

Council on General Affairs and Policy – March 2020

Document	Preliminary Document <input checked="" type="checkbox"/> Information Document <input type="checkbox"/>	Prel. Doc. 3 of December 2019
Title	Future work on the intersection between private international law and intellectual property	
Author	Permanent Bureau	
Agenda item	Item III-5	
Mandate(s)	Mandate of Commission II on General Affairs and Policy of the Twenty-Second Session	
Objective	To present the outcome of the discussions that took place at Commission I on Judgments of the Twenty-Second Session and the mandate of Commission II on General Affairs and Policy To invite CGAP to decide on possible future work on the intersection of private international law and intellectual property after the Twenty-Second Session	
Action to be taken	For Approval <input type="checkbox"/> For Decision <input checked="" type="checkbox"/> For Information <input type="checkbox"/>	
Annex	Annex I: Working Proposal No 1 REV from the Chair of Commission II on General Affairs and Policy	
Related documents		

I. Introduction

1. The *Convention of 2 July 2019 on the Recognition and Enforcement of Foreign Judgments in Civil or Commercial Matters* (hereinafter, 2019 Judgments Convention) was successfully adopted on 2 July 2019, during the Twenty-Second Session (hereinafter, DS) of the HCCH. Following the preparatory Special Commission meetings, the treatment of intellectual property-related judgments was discussed at Commission I of the DS. The issue was whether such judgments should be included or excluded from the scope of the Convention, and 1) if they are to be included, how provisions in relation to the circulation of such judgments and appropriate safeguards should be crafted, or 2) if they are to be excluded, how such an exclusion should be framed.

2. Notwithstanding the diverse positions that were expressed in the Plenary, consensus was finally reached that the Convention would *not* apply to intellectual property, and that such exclusion be framed as “intellectual property”. It was also agreed that further explanation of the treatment of intellectual property-related judgments would be provided in the Explanatory Report to the 2019 Judgments Convention. The relevant provision of the Convention reads as follows:

“Article 2 – Exclusions from scope

1. This Convention shall not apply to the following matters –
[...]
(m) intellectual property; [...].”

3. Given that extensive work had been done over the past years in this field, some delegations, including those which had not been in favour of inclusion or partial inclusion of intellectual property-related judgments, expressed the interest or desire in preserving such work, and to explore whether such judgments could be dealt with by other means in the future.¹

4. In this respect, the Secretary General, in consultation with the Chair of the DS, reminded the participants of the DS of the Rules of Procedure (Art. 5(a)(1)(c)) and past practice of the HCCH, under which the Council on General Affairs and Policy (hereinafter, CGAP) may sit during a DS as Commission on General Affairs and Policy in order to determine subsequent steps of certain topics and to add a matter to the Work Programme of the HCCH. He also observed that delegations at the DS may not have been mandated to take a position on future HCCH work and that the Permanent Bureau (hereinafter, PB) would also need to reassess its Work Programme taking into account available resources and priorities of other projects.² On this basis, the Secretary General recommended the convening of Commission II on General Affairs and Policy, stressing that any decision or recommendation of this Commission be reflected in the Final Act of the DS and that CGAP could deliberate further on this issue at its meeting in March 2020.³

5. Commission II then met during the DS under the chairmanship of Mr Andrew Walter (Chair of CGAP). Different approaches on what recommendation should be made to CGAP were discussed by Members: for example, the creation of a separate protocol to the Judgments Convention on intellectual property;⁴ or continuation of work, in collaboration with the World Intellectual Property Organization (hereinafter, WIPO) and/or through an Experts' Group.⁵ Some Members also suggested that no concrete approach be referred to CGAP, but rather simply inform CGAP of the ongoing

¹ Minutes of the Twenty-Second Session on Recognition and Enforcement of Foreign Judgments (18 June – 2 July 2019), Minutes No 7 of Commission I on Judgments, para. 82 (available on the Secure Portal of the HCCH website < www.hcch.net >).

² *Ibid.*, para. 87.

³ *Ibid.*, para. 88.

⁴ *Ibid.*, paras 70 and 85.

⁵ *Ibid.*, para. 79; Minutes No 1 of Commission II on General Affairs and Policy, para. 16.

discussions and invite CGAP to make decisions at its meeting in 2020, since it was acknowledged that discussions on another mechanism on intellectual property went beyond the existing mandate to negotiate the Convention.⁶ It was also pointed out that taking up such projects would have resource implications for the PB, and this should not interfere with other projects, such as the Jurisdiction Project.⁷ Based on the deliberations, Commission II reached the decision to invite CGAP to consider at its 2020 meeting, “what, if any, further work it wishes the HCCH to undertake on the intersection between Private International Law and Intellectual Property” (see Annex I).

6. Against this backdrop, this document, in Section II, will provide a succinct description of the intellectual property discussions which took place during the past Special Commission meetings and the DS, and, in Section III, invites CGAP to decide on future work, if any, on the intersection between private international law and intellectual property.

II. Brief background of intellectual property discussions

7. The treatment of intellectual property-related judgments was discussed at all Special Commission meetings (with the exception of the fourth meeting). Views were diverse, ranging from a total exclusion, to partial inclusion (*e.g.*, only monetary claims of such judgments), to a total inclusion of such judgments. The same held true for the DS: different positions were expressed or reiterated before and during the Session.

8. In order to advance discussions on this topic throughout the Project, a great amount of work has been done by all stakeholders involved. The PB facilitated inter-sessional work on intellectual property-related matters in preparation for and during the meetings of the Special Commission⁸ and the DS.⁹ Documents had been prepared by the European Union (hereinafter, the EU), and also by the PB, on the operation of the Convention with regard to intellectual property rights, which were based on different earlier drafts of the Convention.¹⁰ Members have devoted many resources to this topic, by assigning experts to the meetings and discussions. Some intellectual property stakeholders were also actively involved: they followed the discussions, participated in inter-sessional work, and some of them submitted positions or consultation papers. In order to provide a full picture of the discussions on intellectual property matters, the PB has compiled all relevant documents throughout the negotiations and uploaded them onto the HCCH Secure Portal.¹¹

9. At the DS, consensus was finally reached on not including intellectual property in the Convention. It was agreed instead to invite CGAP to decide on whether the HCCH should continue the work in the intersection of intellectual property and private international law, and if so, in which form it should be carried out, considering the vast amount of substantive work, research and resources put into this topic by the HCCH.

⁶ *Ibid.*, Minutes No 1 of Commission II on General Affairs and Policy, paras 3 and 8-9.

⁷ *Ibid.*, para. 15.

⁸ “Report on Intersessional Work on Intellectual Property Related Matters”, prepared by the PB, Info. Doc. No 6 of January 2017 for the attention of the Second Meeting of the Special Commission of February 2017 on the Recognition and Enforcement of Foreign Judgments (16-24 February 2017), available on the Secure Portal of the HCCH website < www.hcch.net >; “Treatment of Intellectual Property-Related Judgments under the November 2017 draft Convention”, Background document of May 2018, available on the HCCH website < www.hcch.net > under “Judgments” then “Preparatory work” then “Meetings of the Special Commission” and “May 2018 Special Commission documentation” (this document is also documented as Info. Doc. No 1 of May 2018).

⁹ “Report of Informal Working Group I – Intellectual Property Rights”, prepared by Professor T. M. Yeo, chair of informal working group I, with the assistance of the PB, Prel. Doc. No 10 of April 2019 for the attention of the Twenty-Second Session on Recognition and Enforcement of Foreign Judgments (18 June – 2 July 2019) (available on the Secure Portal of the HCCH website < www.hcch.net >).

¹⁰ “Discussion Document from the European Union on the operation of the future Hague Judgments Convention with regard to Intellectual Property Rights”, prepared by the European Union, Info. Doc. No 10 Revised of December 2017; Info. Doc. No 1 of May 2018, both documents available on the HCCH website < www.hcch.net > (see path indicated *supra* note 8).

¹¹ Available on the Secure Portal of the HCCH website < www.hcch.net >.

III. Suggested options for CGAP decision

10. Based on the foregoing, the PB invites CGAP to decide what further work, if any, it wishes the HCCH to undertake on the intersection between private international law and intellectual property, building upon the related HCCH *acquis*. Should CGAP decide on pursuing further work in this regard, it may wish to consider the establishment of an Experts' Group on IP and PIL (hereinafter, EG). The EG would be tasked to assess possible future work on jurisdiction, applicable law, and recognition and enforcement, including possible cooperation schemes, in the context of cross-border intellectual property litigation. A broad mandate would enable the EG to take a holistic approach in assessing the intersection between private international law and intellectual property. While the EG's work would of course consider, and build on, existing instruments, the possible outcome would remain open. If the EG were to confirm the desirability and feasibility of further legislative action in any (or all) of the private international law areas, the outcome could take the form of a self-standing instrument or, for example, a Protocol to the 2019 Judgments Convention. The EG's work would be complementary to that of the Experts' Group on Jurisdiction, subject to CGAP deliberations in that regard. The EG on IP and PIL would update CGAP as its work progresses.

11. If further work is to be mandated by CGAP, the PB would likewise seek deliberations on the need to conduct such work in close collaboration with WIPO. With a view to exploring the prospects for future co-operation, the PB has informally consulted the Secretariat of WIPO, which welcomes the opportunity for such collaboration, aimed at facilitating international discussions in this complex area, with the broader participation of intellectual property stakeholders. If further work is mandated by CGAP, the PB strongly suggests that the EG be established jointly with WIPO.

ANNEX

COMMISSION II

General Affairs and Policy

TWENTY-SECOND SESSION

(18 June – 2 July 2019)



Distribution: 1 July 2019

**Working proposal No 1 REV from the Chair of
the Commission on General Affairs and Policy**

B – The following decisions and considerations -

The Twenty-Second Session,

...

3. Invites the Council on General Affairs and Policy to consider, at its 2020 meeting, what, if any, further work it wishes the HCCH to undertake on the intersection between Private International Law and Intellectual Property.

B – Les décisions et considérations suivantes :

La Vingt-deuxième session,

...

3. Invite le Conseil sur les affaires générales et la politique à examiner, lors de sa réunion de 2020, s'il souhaite, le cas échéant, que la HCCH entreprenne davantage de travaux sur l'intersection entre le droit international privé et la propriété intellectuelle.