



A I P P I

**ASSOCIATION INTERNATIONALE
POUR LA PROTECTION DE LA PROPRIETE INTELLECTUELLE**

**INTERNATIONAL ASSOCIATION
FOR THE PROTECTION OF INTELLECTUAL PROPERTY**

**INTERNATIONALE VEREINIGUNG
FÜR DEN SCHUTZ DES GEISTIGEN EIGENTUMS**

ExCo

Berlin, Germany

September 24 to 29, 2005

Report

Special Committee Q153

**Hague Conference on Private International Law
Conférence de La Haye de droit international privé
Haager Konferenz betreffend internationales
Privatrecht**

Report Q153

Hague Conference on Private International Law

by Constant J.J.C. VAN NISPEN (The Netherlands)

- 1) In our previous Report of 17 May 2004, we already mentioned that The Hague Conference on Private International Law had abandoned the ambition to produce a wide-ranging convention on jurisdiction, recognition and enforcement of foreign judgments in civil and commercial matters. Instead, it was examining the possibilities to draft a convention with a much more limited scope, beginning with choice of court agreements for commercial transactions ("B2B"); after having completed that, other themes could be added later as "building blocks". We noticed that this approach – as far as Intellectual Property is concerned – is in conformity with the AIPPI Resolution Q153 of 30 March 2001 (Melbourne).
- 2) Our Committee had a meeting during the Geneva Congress on 22 June 2004. We were of the opinion that the Convention had lost much of its importance by restricting its scope to disputes arising from (non-consumer) contracts with exclusive choice of court provisions. The problem how the validity of foreign patents and trademarks should be handled in the context of infringement proceedings was no longer an issue. The Committee decided to monitor the further developments, especially what would happen during the Diplomatic Conference in The Hague in 2005.
- 3) During that conference, which took place from June 14–30, 2005, the final text of the new convention was adopted by The Hague Conference on Private International Law. The convention is now called: "Convention on Choice of Court Agreements", which title reflects its substantially narrowed scope. The text can be found on the website of The Hague Conference: www.hcch.net.
- 4) Of course, this convention – after ratification by a number of countries – would have a certain impact on the IP field for disputes arising from contracts containing exclusive choice of court provisions like license agreements, assignments of right etc. The Convention should guarantee IP right holders that these provisions will be respected by courts of all countries which are party to the convention.
- 5) Article 2(2)(n) and (o) read:
This Convention shall not apply to the following matters:
(...)
(n) the validity of Intellectual Property rights other than copyright or related rights;
(o) infringement of Intellectual Property rights other than copyrights or related rights, except where infringement proceedings are brought for breach of contract between the parties relating to such rights, or could have been brought for breach of that contract.

However, according to Article 2(3), proceedings are not excluded from the scope of the Convention where a matter excluded under paragraph 2 arises merely as a preliminary question and not as an object of the proceedings. Think of an invalidity issue arising by way of defence in an action for paying royalties.

- 6) It is the official viewpoint of The Hague Conference on Private International Law that now other themes than choice of court agreements could be added as “building blocks” for what would finally result in a convention on jurisdiction, recognition and enforcement of foreign judgments in civil and commercial matters.

It is, however, highly improbable that IP matters will form the object of such a building block in the near or even more remote future.

The circle of conflict of law scholars is now well aware that IP rights form a very complex subject and much more scientific exploration of the interface of Intellectual Property and the law of conflicts is needed before legislation could be envisaged; apart from all political issues at stake.

We therefore are of the opinion that Special Committee Q153 could be dissolved.