



WIPO Intellectual Property Judges Forum 2018

Report

Promoting transnational dialogue
among judiciaries

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The creation of the *WIPO Intellectual Property Judges Forum* responded to the demand from Member States for dialogue amongst judges, in order to enable and support the judicial community to better deal with the challenges arising from an increasing number of novel questions in intellectual property (IP) cases. The purpose of the Forum is to provide a platform for the exchange of information and practices on issues of common concern amongst national judiciaries, while recognizing diverse judicial structures within distinct national legal and economic frameworks.

The inaugural Forum was held at the headquarters of the World Intellectual Property Organization (WIPO) in Geneva, from November 7 to 9, 2018.

Program and Format

The Forum comprised ten plenary sessions, with active participation from the audience, and explored the following themes:

- The judicial role in developing IP law and the value of transnational dialogue;
- Separate sessions on emerging issues in patents, trademarks, and copyright;
- Specialization of IP courts or judiciaries;
- Remedies for online IP infringement;
- Judicial discretion in approaches to remedies;
- Judicial capacity building; and
- The judicial role in assessing public interest considerations in IP.

The format of the sessions was designed to maximize dialogue among the four panelists, moderator and audience participants, fostering opportunities for continued discussion and networking on the sidelines.

Thirty-three judges participated as moderators or panelists, from the following countries: Australia, Belgium, Brazil, Cameroon, Canada, China, Costa Rica, El Salvador, France, Germany, Ghana, India, Japan, Latvia, Lebanon, Mexico, Netherlands, Peru, Philippines, Republic of Korea, Serbia, South Africa, Switzerland, Thailand, United Arab Emirates, United Kingdom, United States of America, and Uruguay.

With a view to encouraging open dialogue amongst judicial peers, attendance at the Forum was limited to members of the judiciary and, where applicable, to members of quasi-judicial bodies that are active in adjudicating IP disputes. In total, 119 judges from 64 countries participated in the Forum.

The Forum applied the Chatham House Rule. Participants were free to use information shared during discussions at the Forum, but neither the identity nor the affiliation of the speakers, nor that of any other participant, was to be revealed. The speakers spoke in their personal capacity, expressing their own opinions and views and not necessarily those of the Secretariat or of the Member States of WIPO.

The Forum took place in six languages (Arabic, Chinese, English, French, Russian and Spanish) with simultaneous interpretation.

WIPO Advisory Board of Judges

The Forum was prepared under the direction and guidance of an Advisory Board of Judges comprising: Annabelle Bennett, Former Judge, Federal Court of Australia, Sydney, Australia (Chair); Mohamed Mahmoud Al Kamali, Director General, Institute of Training and Judicial Studies, Abu Dhabi, United Arab Emirates; Colin Birss, Justice, High Court of England and Wales, London, United Kingdom; Edgardo Mateo Ettlín Guazzo, Minister, Court of Appeals, Montevideo, Uruguay; Klaus Grabinski, Judge, Federal Court of Justice, Karlsruhe, Germany; Louis T.C. Harms, Former Deputy President, Supreme Court of Appeal, Bloemfontein, South Africa; Ki Woojong, Judge, Daejeon High Court, Republic of Korea; Marie-Françoise Marais, Former Judge, Court of Cassation, Paris, France; Maria Rowena Modesto-San Pedro, Presiding Judge, Regional Trial Court, Manila, Philippines; Max Lambert Ndéma Elongué, President, Court of First Instance, Yaoundé Ekounou, Cameroon; Kathleen M. O'Malley, Circuit Judge, Court of Appeals for the Federal Circuit, Washington, D.C., United States of America; Manmohan Singh, Chairman, Intellectual Property Appellate Board, New Delhi, and Former Judge, High Court of Delhi, India; Shimizu Misao, Former Chief Judge, Intellectual Property High Court, Tokyo, Japan; Tao Kaiyuan, Justice, Vice President, Supreme People's Court, Beijing, China; and Vesna Todorović, Judge, Commercial Appellate Court, Belgrade, Serbia.

Summary of the Forum

Welcome Address

The Forum was opened by Mr. Frits Bontekoe, Legal Counsel of WIPO. Mr. Bontekoe acknowledged the diversity represented in the audience, comprising judges with many years of IP adjudication experience and others with more recent exposure to IP litigation. Mr. Bontekoe observed that a number of participating judges are actively involved in strengthening their national judiciary, whether by enhancing court administration systems or contributing to the continuing education of their fellow judges.

Mr. Bontekoe described WIPO's new approach to the judicial administration of IP, which combines WIPO's long-standing judicial capacity building activities with a broader and more systematic approach to engaging with national judiciaries. He explained that this would include organizing an annual, global platform for judges to have the opportunity to exchange useful practices on the development and application of IP law and evolving judicial functions, and to develop a network of international judicial colleagues. Mr. Bontekoe further noted that WIPO is working to build a global, open and free online information resource that would provide access to judicial decisions on IP.

Mr. Bontekoe concluded by underlining that the aim of the Forum was for the participating judges to benefit from sharing knowledge and perspectives on the evolving jurisprudence and judicial systems around the world, but stressed that national judicial approaches to IP questions would depend on the distinct circumstances of each country, including legal traditions, economic context and policy priorities.

Special Address by the Director General

The Director General of WIPO, Mr. Francis Gurry, described the current international IP landscape, and the role played by WIPO. He observed three persistent trends over the course of the last ten years: first, increasing demand for IP worldwide, at a rate that outperforms the rate of growth in the world economy; second, the transformation of the geography of IP production, with over 60% of all IP originating in Asia in 2017, in line with demographic and economic trends and other indicators of technology production; and third, the growing complexity of IP, which is a fundamental change agent in society. In addition to the complexity of the national, plurilateral and multilateral architecture giving rise to IP obligations, the complexity in the subject matter of IP itself is of a fundamental nature.

The Director General provided an overview of WIPO's work, particularly in the areas of global IP systems, capacity building, maintenance of the technical infrastructure connecting IP offices around the world, and custodianship of 26 multilateral treaties. The Director General noted the difficulties currently faced by norm setting processes throughout the multilateral system, observing the contrast between the slow pace at which new norms were being developed, and the great need for the elaboration of international norms as a consequence of globalization. The international community will need to address significant questions that are already on the horizon, as a consequence of the technological transformations taking place throughout societies and economies worldwide.

The Director General looked to the judiciary as an important component of the development of the future international framework that will govern IP rights in the world economy. Many countries are confronting new questions of IP stemming from the globalization of economic activity. At the same time, as a result of the rapid pace of technological transformations that legislatures are unable to keep up with, there is a policy lag in responding to these new

questions. This means that the judiciary is going to be, and in some places already is, on the front line for questions that have not yet received a legislative policy response.

In this context, the Director General saw a role for WIPO to serve as a forum for information and experience sharing—an important function in a world that is globalized but also culturally, politically and socially diverse. In addition, WIPO can advance the collective knowledge about the state of the judicial administration of IP by gathering, with the cooperation of national courts, empirical data about the differences in judicial systems around the world. This would include data on what such differences mean in terms of IP policy, the volume of IP cases, and the relationship between IP applications and disputes before courts.

The Director General thanked the judges for their positive response to WIPO's new judicial work, and expressed confidence that, through cooperation, WIPO and national judiciaries would be able to collectively support the judicial administration of IP.

Keynote Address: Tao Kaiyuan, Justice, Vice President, Supreme People's Court of China

Justice Tao Kaiyuan, Vice President of the Supreme People's Court (SPC) of China, delivered a keynote address to share China's experiences in the judicial protection of IP rights. Justice Tao presented the transformations that have taken place in China over the course of 30 years to establish a highly functional IP system, including accession to key international IP treaties, enactment of numerous IP laws and special regulations, and establishment of a "dual-track IP protection system" in response to national conditions.

In reflecting on China's emergence as a global leader in IP and technology, Justice Tao described the judicial protection of IP rights as a central tenet of the country's national strategy to encourage innovation, secure social and economic development, and boost international competitiveness. Justice Tao emphasized that China's strategic vision in implementing consistent and coherent IP policies, and its emphasis on strengthening the IP adjudication system, had enabled the establishment of an effective and authoritative IP adjudication system in a relatively short time.

Justice Tao shared some recent national developments in the area of IP, including the issuance by the SPC in 2017 of the *Outline of Judicial Protection of IP in China (2016–2020)* that identifies major objectives and measures to enhance protection of IP, including: the creation of a specialized IP court system; formulating intellectual property-specific rules for collection of evidence, calculation of damages and technical facts investigation; and launching studies on a specific procedural law for IP litigation. The SPC also fosters the continuing development of China's three existing specialized IP courts and 19 IP tribunals, and is working toward the establishment of a national tribunal to centralize appeals relating to patent and other technical IP cases, with a view to improving the quality, efficiency and coherence of dispute adjudication. Other steps being taken to improve the IP litigation system include strengthening training for the more than 3,000 judges involved in IP adjudication, as well as enhancing the technical fact-finding mechanism.

Justice Tao observed that, given the increasingly important role played by IP in the global economy, the increasing volume of IP disputes is not surprising and shared that, in 2017, the number of new IP disputes received by Chinese courts at first instance increased significantly to over 213,000, making China's IP caseload the largest of any country. In addition, the growing number of cases involving foreign parties reflects the changing nature of modern IP litigation in a global economy.

Justice Tao recalled the successful collaboration between the SPC and WIPO in hosting the first Master Class on IP Adjudication in August 2018 and believed that the challenges driven by current scientific and technological development are common to all judicial systems, and that addressing them would require cooperation and engagement with international partners. This would be especially important in the context of the pace and scale of the transformation associated with the so-called fourth industrial revolution, which is reshaping the way in which innovation, creativity and knowledge are created, disseminated and utilized, and is raising new issues that will need to be weighed by IP judges everywhere. These challenges will be compounded further by the increasing uncertainty and instability emerging in the international arena.

Justice Tao noted that, while much progress has been achieved and a great deal of invaluable experience has been acquired, there is still much more to accomplish. She believed that global vision is essential for future development, and that there is still much to learn from others through international exchanges and cooperation to further develop IP adjudication both within the country and beyond. Engagement in the international sphere would be an effective way to promote the modernization of global IP governance and to create a bright future for IP.

Session 1: The Judicial Role in Developing IP Law and the Value of Transnational Dialogue

The session discussed the value of dialogue among judicial peers in preparing responses to IP challenges arising from new realities such as: the transnational nature of IP disputes involving issues that are not country-specific; disputes relating to new technologies; gaps in statutory provisions, and difficulties in construing statutes, to apply to and address new technologies that were not envisaged by legislative drafters.

The panelists commented on the value of learning from other jurisdictions, but also in sharing with others the challenges experienced in their own jurisdictions. The ways in which international jurisprudence may be relevant were discussed. It was observed that understanding the reasoning employed in other jurisdictions could strengthen a judge's own analysis and decision making, without having to adopt or apply that reasoning. In fact, understanding contrasting national approaches to questions could assist judges in developing their own opinions in ways that apply to their own jurisdictions and may differ from foreign judgments.

Judges related different practices in citing foreign decisions in their own written judgments. Disputes involving advanced technologies, or parallel litigations involving the same technology and same litigants in different countries, were examples of situations in which judges were more likely to refer to foreign judgments. The panelists also debated whether judges could cite or use foreign judgements when these were not raised by the parties, with differences noted among the represented jurisdictions. In addition, the discussion addressed the role of international IP treaties, including the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement), and the circumstances in which reference to these treaties may be made in national decisions.

In recognizing the value of learning from, and using, foreign judgments, the panelists emphasized the importance of querying how a foreign jurisdiction's experience might relate and apply to one's own jurisdiction. Panelists stressed that the judges relying upon foreign judgments should have sufficient knowledge of the applicable foreign law in order to determine whether the laws were comparable; they should similarly understand the context and background of the cited foreign judgment, as well as the specific, local situation of the dispute at hand.

Finally, participants observed the general desirability of a database of IP judgments from jurisdictions around the world to address the difficulty in accessing foreign judgments. Challenges in this regard were noted, including how the selection of leading or persuasive judgments should take place in each country, as well as attendant language issues in reading foreign judgments. Nevertheless, a summary of a case, perhaps in English, would at least amount to notification of the existence of that judgment and enable access to it, even if that first required translation.

Session 2: WIPO's Work in the Area of the Judicial Administration of IP

The session provided an overview of WIPO's work in the field of the judicial administration of IP. It was recalled that, at the Assemblies of the Member States of WIPO in 2017, the Director General had announced a new Organizational approach to the judicial administration of IP in response to increased demand from Member States for engagement with and among their national judiciaries. Although the judicial administration of IP belongs to the province of domestic law, it was considered by Member States that there was a growing need for information exchange and sharing of experiences about common challenges, and for increased capacity building support. WIPO's responses to meet this need are guided by the WIPO Advisory Board of Judges, whose 15 members represent broad geographical and technical coverage and serve in their personal capacity for two year terms.

The panelists gave presentations on the work of the newly-established WIPO Judicial Institute, as well as the long-standing work of the WIPO Academy, Building Respect for IP Division, and WIPO Mediation and Arbitration Center. Together, the various sectors of WIPO provide a wide range of activities relating to the judiciary, including: technical capacity building programs; fora to facilitate transnational judicial dialogue; distance learning courses; support for establishing continuing judicial education programs; resource guides on issues of relevance to courts such as alternative dispute resolution options; comparative studies to support exchange of national experiences on topics such as enforcement mechanisms and remedies; and access to information about judicial systems and decisions including a new series of casebooks on IP enforcement.

Session 3: Emerging Issues in Patents

The session addressed emerging trends in patent law through the lens of four issues: the patentability of emerging technology (and particularly blockchain); evaluating inventive step through an obviousness test; the doctrine of equivalents; and regulatory review exceptions.

First, the session explored boundaries of patentability through discussion of emerging technologies and, in particular, blockchain technology. It was observed that cases involving blockchain were already appearing in courts in some jurisdictions, on which judicial training to understand blockchain would be valuable. In discussing some of the ways in which courts have dealt with blockchain questions so far, links were drawn with other legal questions that are currently more firmly established, such as the patentability of business methods, noting the variety of national approaches to this issue. Participants acknowledged the challenges of evaluating patentability in cases involving highly technical concepts. They further mentioned the possible applications of blockchain technology that could be of public interest.

On the topic of the inventive step requirement for patentability, the participants explored a number of challenges faced by judges in conducting this assessment, for example: the difficulties of interpreting and weighing evidence from technical experts in fields outside the judge's expertise, whether that expert is chosen by the parties or by the court; the proper identification of a person skilled in the art; and hindsight bias, especially in circumstances

where the state of technology at the time of assessment is further advanced than the time at which a patent application was made. The role of the judge in applying a legal standard, as opposed to a scientific standard, was raised. Different national experiences of elaborating legal tests to evaluate obviousness were shared. One of the benefits of establishing a test for obviousness was considered to be its requirement for explicit judicial reasoning on how inventive step is to be assessed, which encourages greater transparency and legal certainty for both the judiciary and patentees.

Turning to infringement issues, the panel canvassed the different national approaches to the doctrine of equivalents in considering infringement by products that do not fall within the literal meaning of a patent claim, but which replace elements of the claim with equivalents. The panelists gave an overview of the policy reasons that have prompted some jurisdictions to adopt the doctrine, as well as variations of the tests used. Some similarities among the requirements established by different national courts were observed. In addition to the legal analysis, there was discussion of the challenges that could arise as a result of the practical peculiarities of patent infringement processes in a given jurisdiction, such as the passage of significant time between the grant of the patent and the infringement action and implications for evolving technology, as well as the impact of amendments to patent claims during the applications process.

Finally, the session explored public policy considerations regarding the regulatory review, or “Bolar”, exception. The panelists recalled the basic patent system principles underlying the Bolar exception. These principles are aimed at balancing patent rights with the public interest by ensuring that the monopoly granted to a patentee is time-limited, and by allowing entry of generic competition into the market upon expiration of a patent. Some examples of different approaches taken by national courts in deciding cases involving generic pharmaceutical products, production and export of goods outside a national jurisdiction, or stockpiling, were shared. Courts may receive applications for injunctions in cases where distribution of generic products is imminent or underway, and where the financial stakes can be very high. Questions from the audience related to the conditions/criteria considered by courts in regard to compulsory licenses for pharmaceutical products, and the role of public interest considerations in that analysis.

In response to a question regarding the identification of a person skilled in the art, reference was made to a study prepared by WIPO, under the aegis of the WIPO Standing Committee on the Law of Patents (SCP), on inventive step as understood in different legal frameworks and national case law, in particular the following three elements: (i) definition of the person skilled in the art; (ii) methodologies employed for evaluating inventive step; and (iii) the level of inventive step (obviousness).

Session 4: Emerging Issues in Trademarks

The session began with discussion on the protection of non-traditional marks, surveying the varying legal frameworks governing this protection in different jurisdictions, and the challenges that trademark owners have encountered in seeking this protection. The panelists shared examples of non-traditional marks that have been granted protection in their jurisdictions such as sound, color, position, motion and olfactory marks, including whether the criteria for their protection differ from traditional marks, and the ways in which non-traditional marks have been represented for the purpose of registration.

There was significant variance in the kinds of marks that are entitled to protection in different jurisdictions. Participants found common ground in Article 15 of the TRIPS Agreement, which does not exclude signs from being protected, provided that they are capable of distinguishing the goods of services of one undertaking from those of another. Different

approaches to considering the element of distinctiveness were presented, with some jurisdictions requiring inherent distinctiveness of a mark, whereas in others it is possible for marks to acquire distinctiveness through use. Participants also discussed examples of the subjective nature of distinctiveness, with implications for the provision of evidence of acquired distinctiveness.

Further, the survey of national positions revealed the existence of common legislation across some geographic regions. In some cases, the protection of marks is governed also at the regional, not only national, level. Some practical implications arising from the grant of protection at the regional level were raised, such as adapted tests for demonstrating acquired distinctiveness across multiple national jurisdictions, and the grant of cross-border remedies such as injunctions.

The discussion additionally explored the ways in which public interest considerations could intersect with trademark protection, with examples of different ways in which the public interest has been relied upon as a ground for refusal to register a trademark. Similarly, participants discussed how different jurisdictions have handled trademarks deemed to be offensive or contrary to public order.

Beyond the legal analysis, participants shared some experiences of practical challenges in recognizing non-traditional marks, across jurisdictions with varying levels of experience with marks. In some jurisdictions where trademark law is relatively young, it has been considered appropriate to provide protection to a narrower set of marks where the experience or technological capacity of a trademark registry to substantively assess non-traditional marks is limited.

Finally, it was observed by some judges that the low cost of trademark registration, coupled with the long-term protection it provides, may incentivize businesses to pursue trademark protection for non-traditional marks whereas, in some of these cases, protection under a different type of IP right may be more appropriate. In this regard, they underlined the need to look at IP as a whole and the way in which each category of IP right fits into the overall system.

Session 5: Specialization of IP Courts or Judiciaries

The session addressed court structures aimed at making IP adjudication more efficient, effective and accessible, coherent with the national IP dispute characteristics and legal traditions. The panelists shared their national approaches to IP specialization in the judicial function, covering the pros and cons of a large spectrum of structures that include: generalist courts with no IP specialization; generalist courts with specialized IP judges or IP chambers; specialized IP courts; and administrative entities that carry out quasi-judicial functions.

Some countries with a long-standing tradition of generalist courts had moved towards quasi-specialization to address the complexity and demanding nature of IP disputes, by establishing a second-instance court that reviews the IP decisions of the first-instance courts. This was aimed primarily at achieving consistency. Others shared the experience of running a pilot project to determine whether efficiency was gained by having trial judges quasi-specialized in patents, with preliminary results indicating the main benefit of concentrated assignment of IP cases to designated judges to be a quicker rate of disposal, rather than a lower rate of reversal on appeal.

In other countries, a limited number of designated courts had exclusive jurisdiction to adjudicate civil IP matters, allowing judges in these courts to acquire necessary IP knowledge, issue rulings, including provisional measures, more quickly and uniformly.

In addition, the different approaches between unified or a bifurcated system in IP courts were also presented. In unified systems, infringement and invalidity were dealt with within the same proceedings by the same court, whereas in bifurcated systems, there were separate proceedings in different courts to establish infringement and invalidity.

Speakers shared diverse systems introduced to address technical or scientific matters, which included: legally qualified judges with technical background; technically qualified judges; judicial technical advisors; court experts; and party experts. The respective issues were debated, in particular in relation to the potential risk of appearing to delegate the adjudicatory role of the judge to the technical experts.

The value of specialized IP procedural rules was introduced by a number of speakers, which might encompass different elements, such as technical judges, technical experts, shorter time periods to expedite procedures; online trials; and promotion of party settlement through conciliation and mediation.

In general, consistency, time- and cost-efficiency, and special procedural rules for IP were cited as advantages of specialized IP courts or judges. On the other hand, the observed disadvantages of specialization included: risks of “tunnel vision” for specialized judges, elitist approaches or less independent adjudication; difficulties in attaining specialization in all areas within the expansive spectrum of IP subject matter; questions of accessibility of the court to parties who are located in geographically distant areas from the designated IP courts; and resource concerns as well as potential increases in costs of access to justice.

The panel also acknowledged the relevance of criminal courts in IP adjudication, as well as the emergence of regional courts that address IP disputes and their attendant challenges. In addition, the discussion raised the value of alternative dispute resolution (ADR), such as conciliation, mediation and arbitration, in particular in disputes involving international, confidentiality or emotional issues, or where parties prefer a business solution not achievable through litigation. The possible role of the judge as a “case manager” facilitating conflict resolution or establishing linkages between a court and an ADR center were noted. The panelists also noted the importance of continuing judicial education in IP in preparing judges for the specificities of IP disputes.

The session underscored the observation that the level of IP specialization in judicial structures depended on the circumstances of the particular country, which included its legal traditions, place of IP in national economy and strategies and budgetary priorities, as well as the volume and complexity of IP cases.

Session 6: Emerging Issues in Copyright

Recalling that copyright touches the lives of every member of society through interaction with creative works such as music and books, the session focused on different national approaches to some emerging issues in the digital copyright realm, as well as to fair use exemptions to copyright.

The panel observed that questions regarding the optimal level of IP protection to foster innovation continue to be under debate in many countries. One such area of contention relates to copyright protection for innovation in the high-tech industries. The panel explored this topic through examples of recent disputes centering on whether, and to what extent, programming language that is used to create software is protected by copyright. The considerations that some courts have taken into account in evaluating both copyrightability

and the elements of fair use defenses, and the way in which the two have been balanced, were shared.

The wide-ranging discussion also touched upon myriad other ways in which copyright law has been challenged in the digital realm. For example, early legislative attempts to govern digital file sharing in some jurisdictions had become obsolete very quickly in the face of a meteoric, and unanticipated, rise of digital platforms, such as music streaming platforms. The discussion raised the question of how courts could deal with certain aspects of the law that are not adapted to the disputes brought before them. It was noted that the WIPO Internet Treaties^[1] provide for flexibility in their national implementation. One example was the provision, within the legislative framework, for consideration and approval of exceptions to technical protection measures (TPMs).

Different perspectives were given on whether the basic definitions of copyright law, and its limitations and exceptions, continued to be appropriate to the digital world, or whether they needed extension or amendment in order to protect copyrighted works on the internet. This position could be different among legal traditions, particularly between the copyright and author's right or *droit d'auteur* systems. Some judges shared experiences of finding solutions for new questions—for example in relation to works produced by 3D printing technologies, or application of the private copying exception for digital copies—through interpreting existing legislation. Participants also exchanged information on their different national approaches to protection of works produced through AI. Significant divergences were observed among the applicable legislative frameworks and judicial approaches in different jurisdictions.

The panel further shared examples of remedies considered in their jurisdictions for copyright infringement cases, including site blocking, destruction of webpage contents, and suspension or seizure of domain names. Participants contributed examples of cases that had been litigated in multiple jurisdictions. The transnational elements of online infringement, such as the ability of infringing websites to shift easily to other jurisdictions, or the location of servers or management of a website in a different country, presented challenges to enforcement of judicial decisions to protect copyright. At the same time, in some circumstances, courts have confirmed their competence to rule on online infringement with extraterritorial links.

Some general currents emerged throughout these discussions. In describing their national approaches, the panelists reflected on the ways in which foreign legal sources and precedents may be viewed by their courts, in the process of reaching their own decisions under national law. Finally, the panelists remarked that many of the emerging issues discussed returned to the very fundamental questions of copyright: what does it mean to be an author or creator? Many legal systems deal with their own permutations of these questions through cases about creativity and originality, how much is needed to have copyright and related rights, and what that means. Asked to give their picks for the most pressing copyright issues to look out for in the coming years, the panelists mentioned not only AI but also, more immediately, balancing of the interests of creators and of the copyright system with the fast pace of technological evolution.

Session 7: Remedies for Online IP Infringement

The session presented different national approaches to questions of liabilities and remedies arising from IP infringement in a digital environment. Building on the experiences shared during the preceding panel on emerging issues in copyright, discussions revolved primarily around infringement of copyright protected content, such as through peer-to-peer file sharing

[1] The WIPO Internet Treaties consist of the WIPO Copyright Treaty and the WIPO Performances and Phonograms Treaty.

networks or online service providers (OSPs). Common to all the topics discussed was the question of how the rights of copyright owners are balanced with the rights of users and the public interest.

By way of background, the panelists illustrated how technological progress, and the changing nature of interaction between people, and between people and machines, creates new types of potentially copyrightable content, and new types of infringement. These include, for example, the protection of digital subject matter such as software, databases, and artificial intelligence; adaptations of “private copying” exceptions in response to changing methods of digital reproduction; and the design of site blocking orders to deal with a variety of challenging circumstances. It was observed that the digital environment presents even greater complexity for judges because such issues, in addition to being novel, continue to evolve, and there are often no past cases to which judges can refer. Some judges observed that, at times, the attention garnered by their cases has even contributed to legislative efforts to introduce new or updated laws.

On the issue of liabilities for online infringement, the panelists provided an overview of the exemptions enjoyed, and liabilities incurred, by OSPs such as major streaming platforms or e-commerce sites. The different systems used to deal with online copyright infringement were presented, including notice-and-takedown, notice-and-notice, or other similar systems. In some countries, a graduated series of responses was used. Further, some jurisdictions permitted joint civil, or even criminal, liability to attach to OSP conduct, for example where an OSP does not comply with its obligations to remove access to infringing goods, or depending on the scale of commercial activity. Some jurisdictions have studied the impact of legislative frameworks in other countries to inform their decisions about the appropriate regulatory scheme for their national context.

Further, they explored the variety of mechanisms through which OSPs may be required to provide information that identifies alleged infringers for the purpose of enforcement, for example in circumstances where the infringements have taken place anonymously. The role played by such a right of information may be more significant in jurisdictions where OSPs do not have a takedown obligation. In a number of jurisdictions, judicial or administrative orders for provision of information are sought, whereas in others, criminal proceedings are also available. The existence of debate in relation to some aspects of the right of information were discussed, such as the competence of administrative bodies (rather than courts) to make orders impacting on personal information; or how this remedy interacts with a right to privacy.

Finally, the considerations attaching to site blocking orders were discussed, including steps required, methods for ensuring their efficacy, and balancing freedom of expression.

Session 8: Judicial Discretion in Approaches to Remedies

The session covered approaches to judicial discretion in the areas of preliminary injunctions, final injunctions and other remedies, observing differences in national practices.

Judicial discretion in preliminary injunctions was found in statutory rules or court rules in certain jurisdictions. In other jurisdictions, the principles applied by the courts in considering preliminary injunctions were to be found entirely within judge-made case law. Some countries, providing for a statutory test, did not make provision for judicial discretion; accordingly, preliminary injunctions were issued when the statutory test was satisfied. Examples of such statutory requirements included: the likelihood of success on the merits, or *prima facie* case; the existence of irreparable or not easily repairable harm; proportionality or balance of convenience. Even in countries where courts are considered to have full

discretion to grant or withhold injunctions as equitable remedies, it was observed that, in practice, the factors taken into account when exercising discretion are often very similar to those required by statutory tests in countries where discretion is not provided.

Different views were also presented on the extent of judicial discretion, if any, available to courts in ordering final injunctions in cases where infringement of a valid IP right has been established. Situations where compulsory licenses may be ordered in lieu of injunctions were debated, and it was observed that these primarily involved cases where public interest considerations came into play.

The session also addressed judicial discretion in other areas, such as the award and quantification of damages (including moral and punitive damages), orders for security, setting deadlines for submissions or other actions by parties, determining possible abuse of rights, or deferring the impact of an injunction in order to permit a defendant sufficient time to manufacture a design-around or readjustment. It was observed that, in some countries, courts may exercise discretion in ordering the losing party to publicize the judgment on a designated website or media outlet; panelists exchanged views on the implications of such orders on freedom of speech. Judicial discretion exercised in introducing special measures to order the destruction of IP-infringing goods in an environmentally-friendly manner was also recognized.

Noting that the exercise of discretion necessarily constituted a balancing exercise, the discussion explored the interaction between judicial discretion and other concepts, ranging from balance of convenience, to proportionality, public interest considerations, multi-factorial exercises in judgment, and predictability.

Session 9: Judicial Capacity Building

The session addressed judicial education and capacity building. Among the foundational elements of judicial education discussed were: the importance of building a judicial curriculum on the basis of a deliberative process that determines training needs, rather than in response to *ad hoc* demands; the effective delivery of knowledge within applicable resource constraints; and the value of a database of IP judgments or other reference points to facilitate knowledge collection and sharing. It was observed that judicial education, in accordance with widely accepted adult education principles, should be based on an articulated curriculum and should address knowledge, skills (e.g. communication or case management) and attributes.

In relation to knowledge, the panelists emphasized the importance of judges understanding not only the legal framework of IP, but also the social and economic context in which IP disputes arise, including the role of IP in national economic development and the impact of IP infringing goods on public health, security, and tax revenue.

The panelists also explored training with respect to the skills employed by judges to harness technical expert knowledge of disputed technology. The issues raised in the context of such training included not only awareness of the applicable procedural rules but also appreciation of the ethical considerations arising from undue reliance on technical experts and other sources.

Some examples of recent national experiences of facilitating access to IP-related judicial information were shared by the panel. These included the development of IP training kits with a collection of local IP laws and the establishment of an online community of judges working or interested in IP, with online and offline fora through which domestic and foreign judgements or scholarly articles might be shared and views exchanged. It was further

proposed that such a local community be extended to the international level, in light of the significant number of common challenges shared by judges in different jurisdictions, while keeping in mind the differences among relevant law and judicial systems.

The panelists also discussed the importance of adopting an appropriate pedagogy for judicial education, reflecting the fact that judges are distinctive learners. Key elements of the pedagogical methodologies discussed included train-the-trainer models and participatory, conversation-based methods, which were found to be more effective than lecture-style learning. Pre- and post-education baselines were observed to be important in evaluating the effectiveness of training programs and in assessing whether the goal of increasing knowledge has been achieved.

The discussion raised the observation that judiciaries do not operate in a knowledge vacuum. The importance of understanding the work of multi-sectoral agencies, including IP offices, in the process of IP enforcement was raised, as well as the role that exposure to practices in other jurisdictions might play in allowing judges to open their minds and explore possible methods that may be relevant and appropriate to apply locally in their courts. In this spirit, some judges suggested that WIPO could play a role in facilitating judicial exchanges, to allow national judges to visit and learn from their peers in other courts.

Session 10: The Judicial Role in Assessing Public Interest Considerations in IP

The session expanded on the discussions of public interest in earlier sessions, such as the role of trademark in protecting the public from being misled (Session 4); application of the fair use doctrine in copyright law (Session 6); as well as public interest considerations in the grant of remedies (Session 8).

The panelists discussed the public interest factors that are statutorily mandated or developed through common law principles. Varying practices in defining public interest were represented, with some countries defining it broadly to include interest in the environment, public health, and safety and national security, and other countries defining public interest narrowly; in others still, there was no definition at all. Different experiences were also exchanged on the ways in which public interest is considered by judges; the areas of IP where it comes into play; and whether judges have discretion or an obligation to weigh public interest considerations in rendering decisions. For example, the panel discussed how public interest arguments raised as a defense in infringement proceedings are weighed by courts in deciding whether to grant injunctions, and how to measure a credible or meaningful defense in such cases.

In the trademark area, the panelists discussed public interest grounds for exclusions from registration; the authority of the judge to provide redress (e.g. removal from register) where the trademark was not being used; and the intersection between trademark law and unfair competition law.

In the area of patents, the role of public interest considerations in granting compulsory licenses was discussed. It was observed that compulsory licenses are generally confined to exceptional circumstances where certain requirements are met, such as where the party seeking the license has attempted to negotiate a license on reasonable terms, and the issuance of that compulsory license is in the public interest; or where the compulsory license is sought for pharmaceutical products treating serious illnesses for which no similar, alternative product exists on the market. Examples of different national judicial structures implicated in the grant of compulsory licenses were shared by the participants. These included structures in which the request for a compulsory license and infringement

proceedings are decided by the same court. Alternatively, the two issues may be decided in different fora; the panelists also explored the extent to which the separate proceedings interact with each other in such structures.

Other applications of the public interest in patent cases could include the exercise of discretion by a court to delay the application of an injunction, in order to allow time for a design-around or substitute product to be developed, or for stockpiles to be distributed. Examples of such decisions were exceptional, and typically involved cases where a minor portion of a complex, multi-component product was found to be infringing, and it was considered desirable to avoid forcing the whole product out of the market. The panelists further remarked that competition law considerations may also lead a court to grant a compulsory license in relation to standard essential patents. Finally, in some jurisdictions public interest considerations could bear upon threshold inquiries regarding patentability of inventions deemed to be unethical.

The session also raised challenges in addressing public interest or public order considerations in a regional context where, for example, the invalidation of a regionally-protected IP right on public order grounds would apply only in the country in which the invalidation order was made, with the right continuing to be considered valid in other countries in the region.

The panelists observed that international IP treaties, such as the TRIPS Agreement, deliberately provided flexibility for countries to take into account their own public interest considerations to address domestic needs, especially in relation to the public interest in health and access to medicines. It was suggested that, ultimately, the question could be conceived as whether there exists an identifiable public interest that outweighs the public interest in a robust IP system.

About the WIPO Judicial Institute

The WIPO Judicial Institute and other relevant WIPO sectors collaborate closely to support the efficient and effective judicial administration of intellectual property, aligned with the national legal traditions, and economic and social circumstances, of Member States.

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