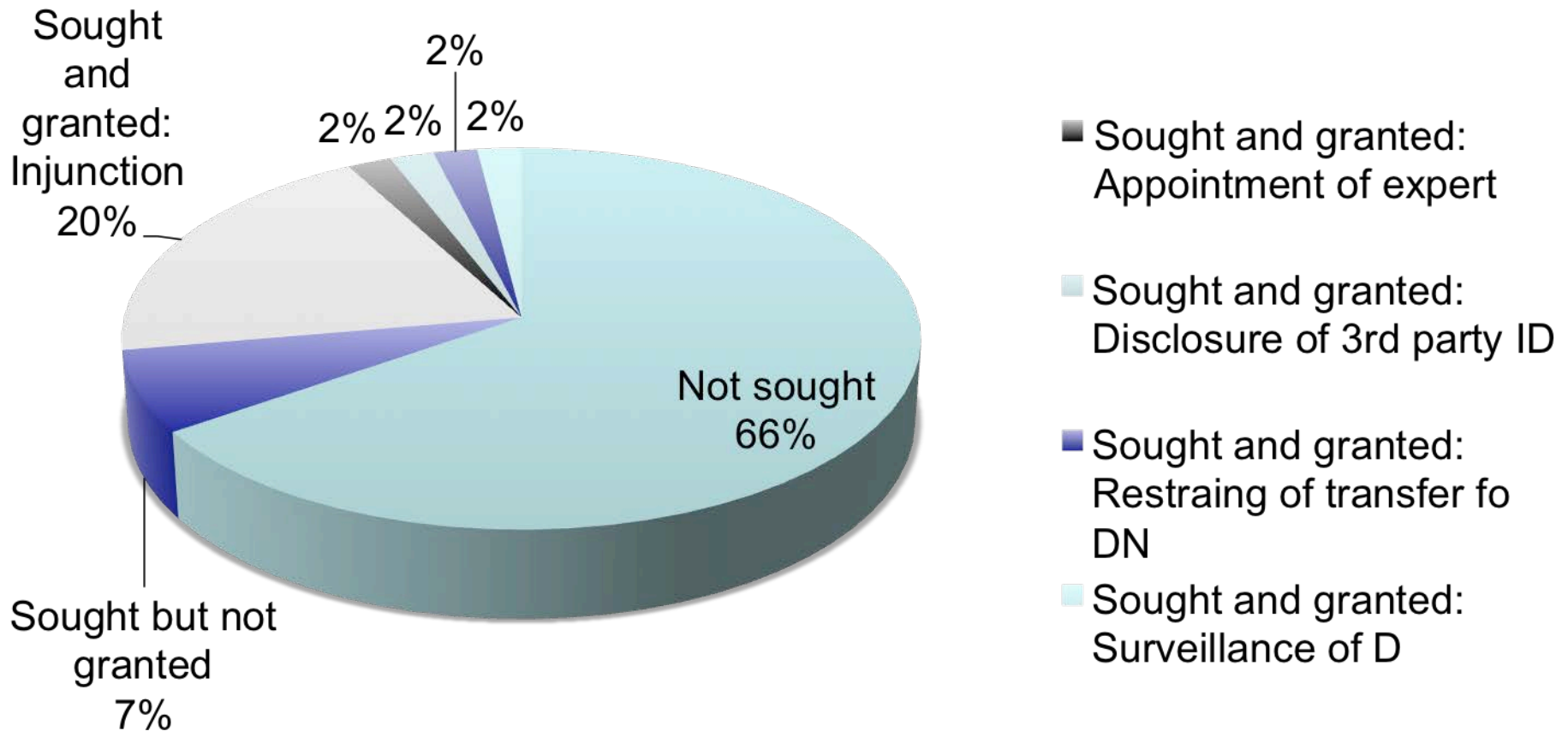
## Yes; Parallel Proceedings

Yes;  
12%



# Order: Provisional Measures

## Provisional Measures Sought / Granted

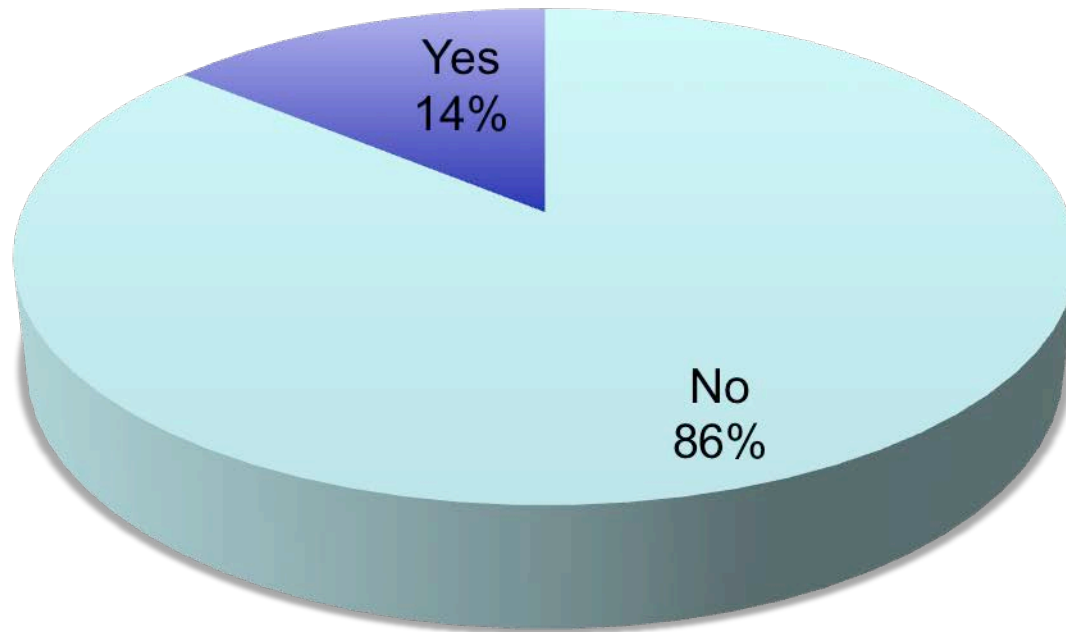


# Orders: Remedies

	<b>Injunc</b>	<b>Dams</b>	<b>T/fer of DN</b>	<b>Jur'n Decl'n</b>	<b>Enf't of J'ment</b>	<b>Misc. Other</b>
Sought	29	18	8	2	1	7
Sought in succ. action	14	7	4	2	1	6
Granted	14	7	4	2	1	5

# Orders: Foreign Enforcement of Order

## Local Order requires Foreign Enforcement

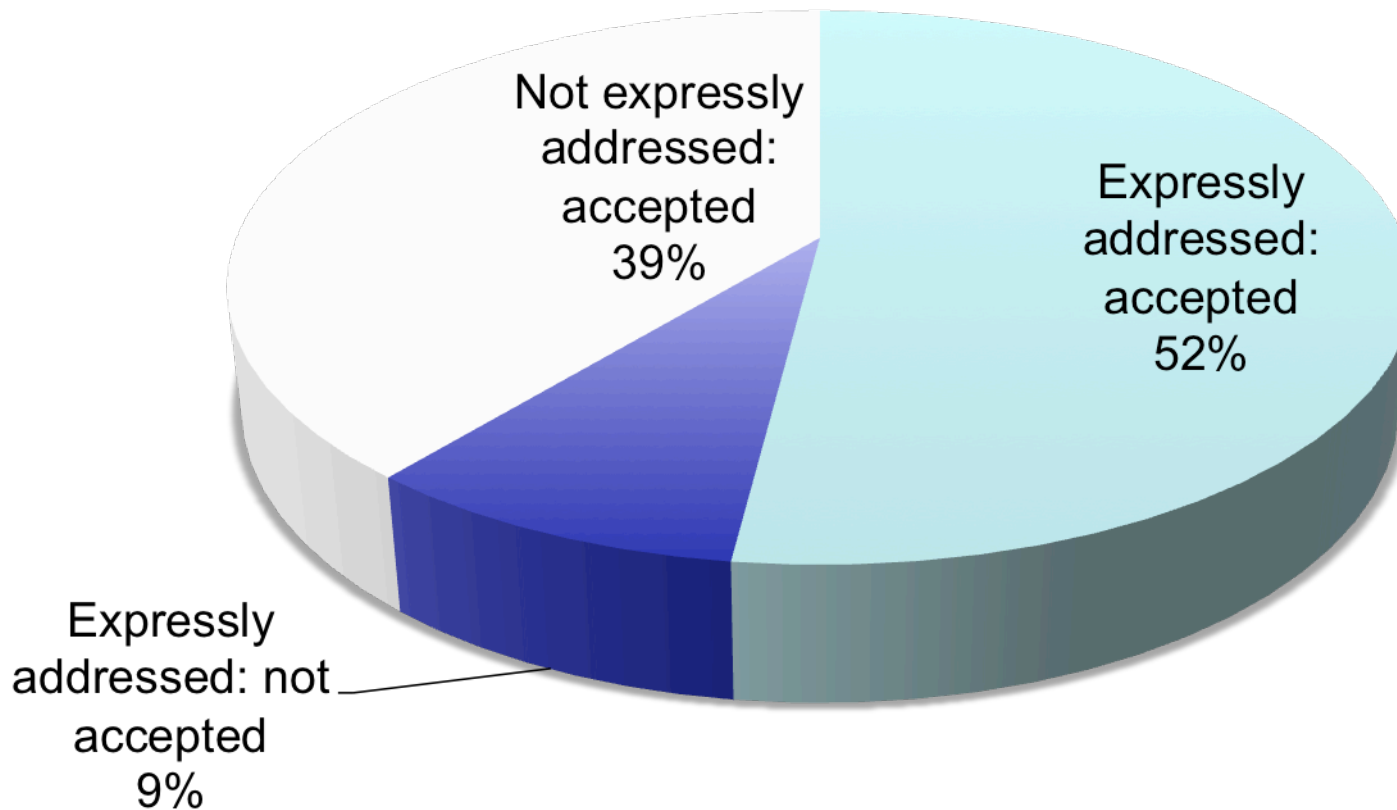


# Typical Cross-border Online IP Infringement

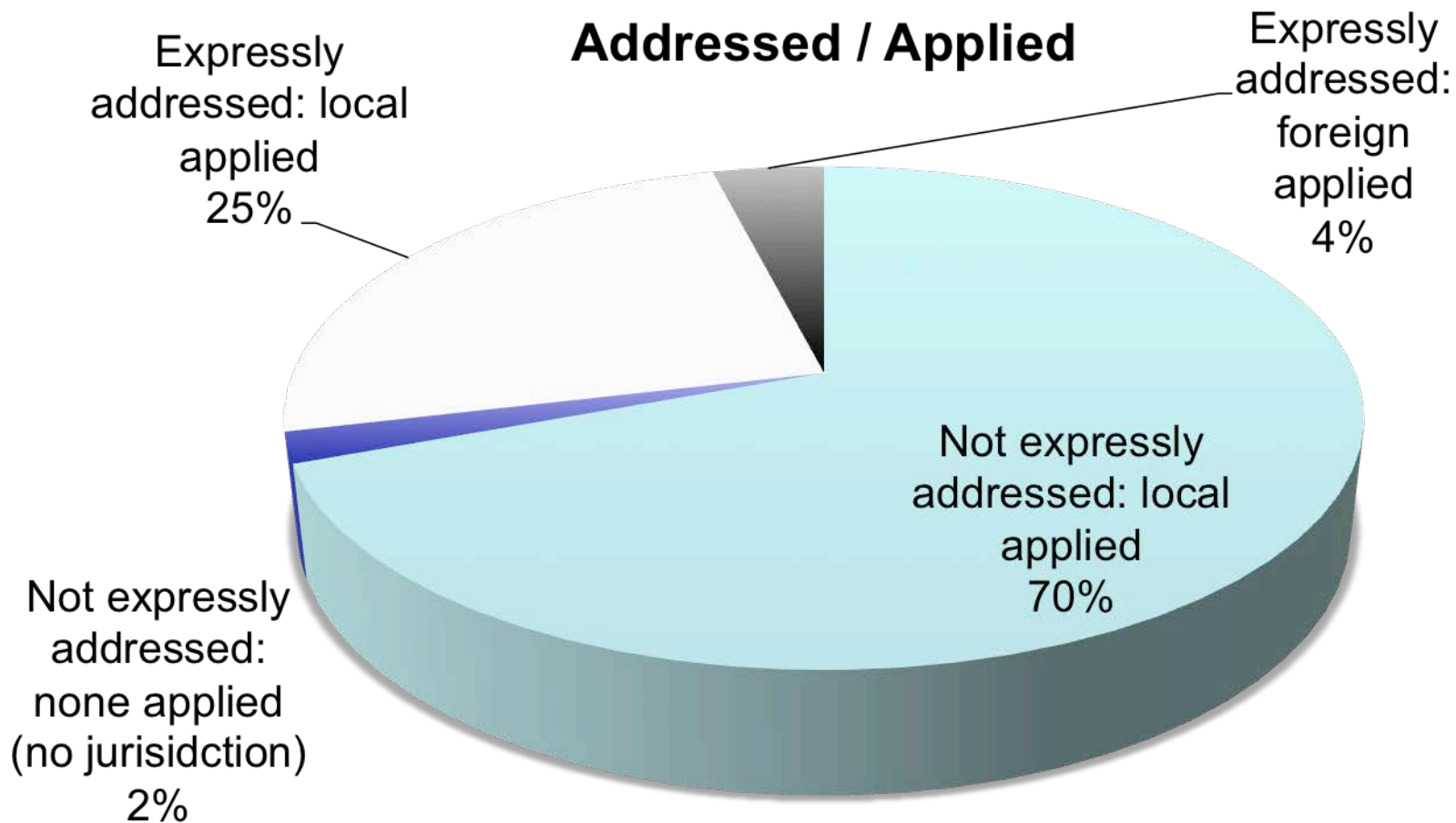
- Concerns:
  - online marketing using a (reg. or unreg.) TM , or
  - online distribution of copyright or related material
- Brought:
  - by local P against foreign D re local IPR
  - re foreign action causing local damage
- Being:
  - civil action for primary infringement
  - without challenge to IPR validity or parallel proceedings
- Seeking:
  - only final remedies, of injunction and damages
  - to be enforced locally

# PIL Issues: Jurisdiction

## Addressed / Accepted

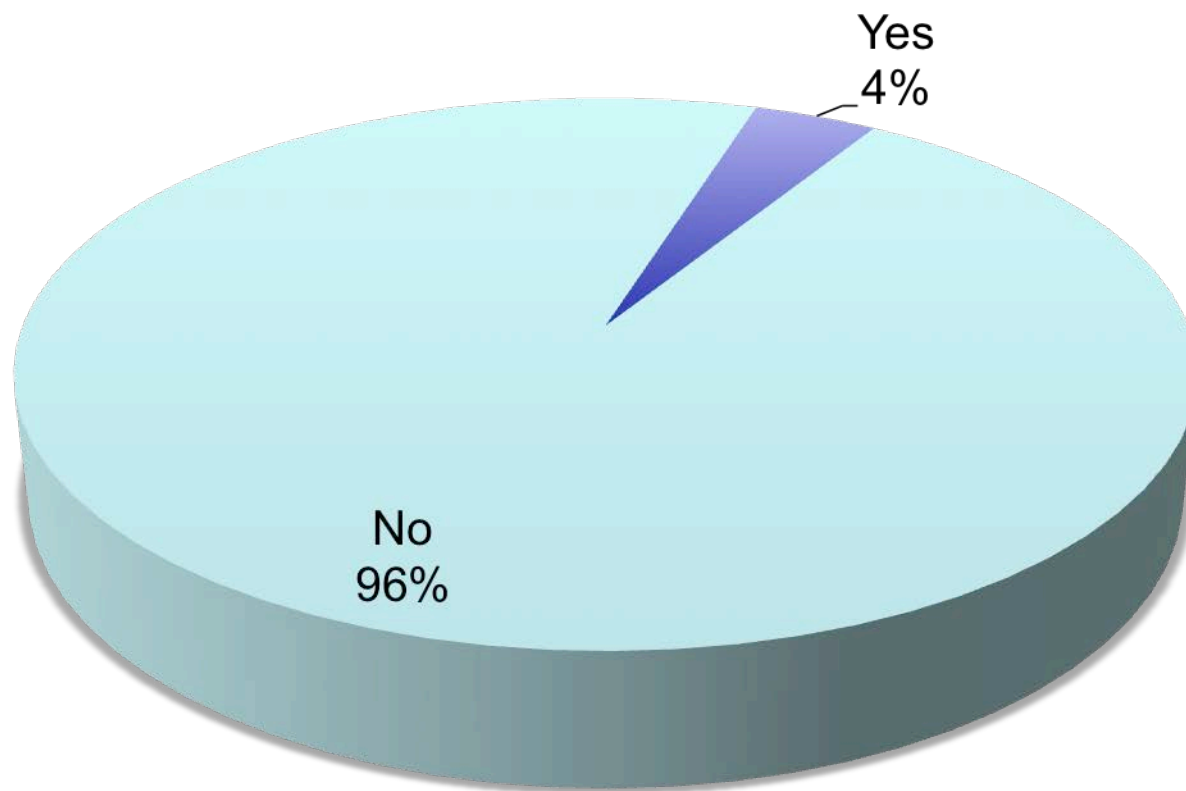


# PIL Issues: Applicable Law



# PIL Issues: Enforcement of Foreign Order

## Local Enforcement sought of Foreign Order





# PIL Issues: Considerations re Online Aspect

- Online aspect: placing TM or copyright material on foreign website makes it accessible locally
- PIL issue: whether court has jurisdiction where D acted outside country
- Relevant question: is there infringement locally?
- Two general approaches to answer:
  - mere accessibility locally is not sufficient – some targeting is required
    - generally re online marketing using TM
  - mere accessibility locally is sufficient
    - often re online distribution of copyright material

# Concluding Observations

- Online infringement = “ubiquitous” infringement
  - potential for either:
    - multiple actions in multiple countries; or
    - single action seeking multi-country relief
  - PIL concern: develop special principles re jurisdiction and applicable law?
- In practice
  - generally:
    - no multiple actions in multiple countries
    - no single action seeking multi-country relief
  - IP law concern: develop consistency on when foreign action = local infringement?