

Council on General Affairs and Policy of the Conference – March 2017

Document	Preliminary Document ☒ Procedural Document ☐ Information Document ☐	No 7 of January 2017
Title	The Development of a Resource Tool Addressing the Intersection Between Private International Law and Intellectual Property Law	
Author	Permanent Bureau	
Agenda item	Item IV.8.c.	
Mandate(s)	C&R No 24 of the 2016 Council on General Affairs and Policy	
Objective	To report on progress made on the development of a Resource Tool addressing the intersection between private international law and intellectual property law To suggest further steps leading to the finalisation of the project.	
Action to be taken	For Approval ☒ For Decision ☐ For Information ☐	
Annexes	n.a.	
Related documents	n.a.	

A. Introduction

1. At its March 2016 meeting, Council directed the Permanent Bureau to assist the World Intellectual Property Organization (WIPO) in developing a resource tool addressing the intersection between private international law and intellectual property law (Resource Tool).¹ The purpose of this document is to inform Council of progress made so far and to seek instructions from Council with regard to further work.

B. Progress to date

2. In 2016, WIPO approached HCCH to discuss the increasing need for more accessible and easily-understandable resources on private international law issues relating to intellectual property (IP). More specifically, it identified the need for experts who are specialised in one of these fields with limited knowledge of the other to have a Resource Tool which would provide an accurate and reliable overview of how these two fields of laws intertwine. It was agreed that a practical guide that is user-friendly and written in plain language would be useful for judges and other legal stakeholders.

3. The Resource Tool is thus set to be an introductory non-normative text of approximately 22,000 words (maximum 50 pages). It is intended to cover internationally and regionally binding instruments and soft-law initiatives dealing with the intersection between private international law and IP, as well as selected references to national laws and cases.

4. The Permanent Bureau and the WIPO Secretariat undertook a search for suitable candidates to co-author the Resource Tool. Judges being the main end-users of the envisaged publication, the objective was to identify two (former) judges from different legal traditions and geographical backgrounds who are specialised in adjudicating IP disputes and have sufficient knowledge and experience in private international law.

5. Based on a list of possible candidates prepared by the Permanent Bureau and the WIPO Secretariat, two final candidates were offered the possibility of contributing to this project, and they expressed great interest for it.

6. The two experts who have been retained to co-draft the Resource Tool (Co-Authors) are:

- The Honourable Dr Annabelle Bennett (Australia) – the Honourable Dr Bennett is Chancellor of Bond University, Arbitrator on the Court of Arbitration for Sport and a Member of the Advisory Board of the Faculty of Law at The Chinese University of Hong Kong. She is a former Judge of the Federal Court of Australia, additional judge of the Supreme Court of the Australian Capital Territory and previously Senior Counsel specialising in intellectual property;
- Judge Samuel Granata (Belgium) – Judge Granata is a Judge at the Court of Appeal of Antwerp and an external member of the Enlarged Board of Appeal of the European Patent Office, as well as a member of the Legal Framework Group Unified Patent Court. He was previously an active IP lawyer, mediator and university assistant.

7. While the initial contacts with the Co-Authors were being established, the Permanent Bureau and the WIPO Secretariat prepared a list of tentative issues to be addressed in the Resource Tool. There is consensus that the Resource Tool will provide basic information on relevant instruments and case law, on issues such as:

- the interaction between private international law and intellectual property law;
- the legal sources (at international, regional and national levels, including binding and soft law initiatives);
- which court is competent to decide the dispute in question;
- which law applies;

¹ See “Conclusions and Recommendations of the Council on General Affairs and Policy of the Conference (15-17 March 2016)”, C&R No 24.

- how a judgment on IP may be recognised and enforced in other States;
- other related issues, *e.g.*, co-operation and co-ordination among courts.

8. Next, the issues, structure and format of the Resource Tool were mapped out in a flowchart. This document also serves as a basis for the division of tasks between the Co-Authors. Where necessary, the Permanent Bureau and the WIPO Secretariat will provide assistance to the Co-Authors, and take up initial drafting responsibilities for the issues that fall under the work span of the respective organisations. While the documents developed so far (such as the list of tentative issues and flowchart) are work in progress, the Permanent Bureau will be pleased to share them with any interested Member and would welcome any feedback that Members would be in a position to provide at any stage of the project.

9. With regard to the timeline, the WIPO Secretariat targets the presentation of the Resource Tool at the 12th Session of its Advisory Committee on Enforcement, which is to be held from 4 to 6 September 2017. Given the advancement the project has made thus far, the Permanent Bureau is of the view that the deadline is ambitious, yet feasible thanks to the dedication and expertise of the Co-Authors. Against this background, Council is asked to consider which steps should lead to the finalisation of the Resource Tool (below, under C).

10. For the time being, the Permanent Bureau, the WIPO Secretariat and the Co-Authors have developed a tentative timeline for further work on the Resource Tool:

- the Co-Authors will submit a first draft by the end of February 2017 to the Permanent Bureau and the WIPO Secretariat;
- the Co-Authors will complete a second draft by the end of April 2017 incorporating feedback received;
- subject to the instructions received from Council, the Co-Authors, together with the Permanent Bureau and the WIPO Secretariat, will be ready to finalise an English version of the Resource Tool by the end of August 2017.

C. Suggested next steps

11. Council is respectfully requested to give directions for further work on the Resource Tool. Based on recent experiences with similar projects, the Permanent Bureau suggests that, upon completion of the second draft, the Resource Tool could be circulated to Members for comments. Any comments should be submitted in writing to the Permanent Bureau within two months after circulation. The Permanent Bureau, in co-ordination with the WIPO Secretariat and the Co-Authors, would then review those comments and finalise the Resource Tool accordingly. If necessary, and resources permitting, the Permanent Bureau, in co-ordination with the WIPO Secretariat, may convene an Experts' meeting to facilitate the input from Members' experts in the finalisation of the Resource Tool.

12. In line with the above, the Permanent Bureau invites Council to:

- approve the suggested directions for the finalisation of the Resource Tool, including, if necessary and subject to available resources, the organisation of an Experts' meeting to discuss input received from Members and finalise the Resource Tool accordingly.