

HCCH-WIPO Questionnaire on Identifying Actual and Practical Issues of Private International Law in Cross-Border Intellectual Property Dealings



Instructions for Completion

1. For the purposes of this Questionnaire, the term “intellectual property” includes the following categories of intellectual property: copyright and related rights; trademarks; geographical indications; industrial designs; protection against unfair competition; patents and utility models; layout-designs (topographies) of integrated circuits; protection of undisclosed information; protection of undisclosed information (trade secrets); and plant breeders’ rights. In addition, the term “cross-border IP disputes” refers to IP disputes that raise private international law questions.
2. When completing the Questionnaire, kindly answer only the questions that you consider relevant in light of your experience in this area, and specify when your response is specific to only certain types of IP rights.
3. Please include or attach any relevant information on domestic, regional, or multilateral instruments and related provisions, actual IP cases (incl. references), and any statistics relating to cross-border IP disputes, as appropriate. Any additional information or material provided is equally welcome.
4. Your cooperation in responding to this Questionnaire is greatly appreciated and will provide invaluable assistance to the Secretariats of HCCH and WIPO.

Name of Member/Institutions/Other: *

Information (for follow-up purposes)

Name and title of contact person: *

Name of Authority / Office, where relevant:

Member State / Organization / Other *

Telephone number: *

E-mail address: *

Questionnaire

1. Does your jurisdiction have statutory provisions or case law addressing, expressly or impliedly, PIL issues (jurisdiction, applicable law, recognition and enforcement of foreign judgments, administrative or judicial international cooperation) in cross-border IP disputes? *

- Yes
- No
- Uncertain

Please describe: *

Please attach relevant provisions or case law:

Browse...

2. Is your jurisdiction bound by any bilateral, regional or multilateral instrument(s) that, expressly or impliedly, govern or contain provisions addressing PIL issues (jurisdiction, applicable law, recognition and enforcement of foreign judgments, administrative or judicial international cooperation) in cross-border IP disputes? *

- Yes
- No
- Uncertain

Please describe: *

Please attach relevant instruments:

[Browse...](#)

3. Have the courts of your jurisdiction referred to any policy guidelines or other sources (binding or non-binding) that address PIL issues (jurisdiction, applicable law, recognition and enforcement of foreign judgments, administrative or judicial international cooperation) in cross-border IP disputes? *

- Yes
- No
- Uncertain

Please describe: *

Please attach relevant instruments:

[Browse...](#)

4. Have you faced any PIL-related challenges in cross-border IP disputes, including any gaps in the current framework or any other practical hurdles? *

- Yes
- No
- Uncertain

Please explain: *

5. Please share with us if there is any statistical information regarding IP disputes with private international law issues available in your jurisdiction.

Please attach relevant instruments:

[Browse...](#)

Jurisdiction

Please respond to below questions either by reference to an applicable legal framework or to practical considerations.

6. Are there any practical or legal considerations that are relevant to selecting / establishing / challenging jurisdiction in a dispute arising out of a cross-border IP dealing? *

- Yes
 - No
 - Uncertain
-

Please explain the relevant considerations: *

7. Is (habitual) residence / domicile, branch, agency or other establishment of the defendant the principal factor determining jurisdiction in cross-border IP disputes? *

- Yes
 - No
 - Uncertain
-

Please explain: *

8. If the cross-border IP dispute concerns the validity, grant or registration of an IP right, would that require or permit jurisdiction rules to be applied that are different from the principal rule for jurisdiction? *

- Yes
 - No
 - Uncertain
-

Please explain: *

9. If the cross-border IP dispute concerns contractual issues, would that require or permit jurisdiction rules to be applied that are different from the principal rule for jurisdiction? *

- Yes
 - No
 - Uncertain
-

Please specify the rules, and explain how these rules are applied in practice: *

10. If the cross-border IP dispute concerns infringement of an IP right, would that require or permit jurisdiction rules to be applied that are different from the principal rule for jurisdiction? *

- Yes
 - No
 - Uncertain
-

Please specify the rules, and explain how these rules are applied in practice: *

11. If the cross-border IP dispute concerns claims of entitlement to or ownership of an IP right, would that require or permit jurisdiction rules to be applied that are different from the principal rule for jurisdiction? *

- Yes
 - No
 - Uncertain
-

Please specify the rules, and explain how these rules are applied in practice: *

12. If the cross-border IP dispute concerns several claims, such as those mentioned in questions 8-11, would the jurisdiction rules or considerations be different than those required or permitted in individual claims? *

- Yes
 - No
 - Uncertain
-

Please specify the rules, and how these rules are applied in practice: *

13. Would the above considerations be different if they concern an IP right subsisting or registered in another jurisdiction? *

- Yes
 - No
 - Uncertain
-

Please explain: *

Exclusive jurisdiction

14. Would certain IP matters fall under exclusive jurisdiction of a court of your jurisdiction? *

- Yes
 - No
 - Uncertain
-

Which IP matters? *

15. Would the above exclusive jurisdiction rules / considerations be different between registered and unregistered IP rights? *

- Yes
 - No
 - Uncertain
-

Please explain: *

16. Would the above exclusive jurisdiction rules / considerations be different if the IP issue is raised by way of an action, defence or counterclaim? *

- Yes
 - No
 - Uncertain
-

Please explain: *

Prorogation of jurisdiction

17. Are there circumstances where the parties' agreed choice of forum may be denied in the claims raised in questions 8, 11 and 14? *

- Yes
 - No
 - Uncertain
-

Please explain: *

Preliminary questions

18. Would a court deal with a matter that falls under the exclusive jurisdiction of a court of another State differently, if the matter is raised as a preliminary question or as the main subject matter of the dispute? *

- Yes
 - No
 - Uncertain
-

Please explain: *

19. When there are multiple defendants located in different States that are involved in an IP dispute (e.g., subsidiaries of the same multinational company), can courts in your jurisdiction consolidate proceedings so as to sue all the defendants? *

- Yes
- No
- Uncertain

Please specify the options, conditions and any particular challenges in practice: *

Online IP activities

20. Are there specific rules or considerations in determining / establishing / challenging jurisdiction over IP matters relating to the internet, e.g., with regard to ubiquitous infringement? *

- Yes
- No
- Uncertain

Please elaborate on the different rules or considerations that would apply depending on the nature of the dispute or type of the IP right involved, and any challenges that are faced in applying these rules: *

Interim, including protective, measures

21. Would a court in your jurisdiction be competent to decide or grant interim, including protective, measures in relation to an IP right subsisting or registered in another jurisdiction? *

- Yes
- No
- Uncertain

What are the conditions and / or particular challenges in this regard? Please explain: *

Decline jurisdiction or stay proceedings

22. In cross-border IP disputes, in view of proceedings brought elsewhere, may a court in your jurisdiction stay the proceedings or decline to hear a dispute over which it has jurisdiction? *

- Yes
- No
- Uncertain

Please specify the grounds or the mechanism (by the application of the forum non conveniens doctrine or by the existence of parallel proceedings in a foreign State, or other situations), and the conditions for its declining jurisdiction or staying the proceedings: *

Territorial scope of remedies

23. Are there circumstances where a remedy granted by a court in your jurisdiction may have extraterritorial legal effect, such as an award of damages incurred in a foreign country or an injunction outside the forum? *

- Yes
- No
- Uncertain

Please explain, including any requirements: *

Applicable law

24. Please respond to the applicable law questions below for specific types of disputes, in your jurisdiction:

a) In a validity, grant or registration dispute concerning **registered** IP rights, would the law of the State in which the registered right is granted or registered be exclusively applicable? *

- Yes
- No
- Uncertain

Please explain: *

b) In an **offline** infringement dispute, would the law of the place of infringement be applicable? *

- Yes
- No
- Uncertain

Please specify the place of infringement: the place where the alleged infringing activities occurred, or the place where the damage sustained, or others. *

Please specify the applicable law. *

c) In an **online** infringement dispute, would the law of the place of uploading be applicable? *

- Yes
- No
- Uncertain

Please specify the applicable law. *

d) In a contractual dispute relating to an IP right, such as licensing, would the parties' choice of law always be respected? *

- Yes
- No
- Uncertain

Please explain: *

e) In a contractual dispute relating to an IP right, such as licensing, in the absence of a parties' choice of law or the parties' choice is found to be invalid, would the law governing the contract be the applicable law to the dispute? *

- Yes
 - No
 - Uncertain
-

Please explain, specifying the applicable law(s): *

f) In a dispute concerning initial title or ownership, would the law of the State for which protection is sought be the applicable law? *

- Yes
 - No
 - Uncertain
-

Please explain, specifying the applicable law(s): *

g) In a dispute concerning transferability, would the law of the State for which protection is sought be the applicable law? *

- Yes
 - No
 - Uncertain
-

Please explain, specifying the applicable law(s). *

h) In a dispute concerning security rights in IP, would the law of the State where the grantor has his/her domicile or (habitual) residence at the time of the creation of the security right be applicable? *

- Yes
 - No
 - Uncertain
-

Please explain, specifying the applicable law(s): *

i) Are there other types of IP disputes that would encounter applicable law issues? *

- Yes
 - No
 - Uncertain
-

Please explain: *

25. In cross-border IP disputes, would a court in your jurisdiction apply different laws to different claims in the same suit in relation to the same rights? *

- Yes
 - No
 - Uncertain
-

Please elaborate. *

26. Can a foreign law chosen by the parties be set aside by a court of your State in cross-border IP cases? *

- Yes
 - No
 - Uncertain
-

On what bases? Please explain: *

Recognition and Enforcement

27. Have you experienced difficulties in having an IP-related judgment recognised and / or enforced outside the State where it was given? *

- Yes
 - No
 - Uncertain
-

Please explain the difficulties: *

28. Does your jurisdiction have recognition and enforcement rules specific for foreign IP-related judgments? *

- Yes
 - No
 - Uncertain
-

Please describe the conditions that must be met for a foreign IP judgment to be recognised and / or enforced in a court of your State. *

29. Does your jurisdiction have any specific grounds to refuse the recognition and / or enforcement of a foreign IP judgment? *

- Yes
 - No
 - Uncertain
-

Please explain: *

Provisional measures or interim decisions

30. Can provisional measures or interim decisions relating to IP rendered in a foreign State be recognised and / or enforced in your jurisdiction? *

- Yes
 - No
 - Uncertain
-

Please explain: *

31. If courts in your jurisdiction do recognise or enforce foreign IP-related judgments, do they recognise and/or enforce non-monetary part of the judgments, such as injunctions? *

- Yes
 - No
 - Uncertain
-

Please explain: *

Others

32. Are there any other PIL issues arising in cross-border IP disputes which are not addressed above? *

- Yes
- No
- Uncertain

Please explain: *

Future work

33. In inviting WIPO to cooperate with HCCH on this questionnaire, the governing body of the HCCH recognized the need for further work on the intersection of private international law and IP (Conclusions and Decisions of HCCH Council on General Affairs and Policy 2020).

Please share any observations or suggestions that you may have on possible future activities by HCCH and WIPO in relation to the PIL and IP interface, such as greater awareness raising and educational initiatives, enhanced judicial cooperation or coordination, or continued discussion within the HCCH Jurisdiction Project.

Thank You!

Thank you for taking our survey. Your response is very important to us.
