



Australia Group's response to Questionnaire HCCH Judgments Project

Note: In view of the short time frame for response, this response reflects the preliminary views of the Australian group, on the basis of the work of a subset of the Australia Group's committee. The Australia Group may refine its position pending further developments in the drafting and its own further study and consideration of the issues.

1) Relating to Article 2(1)(l) of the Draft Convention:

“This Convention shall not apply to the following matters - ... [(l) intellectual property rights [, except for copyright and related rights and registered and unregistered trademarks]].”

a) Should any intellectual property rights be included in the scope of the Convention? Please explain.

Yes. Intellectual property rights, including but not limited to copyright and related rights and registered and unregistered trade marks, should be included in the scope of the Convention. There is no basis for distinguishing between these and other types of intellectual property rights. Nor should intellectual property rights be excluded, since exclusion would diminish the value of these rights.

b) If you answered YES to question 1a, do you think certain intellectual property rights should nevertheless be excluded? If so, which? Please explain.

No, the Australian group does not consider that any other intellectual property rights should be excluded.

2) Relating to Article 12 of the Draft Convention:

“A judgment granting a remedy other than monetary damages in intellectual property matters shall not be enforced under this Convention.”

a) Should the Convention only cover judgments exclusively granting a remedy consisting of monetary damages? Please explain.

No. For example, if an award of an account of profits is made, the judgment should be covered.

In addition, other orders should be enforced where it is necessary to do so (for example, an order that intellectual property rights should be transferred by reason of a finding of lack of entitlement).

b) Should the Convention cover judgments which grant, amongst other remedies, a remedy consisting of monetary damages? If so, please explain



and specify whether the Convention should in these cases only cover the remedies in a judgment granting monetary damages or the whole judgment including non-monetary damages.

Yes. The Convention should cover judgments including monetary damages and other remedies. All remedies in the judgment should be enforced.

3) Relating to Article 5(1)(k) and (m) of the Draft Convention:

“A judgment is eligible for recognition and enforcement if one of the following requirements is met – ... (k) the judgment ruled on an infringement of a patent, trademark, industrial design, plant breeder’s right, or similar right required to be granted or registered and it was given by a court in the State of origin in which the grant or registration of the right concerned has taken place, or is deemed to have taken place under the terms of an international or regional instrument[, unless the defendant has not acted in that State to initiate or further the infringement, or their activity cannot reasonably be seen as having been targeted at that State]; ... (m) the judgment ruled on an infringement of copyright or related rights, [or use-based trademarks, trade names, or unregistered designs] [or other intellectual property rights not required to be registered] and the right is governed by the law of the State of origin, [unless the defendant has not acted in that State to initiate or further the infringement, or their activity cannot reasonably be seen as having targeted at that State];”

Should a judgment that ruled on the infringement of an intellectual property right only be eligible for recognition and enforcement if given by a court of a contracting state the law of which governs the right concerned (i.e. the country where the right is registered etc.)? Please explain.

Yes. Only the state the law of which governs the intellectual property rights concerned should rule on the infringement of those rights, given the differences between the intellectual property laws of different jurisdictions.

4) Relating to Article 5(1)(l) of the Draft Convention:

“A judgment is eligible for recognition and enforcement if one of the following requirements is met – ... (l) the judgment ruled on the ownership or subsistence of copyright or related rights, [or use-based trademarks, trade names, or unregistered designs] [or other intellectual property rights not required to be registered] and the right is governed by the law of the State of origin;”

Should a judgment that ruled on the ownership of an intellectual property right only be eligible for recognition and enforcement if given by a court of a contracting state the law of which governs the right concerned (i.e. the country where the right is registered etc.)? Please explain.

Yes. Only the state the law of which governs the intellectual property rights concerned should rule on the ownership of those rights, given the differences between the intellectual property laws of different jurisdictions.



5) Relating to Article 6(a) of the Draft Convention, which is an exception to Article 5:

“Notwithstanding Article 5 – (a) a judgment that ruled on the registration or validity of a patent, trademark, industrial design, plant breeder’s right, or similar right required to be granted or registered shall be recognised and enforced if and only if the State of origin is the State in which grant or registration has been applied for, has taken place, or is deemed to have been applied for or to have taken place under the terms of an international or regional instrument;”

Relating to Articles 6(a) and 8(3) of the Draft Convention:

Article 8(3): “However, in the case of a ruling on the validity of a right referred to in Article 6, paragraph (a), recognition or enforcement of a judgment may be postponed, or refused under the preceding paragraph, only where – (a) that ruling is inconsistent with a judgment or a decision of a competent authority on that matter given in the State referred to in Article 6, paragraph (a); or (b) proceedings concerning the validity of that right are pending in that State.”

Should a judgment that ruled on the registration or validity of an intellectual property right only be eligible for recognition and enforcement if given by a court of a contracting state the law of which governs the right concerned (i.e. the country where the right is registered etc.)? Please explain.

Yes. Only the state the law of which governs the intellectual property rights concerned should rule on the registration or validity of those rights, given the differences between the intellectual property laws of different jurisdictions.

6) Relating to Article 7(1)(g) of the Draft Convention:

“Recognition or enforcement may be refused if – (g) the judgment ruled on an infringement of an intellectual property right, applying to that right a law other than the law governing that right.”

Should the application of a law other than the law governing a particular intellectual property right, be a ground for refusal for recognition or enforcement? Please explain.

Yes. Only the state the law of which governs the intellectual property rights concerned should be applied in determining infringement of the intellectual property rights, given the differences between the intellectual property laws of different jurisdictions.

7) Should, for a judgment to be eligible for recognition and enforcement, all appeal options in relation to the judgment have been exhausted? Please explain.

Yes. Judgments should only be enforced at the point when all appeal options have been exhausted.

8) Do you have any other comments?

No.

Australian Group

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