

**Master Programme in European Intellectual Property Law
Spring Term 2010**

**Module 2b
Transborder IP Conflicts**

Introduction: In an environment characterised by globalized markets and limitless communication structures, it is no longer merely a theoretical possibility that the exercise as well as the infringement of IP rights assumes multistate or even global dimensions. This creates a need to focus more strongly than previously on the rules that indicate which courts are competent to exercise jurisdiction in transborder conflicts and which country's law is applicable to the determination of ownership, existence and scope of intellectual property rights, in contractual as well as non-contractual relationships. As the application of traditional principles, ensuing from the territoriality of IP rights, may raise intricate problems for courts having to deal with multistate infringements, a preferable way to solve conflicts with transborder impact could be to take resort to alternative schemes of dispute resolution, like international arbitration and mediation, including specifically developed dispute resolution policies, like the UDRP. Finally, with respect to the European Union, the merging of national markets and the development of harmonized or even unitary IP rights call for the development of a common judiciary, which has been under debate in the context of a possible Community Patent as well as in the framework of the European Patent Convention.

The course will address the following topics:

1. IP and Private International Law: General principles and the current legal framework
2. Arbitration and Mediation in IP conflicts, including the UDRP
3. A common European patent jurisdiction and the proposed Community patent
4. Perspectives for the Future – the ALI Principles, the Max Planck Project and other alternatives

The course is composed of lectures and a final seminar. Two individually written home assignments must be submitted. The primary purpose of these assignments is to assist the student in gaining a better understanding of the issues. The assignments may influence the student's grade to the extent that the student falls in between two grade categories. The examination consists of a written take home exam, and the presentation and discussion of the exam at the final seminar.

In charge of the course:

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Schedule:

Friday, May 7, 2010 (Room C487)

	Lecturer		
9-10	Introduction		LL
10-12	Practical experiences with cross border disputes		HB
13-16	Arbitration of IP Disputes		KS

Saturday, May 8, 2010 (Room D397)

	Lecturer		
10-12	Common European Patent Jurisdiction		SL
13-15	Cross-border IP Litigation: A U.S. Perspective		LL
15-17	Ownership disputes		LL

Saturday May 15, 2010 Deadline for first individual assignment

Saturday May 22, 2010 Deadline for second individual assignment

Friday May 21, 2010 (Room C487)

	Lecturer		
9-11	Goods in transit		LL
11-13	UDRP		KW
14-16	Border measures		AS

Saturday May 22, 2010 (Room D397)

	Lecturer		
8-10	CLIP and ALI Principles		BU
10-12	General Principles		PT
13-15	General Principles		PT
15-16	Contributory infringements		AK
16-17	Summation		AK
17	Distribution of home exam		

Saturday, May 29, 2010 Deadline for home exam

Friday **June 4, 2010** **(Room D397)**
9 -17 Final seminar and presentation of home exam

AK/LL

Lecturers:

Professor Annette Kur, Max Planck Institute (AK)
Lydia Lundstedt, LL.M, doctoral candidate, Stockholm University (LL)
Professor Dr Paul L.C. Torremans, University of Nottingham (PT)
Katarina Strömholm, Advokatfirman Lindahl, Stockholm (KS)
Stefan Luginbuehl, European Patent Office (SL)
Ann-Charlotte Söderlund, Advokatfirman Delphi, Stockholm (AS)
Knud Wallberg, Sandel, Løje & Wallberg, Copenhagen (KW)
Henrik Bengtsson, Advokatfirman Delphi, Stockholm (HB)
Benedetta Ubertazzi, IULM University, Milano (BD)

Individual Home Assignments:

1. It is a truism that intellectual property rights are territorial in nature. A logical consequence of this principle is that the law of the protecting country (*lex protectionis*) is applicable to determine the existence and scope of an intellectual property right. Discuss how this principle of the law of the protecting country is expressed or otherwise implied in the various IP conventions. Is this principle regulated in the national statutory law of your home country? If not, is this principle followed in the case law or doctrine?

2. Traditionally, it has been assumed that the territoriality principle implied in the international conventions limited the international jurisdiction of national courts. Specifically, the assumption has been that the jurisdiction of national courts was restricted to the adjudication of disputes concerning the infringement of domestic rights. What is the prevailing view today? Do the rules on international jurisdiction in your home country allow courts to exercise international jurisdiction over foreign rights? If you come from a EU (or Lugano state), discuss the situation both before and after the ECJ ruling in *GAT v. Luk*, and with respect to rights registered or protected in non-EU states.

The assignments should be about 2-3 pages long and should be equipped with references corresponding to established academic standards. The home assignments should be e-mailed directly to Annette and Lydia. The deadline for the first short assignment is Saturday, May 15th and deadline for the second short assignment is Saturday, May 22nd.

Home exam: The home exam will be distributed on Saturday, May 22nd. The submission deadline is Saturday, May 29th. The home exam should be no more than 5000 words per case and should be equipped with references corresponding to established academic standards. The home exam should be e-mailed directly to Annette and Lydia.

Final Seminar: During the final seminar, the students will be asked to work in groups to present the home exam and to discuss the other groups' presentations.

Materials:

Please review the following materials before each lecture:

Henrik Bengtsson's lecture on practical experiences:

Brussels I Regulation, the Rome II Regulation (both are in your compendium of IP statutory instruments), ECJ cases C-21/76, *Bier v. Mines de Potasse d'Alsace* and C-68/93, *Shevill v. Presse Alliance SA* (both can be found at http://curia.europa.eu/en/content/juris/c2_juris.htm), and WIPO's Joint Recommendation Concerning Provisions on the Protection of Marks and Other Industrial Property Rights in Signs, on the Internet (with Explanatory Notes), WIPO

Sept/Oct 2001, available at http://www.wipo.int/about-ip/en/development_iplaw/pub845-toc.htm#TopOfPage

Katarina Strömholm's lecture on arbitration of IP disputes:
New York Convention on Recognition and Enforcement of Foreign Arbitral Awards,
available at http://www.uncitral.org/uncitral/en/uncitral_texts/arbitration/NYConvention.html.
If possible, find out whether your country is a contracting party, and how the Convention has
been transposed into your national law.

Stefan Luginbuehl's lecture on Common European Patent Jurisdiction:

<http://register.consilium.europa.eu/pdf/en/09/st07/st07928.en09.pdf>

[http://documents.epo.org/projects/babylon/eponet.nsf/0/2577CA3C51E347CCC125768600441059/\\$File/conclusions_enhanced_patent_system_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/2577CA3C51E347CCC125768600441059/$File/conclusions_enhanced_patent_system_en.pdf)

<http://register.consilium.europa.eu/pdf/en/09/st16/st16113-ad01.en09.pdf>

<http://www.epo.org/patents/law/legislative-initiatives/epla.html>

Lydia Lundstedt's lecture on Cross-border IP Litigation: A U.S. Perspective:

Voda v. Cordis, 476 F.3d 887 (Fed. Cir. 2007),
<http://caselaw.lp.findlaw.com/data2/circs/fed/051238p.pdf> and
Steele v Bulova Watch Co, 344 U.S. 280 (1952),
<http://supreme.justia.com/us/344/280/case.html>

Lydia Lundstedt's lecture on ownership disputes:

EPC Protocol on Recognition, <http://www.epo.org/patents/law/legal-texts/html/epc/1973/e/ma4.html>

Knud Wallberg's lecture on the UDRP:

<http://www.wipo.int/amc/en/domains/index.html>

Lydia Lundstedt's lecture on goods in transit:

Nokia Corp. v. Her Majesty's Commissioners of Revenue & Customs, High Court of Justice,
Chan Div., July 27, 2009, which will be distributed to you

Ann-Charlotte Söderlund's lecture on border measures:

Council Regulation 1383/2003 concerning customs actions against goods suspected of
infringing certain intellectual property rights (included in your compendium of IP statutory
instruments)

Benedetta Ubertazzi's lecture on CLIP and the ALI principles: article by Kur and Ubertazzi,
The ALI Principles and the CLIP project: A Comparison, which will be distributed to you.

Paul Torremans's lecture: chapter 10 and 11 of his book, which will be distributed to you

Annette Kur's lecture on contributory infringement: article by Dinwoodie, Dreyfeus, & Kur, The Law Applicable to Secondary Liability in Intellectual Property Cases, which will be distributed to you.

Other legal texts not included in your compendium of IP statutory instruments:

1980 Rome Convention on the Law Applicable to Contractual Obligations,
[http://europa.eu.int/smartapi/cgi/sga_doc?smartapi!celexapi!prod!CELEXnumdoc&lg=EN&numdoc=41998A0126\(02\)&model=guichett](http://europa.eu.int/smartapi/cgi/sga_doc?smartapi!celexapi!prod!CELEXnumdoc&lg=EN&numdoc=41998A0126(02)&model=guichett)

Hague Convention on Choice of Court
http://www.hcch.net/index_en.php?act=conventions.text&cid=98