

Report  
November 15–16



# 2023 WIPO Intellectual Property Judges Forum

Promoting  
transnational dialogue  
among judiciaries



**WIPO**

## **About the WIPO Judicial Institute**

Established by the World Intellectual Property Organization (WIPO) in 2019, the WIPO Judicial Institute collaborates with other relevant WIPO sectors to support the efficient and effective judicial administration of intellectual property (IP), aligned with the national legal traditions, and economic and social circumstances, of Member States.

Information on WIPO's work relating to judiciaries is available on the WIPO website at [www.wipo.int/about-ip/en/judiciaries](http://www.wipo.int/about-ip/en/judiciaries).

## **Acknowledgments**

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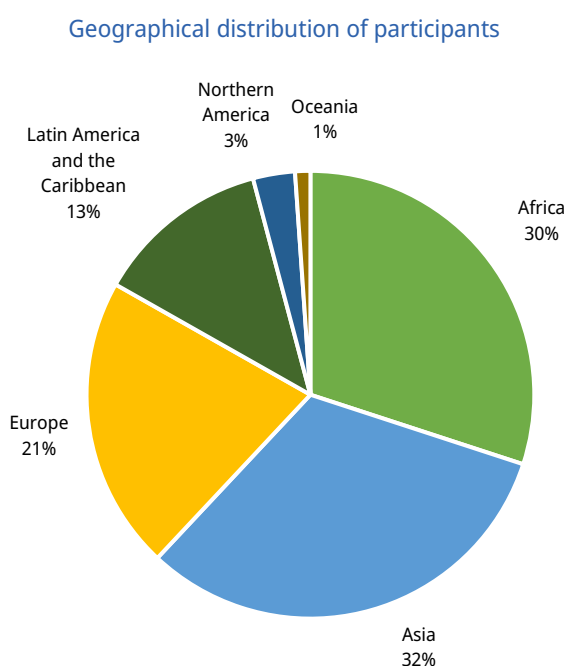
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## 2023 WIPO Intellectual Property Judges Forum

### Promoting transnational dialogue among judiciaries

The annual WIPO Intellectual Property Judges Forum aims to provide a platform for judges from across the globe to exchange their expertise on the most pressing intellectual property (IP) challenges raised by accelerating innovation and the increasingly transnational use of IP. The participants observe the judicial approaches of other countries and gain insight to strengthen their own courts' analyses. The Forum is part of WIPO's work intended to empower judiciaries to fulfill their vital role in ensuring that IP, innovation and creative ecosystems in Member States are balanced and effective.

The 2023 edition of the Forum was conducted in a hybrid format (both in-person at WIPO Headquarters in Geneva, Switzerland, and virtually) on November 15 and 16, 2023. This year, over 360 judges from 101 countries and four regional courts participated in total. Of these, 107 judges from 55 countries and four regional courts attended in person. Thirty-six speakers from 27 jurisdictions participated as moderators or panelists. All judges 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.



This year's program centered on emerging issues within some of the most established areas of IP law, such as trademarks, industrial designs and geographical indications. It also delved into some key aspects of judicial case management of IP disputes, such as simplified procedures, rules of evidence and court-referred mediation. The program also addressed significant overarching themes in the evolution of IP adjudication, exploring its interaction with competition law and its adaptation to the latest artificial intelligence (AI) technologies.

The Forum was conducted in six languages (English, Arabic, Chinese, French, Russian and Spanish) with simultaneous interpretation. The program and the list of participants may be accessed on the Forum [webpage](#).

The 2024 WIPO Intellectual Property Judges Forum will take place, in hybrid form at WIPO Headquarters in Geneva and online, on October 9 and 10, 2024.

## Summary Report

*The following summary reports on the discussions which took place during the Forum, and does not reflect the views of any individual participant or WIPO. As the discussions were limited to certain aspects of a small number of sample cases, this summary does not represent the state of the law of any jurisdiction.*

*All participants took part in their personal capacity.*

## Opening

The *2023 WIPO Intellectual Property Judges Forum* was opened by Mr. Daren Tang, Director General of WIPO, and by Judge Hugo Ramiro Gómez Apac, Member of the WIPO Advisory Board of Judges.

The Director General welcomed the judges participating in person and virtually from around the world. He observed that the Forum was meeting at a time when more people are using IP than ever before. As highlighted by the Director General, rising IP filings are not confined to a handful of countries or any one region. Rather, the growth in IP applications spans the globe, with many developing countries emerging as key IP engines. The Director General mentioned rising patent, trademark and design filings in a number of geographically and culturally diverse countries.

The Director General further recognized that, although this global growth in the use of IP can be seen across economic sectors, it has been quickest and deepest in the field of digital technologies. He reflected on how rapidly evolving digital technologies raise questions that go to the very heart of IP law including, for instance, who should be considered an inventor or creator.

In a fast-moving judicial landscape, and as cases frequently have cross-border implications, the Director General noted the growing recognition of the critical role played by judiciaries in the development of IP ecosystems globally and reflected on the special importance of transnational judicial dialogue, whereby judges can become aware of each others' decisions. WIPO supports such global judicial exchange through the annual IP Judges Forum and by gathering and making available IP laws, treaties and judgments from around the world. The Director General noted the addition of significant decisions from a number of jurisdictions to WIPO Lex, WIPO's global database of IP legal data. The Director General also recalled the wider work of the WIPO Judicial Institute in building IP skills and knowledge on the ground.

The Director General concluded by underscoring that, through the discussion of real decisions presented by judges from diverse legal and cultural backgrounds, the Forum uses WIPO's convening power to promote transnational judicial dialogue, allowing judges to navigate a complex and interconnected environment together.

Judge Gómez Apac delivered his welcome to the participating judges in his capacity as a Member of the WIPO Advisory Board of Judges. He reflected on the fact that WIPO represents a collective belief in the importance of protecting IP. Judge Gómez Apac noted that IP protection encourages creativity, innovation and competition, materially improving the lives of millions of people around the world.

Judge Gómez Apac emphasized the important role played by judges in the IP ecosystem through their interpretation and application of the law. He expressed his belief in the value of judicial dialogue in developing an ecosystem that is protective of IP, highlighting the work of the WIPO Judicial Institute to facilitate exchanges between judges as well as training activities.

Judge Gómez Apac concluded his opening remarks by sharing his hope that, following the Forum, participating judges will return to their courts with valuable shared knowledge, obtained from an exchange of experiences and international dialogue on the most complex issues in IP.

## Session 1: Emerging Issues in Trademarks

Session 1 primarily focused on issues involving non-traditional trademarks and bad faith trademark filings. The panelists shared recent significant decisions from their jurisdictions on these emerging issues in trademarks. Discussions touched upon the factors for assessing the distinctive character of three-dimensional and sound marks, and approaches to assessing bad faith registrations, including in the context of well-known marks, and in differentiating between bad faith and honest concurrent use.

Assessment of the distinctive character of a sound mark was discussed with reference to a decision issued by the General Court of the European Union (EU) in which the General Court, held that the sound in question could not be perceived as an indication of the commercial origin of the goods at issue and was devoid of distinctive character. During the discussion, the specificities of applying the criteria for assessing the distinctive character of a mark to sound marks were addressed, noting the importance of the perception of the relevant public in establishing distinctiveness in practice.

Questions arising from non-traditional trademarks were also addressed in the context of three-dimensional marks. A preliminary ruling from the Court of Justice of the Andean Community was presented, in which the Court provided an interpretation of Andean law concerning the registrability of three-dimensional trademarks. It was observed that in the case of combined marks with word and figurative elements, distinctiveness comes from the perception of the sign considered in its entirety.

Panelists and participants further discussed the distinctive character of three-dimensional trademarks, with a particular focus on what constitutes a significant departure from the

norms or customs of a sector, as well as the interplay of three-dimensional marks and industrial designs.

The panel proceeded to consider bad faith trademark filings, referring to decisions issued by courts in Albania, the Andean Community, Indonesia and Jamaica. In a preliminary ruling, the Court of Justice of the Andean Community advised on the legal criteria for determining whether an applicant for a trademark registration has acted in bad faith in seeking to register a sign that is identical or similar to a trademark used by a third party abroad. The Court indicated that a person acts in bad faith if, at the time of requesting a trademark registration, they know or should have known that the sign is similar or identical to a distinctive sign used by a third party abroad, to the point that it may give rise to confusion in the local market.

A judgment issued by the Supreme Court of Indonesia shared the trajectory of a case that was decided prior to the enactment of regulations providing for the cancellation of marks that have similarities in essence with well-known trademarks for non-similar goods. Discussion of the judgment also touched upon the procedure for calculating damages in the event of trademark infringement.

The next decision shared, handed down by the Court of Appeal of Jamaica, brought further deliberation of what constitutes a bad faith filing, while also raising questions about the relationship between “honest concurrent use” of a mark and bad faith. In this case, the Court had found the two marks in question, as well as their respective goods and services, to be similar, creating a likelihood of confusion amongst the public. Thus, the Court held that the registration of the later mark should be refused. The Court additionally found there to be no honest concurrent use of the later mark, such that the application for its registration was deemed to have been made in bad faith. The panelists considered whether the bad faith finding was a separate ground for refusal of the application, or supplemented the finding of similarity that gave rise to a likelihood of confusion.

A judgment issued by the District Court of Tirana, Albania, demonstrated how the factors for determining whether an application for trademark registration was made in bad faith are evaluated. These factors include: identity or confusing similarity of marks; intentional behavior to use an identical or very similar mark of another party; economic impact and financial gain/loss; unfair competition; and consumer confusion.

### Reference judgments

- District Court, Tirana, Albania [2018]: [Besniku v M & Sillosi, Elledii and the General Directorate of Industrial Property, Decision No. 5839](#)
- Supreme Court of the Republic of Indonesia [2016]: [BMW Aktiengesellschaft v Hendrywo Yuwijoyo, Decision No. 29 PK/Pdt.Sus-HKI/2016](#)
- Court of Appeal of Jamaica [2017]: [3M Company v Manufacturera 3M SA DE CV \[2017\] JMCA Civ 21](#)
- Federal Supreme Court, Switzerland [2022]: [Chokoladefabriken Lindt v Lidl, 4A 587/2021](#)
- Court of Justice of the Andean Community [2022]: [Preliminary Ruling 81-IP-2020](#)
- Court of Justice of the Andean Community [2023]: [Preliminary Ruling 128-IP-2022](#)
- General Court of the European Union [2021]: [Ardagh Metal Beverage Holdings v EUIPO, Case No. T-668/19](#)
- Court of Justice of the European Union (Fourth Chamber) [2012]: [Chokoladefabriken Lindt & Sprüngli AG v Office for Harmonisation in the Internal Market \(Trade Marks and Designs\), Case No. C-98/11 P](#)

## Session 2: Emerging Issues in Industrial Designs

The session began by recognizing that the adjudication of disputes involving industrial designs can be complex and present specific challenges for judges, due to the highly interconnected nature of industrial design rights with other kinds of IP rights.

In one of the cases presented, the Intellectual Property Court of Portugal considered alleged infringement of Community design protection granted for the layout of a retail store, alongside connected claims of copyright infringement and unfair competition. The Court compared the store layout protected by a registered design with the allegedly infringing version by reference to the significant features and taking into account evidence such as a market study and architectural expert testimony. The Court concluded that the stores were similar only insofar as they shared characteristics that were common to the same type of store, marketing the same type of fashion accessories to the same target audience. The overall impression of the stores, assessed qualitatively, were found to be different, and there was no infringement. The judgment also provided commentary on the interplay of design and copyright law principles, for example in relation to the requirements for obtaining protection, the scope of protection and their coexistence.

Another intersection explored during the session was that between industrial designs and trademarks. In a Preliminary Ruling by the Court of Justice of the Andean Community, the Court considered the criteria for determining the likelihood of confusion between an industrial design and a three-dimensional trademark. In its ruling, the Court found that, in principle, it is possible for a three-dimensional creation to be protected by both an industrial design (because it is novel) and by a three-dimensional trademark (because it is distinctive). In the case at issue, a situation had arisen where these separate IP rights were held by different owners, despite consisting of a similar object. The potential risk of confusion for

consumers was discussed, as well as the Court's reasoning in reaching the interpretation that the first-registered right must be prioritized.

Furthering the comparative perspectives, a case from Egypt was presented in which the Court of Cassation provided a final judgment in an infringement dispute that involved interaction between civil and criminal proceedings. The dispute concerned alleged infringement of a protected design for a 19-liter bottle. The cassation decision examined whether an earlier acquittal of the defendant in a criminal proceeding relating to the same alleged infringement precluded a finding of infringement in the civil proceeding. The factors that were significant for the Court in considering whether the criminal judgment was binding in this instance, as well as the evidence available in relation to infringement, were described to explain the Court's reasoning in arriving at the conclusion that it was not bound by the criminal decision and that infringement was established.

The analysis used by a court in assessing infringement was also explored in the context of a decision of the High Court of Uganda concerning infringement of the design of a gumboot, which was claimed alongside passing off and fraud. This case is the first decision concerning industrial designs in Uganda, since the enactment of the relevant legislation in 2014. The discussion focused on the Court's detailed examination of the features of the gumboot, and whether the relevant ornamental aspects of the design were defined exclusively by the technical function of the article, or whether multiple aesthetic choices existed to achieve the function. The Court also considered the nature of the multimillion-dollar market in which the goods competed, the characteristics of the consumers, the close commercial relationship between the parties, and each of their use of the design prior to their applications for registration. The presentation illustrated how the Court arrived at the finding that the defendant's use of the design was infringing because it was intentionally similar to a prior, non-registered design, despite being registered first in time.

A further example was presented of a decision of the High People's Court of Ho Chi Minh City, Viet Nam, in which the infringement of the design of a well-known motorbike was at issue. The discussion of this case touched upon the range of remedies that may be available in industrial design infringement cases in some countries. It was revealed that, in Viet Nam, the Court is empowered to order not only damages, costs, removal and destruction of infringing goods and parts thereof, but also to issue a public apology in a specified newspaper. During discussion, the distinct national practice was further shared, indicating that courts have discretion to determine the number of apologies to be provided, as well as the form and frequency of the publication (including digital), depending on the circumstances and gravity of the case.

The discussion further took up the intersection of design rights with other types of IP rights, in particular copyright, trademarks and unfair competition. It was noted that, despite any coexistence between designs and other IP rights, there were notable differences, including in the nature and scope of the protection afforded by each, as well as in the respective requirements, duration, exceptions and limitations. In conclusion, it was acknowledged that the comparative dialogue helped understand the variation in how the subject matter of industrial rights are protected across different jurisdictions.



### Reference judgments

- Court of Cassation of Egypt [2015]: [Case number 4583 of Judicial Year 84](#)
- The Hague Court of Appeal, Netherlands [2020]: [Digital Revolution B.V. and Maxperian NL B.V. v Samsung Electronics Co., Ltd., Case No. 200.216.620/01](#)
- Intellectual Property Court of Portugal [2022]: [Barata & Ramilo, S.A. v Fabulous Cipher, Lda., Vila Nova Carneiro, S.A. and Cofemel – Sociedade de Vestuário, S.A.](#)
- High Court of Uganda, Commercial Division [2021]: [Migoo Industrial and Trading Company \(U\) Limited v Rida International Industry \(U\) Limited \(Civil Suit No. 359 of 2019\) \[2021\] UGCommC 145](#)
- People’s Court of Hanoi City, Viet Nam [2018]: [P & CSPA v D Technology Development Support Joint Stock Company, Case No. 36/2018/KDTM-ST](#)
- Court of Justice of the Andean Community [2021]: [Preliminary Ruling 476-IP-2019](#)
- Court of Justice of the European Union (Second Chamber) [2018]: [DOCERAM GmbH v CeramTec GmbH, Case No. C-395/16](#)

## Session 3: Emerging Issues in Geographical Indications

The panel discussed current issues in geographical indications (GIs) in relation to their scope of protection and conditions for registration, with reference to recent significant decisions from various jurisdictions. Topics included conflicts with trademarks, generic term determination, translation, unlawful evocation, as well as evidence-related issues.

The scope of protection of GIs was first addressed by reference to a recent decision from the High Court of Singapore. The Court had to assess whether a term was a translation of a GI and therefore could be protected as such. In that instance, the Court considered that a faithful translation (as opposed to a strictly literal translation) captures the essence of the word or phrase and ensures that the function of the GI (the link between quality and origin) is retained. The case also revealed questions relating to the burden of proof required to establish whether a particular term is a translation of a GI, and the relevant type of evidence (e.g., expert evidence, dictionary definitions, consumer perception) for a translation query.

The panel also addressed the scope of protection in the context of a conflict between a trademark and a protected designation of origin (PDO) in the EU – a PDO is a type of GI used in the EU and the United Kingdom (U.K.). The Board of Appeal of the EU Intellectual Property Office (EUIPO) had to determine whether a term contained in a PDO was generic and therefore could be used freely. The discussion highlighted the difficulties in analyzing all the relevant elements that need to be verified to determine the generic nature of the term, including the historical, regional, economic and societal factors. Relevance was given to the necessary evidence to make this determination, emphasizing the importance of expert reports, which in this case, was the basis for the determination that the term was not generic.

Genericness in the context of GIs was also explored with reference to a decision from the United States of America (U.S.). The Trademark Trial and Appeal Board (TTAB) of the U.S. Patent and Trademark Office had to consider the genericness in the U.S. of the term “Gruyere”, which is a protected geographical indication in Switzerland and France. The TTAB analyzed the claim under a two-part test that considers the “genus” of goods identified in an application and whether the relevant public understands the designation to refer to the genus of goods. The panel mainly focused on the evidence that is used for establishing the relevant consuming public’s perception of a term, which in this case included dictionary definitions, news items, internet reference materials, trade and merchant publications, production and sales data, and educational consumer campaigns.

The panel also addressed the specific issue of unlawful evocation of GIs. With reference to a case involving a decision from the Supreme Court of Spain and a preliminary ruling from the Court of Justice of the EU (CJEU), the question of whether a GI can be evoked by figurative signs was raised. In this case, it was considered that GIs must be protected against any type of evocation (whether coming from words or figurative signs), and such evocation can occur when the sign is capable of triggering, directly in the consumer’s mind, the image of the product whose designation is protected.

The registrability of GIs was further explored when discussing a recent decision from the Court of Appeal of Singapore related to the registration of “Prosecco” as a GI from certain Italian regions. The registration was opposed by a consortium of grape growers and winemakers from Australia. The Court had to consider, first, whether the GI contained the name of a plant variety, and, second, whether it was likely to mislead the consumer as to the true origin of the product. In its analysis, the Court held that the first question was to be objectively established and that, to do so, it was sufficient to show that the name is that of a plant variety. Regarding the likelihood of misleading the public, the Court laid down three factors for this determination: first, whether the average consumer is aware that it is the name of a plant variety; second, whether the consumer is aware that the plant variety in question is involved in the production of the product; and third, whether the GI sought to be registered is identical to the name of the plant variety. Matters of evidence and burden of proof were also discussed in this context, particularly the use of marketing materials and consumer surveys.

In another case, the Federal Civil and Commercial Court of Appeals in Argentina considered whether a GI for wines had to be registered beyond its country of origin to benefit from its protection elsewhere. In this case, a GI for Italian wines was registered in Italy but had not been registered in Argentina, where the owner of the GI opposed registration of a mark allegedly containing the GI. In its decision, the Court concluded that Member States cannot deny protection for GIs by adding greater requirements than those set out in the Agreement on Trade-Related Aspects of IP Rights (TRIPS Agreement). Since the TRIPS Agreement does not impose an obligation for the GI to be registered outside its place of origin, the Court considered that registration of the GI in Argentina was discretionary. The Court also referred to the enhanced protection for wines and spirits granted by the TRIPS Agreement and concluded that to deny a trademark registration of a mark that contains a GI for wines,

it is not necessary to establish a likelihood of confusion between the contested mark and the GI.

The discussion between the panelists and the participants shed light on some of the issues, for instance, the use of evidence when determining some of these controversies. It was acknowledged that jurisdictions have different rules on appointed experts, but it was highlighted that, for deciding some of these cases, it might be necessary to resort not only to one court-appointed expert but to have different perspectives and challenge them.

#### *Reference judgments*

- Federal Civil and Commercial Court of Appeals - Chamber I, Argentina [2021]: [\*Molinos IP S.A. v Consorzio Tutela del Lambrusco di Modena and Consorzio per la Tutela dei Vini Reggiano\*](#)
- Court of Appeal of Singapore [2023]: [\*Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Incorporated, Case No. SGCA 37\*](#)
- High Court of Singapore (General Division) [2022]: [\*Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco, Case No. SGHC 33\*](#)
- High Court of Singapore (General Division) [2023]: [\*Fonterra Brands \(Singapore\) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano, Case No. SGHC 77\*](#)
- Supreme Court of Spain (Civil Bench) [2019]: [\*Fundación Consejo Regulador de la Denominación de Origen protegida Queso Manchego v Industrial Quesera Cuquerella SL and Juan Ramón Cuquerella Montagud, Case No. 451/2019\*](#)
- Trademark Trial and Appeal Board, United States Patent and Trademark Office [2020]: [\*Int'l Dairy Foods Ass'n v Interprofession du Gruyère, 2020 USPQ2d 10892\*](#)
- Fifth Board of Appeal of the European Union Intellectual Property Office [2021]: [\*Torta del Casar v Queso de La Serena, Case No. R 696/2018-5\*](#)
- Court of Justice of the European Union (Fourth Chamber) [2019]: [\*Fundación Consejo Regulador de la Denominación de Origen Protegida Queso Manchego v Industrial Quesera Cuquerella SL & Juan Ramón Cuquerella Montagud, Case No. C-614/17\*](#)

## Special Guest Speaker on Artificial Intelligence and Decision Making

Professor Arvind Narayanan, computer scientist and Director of the Center for Information Technology Policy at Princeton University, drew upon his expertise in the area of the societal impact of digital technologies to examine potential applications of AI to judicial decision making.

Professor Narayanan began by expressing his belief that, because legal technology is already a mature field, the impact of AI on judicial decision making is likely to be evolutionary, not revolutionary. He then presented three categories of potential legal applications of AI: information processing; creativity, reasoning and judgment; and prediction. Information processing includes tasks such as summarization, translation,

transcription, electronic discovery (e-discovery), and redaction. The category of creativity, reasoning and judgment can entail preparing legal filings, research assistance, legal interpretation, and automated mediation and dispute resolution. Lastly, Professor Narayanan described a category of tasks that involve predicting the future in some capacity, including criminal risk prediction and the prediction of court decisions.

On the category of information processing, Professor Narayanan noted that, although systems such as ChatGPT could now complete summarization, translation, transcription and e-discovery tasks, these are tasks that special purpose software had long been able to perform. What was new was the existence of a single tool that could be instructed, in English, to perform any of these tasks, as opposed to a need for programmers to create a new tool for each task. However, because the set of tasks that are useful to judges and lawyers are well understood, Professor Narayanan did not consider this ability to be revolutionary in legal applications.

Professor Narayanan then discussed some of the known limitations of AI, including the so-called hallucination problem, in which AI produces invented details when asked to summarize a document. Professor Narayanan expressed his belief that human oversight will be required when using AI tools for legal applications for the foreseeable future (i.e. the next 2-3 years).

Regarding tasks involving creativity, reasoning and judgment, Professor Narayanan noted that the hallucination problem becomes much worse in open-ended applications, such as when AI is asked to produce a legal brief or argument. He explained that evaluation of AI against benchmarks, including bar exam questions, may be unhelpful in comparing the appropriateness of AI tools in this area. He noted that benchmark evaluations did not envision the real-world work of lawyers, which is not to answer bar exam questions. Benchmark questions may also be in the data used to train AI, presenting a further problem for evaluation. Professor Narayanan was of the view that evaluation of AI in this area needs to be led by legal professionals.

Professor Narayanan also discussed the potential application of AI to legal interpretation. He noted that AI can serve as a tool to illuminate the 'ordinary meaning' of words, which is an inquiry that is often undertaken by judges. However, Professor Narayanan indicated that such uses of AI can be highly prone to error. Nonetheless, Professor Narayanan believed that AI could possibly be useful for certain tasks involving creativity, reasoning and judgment, such as the use of AI to automatically identify errors in submitted trademark applications. He further suggested that more advanced AI technology could potentially be used for forms of adjudication and dispute resolution.

Concerning the application of AI to legal prediction tasks, Professor Narayanan highlighted the bias that has been observed in AI tools used for criminal risk prediction. He also found AI to be relatively ineffective in predicting court decisions.

Professor Narayanan then turned to the question of whether there is likely to be a wave of AI-generated discoveries and inventions. He expressed his view that, for the foreseeable

future, AI will not be at a point where it can be considered the inventor of a scientific innovation. Rather, human beings will still be responsible for the critical steps of inventions, such as the conducting of medical trials.

Professor Narayanan concluded by reiterating his belief that progress in AI is best regarded as evolutionary, not revolutionary. Although he believed that AI could serve useful functions for judges and lawyers, he doubted that it will revolutionize legal practice.

In their questions and comments, participants discussed the human rights implications of using AI for criminal risk prediction, as well as the implications of the asymmetry in the proportion of data from different geographical regions used to train AI technologies for the risk of bias.

#### *Reference articles*

- Kapoor, S. and Narayanan, A. (2022). [AI Snake Oil: A sneak peek into the book](#)

## Session 4: Intellectual Property and Competition Issues

The session addressed the intersection between IP and competition, touching upon both unfair competition and antitrust (anti-monopoly) aspects. The unfair competition regime was introduced as governing the behavior of businesses engaged in competitive activities, and prohibiting actions such as misrepresentation, deception, false advertising, bribery, disparagement, trademark infringement, passing off, unjust enrichment, trade secret theft, bait-and-switch tactics, and intentional or negligent interference with prospective economic advantage. On the other hand, antitrust laws regulate the market structure, prohibiting conspiracies, acquisitions that weaken competition, and restraints of trade, with a view to ensuring allocative efficiency and consumer well-being. As such, unfair competition laws aim to ensure fairness in competition, while antitrust laws are designed to achieve and preserve freedom of competition.

The panelists shared significant decisions from their jurisdictions on this intersection, noting that the relationship between competition law and IP rights has been defined differently depending on the jurisdiction and the historic time period. In the past, the relationship was often perceived as an area of (inherent) conflict, due to the role of competition law in regulating abusive attempts by some actors in the exercise of their exclusive IP rights. However, in some jurisdictions, there appeared to be a contemporary shift to acknowledge the complementarity in the two areas of law.

The particularity of competition laws in the EU, which seek to maintain the single market, was noted. The legal basis for reconciling EU rules on competition and national IP laws is provided in Article 345 of the Treaty on the Functioning of the EU, which excludes the system of property ownership governed at the national level from the scope of EU norms on competition. This necessitated distinguishing the existence of IP rights, unaffected by EU

competition norms, and the exercise of the IP rights, subject to EU norms on competition. This relation has been addressed by decisions of the CJEU. The CJEU's 2004 *Magill* ruling set the criteria for establishing the exceptional circumstances in which a refusal to license can be found to be abusive: that is, where a refusal to license prevents the appearance of a new product; it eliminates competition in the secondary market; it lacks objective justification; and the product is indispensable for the development of the concerned activity. The *Huawei* ruling by the CJEU in 2015 addressed the dominant position of SEP holders, and risks such as excessive royalties or engaging in competition on secondary markets, as well as the definition of fair, reasonable, and non-discriminatory (FRAND) conditions. The ruling highlighted the dominance conferred upon SEP holders and the potential anti-competition defense if a SEP holder fails to grant a license on FRAND terms.

The evolving approach to this intersection in Australia was illustrated by the repeal of a section of the Competition and Consumer Act, which had previously provided a limited exemption for some conduct related to IP rights from certain anti-competitive conduct prohibitions under the Act. The official Guidelines concerning this legislative change were shared, noting that any conduct involving IP rights that has the effect or likely effect of substantially lessening competition is now subject to anti-competitive conduct prohibitions. Such conduct may include the use of a "no challenge provision" in a patent license, price fixing and allocation of customers, suppliers, or territories in patent licenses. The application of this framework to settlements in patent cases was discussed, including how the parties may decide to proceed to the trial of patent cases, in light of the transparency demands and time associated with seeking approval of the settlement agreement from the competition authority.

It was explained that, in China, the potential negative impact of antitrust laws on innovation is a key factor that is considered in the intersection between IP and competition laws, such that antitrust laws are not applied if doing so would hinder innovation. This can be seen in the fact that a 2022 amendment to the Anti-Monopoly Law introduced the encouragement of innovation as one of its principal objectives. As such, certain activities, such as joint research and development or new technologies for a single industry standard, may be exempt from the application of antitrust laws. A decision considering whether a patent holder had abused its dominance or engaged in unfairly high pricing behavior, was presented. The judgment illustrated the economic analysis utilized by the court to assess the antitrust impact of patent holder behavior on competitors and consumers, and the internal rate of return method employed to assess the reasonableness of returns for innovators and IP holders, factoring in risks and potential returns, particularly in scenarios that are high-risk for innovators.

The panel also discussed competition issues arising in advertising in the digital world, in particular through the use of third-party trademarks as adwords in paid advertisement campaigns to attract web traffic. In Brazil, this behavior was found by the court to constitute an act of unfair competition that undermines the purposes of trademarks to protect trademark holders against parasitic economic gain and unfair diversion of clientele, and to prevent consumers' confusion regarding the origin of the product. This approach was contrasted with the approach in Europe, where the CJEU has established that the intermediary is not liable including in cases where trademark infringement is found; and

that the purchase of a third party's trademark as a keyword is not automatically deemed as an infringement, if it is sufficiently clear who the advertiser is and that they are not connected with the trademark owner.

One panelist described the intersection of competition law and IP, particularly in the area of patents, using the analogy of the "Little Red Riding Hood" fairy tale to present two potential choices for the patent holder. The first is that the young girl, the patent holder, does not embark on her journey due to fear of the wolf, representing a reluctance to engage in innovation. The second is the risk of getting eaten by the wolf on her way, symbolizing the potential negative consequences of not finding a balanced approach to stimulate innovation. In response, it was opined that the analogy may apply conversely, the little girl being the competition authority.

The discussion emphasized the importance of finding the right balance between stimulating innovation (including follow-on innovation) and ensuring a vibrant and competitive market structure, and the risk that, without an effective balance, inventors may rely less on patents and turn to trade secrets. This would hinder the sharing of inventions with the public, which is typically done through the quid pro quo of providing a monopoly patent right.

#### *Reference judgments*

- Superior Tribunal of Justice of Brazil [2023]: [\*Esperança Holding Ltda. and Hope Do Nordeste Ltda. v Loungerie S/A and Google Brasil Internet Ltda.\*](#)
- Supreme People's Court of China [2023]: [\*Yangtze River Pharmaceutical Group v HIPI Pharma Tech\*](#)
- United States Court of Appeals for the Federal Circuit [2023]: [\*TRUSTID, Inc. v Next Caller, Inc., No. 2022-1433\*](#)
- Court of Justice of the European Union (Fifth Chamber) [2004]: [\*IMS Health GmbH & Co. OHG v NDC Health GmbH & Co. KG, Case No. C-418/01\*](#)
- Court of Justice of the European Union (Fifth Chamber) [2015]: [\*Huawei Technologies Co. Ltd v ZTE Corp. and ZTE Deutschland GmbH, Case No. C-170/13\*](#)

#### *Further reference materials*

- Australian Competition & Consumer Commission (2019). [Guidelines on the repeal of subsection 51\(3\) of the Competition and Consumer Act 2010 \(Cth\)](#)

## Session 5: Generative Artificial Intelligence, the Metaverse and Intellectual Property Infringement

This session began with an introduction to the metaverse and its central concepts, as well as the vision, currently dominating the technology industry, of the metaverse as a future generation of the internet. The session first explored the IP adjudication issues that can reasonably be expected to arise with the future development of the metaverse through the lens of trademarks. For example, some brands already engage in the sale of digital fashion

accessories using gaming platforms, while others have developed their own non-fungible tokens (NFTs). Now, anticipating increases in sales of virtual items, some brand owners are taking steps to protect their marks from misuse in the virtual environment.

The issues that courts can expect to face as these developments gather pace include the central problem of identifying the territory in which infringement involving digital goods has occurred. Another question may relate to the identification of an infringing user, where the real life identity of an avatar cannot be readily ascertained. The application of discovery mechanisms to the metaverse could be expected. It also remained to be seen whether currently existing tools, such as website blocking orders in the area of copyright, would find analogy in the new space. A host of other questions that could be envisaged were discussed including, importantly, the role of metaverse platforms.

The localization of infringement in a future metaverse was examined in greater detail using a hypothetical fact scenario, involving a user who directs an avatar in a virtual world to purchase, using virtual credit, branded virtual goods that are identical to branded goods in the real world. The discussion illustrated how this foreseeable scenario could create complexity for courts in adjudicating the claim.

The panel first considered which courts would have jurisdiction to hear such an infringement claim. It was possible to imagine that each element of the facts—such as the residence of the user of the avatar, the domain name of the website from which the virtual world is operated, the location of the servers hosting the website, the location of the company that owns the website, the language used in the virtual world, the currency used for any participation fees, and so on—could involve a different country. In this situation, current rules for establishing jurisdiction in the digital environment, such as rules linking jurisdiction to the territory of the infringing user or in the territory where the infringement occurred, may help. In addition, existing case law may provide guidance on determining the location of infringement in the digital environment, such as by reference to the location in which the user's acts took place, or the territory in which the trademarks are registered. However, the conditions required to satisfy existing rules and jurisprudence may be more difficult to establish in the metaverse.

The discussion also addressed the substantive IP questions relating to whether there had been infringement, and by whom. For example, assuming that the scenario concerned the use of an identical sign for identical goods or services, could the use of the sign in the metaverse (either by the user or by the operator) constitute use “in the course of trade”? If yes, could that virtual use be considered to fall within the territorial jurisdiction of the court? Recent case law from the U.K. was shared, relating to whether the sale or advertising of trademarked goods on a foreign website can constitute infringement of the relevant trademarks in the U.K. Finally, assuming that infringement could be established in the hypothetical scenario, the available remedies and their enforcement were also discussed. In this context, the possible application of existing jurisprudence on the availability of damages and injunctions for online infringement, and on alternative routes of enforcement against online intermediaries, was considered.



Next, the panel turned its attention to the area of copyright, where substantive questions are emerging from the use of generative AI systems, both in terms of the input used by AI, and the output produced by it. These questions were explored by reference to three recent cases from China. In one case, graphics produced by a human operating a software were not found to be copyrightable, as the generation of the images did not involve a creative choice. In the second case, an article that was generated using software was found to be copyrightable, as the specific form of expression of the article originated from the personalized selection and arrangement choices of the humans involved in the process. In a third case, the court considered, among other issues, whether a digital avatar of a human can be considered an “author” and enjoy copyright and related rights, including performers’ rights. The court answered in the negative, finding that the avatar was a tool of human authors.

Finally, the session considered what the issues raised mean for the role and responsibilities of judges. Jurisdictional challenges dealing with the venue of litigation were considered to be likely to proliferate; at the same time, it was noted that the indices used by courts to establish jurisdiction were ever-changing and would continue to evolve in the digital environment. The panel also reflected on the ethical implications of the use of AI technologies by the judiciary, and the responsibility to preserve the independence, integrity and impartiality of the judiciary. A further challenge identified was the increasing volumes of information coming to courts in digital form, and the judge’s task of ensuring appropriate levels of confidentiality where required, while balancing the public interest of access to judicial proceedings. Judges will also increasingly be required to evaluate evidence that is produced with the involvement of AI technologies, which requires awareness of the range of tools and their operation, including their strengths and weaknesses.

In discussion, it was noted that judges could expect to face these questions earlier than the rest of society, given that commercial realities outpace policy and legislative developments. It was noted that some of the questions were already being litigated. On the question of copyright infringement by AI systems, courts in more than one jurisdiction have already received claims alleging that the use of copyrighted works as input for AI systems constitutes infringement. Some jurisprudence regarding the liability of NFT platforms for infringement is also emerging. A recent case from China was shared, in which the operator of an NFT platform was held responsible for ensuring that a virtual work sold on its platform was not copyright infringing. It was also acknowledged that eventual questions regarding apportioning of liability for infringement between AI systems and the humans involved in their programming would be subject to future developments in policy and legislation.

#### *Reference judgments*

- Primary People’s Court of Nanshan District, China [2019]: [\*Tencent Company v Yingxun Company\*](#)
- Intermediate People’s Court of Hang Zhou City, China [2022]: [\*Yuanyuzhou Company v Qice Company\*](#)
- United States District Court of the Southern District of New York [2023]: [\*Hermes Int’l v Rothschild, No. 22-CV-384 \(JSR\)\*](#)

- United States District Court for the District of Columbia [2023]: [Thaler v Perlmutter, Civil Action No. 22-1564 \(BAH\)](#)

#### *Further reference materials*

- Rosati, E. (2023). [The Localization of IP Infringements in the Online Environment: From Web 2.0 to Web 3.0 and the Metaverse](#). World Intellectual Property Organization.
- Ryan, M. (2022). [Intellectual Property Considerations and Challenges in the Metaverse](#). SSRN.
- Saw, C. L. and Chan, Z. W. S. (2023). [The subsistence and enforcement of copyright and trademark rights in the metaverse](#). Research Collection Yong Pung How School of Law, Singapore Management University.

## Session 6: Rules of Evidence in Intellectual Property Litigation

This session covered a range of perspectives on gathering evidence in IP disputes. It was noted that, in most jurisdictions, general rules of evidence apply to IP disputes, with some jurisdictions having IP-specific rules of evidence.

The topics touched upon by the session included: techniques used by courts to make evidence collection more time-effective; the use of expert evidence; cross-border discovery; digital evidence; remote recording of evidence, including through video-conference; survey evidence in trademark cases; and evidence gathered through trap purchase or test buys.

On the topic of expert evidence, the panelists revealed a range of different approaches among jurisdictions, including in relation to the use of court-appointed vs. party-appointed experts; reliance on court assessors; requirements for the expertise, qualifications and other attributes of experts; the use of lists of experts; the weight given to expert evidence; the manner in which experts give evidence (e.g. oral, written or both); the use of concurrent evidence (or “hot-tubbing”, where multiple party-appointed experts prepare a joint report prior to the trial, and give their evidence concurrently); who pays the cost of experts; and objections and challenges to expert reports.

For example, it was explained that, in Germany, only court-appointed experts may provide evidence, and the court appoints a single expert. The specificities of the national context in which this judicial practice had developed were noted, such as the significant technical subject matter experience possessed by judges appointed to patent disputes; the status of certain questions, such as obviousness in patentability disputes, as questions of law which can only be answered by the judge; and the rarity of questions of fact, such as evaluation of the common technical knowledge, that may benefit from an expert opinion. In Japan, it was noted that the support provided by judicial research officers and technical advisors to the court in patent cases lessens the need to utilize expert evidence, although such evidence is admissible. By contrast, in other countries – such as in Nigeria, where the provision in the Patents and Designs Act allowing the court to be advised by assessors is rarely used – courts rely more frequently on party-appointed experts. In India, the practice of using both court-appointed and party-appointed experts is prevalent. Indian courts benefit from relying on

expert opinions, especially in complex IP disputes involving technical subjects. However, as in other jurisdictions, expert opinion is not binding. It was felt that experts are used for assisting the court but the word of caution was that 'adjudication could not be outsourced.'

A further approach was shared from Japan, where evidence collection involves court orders to produce documents, as well as an inspection system through which courts can order the inspector to collect necessary evidence. Document submission orders are provided for under Code of Civil Procedure as well as the Patent Act, with the latter procedure being granted more easily, unless there are reasonable grounds to refuse. The court's approach to assessing a party's grounds for refusal to submit the required evidence was shared, including weighing the disadvantage that would be suffered by the document holder against the disadvantage that would be suffered by the petitioner due to non-disclosure. It was noted that the court may use in-camera (closed) proceedings when making this determination. Similar to Japan, other jurisdictions reported that the courts have the authority to order the production of documents critical to the case.

The panel discussed exchanged their experiences of receiving evidence from court-appointed experts vs. party-appointed experts, and in general noted that there were significant differences between court and party-appointed experts. Cases were shared illustrating the court's approach when there were conflicting views presented by the party-appointed experts. The panel highlighted that the assessment of evidence in IP cases is not dependent on the view of experts, as it is ultimately evaluated by the courts.

In relation to cross-border discovery, a growth in the use of cross-border discovery in a jurisdiction was noted. It was suggested that the simplification of judicial procedures for discovery of documentary evidence (in particular electronically-stored information (ESI)) and testimony, and adaptation of relevant rules of civil procedure to govern cross-border discovery, could assist courts in more effectively overseeing discovery in cross-border disputes. In this context, a proposal submitted for a new rule of civil procedure was shared. The proposal provided for a procedural framework when cross-border discovery was initiated. It was further noted that the *Letters of Request* procedure set out in the Hague Convention on the Taking of Evidence Abroad in Civil or Commercial Matters is applicable only among contracting parties to the Convention.

The use of digital evidence in cases involving the online infringement of IP rights was also discussed. Two trademark counterfeiting cases were presented, involving the gathering of electronic evidence through offers displayed on an online social networking platform and the seizure of electronic evidence to establish trademark counterfeiting through provisional measures. The role of the doctrine of 'purposeful availment' in establishing jurisdiction in cases of online infringement of IP rights was also discussed.

The panel discussed whether special rules governing digital evidence were necessary. Some jurisdictions had provisions that create a distinction in the admissibility of digital evidence,

whereas other jurisdictions do not create such a distinction, and the rules relating to admissibility are technologically-neutral.

The session also addressed the use of survey evidence in trademark disputes, and the challenges for courts in evaluating this evidence, due to factors such as population size and selection, as well as potential question bias. The panel exchanged their experiences of dealing with survey evidence. Broadly speaking, survey evidence seeking to prove acquired distinctiveness may be admitted provided that the survey has been properly designed and carried out; in such instances, the court may place some weight upon the survey evidence. However, an example was shared of a case in which the results of such survey evidence were found to be flawed due to inappropriate selection of questions. On the other hand, courts are generally skeptical of the value of survey evidence seeking to prove infringement, such as likelihood of confusion. It was shared that, in the U.K., there is strict court control over the admission of survey evidence in trademark cases, and parties may apply in advance, on the basis of a pillory survey, to obtain the court's permission to carry out a full survey.

#### *Reference judgments*

- Federal Court of Justice, Germany [2020]: [Case No. X ZR 111/18](#)
- High Court of Delhi, India [2023]: [Communication Components Antenna Inc. v Rosenberger Hochfrequenztechnik GmbH, 2023:DHC:4582](#)
- High Court of Delhi, India [2023]: [Eicore Technologies Pvt. Ltd. v Eexpedise Technologies Pvt. Ltd., CS\(COMM\) 1146/2018](#)
- Intellectual Property High Court of Japan (Third Division) [2020]: [Case No. 2020 \(Gyo-Ke\) 10076](#)
- Court of First Instance, Amman, Jordan [2008]: [Aowrgo Food and Befrg International Company v Akhaa Arabia Company](#)
- Court of First Instance, Amman, Jordan [2008]: [Talhowni and Aqeel Corporation v Tashera Company](#)
- Court of Appeal of Nigeria, Kaduna Judicial Division [2002]: [Arewa Textiles Plc & Ors v Finetex Ltd\[2002\] LPELR-5361 \(CA\)](#)
- Federal High Court of Nigeria, Lagos Judicial Division [2022]: [Technocrat Consult and IT Limited v Central Bank of Nigeria et al., Suit No. FHC/LCS/1519/2012](#)
- United States Court of Appeals for the Third Circuit [2022]: [Behrens et al. v Arconic, Inc. et al., Nos. 20-3606, 21-1040 and 21-1041](#)

#### *Further reference materials*

- India (2021): [High Court of Delhi Rules for Video Conferencing for Courts 2021](#)
- Jordan (1952): [Evidence Law](#)
- Jordan (2021): [Border Measures System for the Protection of Intellectual Property Rights](#)
- United States of America: 28 U.S. Code § 1782 – [Assistance to foreign and international tribunals and to litigants before such tribunals](#)

## WIPO's Work with Judiciaries

The session provided an overview of [WIPO's work with judiciaries](#), which aims to support fair and effective justice systems that allow the IP and innovation ecosystems in each Member State to realize their purpose. The four focuses of WIPO's work were described as follows: promoting avenues of exchange for transnational judicial dialogue; producing resources for judges; providing judicial education on IP; and making available an open and free global repository of IP laws, treaties, judgments and information on judicial systems through [WIPO Lex](#). It was reiterated that this work is guided by judges, in particular through the guidance provided by the [WIPO Advisory Board of Judges](#).

In the first area of exchange, WIPO serves as a convener of the global community of IP judges through various activities, such as the flagship annual IP Judges Forum, the annual Master Class on IP Adjudication targeting experienced IP judges in a workshop format and in partnership with national courts, and the WIPO Webinars for Judges.

The second area focuses on the publication of judicial resources on IP. It was reported that [An International Guide to Patent Case Management for Judges](#) was released in April 2023. This publication draws upon the expertise of some 70 contributors from ten patent heavy jurisdictions, to build a comprehensive, accessible and practical guide to the different stages of patent litigation. In addition, it was noted that further to the release of the [IP Benchbook Series](#), further volumes are in progress in collaboration with countries in Africa and in Asia.

In the third area of judicial education, WIPO collaborates with national judicial training authorities to deliver a suite of tailored and holistic capacity building initiatives to establish a continuing judicial education on IP.

Finally, WIPO strives to be the authoritative source of global IP legal information through the [WIPO Lex](#) database, which covers not only laws and treaties applicable to all Member States, but now also includes IP judgments from 36 jurisdictions.

The WIPO Judicial Institute expressed gratitude to the personal engagement and support of judges, that enable these areas of work with judiciaries across WIPO's membership.

## Session 7: Simplified or Fast Track Procedures for Certain Intellectual Property Claims

In recognition of the ongoing efforts by many courts to align their procedures with the specificities of IP disputes, Session 7 explored examples of simplified or fast-track procedures used in different jurisdictions, including their objectives, scope of competence, and procedural features.

The session began by noting that, as IP litigation has become increasingly complex and expensive, legislators and courts in some countries have established various processes to streamline the resolution of certain, less complicated IP disputes.

For example, the simplified process established under Singapore's *Supreme Court of Judicature (Intellectual Property) Rules*, which is largely modeled on the Intellectual Property Enterprise Court (IPEC) in the U.K. and came into force in 2022, aims to provide access to justice for less well-resourced parties, including individuals and small and medium enterprises (SMEs), in a cost-effective and expeditious manner. The rules establish the conditions that must be satisfied for an IP case to qualify for adjudication under the simplified process. Insights on the evaluation of these conditions were provided from the first case to invoke the simplified process in Singapore. In this case, the High Court of Singapore found the dispute to be suitable for resolution under the simplified process, as the issues were neither legally nor factually complex, the trial was not expected to exceed two days, and the damages claimed did not exceed the stipulated limit.

A further approach was shared from the U.K., where IPEC was created to achieve more effective resolution of certain IP disputes. In addition to a limit on trial length and on the issues allowed to be heard, the procedure governing cases before IPEC is distinguished by robust case management and a cap on costs. Two decisions relating to the discretion exercised by judges in evaluating applications by parties to depart from the standard restrictions of a simplified procedure were shared. One decision highlighted the effect of granting an application to amend statements of case in a regime with capped costs and illustrated the cost-benefit balancing exercise conducted by judges to determine such an application. The other judgment explored the considerations bearing on the court's discretion to depart from the cost caps themselves and found that such discretion should only be exercised in truly exceptional cases.

A judgment from South Africa was presented in which the Supreme Court of Appeal affirmed the legitimacy of the Final Appeal Committee (FAC) of the Advertising Regulatory Board (ARB), which provides a simplified and accelerated procedure to resolve certain IP disputes. The Court considered the constitutionality of the ARB's powers, including issues such as its rules of evidence, the lack of appeal to a court of law of its decisions, and whether it ousts the jurisdiction of the ordinary courts by establishing a parallel dispute resolution procedure. The Court's reasoning in finding the ARB to be a legitimate parallel adjudicative administrative tribunal was discussed.

The revised *Rules of Procedure of the Boards of Appeal of the European Patent Office (RPBA)*, which came into force in 2020 to enhance the efficiency of the proceedings of the Boards of Appeal, were also shared. These rules include the codification of a so-called convergent approach. Under this approach, the scope of amendments permitted to a party's case narrows as the proceedings progress. It was also shared that, as a general rule, the Boards of Appeal issue nonbinding preliminary opinions prior to oral hearings, intended to allow parties to better prepare for the hearing. The RPBA also provide for the consolidation of related appeals and the acceleration of proceedings.

An example of recently established simplified procedures for small claims was presented through the experience of the Copyright Claims Board (CCB) in the U.S. It was explained that the CCB was designed as a more streamlined, cost-effective alternative to full litigation in federal courts. As a result, the CCB can only hear certain copyright-related claims, including claims of infringement, claims seeking declarations of non-infringement, and claims of misrepresentation relating to takedown notices or counter-notices to an online service provider. In a standard case before the CCB, possible damages are capped at USD 30,000. The procedural features used by the CCB to achieve its objectives include conducting proceedings virtually to facilitate self-representation; the use of a standard set of interrogatories and document requests, to the exclusion of depositions and subpoenas; and the provision of a track for the smallest claims, in which possible damages are capped at USD 5,000.

The discussion also canvassed the tools available to courts in India to simplify or expedite procedures for certain IP claims. Together, the Commercial Courts Act of 2015, Delhi High Court Intellectual Property Rights Division Rules, and High Court of Delhi Rules Governing Patent Suits provide a legal framework for summary judgments, expedited trials and improved case management. The range of procedural features used by Indian courts to achieve these objectives were shared, including the use of summary judgments under certain conditions, the recording of evidence by appointed persons, the use of transcription for recording evidence, the ability of the court to reduce witness lists and the number of issues, and the application of a very strict timeline for the filing of the defense, which has helped in clearing court backlogs.

Participants and panelists finally exchanged on their experiences in the application of simplified procedures. A majority of the experiences shared suggested that litigants had generally responded positively to these procedures, even when they greatly reduce discovery and other elements typical of 'standard' IP litigation.

#### *Reference judgments*

- Patents County Court of England and Wales [2013]: [\*Henderson v All Around the World Recordings Ltd & Anor\* \[2013\] EWPC 19](#)
- Patents County Court of England and Wales [2011]: [\*Temple Island Collection Ltd v New English Teas Ltd & Anor\* \[2011\] EWPC 19](#)
- High Court of Singapore (General Division) [2023]: [\*Tiger Pictures Entertainment Ltd v Encore Films Pte Ltd\*, Case No. SGHC 138](#)
- Supreme Court of Appeal of South Africa [2022]: [\*Advertising Regulatory Board NPC and Others v Bliss Brands \(Pty\) Ltd\* \(Case No. 786/21\) \[2022\] ZASCA 51](#)

### *Further reference materials*

- India (2022): [Delhi High Court Intellectual Property Rights Division Rules](#)
- India (2022): [High Court of Delhi Rules Governing Patent Suits](#)
- Singapore (2022): [Supreme Court of Judicature \(Intellectual Property\) Rules](#)
- United Kingdom (2023): [Civil Procedure Rules, Part 63 – Intellectual Property Claims](#)
- United Kingdom (2020): [Practice Direction 63 – Intellectual Property Claims](#)
- United States of America (2020): [Copyright Alternative in Small-Claims Enforcement Act of 2020](#)
- Boards of Appeal of the European Patent Office (2020): [Rules of Procedure of the Boards of Appeal of the European Patent Office](#)

## Session 8: Court Referred Mediation Mechanisms Available for Intellectual Property Disputes

This panel explored the use of mediation across various jurisdictions, shedding light on relevant aspects of this mechanism, such as the judge's role in mediation, mediation protocols and practices adopted in each jurisdiction, the importance of training programs to aid judges in identifying suitable IP cases for mediation, criteria for becoming a mediator, and advantages and challenges of mediation.

The session was introduced by noting a global trend toward increased use of mediation in IP disputes. The moderator highlighted the different collaboration agreements that have been concluded in recent years between WIPO and various judicial authorities to refer IP cases to WIPO mediation, including the use of WIPO online case administration tools.

The discussion on the role of judges in IP disputes provided context to the conversation. Panelists emphasized that judges may play a supportive role, guiding parties toward the most effective means of enforcing their rights—whether through settlement, mediation, arbitration, or a court ruling. Panelists underlined that IP judges aim to achieve justice, and that mediation is a possible avenue to achieve this.

The panelists illustrated mediation practices in their respective jurisdictions and highlighted recent changes in their legislation or court protocols toward enabling the use of mediation. For example, in Latvia, since 2015, judges have been obliged to suggest mediation to parties in all civil cases, including IP cases. In Canada, the Federal Court Rules empowers courts to arrange mediation and other forms of alternative dispute resolution conducted by an associate judge at any time during the proceedings. In the Republic of Korea, a panel of judges may refer the case to mediation at any time during the proceedings. The mediator can either be a judge from the panel that is hearing the case, a mediation committee, a court-annexed mediation center, or a mediation institute outside the court. In Paraguay, mediation (whether judicial or not) is encouraged by judges in civil, commercial, and criminal IP-related disputes; this has been the case especially after several recent legal reforms and awareness-raising efforts. Finally, in France, there have been efforts to support the use of



mediation at all stages of proceedings, including a recent protocol for the Paris Judicial Court (Third Chamber), which hears IP disputes.

The discussion also touched upon the criteria or professional requirements for becoming a mediator. It was emphasized that the requirements are specific to each jurisdiction. For example, in Latvia, state-certified mediators must comply with several requirements, such as several hours of mediation training, a minimum age, and a three-part test. The emphasis on judicial education in mediation was underscored, with examples from Canada, Latvia and Paraguay, detailing specialized training for judges to understand mediation, identify suitable cases, and engage effectively with parties.

The discussion highlighted several advantages of mediation, including cost benefits, expedited resolution, confidentiality, procedural flexibility, and the potential to maintain or improve relationships between disputing parties. Obstacles to referring parties to mediation were also acknowledged, such as a prevailing litigation culture and the role of some lawyers steering clients toward litigation despite potential drawbacks.

Finally, the panelists delved into other questions, including the enforcement of settlement agreements. It was emphasized that, in numerous jurisdictions, mediation agreements are binding, holding equivalent legal weight as a court judgment. Consequently, if breached, the affected party has the right to seek damages. The discussion also touched upon formalities associated with mediation agreements, such as whether notarization, sealing, or court validation is required.

#### *Reference judgments*

- Intellectual Property High Court of the Republic of Korea [2023]: [Case No. 2022Na2357](#)

#### *Further reference materials*

- Canada (1998): [Federal Courts Rules \(SOR/98-106\)](#)
- France (2023): [Protocol for the Evolution of Procedural Practice before the Third Chamber of the Paris Judicial Court](#)
- Latvia (2014): [Law on Mediation](#)
- Paraguay (2002): [Law 1879/2002 on Arbitration and Mediation](#)
- Republic of Korea (1990): [Judicial Conciliation of Civil Disputes Act](#)
- Republic of Korea (2018): [Practice Directions for Civil Appellate Trial in the Patent Court of Korea](#)

## Closing

The 2023 WIPO IP Judges Forum was closed by Mr. Marco M. Alemán, Assistant Director General of the IP and Innovation Ecosystems Sector at WIPO, and Judge Jimmie V. Reyna, Member of the WIPO Advisory Board of Judges.

Mr. Alemán observed that innovation has emerged as a central component of economic and industrial strategies across a wide spectrum of countries and across all industry sectors. He stressed the need for a robust IP legal framework, coupled with a fair and effective dispute resolution system, which together provide predictability for market structures, and contribute to achieving the balance envisaged in the IP system.

Mr. Alemán underscored the role of courts in interpreting and applying IP laws to real-life disputes, integrating the static legal framework into the dynamic fabric of societies, and shaping the course of history for IP laws.

Against this backdrop, Mr. Alemán reiterated the role of WIPO as a global convener for judicial dialogue, a source of collective judicial knowledge, a provider of judicial education, and a provider of alternative dispute resolution mechanisms.

Mr. Alemán observed that, in the contemporary interconnected world, challenges in the judicial administration of IP disputes cannot be overcome by a single country. They require regional and international cooperation, as well as national and regional courts' engagement and familiarity with foreign laws and systems while recognizing the normative, structural and socio-economic background of each jurisdiction.

Mr. Alemán underscored the significance of the annual IP Judges Forum as WIPO's flagship activity in this space, providing a forum for the exchange of information and practices. He reflected on the multiple areas covered by this year's program. For example, participants had learned from the experience of courts across the world on a range of substantive IP law questions. There was also the sharing of different approaches to the modernization and the specialization of IP dispute adjudication structures to provide effective and expedited justice in IP disputes, as well as exploration of the issues that may arise with the further development of technologies on the horizon.

In bringing the Forum to a close, Mr. Alemán invited all participants to continue engaging with WIPO and the international IP community. He also reiterated WIPO's deep gratitude to the members of the Advisory Board of Judges for their engagement in WIPO's work, and for their guidance in further developing the Organization's work to support judiciaries.

Speaking in his capacity as a Member of the WIPO Advisory Board of Judges, Judge Reyna highlighted that the Forum had successfully provided a space to foster relationships, exchange experiences, and acknowledge differences and similarities among IP systems, and encouraged the participants to take home the acquired knowledge and use it for the benefit and economic well-being of their respective communities.



