



# HCCH Work in relation to the Enforcement of IP Rights

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# Outline



- Hague Conference on Private International Law (HCCH)
- Private international law (PIL) and IP law
- HCCH work in relation to enforcement of IP rights
- Co-operation and joint initiatives





# What is the HCCH?

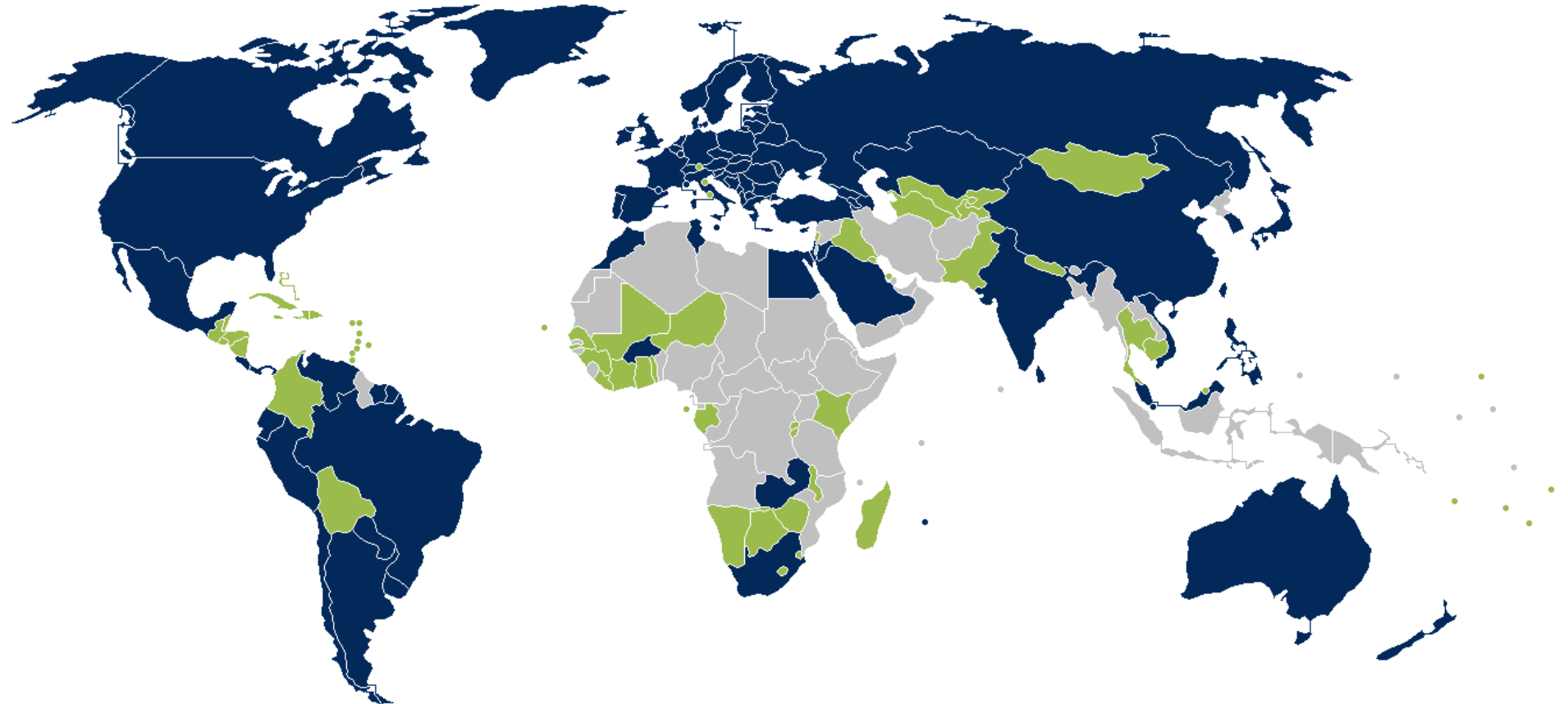


- An **intergovernmental organisation** with a **legislative function**, dating from **1893**
- Works towards the “**progressive unification of the rules of private international law**”
- Develops and adopts **Hague Conventions and Protocols** (currently **38 + 1 soft law instrument**), dealing with:
  - (1) *Int’l Legal Co-operation & Litigation*
  - (2) *Int’l Commercial Law & Finance Law*
  - (3) *Int’l Family Law & Child Protection*

# 150 States “Connected” with HCCH



A “Connected” State is either a Member State (incl. candidate and admitted States)  
or a Contracting State to one or more of the Hague Conventions



■ Member State “Connected” State

■ Non-Member “Connected” State

# PIL in the context of IP



JURISDICTION

APPLICABLE LAW

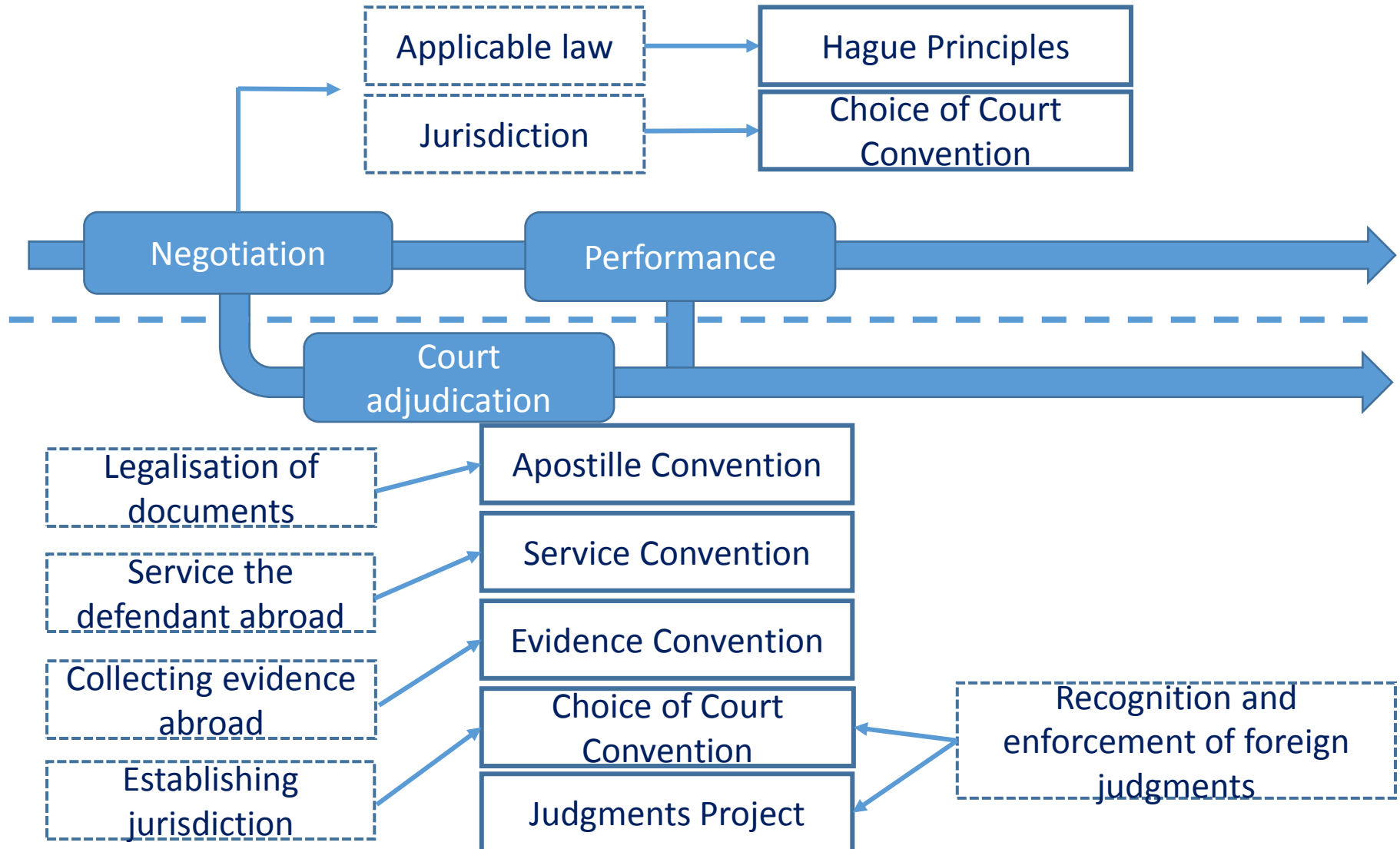
RECOGNITION &  
ENFORCEMENT

LEGAL CO-OPERATION

PIL issues are involved both **before** and **after** disputes on IP arise.



# HCCH work relating to IP

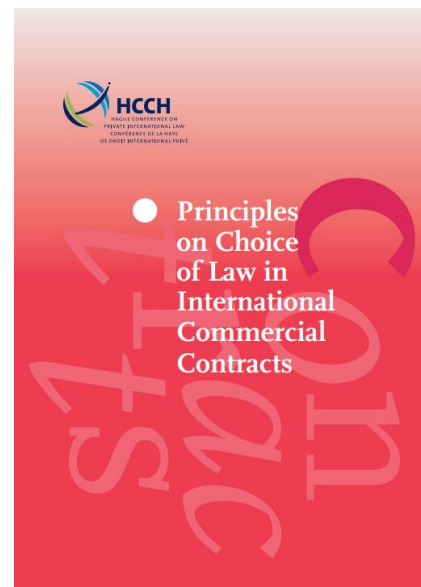


# The Hague Principles

*Principles on Choice of Law in International Commercial Contracts*



- Approved on 19 March 2015
- First HCCH soft law instrument
- Include international contracts concerning IP rights
- Affirm party autonomy in international commercial contracts, giving the parties' chosen law the widest scope of application, but subject to balanced boundaries
- Strengthen legal certainty and predictability
- May be considered an international code of current best practice in relation to party autonomy in international commercial contracts
- Endorsed by UNCITRAL and the International Chamber of Commerce, implemented by Paraguay



# The Apostille Convention

*Hague Convention of 5 October 1961*

*Abolishing the Requirement of Legalisation for Foreign Public Documents*



- Replaces legalisation with a **simple, one-step procedure** (*does not* create a requirement for Apostille where there is a simpler method available)
- **114 Contracting Parties** (most widely ratified/acceded to Hague Convention)
- One **single, universal system** – instead of 6,441 bilateral treaties...
- Used **several millions** of times every year – Direct impact on people's lives / commercial operators' transactions
- Strongly supported by a number of international organisations, such as the **World Bank Group (IFC)**, **International Chamber of Commerce**, and **APEC**
- Facilitates cross-border **trade, commerce, and investment**
- **Alleviates pressure** on consular officials





# The Apostille Convention (cont'd)



- Scope: covering only “public documents”, including
  - Grants of patents or other IP rights
  - Extracts from IP registers
  - Grants of license
- Excluding:
  - Administrative documents dealing directly with commercial or customs operations
  - Assignment contracts (documents created in a private capacity)

Note: Patents/trademarks issued by the **EPO** and **EUIPO** are not directly addressed under the Convention.

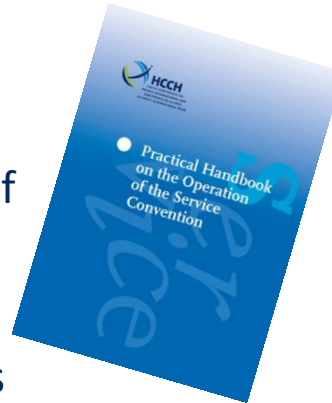
(A HCCH Working Group will meet on 1 December 2017 in The Hague to discuss the applicability of the Convention to such documents.)

# The Service Convention & the Evidence Convention



*Hague Convention of 15 November 1965 on the Service Abroad of Judicial and Extrajudicial Documents in Civil or Commercial Matters*


- 73 Contracting States
- Simplified and expedited methods of transmission of documents for service
- 1 Convention instead of... 2,628 bilateral agreements
- Over 40,000 applications a year – 75% executed in less than 2 months (some within 48 hours!)



*Hague Convention of 18 March 1970 on the Taking of Evidence Abroad in Civil or Commercial Matters*

- 61 Contracting States
- Means to overcome differences between legal systems with respect to the taking of evidence
- 1 Convention instead of... 1,830 bilateral agreements
- Approx 5,000 applications a year – 55% executed in less than 4 months



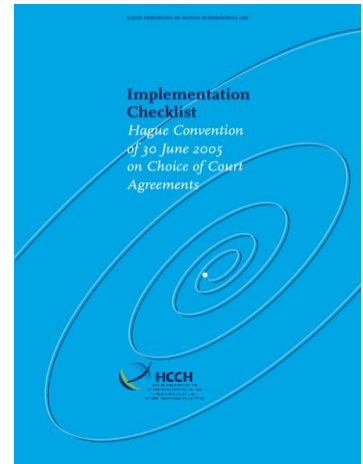
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- Alleviates pressure on consular officials
  - Contribute to international standards of legal co-operation

# The Choice of Court Convention

*Hague Convention of 30 June 2005 on Choice of Court Agreements*



- Provides **legal certainty and predictability** in international commercial transactions, and allows for effective planning of possible litigation (alleviates the risk of parallel proceedings and conflicting judgments)
- Chosen court **must** hear the dispute – **no other court** in a Contracting State may hear the dispute – **judgment of the chosen court is recognised and enforced** in the other Contracting States
- Entered into force between the EU (excl. Denmark) and Mexico on 1 October 2015, Singapore ratified in June 2016
- 29 States and 1 REIO (EU) bound by the Convention
- Offers real alternative to arbitration



# The Choice of Court Convention and IP Rights



The Convention distinguishes between:

## Copyright and related rights

**completely covered** by the Convention  
– this applies even to questions of validity, but only as between the parties, not *in rem*

(because the judgment is enforceable under the Convention only as against persons bound by the choice of court agreement)

## Other IP rights (patents, trademarks and designs)

### validity:

- if raised as an object of proceedings, **excluded** (because generally the State under the law of which the right was created claims exclusive jurisdiction, and party autonomy is not admitted)
- if raised as a preliminary question, **included** (the preliminary ruling on validity of patents, however, will not be given any effect under the Convention in other Contracting States)

### infringement: **excluded**

(except when they are brought (or could have been brought) pursuant to a contract (scope of license/payment of royalties))

# The Judgments Project



## Objectives

- To develop a commonly accepted international standard on **the recognition and enforcement** of foreign judgments
- To enhance foreseeability of international litigation to improve **access to justice**, including in cross-border dealings
- To provide more legal certainty, which **facilitates cross-border trade and investment**

## Status

- At the stage of States level negotiation: **two** Special Commissions have been convened;
- **3<sup>rd</sup> meeting** will take place in November 2017, to continue its work on the February 2017 draft Convention, **including IP**;
- Possible Diplomatic Session in **late 2018** for the adoption of the Convention.
- Current text deals with the treatment of IP judgments and upholds IP **“territoriality”** principle.

# Co-operation with IP stakeholders



- The HCCH works in close co-operation with WIPO and other IP stakeholders
- The HCCH welcomes further joint initiatives for the benefit of better IP enforcement

Thank you!

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[www.hcch.net](http://www.hcch.net)