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Are There Any Common European Principles of Private International Law with Regard to Intellectual Property?

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Structure of the Presentation

I. Areas where common rules on private international law exist under European law

II. Are there any common principles underlying those rules?

III. Outlines of the CLIP project

IV. (Brief) comparison with the ALI project



European legislation in the field of IP: Jurisdiction

- **Brussels I Regulation**
 - Art. 22 (4)
 - Further provisions of practical relevance for Ip matters:
 - Art. 2
 - Art. 5 (1) and (3); Art. 6 (1)
 - Art. 27; Art. 31
- **Community Rights**
 - Art. 90 et seq CTMR
 - Art. 79 et seq CDR
- **Lacking:**
 - Common judiciary for European and/or Community patents
 - Special rules for internet infringement



European legislation in the field of IP: Applicable Law

- **No common rules exist regarding first ownership of copyright**
- **Contractual obligations: Common European ground exists already since 1980 – now transposed into the Rome I regulation**
- **Non-contractual obligations: Rome II, Art. 8**
 - **Para 1: Lex protectionis applies to obligations resulting from infringement**
 - **Para 2: Community rights (exact meaning remains unclear)**
 - **Para 3: Choice of law excluded!**



Are there any „Common Principles“?

- **Categories of Principles to be distinguished**
 - **Territoriality (and the sovereignty aspects underlying it)**
 - The power to determine the contents of national rules on IP
 - The power to grant and take away IP rights, in particular through registration/cancellation
 - **Efficiency**
 - Of court proceedings
 - Of international (trade) transactions
 - **Party autonomy**
 - **Others**
 - Legal security and foreseeability
 - Protection of weaker parties
 - More....
- **Is/are any of those Principles prevailing in European law?**



Territoriality/lex protectionis as the prevailing principle in IP?

- **Without claiming that European private international law regarding IP matters is generally imbalanced, there is a certain tendency to give the territoriality/lex protectionis aspects prevalence over countervailing interests**
- **Regarding jurisdiction, this became obvious in the GAT/LuK and Roche/Primus decisions**
- **Regarding the law applicable on infringement, it is reflected in Art. 8 (3) Rome II**
- **In both cases, better balanced solutions could be envisaged (like in the CLIP project.... :-))**

The CLIP-project

What it is and what it wants



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- **CLIP („The European Max-Planck Group on Conflict of Laws in Intellectual Property“)** was set up in 2004 – for information, visit www.cl-ip.eu
- **The Principles to be elaborated will cover jurisdiction, applicable law and enforcement – parallel to the ALI project**
- **The rules are meant to be globally applicable, i.e. they are not focused on the European situation**
- **Nevertheless, they could also function as guidelines for further development within the EU**



Jurisdiction according to the CLIP rules (work still in progress!)

- **Contrary to GAT/LuK, claims involving (in)validity as a defense are not subject to exclusive jurisdiction**
- **Courts in the defendant's country of domicile can entertain multiterritorial or even worldwide claims**
- **All other courts (i.e., courts in other countries where infringements occur) are only competent to adjudicate the infringement occurring in their own territory**
- **Two exemptions (for reasons of efficiency):**
 - **Claims against multiple defendants**
 - **Claims concerning infringements carried out through ubiquitous communication**



Applicable law according to the CLIP rules (work still in progress!)

- **Contractual obligations:**
 - Party autonomy prevails (as in Rome I), with explicit and differentiated criteria for determining the applicable law in absence of choice
- **Infringements: Lex protectionis, with some exceptions owed to party autonomy/efficiency**
 - parties may choose the law applicable to the remedies
 - „de minimis“ effects are not considered as infringing
 - In case of ubiquitous infringements, courts may apply the law of the country having the closest connection, with the opposing party being given the opportunity to plead (an)other law(s) that must be taken into account for the remedies
- **First ownership, transferability, waivability of exceptions and limitations: lex protectionis**



Where/how does CLIP differ from the ALI project?

- **One major difference between the projects lies in the approach towards first ownership**
- **Another difference concerns coordination of proceedings, where the ALI project proposes complex cooperation rules**
- **(Slight) differences as to substance also exist in other parts of the Principles**
- **However, the differences primarily concern the style and structure of rules, and do not lead to inconsistent results**
- **Hopefully, after completion of the project (and other, parallel projects, e.g. in Asia) it may be possible to formulate a „meta-text“ containing truly Common Principles accepted worldwide**