



 **WIPO and
Private International Law**

Conference on Jurisdiction & Dispute
Resolution in the Internet Era
University of Geneva

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Eun-Joo MIN, Building Respect for IP Division

Coping with relationships involving foreign elements

- Reliance on private international law
- Substantive harmonization (IP approach)
- Combination of various approaches

How does the international IP system address transnational matters?

- “PIL Approach”

- Lex loci protectionis – “the laws of the country where the protection is claimed”
 - Berne Art 5(2), Rome Art 7, Beijing Art 5

How does the international IP system address transnational matters?

- “IP Approach”

- Harmonization of national laws – minimum standards

- Territoriality / Rule of independence
 - Paris Art 4*bis*, Art 6, Berne Art 5

- National treatment
 - Paris Art 2(1), Berne Art 5(1)

- Right of priority / Country of origin
 - Paris Art 4, Berne Art 5

How does the international IP system address transnational matters?

- “IP Approach”

■ Substantive norms

- Use of mark on the Internet / commercial effect (JR on Marks on the Internet)
- Uniform Domain Name Dispute Resolution Policy

■ Facilitation of multi-territorial protection

- PCT, Madrid, Hague, Lisbon

■ Alternative dispute resolution

- WIPO arbitration, mediation, expert determination
- WIPO domain name dispute resolution services

WIPO Tool: National Approaches to Private International Law Issues in Online IP Infringement Disputes with Cross-Border Elements

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WIPO-ILA Seminar on Intellectual Property and Private International Law - January 2015

Analysis of National Approaches to PIL
Issues in Cross-border Online IP
Infringement Disputes

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Facts: Cross-border elements

CBE Type	Cross-border Element	Occurrence
Action location	Act of infringement is outside jurisdiction	49
Party location	At least one of parties is outside jurisdiction	48
IPR location	Infringed IPR is outside jurisdiction	7
Damage location	Infringement caused damage outside jurisdiction	4

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PIL Issues: Considerations re Online Aspect

- Online aspect: placing TM or copyright material on foreign website makes it accessible locally
- PIL issue: whether court has jurisdiction where D acted outside country
- Relevant question: is there infringement locally?
- Two general approaches to answer:
 - mere accessibility locally is not sufficient – some targeting is required
 - generally re online marketing using TM
 - mere accessibility locally is sufficient
 - often re online distribution of copyright material



Concluding Observations

- Online infringement = “ubiquitous” infringement
 - potential for either:
 - multiple actions in multiple countries; or
 - single action seeking multi-country relief
 - PIL concern: develop special principles re jurisdiction and applicable law?
- In practice
 - generally:
 - no multiple actions in multiple countries
 - no single action seeking multi-country relief
 - IP law concern: develop consistency on when foreign action = local infringement?



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