

# **Jurisdiction in Internet-related intellectual property disputes**

Edouard Treppoz, Professor at the  
University Jean Moulin Lyon 3,  
Director of the Centre Paul Roubier

# Introduction

Why has jurisdiction in Internet-related IP disputes evolved into a major issue?

- Multiple infringers.
- Countless possible localization for a cyber-infringement.

# Introduction

How to determine jurisdiction?

- By limiting the influence of the principle of territoriality.
- By taking into account procedural and substantial values.

# For a limited influence of the principle of territoriality

No clear definition of the principle of territoriality.

The principle of territoriality is linked to the condition of registration.

# For a limited influence of the principle of territoriality

## Impacts of the principle of territoriality

Validity issue raised as a defence

Article 24 REGULATION (EU) No 1215/2012

The following courts of a Member State shall have exclusive jurisdiction, regardless of the domicile of the parties:

(4) in proceedings concerned with the registration or validity of patents, trade marks, designs, or other similar rights required to be deposited or registered, irrespective of **whether the issue is raised by way of an action or as a defence**, the courts of the Member State in which the deposit or registration has been applied for, has taken place or is under the terms of an instrument of the Union or an international convention deemed to have taken place.

// *Vanity Fair Mills, Inc v. T. Eaton*, LTD 234 F.2d 633 (2d Cir.)

# For a limited influence of the principle of territoriality

## **Impacts of the principle of territoriality**

Localization of the cyber infringement

- Bundle of local infringement v. one transnational infringement.
- The ECJ refusal to offer a *forum actoris* for IP rights

# For a limited influence of the principle of territoriality

## **Impacts of the principle of territoriality**

EU refusal of forum actoris for IP

C-523/10 Wintersteiger (2012)

C-441/13 Hejduk (2015)

*Contra* Penguin Group (USA) Inc. V. America  
Buddha, 16 NY3d 295 (NY 2011)

# For a limited influence of the principle of territoriality

Why the impact should be limited?

- distinction between *inter partes* effect and *erga omnes* effect.
- criticism of the hybrid approach of th ECJ.



# Values determining IP Jurisdiction

Jurisdiction values : minimum point of contacts, foreseeability, predictability.

Consequences: exclusion of the place of the server, exclusion of the accessibility approach, what about the *forum actoris*?

# Values determining IP Jurisdiction

## Substantial values

### Article 41 of the TRIPS

**1.** Members shall ensure that enforcement procedures as specified in this Part are available under their law so as to permit effective action against any act of infringement of intellectual property rights covered by this Agreement, including expeditious remedies to prevent infringements and remedies which constitute a deterrent to further infringements. These procedures shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.

**2.** Procedures concerning the enforcement of intellectual property rights shall be fair and equitable. They shall not be unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delays.

# Values determining jurisdiction

Consequence

*Forum actoris* appears as coherent solution, which mirrors local IP values.