



STUDY ON SPECIALIZED INTELLECTUAL PROPERTY COURTS

A joint project between the International Intellectual Property Institute (IIP)
and the United States Patent and Trademark Office (USPTO)



INTERNATIONAL
INTELLECTUAL
PROPERTY
INSTITUTE



Study on Specialized Intellectual Property Courts

Assoc. Prof. Rohazar Wati Zuallcoblej

Lead Consultant, International Intellectual Property Institute

Hon. Jorge Amigo Castañeda

Ahmed J. Davis

Owen Dean

Hon. Michael Fysh QC, SC

Hon. Louis Harms

Prof. Dionysia Kallinikou

Hon. Ryoichi Mimura

Hon. Nicholas Ombija

Shinjiro Ono

Dr. Ana María Pacón

Kiat Poonsombudlert

Consultants, International Intellectual Property Institute

25 January 2012

Abstract

In this report, we study the effect of specialized intellectual property rights (IPR) courts on the adjudication of intellectual property (IP) -related disputes. We catalog the number and type of specialized IPR courts throughout the world, and assess the effectiveness of these courts in a series of ten case studies. The case studies were chosen to represent the various types of specialized IPR courts and to ensure geographic and economic diversity. These case studies analyze the impact of specialized IPR courts on producing consistent case outcomes in similar factual situations, the level of IPR expertise in the judiciary, and the conduct of commerce in IPR-dependent sectors. The results of these case studies suggest a positive correlation between specialized IPR courts and the efficient and effective resolution of IP cases. The case studies also reveal that factors internal and external to the court play a role in its success and that countries should consider these factors and their own limitations when establishing a specialized IPR court. We summarize the characteristics of the most successful regimes and provide effective practices recommendations for establishing or improving specialized IPR courts.

About the Report

This is a joint project between the International Intellectual Property Institute (IUPI) and the United States Patent and Trademark Office (USPTO).

The INTERNATIONAL INTELLECTUAL PROPERTY INSTITUTE (IUPI) is a not-for-profit 501(c)(3) corporation organized under the laws of the United States located in Washington, DC. As an international development organization and think tank, IUPI is dedicated to increasing awareness and understanding of the use of intellectual property as a tool for economic growth, particularly in developing countries. For more information about IUPI, visit <http://www.iipi.org>.

The UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO) is the U.S. Federal agency for granting U.S. patents and registering trademarks. The USPTO advises the President of the United States, the Secretary of Commerce, and U.S. Government agencies on intellectual property (IP) policy, protection, and enforcement; and promotes the stronger and more effective IP protection around the world. For more information about USPTO, visit <http://www.uspto.gov>.

Acknowledgments

The authors wish to express their deep appreciation to all those who contributed to this study and participated in the subsequent seminar. We wish to thank specifically Ben Picozzi who formatted and finalized the study, Rachel Wallace who contributed significantly to all aspects of the study and seminar, Salvador Behar who helped with the content of the study and arranged for participants in the seminar, Dr. Chryssoula Pentheroudakis who provided essential information on the courts of Europe, Cesar Parga who donated the expertise and facilities of the Organization of American States, and Shinjiro Ono who identified consultants and speakers. We wish also to thank Lester Hyman, a consultant to IUPI who was integral in the planning of the seminar, as well as IUPI interns and fellows who assisted with reference and research tasks, including Joanna Holguin, a graduate of the University of North Carolina Chapel Hill Law School who continued to participate on this study while working at the Mexican Embassy to the United States, Eric Robbins, a graduate of the Georgetown University Law School who along with Joanna researched and authored many of the brief country descriptions, and Chelsea Masters, a second-year at American University Law School who provided assistance with citations and editing.

TABLE OF CONTENTS

Table of Acronyms	ii
I. Introduction	1
A. Background and Purpose.....	1
B. Methodology	1
C. Categories	2
D. Key Findings.....	4
E. Effective Practices.....	8
F. Conclusion	10
II. Summaries by Country.....	11
A. Worldwide	11
B. Regional	13
1. Asia and Oceania.....	13
2. Europe.....	19
3. Middle East and North Africa.....	31
4. North America and South America and Caribbean	34
5. Sub-Saharan Africa.....	42
III. Case Studies	46
A. Andean Community	46
B. Greece.....	55
C. Japan	60
D. Kenya	66
E. Malaysia.....	83
F. Mexico	95
G. South Africa.....	104
H. Thailand.....	114
I. United Kingdom.....	121
J. United States.....	127
IV. Contributors.....	136

TABLE OF ACRONYMS

AC	Andean Community
ACTJ	Andean Community Tribunal of Justice
AIS	Andean Integration System
ARIPO	African Regional Intellectual Property Organization
CAN	Community of Andean Nations
CIP	Regional Specialized Court on Intellectual Property Matters (Mexico)
D.O.	Diario Oficial (Chile, Colombia, Costa Rica, Ecuador)
DOF	Diario Oficial de la Federación (Mexico)
ECSC	Eastern Caribbean Supreme Court
ECJ	European Court of Justice
EU	European Union
FCCN	Fundaçao Para a Computaçao Cientifica Nacional (Portugal)
FCTAA	Federal Court for Tax and Administrative Affairs (Mexico)
FSR	Fleet Street Reports
FTT	Federal Tax Tribunal
GATT	General Agreement on Trade and Tariffs
IEPI	Instituto Ecuatoriano de la Propiedad Intelectual
IMPI	Instituto Mexicano de la Propiedad Industrial
INAPI	Instituto Nacional de Propiedad Industrial (Chile)
Indautor	Instituto Nacional del Derecho de Autor (Mexico)
INDECOPPI	Instituto Nacional de Defensa de la Competencia y de la Protección de la Propiedad Intelectual (Peru)
INPI	Instituto Nacional da Propriedade Industrial (Portugal)
IP	Intellectual Property
IPA	Industrial Property Act (Kenya)
IPIT Court	Central Intellectual Property and International Trade Court (Thailand)
IPJ	Industrial Property Journal (Kenya)
IPO	Intellectual Property Office of Trinidad and Tabago
IPR	Intellectual Property Rights
IPT	Industrial Property Tribunal (Kenya)
JPO	Japanese Patent Office
JSC	Judicial Services Commission (South Africa)
KECOBO	Kenya Copyright Board
KEPHIS	Kenya Plant Health Inspectorate Services
KIPI	Kenya Industrial Property Institute
KLCC	Kuala Lumpur Convention Center
KPI	key performance indicator
LAFTA	Latin American Free Trade Association
NAFTA	North American Free Trade Agreement
OGCA	Official Gazette of the Catagena Agreement
PCT	Patent Cooperation Treaty
RNPC	Instituto dos Registros e Notariado (Portugal)
R.O.	Registro Oficial (Peru)
R.P.C.	Reports on Patent Cases
SCA	Supreme Court of Appeal
SENAPI	Servicio Nacional de Propiedad Intelectual (Colombia)
SIC	Superintendencia de Industria y Comercio (Colombia)
STAK	Seed and Trade Association of Kenya
SPVA	Seeds and Plant Varieties Act (Kenya)
TMA	Trademark Act (Kenya)
TRIPS	Agreement on the Trade Related Aspects of Intellectual Property Rights
UNESCO	United Nations
U.S.	United States
USPTO	United States Patent and Trademark Office
WIPO	World Intellectual Property Organization
WTO	World Trade Organization

I. INTRODUCTION

A. Background and Purpose

By signing onto the World Trade Organization's (WTO) Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS), signatories publically recognized the importance of effectively protecting and enforcing intellectual property rights (IPR).¹ Although TRIPS itself does not obligate its signatories to establish separate IPR courts, many governments have done so on their own accord.²

The majority of signatory countries have established some form of court or tribunal which specializes in IPR issues. These courts are referred to by various names, including the Specialized Intellectual Property Court,³ the Intellectual Property Court,⁴ The Patent Court,⁵ the Intellectual Property and International Trade Court,⁶ and the Court for Intellectual Property Disputes,⁷ to name a few. All of these courts exist mainly to adjudicate IPR disputes.

The International Intellectual Property Institute (IUPI) and its partner, the United States Patent and Trademark Office (USPTO), realize the importance of an informed and capable judiciary for effective IPR enforcement. Judicial specialization promotes greater understanding of and familiarity with IPR-related issues. Such specialized knowledge reduces judicial errors and lowers litigation costs, potentially resulting in greater consistency and increased predictability of case outcomes.

This study aims to further the development of specialized IPR courts and tribunals by examining the advantages and disadvantages of specialized IPR court regimes and their contributions to the efficient and effective adjudication of IPR-related disputes to develop a set of best practices guidelines for the establishment and administration of IPR courts. The goal of this study is to assist countries that are considering establishing specialized IPR courts and countries that wish to improve upon their existing regimes by qualifying the impact of IPR courts on improving judicial expertise, increasing court efficiency, and producing consistent case outcomes.

B. Methodology

This study updates the groundbreaking International Bar Association Intellectual Property and Entertainment Law Committee's "International Survey of Specialized Intellectual Property Courts and Tribunals,"⁸ which surveyed IPR practitioners, judges, policy-makers, and public officials throughout the world on specialized IPR courts in their countries.

¹ Preamble of the TRIPS Agreement 1995.

² Art. 41(5) Section 1.General Obligations. Part III.

³ Malaysia names its court the "Intellectual Property Session Court."

⁴ Singapore's "Intellectual Property Court" is one of the specialist commercial courts established under the High Court of Singapore.

⁵ United Kingdom.

⁶ Thailand

⁷ Russia

⁸ INT'L BAR ASS'N, INTERNATIONAL SURVEY OF SPECIALISED INTELLECTUAL PROPERTY COURTS AND TRIBUNALS (2007).

Unlike the original report, the information contained in this study was gathered predominantly from internet sources and does not include a formal survey component. The study catalogs specialized IPR courts in 90 countries from Asia and Oceania,⁹ Europe,¹⁰ the Middle East and Northern Africa,¹¹ North and South America and the Caribbean,¹² and Sub-Saharan Africa.¹³ Any changes in the types of specialized IPR courts possessed by the countries in this study will be included in an electronic version, which will be made publically available at www.iipi.org. IUPI intends for this study to evolve as more countries implement specialized IPR courts.

Of the 90 specialized IPR courts identified, ten were chosen to be the subjects of case studies.¹⁴ These courts systems were selected to represent a range of geographic locations, levels of economic development, and types of specialized IPR courts. IUPI engaged experts in each of the chosen jurisdictions to author case studies assessing the impact of that jurisdiction's specialized court on the adjudication of IPR disputes, taking into account the specific characteristics of each country or region.

The experts were asked to gather and examine information on the specialized IPR system and analyze its effect on producing consistent case outcomes in similar factual situations, the level of IPR expertise in the judiciary, and the conduct of commerce in IPR-dependent sectors. They were also asked to assess the advantages and disadvantages of the specialized IPR judicial system, focusing on the characteristics of the jurisdiction that make it effective or ineffective, and recommend ways in which other jurisdictions could benefit from establishing or not establishing a similar system.

Although IUPI reviewed and edited these case studies to increase study cohesion, editors attempted to preserve as much of the original content as possible.

C. Categories

This study differentiates the deliberative bodies which handle IPR matters into two major categories. The first category includes bodies that hear disputes brought by rights holders concerning the grant or registration of an IPR. These disputes are usually between the owner and the IP offices of each country. For example, when determining whether to grant a patent, an IP office is exercising a quasi-judicial function, which requires either judicial oversight or another avenue of appeal. The second category concerns judicial enforcement of IPR in disputes between rights holders and alleged infringers. This study considers both categories of disputes in defining specialized courts.

⁹ Australia, Azerbaijan, Bhutan, Cambodia, China, Hong Kong, Indonesia, India, Iran, Japan, New Zealand, Philippines, Singapore, South Korea, Sri Lanka, Taiwan, Tajikistan, Uzbekistan.

¹⁰ Armenia, Austria, Belgium, Belarus, Croatia, Czech Republic, Finland, France, Germany, Hungary, Italy, Iceland, Ireland, Lithuania, Luxembourg, Former Yugoslav Republic of Macedonia, Norway, Romania, Slovakia, Slovenia, Russia, Sweden, Switzerland.

¹¹ Egypt, Iraq, Israel, Jordan, Morocco, South Arabia, Syria, United Arab Emirates.

¹² Antigua and Barbuda, Bahamas, Barbados, Bolivia, Brazil, Canada, Chile, Colombia, Costa Rica, Ecuador, El Salvador, Guatemala, Guyana, Jamaica, Panama, Paraguay, Peru, Suriname, Trinidad and Tobago, Eastern Caribbean.

¹³ Eritrea, Malawi, Mauritius, Mozambique, Rwanda, Sudan, Tanzania, Uganda, Zimbabwe

¹⁴ Andean Community, Greece, Malaysia, Mexico, Kenya, South Africa, Thailand, United Kingdom, Japan, United States.

There are many different types of specialized IPR courts, and governments give these courts different names, although the core functions of such courts are often similar. In creating any of these courts or tribunals, governments intend to create a specialized forum for the adjudication of IPR property cases. This study identifies each country as possessing one or more of the following:

1. Specialized IPR Trial Court¹⁵
2. Specialized IPR Appeals Court¹⁶
3. Specialized IPR Trial Division¹⁷
4. Specialized IPR Appeals Division¹⁸
5. Commercial Trial Court¹⁹
6. Commercial Appeals Court²⁰
7. Trial Court that Exclusively Hears IPR Cases²¹
8. Appeals Court that Exclusively Hears IPR Cases²²
9. Administrative Tribunal²³
10. Specialized Judges on Courts of General Jurisdiction²⁴
11. Considering Specialized IPR Court, Division, or Tribunal²⁵
12. Considering Commercial Court²⁶

The alternative to a strict IPR court is to create a court of general jurisdiction containing a specialized division that exclusively hears IPR cases. Since most IPR disputes are trade related, many countries designate commercial courts as the proper venue for IPR cases. We have included these commercial courts in the list of IPR courts.

In some countries, no court has exclusive jurisdiction over all IPR matters. For example, in the United Kingdom, the Copyright Tribunal decides the terms and conditions of licenses offered by the collective licensing bodies. By statute, the tribunal is charged with establishing the facts of a case and then deciding upon them. Its decisions may be appealed to the High Court, but only on points of law. In addition, the United Kingdom has two other courts of first instance which adjudicate IPR disputes: the Patents Court, which is part of the Chancery Division of the High Court, and the Patents County Court. The Court of Appeals hears appeals from both courts. All of the judges from both the Patents Court and the Patents County Court are specialists. There is also a special patents judge in the Court of Appeals.

¹⁵ First instance court that only hears IPR matters.

¹⁶ Second instance court that only hears IPR matters.

¹⁷ Specialized division of a first instance court of general jurisdiction that only hears IPR matters.

¹⁸ Specialized division of a second instance court of general jurisdiction that only hears IPR matters.

¹⁹ First instance court that hears IPR matters in addition to other commercial, economic, and business matters

²⁰ Second instance court that hears IPR matters in addition to other commercial, economic, and business matters.

²¹ First instance court of general jurisdiction that exclusively hears IPR matters.

²² Second instance court of general jurisdiction that exclusively hears IPR matters.

²³ Specialized tribunal that is part of an administrative agency and hears IPR matters.

²⁴ Judges sitting on courts of general jurisdiction who have training or experience in IPR matters.

²⁵ The nation is considering implementing a specialized IPR trial or appeals court, a specialized IPR trial or appeals division, or a specialized IPR administrative tribunal.

²⁶ The nation is considering implementing a commercial trial or appeals court.

South Africa possesses a similar regime. The Copyright Act of 1978 establishes a Copyright Tribunal to decide licensing disputes while permitting the Magistrate Courts and High Courts to hear cases on IPR infringement.

In Kenya, the Magistrates' Courts, which are part of the ordinary judiciary, adjudicate infringements of copyrights and trademarks. In addition, Kenya has a specialized Industrial Property Tribunal which was established by Parliamentary law.²⁷ The tribunal has exclusive jurisdiction to hear appeals from the decisions of the Managing Director of the Kenya Industrial Property Institute. The tribunal also adjudicates proceedings relating to licenses, revocation or invalidation, and infringement of IPR.

The United States has one specialized IPR court: the United States Court of Appeals for the Federal Circuit.²⁸ This is an appellate court whose jurisdiction involves appeals on primarily patent issues. The Federal Circuit has subject matter jurisdiction over patent appeals, appeals from the U.S. Trademark Trial and Appeal Board, and issues arising out of the U.S. International Trade Commission, etc. It was formed to adjudicate IPR cases and to provide guidance to lower courts.

Greece, on the other hand, has Specialized Intellectual Property Right Divisions, created within the jurisdiction of the existing civil courts, which deal with IPR cases. Specialized judges with expertise in IPR, such as copyrights and trademarks, staff these divisions.

Japan has a specialized appeals court and specialized divisions of district and appeals courts that handle IPR matters. The Intellectual Property High Court hears appeals from district courts on patent actions, suits against decisions of the Japan Patent Office, and cases of first instance that come before the High Court and deal with IPR.²⁹ In addition to the High Court, four divisions of the Tokyo District Court, two divisions of the Osaka District Court, and one division of the Osaka High Court are specialized IPR divisions.³⁰

Mexico established the Regional Specialized Court on Intellectual Property Matters in 2008. This court has jurisdiction over appeals against final determinations issued by the Mexican Institute of Industrial Property.

Other countries have access to community tribunals, such as the Andean Community Tribunal of Justice.³¹ This tribunal has exclusive jurisdiction to interpret Andean law, including IPR law.

D. Key Findings

1. The benefits of specialized intellectual property courts

a. Creation of subject matter experts/expertise

²⁷ The main specialized tribunals are: the Managing Director of KIPI, the Industrial Property Tribunal, the Registrar of Trademarks, the Seeds and Plant Varieties Tribunal, and the Competent Authority. The Industrial Property Tribunal was first established by the Industrial Property Act (1989), repealed by the Industrial Property Act (2001).

²⁸ Created by Congress in 1982

²⁹ *Id.*

³⁰ Intellectual Property High Court, *infra* note 469.

³¹ The Cartagena Agreement created the Andean Pact which members consist of Bolivia, Colombia, Ecuador and Peru.

The laws that govern IPR are complex, and the technologies protected by those laws can be even more complex. Due to these intricacies, highly experienced judges are often needed to assure timely adjudication and accurate, consistent case outcomes.

Although the creation of a specialized IPR court, on its own, does not ensure that judges will be competent in those matters, specialized IPR courts increase judicial exposure to IPR law by funneling cases to a limited number of judges. Specialized IPR courts also facilitate the appointment of judges with specialized knowledge of IPR issues. This should result in higher quality opinions and a more consistent body of law.

b. Effectiveness of decision

Specialized IPR courts often make quicker and more effective decisions. Because judges in specialized courts are generally encouraged to have specialized knowledge, they are able to understand the procedures and technicalities associated with IPR cases. Specialist judges recognize case patterns and legal issues, which reduces delays and facilitates the speedy resolution of cases. This saves time and allows court resources to be used more efficiently. With increased judicial competence in effectively and efficiently resolving IPR cases, confidence in IPR litigation will also increase.³²

c. Ability to create special court procedures to enhance efficiency and accuracy

The creation of a specialized court allows the government to establish specialized rules and procedures which are uniquely suited to IPR cases.³³ These rules can help manage complex issues of IPR litigation by allowing courts to appoint associate judges or experts with technical knowledge to assist the presiding judge.

Certain specialized IPR courts, such as administrative courts, can help ensure that only strong patents are granted. Established case law from IPR court rulings is integrated into the guidelines of examiners, providing better certainty that the IPR will be upheld in court.³⁴ This minimizes the risk of later litigation and makes it easier for small and medium enterprises to protect their IPR without expensive court proceedings.³⁵

Procedures for fast-tracking appeals can expedite the adjudication of IPR-related disputes. IPR disputes may concern new or rapidly evolving subject matter and are often time sensitive. These rules and procedures increase judicial efficiency and encourage IPR holders to invest by better ensuring that their disputes will be swiftly resolved.

d. Consistency and predictability of case outcomes

The creation of an IPR court increases the consistency of case outcomes. Consolidating IPR cases to a single or several courts limits the number of judges writing

³² Louis Harms & Owen Dean

³³ Thailand as an illustration: Section 7 of the Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E.2539(1996)

³⁴ Laurence Helfer, Co-Dir., Duke Univ. Ctr. for Int'l & Comparative Law, Presentation for the International Intellectual Property Institute Seminar on Specialized Intellectual Property Rights Courts: Effective International Intellectual Property Adjudication: The Andean Tribunal of Justice (Jan. 17, 2012).

³⁵ *Id.*

opinions and reduces the likelihood of conflicting precedents from multiple jurisdictions. In addition, the higher level of judicial expertise that specialized courts provide increases the judges' familiarity with relevant precedents, which further improves consistency.

Consistency in litigation is important because it reduces uncertainty and increases the predictability of case outcomes. This reduces litigation, as it becomes clearer to potential litigants when a case is without merit. Businesses have greater confidence that their investments in innovation will be protected, allowing them to better plan their business strategy, spurring economic growth.

e. Progressive development or dynamism

Constantly evolving legal subjects, such as IPR, require judicial and practitioner expertise in order to adapt to changing technologies and issues. The establishment of specialized IPR courts produces more knowledgeable judges and practitioners, who are better able to manage and preside over IPR matters. Because their subject matter is concentrated, specialized IPR courts are better equipped to remain current on new IPR issues and laws. Court specialization is followed by lawyer specialization. In turn, this leads to an increased demand for IPR training and studies in tertiary education, which will increase general awareness of IPR. As many IPR laws are subject to constant evolution, judges and lawyers will be better able to rapidly assess and apply legal changes.

f. Government investment in specialized intellectual property courts signals to the public that intellectual property rights will be enforced

Establishing a specialized court raises the profile of IPR within a country by signaling that the government considers it an important area to protect. Greater awareness of IPR stigmatizes the actions of those who knowingly infringe on them, and this social pressure decreases the likelihood of infringing activities. Rights holders have greater assurance that their rights will be protected, thereby encouraging artistic creation and innovation. Investments in the arts and innovation benefit society as a whole by bringing confidence to the commercial and business communities, increasing the likelihood of foreign investment and, ultimately, contributing to economic growth.

2. Potential issues involved with the creation of specialized intellectual property courts

Although many benefits accrue to countries that create and maintain specialized IPR courts, government officials should consider their country's particulars before establishing a specialized court.

a. Are the costs associated with the development and maintenance of a specialized court justified?

In a world of limited resources, governments should consider the costs associated with setting up a specialized IPR court. In addition to infrastructure costs, the creation of a specialized court is likely to require the training of judges and lawyers and the hiring of

administrative and enforcement personnel. Because IPR constitute an ever-changing area of law, the need for training may be an ongoing cost.

However, these costs must be weighed against possible savings. Specialization should result in increased judicial efficiency, thereby reducing costs in the long term. Increased predictability of case outcomes should also spur innovation, and in turn, stimulate economic growth.

b. Is there enough intellectual property litigation to justify the creation of a specialized court?

In some jurisdictions, there may be insufficient IPR litigation to justify setting up a specialized court. However, officials should be mindful that a lack of litigation could be the result of rights owners believing that it is pointless to litigate their rights because the current judicial regime does not adequately protect IPR. In such cases, establishing a specialized court may be a necessary step towards adequate IPR protections. It is also important to consider that while IPR case loads may not justify the establishment of an independent court that exclusively hears IPR cases, there are many alternative regimes that may better suit a country's needs, such as specialized divisions and judges.

c. Are there enough judges with knowledge of intellectual property to sit on the court?

Specialized courts are of little benefit if there are no judges in the country who are competent to adjudicate the issues or if those judges who are knowledgeable in IPR are not appointed. However, this issue can be remedied through the development of judicial educational programs and increased exposure to IPR in legal education. In addition, the creation of a court itself will help to train judges on the job by centralizing institutional knowledge. However, experiential knowledge is only useful where judges hold the position long enough to acquire expertise.

d. Would the court be adequately accessible to litigants?

Oftentimes, IPR litigation is isolated to a country's commercial centers. In some countries, it may be difficult to set up a single court that is easily accessible to litigants throughout the country. In cases where territorial and geographic issues preclude a centralized court, one alternative is to educate a number of specialist judges who are specifically selected to hear IPR cases when they occur on the ordinary judicial circuit. Likewise, special IPR divisions may be established in a few select courts located in the commercial districts that receive the greatest number of IPR cases.

3. Criticisms of specialized intellectual property courts

a. The possibility of bias

Critics of specialized courts contend that such courts are more likely to become biased. They believe court impartiality may be at risk due to the likelihood that only a few judges and attorneys will specialize in IPR, thereby potentially biasing court personnel and judges who consistently interact with a limited group of attorneys and judges. This study

has found no evidence to support such claims. Additionally, proper oversight and an effective appeals process should minimize this concern. Furthermore, specialized IPR courts typically increase awareness of and interest in IPR law, thereby raising the number of practitioners in this field.

b. Judicial “tunnel vision” in viewing intellectual property law in context of the general law

Some have argued that specialization can lead to judges losing sight of how IPR law fits into the larger fabric of a legal system, resulting in judges either under-emphasizing or, more likely, over-emphasizing the importance of IPR. In addition, extreme specialization can narrow a judge’s view and prevent him or her from accepting or integrating developments from other areas of law.³⁶ These issues can be easily addressed by having specialized IPR judges occasionally adjudicate general matters when not otherwise busy with IPR cases. Even if judges are not assigned to outside cases, many IPR disputes involve multiple causes of action and issues that implicate other legal areas.

E. Effective Practices

Based on the case studies, this report recommends that government officials follow the following practices while developing a specialized IPR court.

1. Appoint judges who have a background in intellectual property issues

Knowledgeable judges will increase the efficiency of IPR cases and will reduce the likelihood of review on appeal, saving time and money. As the majority of cases that come before a specialized IPR court will be decided by a single judge, it is important that the judge be competent to deliberate over the highly complex, and often technically challenging, cases that come before them. This is especially true in patent infringement cases; to determine whether infringement has occurred, priority should first be given to judges whose background and technical experience is commensurate with the subject matter of the case. This may not be feasible in all jurisdictions, especially given the range of patentable subject matter that may be litigated versus the number of judges in a given jurisdiction. Technical experts may provide great value in such cases so long as the judge possesses legal expertise regarding IPR law.

It is important to remember that a technical background does not guarantee that a judge will be knowledgeable or effective.³⁷ As some have remarked, a lazy or irresponsible judge will hinder court efficiency, no matter how impressive his or her IPR background.³⁸ The importance of protecting IPR should be reflected in the quality of judges that are appointed to the court and the prestige associated with the position.

³⁶ See, e.g., The Commission’s Recommendations, *infra* note 696.

³⁷ Tshepo Shabangu, Partner, Spoor & Fisher, Presentation for the International Intellectual Property Institute Seminar on Specialized Intellectual Property Rights Courts: The Benefits and Challenges of IP Enforcement and Specialized IPR Courts (Jan. 17, 2012).

³⁸ Numeriano Rodriguez, Gen. Counsel, Phil. Intellectual Prop. Coal., Presentation for the International Intellectual Property Institute Seminar on Specialized Intellectual Property Rights Courts: Update on the Philippine’s Experience Establishing a Specialized Court (Jan. 19, 2012).

2. Try intellectual property cases by judge, not by jury

In the majority of the case studies, jury trials have been replaced by trial by judge. Normally, a single judge will decide a case in the court of first instance, while on appeal, there is likely to be a minimum of three judges hearing the case. This approach may minimize costs and increase judicial expertise by keeping the overall number of specialized judges required low.

3. Provide judges with continuing training throughout their appointment

IPR laws and the technologies they protect are constantly evolving. As such, IPR judges must undergo regular training and education to keep up with these developments and to remain properly qualified to adjudicate intellectual property cases. Without continuing training and education, specialized judges may be less equipped to hear new issues, and the court may become less efficient and consistent.

4. Anticipate judicial turnover and be prepared to train replacement judges

One downside of specialization is that it may cause the judge's job to become repetitive, reducing the judge's mental stimulation and causing burnout. Additionally, some judges fear that their career development will be hindered if they stay in a specialized position too long. For these reasons, the tenure of specialized IPR judges can be short, which makes it important for the courts to have a mechanism for efficiently training replacement judges. Courts can also reduce losing knowledgeable judges in specialized IPR courts by raising the prestige of the position, either through salary increases, or through appellate level specialization.

5. Provide judges with technical experts

No matter the type of system that a country ultimately chooses – specialized IPR court, specialized division of a general court, or an ordinary court – judges should be provided with access to technical experts to assist with more nuanced issues that often arise during IPR litigation.³⁹ These experts should be available to the judges at multiple stages of the trial and provide the judge with a fair and neutral viewpoint on technical matters.⁴⁰ Due to the pace at which technology develops, even a judge with specialized knowledge of patent law is unlikely to be able to keep up without expert assistance.

6. Create specialized intellectual property enforcement units

In order to obtain the maximum benefits that accrue from the creation of a specialized IPR court, it is advisable that governments create and train specialized enforcement units who are tasked primarily with handling IPR-related offenses; i.e. police

³⁹ Ahmed Davis & Judge Michael Fysh, Panel for the International Intellectual Property Institute Seminar on Specialized Intellectual Property Rights Courts: The Role of Judges and Court Appointed Experts with Technical Knowledge (Jan. 18, 2012).

⁴⁰ Judge Ryoichi Mimura, Former Judge, Japan Intellectual Prop. High Court, Presentation for the International Intellectual Property Institute Seminar on Specialized Intellectual Property Rights Courts: What Characteristics Make a Specialized Judicial Regime the Right Fit for a Country? (Jan. 17, 2012).

officers, customs officials, and prosecutors. In situations where resources are scarce, governments should train at least one expert in each enforcement unit.⁴¹ They may also establish an expert hotline that local police can call and consult.⁴²

Without adequate training as to both the law and the new regime, enforcers may lack the confidence to act *ex officio* or potentially make procedural errors and compromise cases before they ever reach court. In addition, it is impossible to overstate the importance of minimizing corruption in all rule of law institutions.

7. Evaluate costs

In judging whether a country should invest in a specialized IPR court, it is advisable to first undertake a survey to determine the number of IPR cases that are either pending, or that are likely to arise under a new legal regime. If the number is small, and the ordinary courts are already able to expeditiously settle the cases, then there is less reason to create a specialized court. However, increased judicial expertise may have other benefits, such as increased predictability of case outcomes which may spur economic growth. If there are a great number of IPR cases, or if specialization is likely to result in a greater number of cases (due to better protections which encourage rights owners to seek enforcement), then there is greater incentive to create a specialized court, because increased judicial efficiency typically results in savings. A middle ground, and a possible way to minimize the initial costs of moving to a specialized regime, would be to create a specialized IPR division within an existing court structure.

F. Conclusion

Based upon the case studies, this report finds that specialized IPR courts have many advantages. Specialized courts benefit the IPR owners and the government alike as they are more efficient and expedient. While all countries must consider their own needs and priorities, such as case loads and financial limitations, it is advisable for government officials to consider developing and maintaining some form of specialized IPR court.

⁴¹ Jason Gull, Senior Counsel, Computer Crime and Intellectual Prop. Section of USDOJ, Presentation for the International Intellectual Property Institute Seminar on Specialized Intellectual Property Rights Courts: The Benefits and Challenges of IP Enforcement and Specialized IPR Courts (Jan. 17, 2012).

⁴² *Id.*

II. SUMMARIES BY COUNTRY

This chapter describes the specialized IPR courts that countries have established or are considering establishing. The following section contains a master chart that classifies a country according to the list of categories of specialized IPR courts described in the previous chapter. Further sections contain geographic subsets of the master chart. These sections also contain paragraph-length summaries of the particular specialized IPR courts possessed by the countries in that geographic region. The charts in this chapter also categorize the courts possessed by international confederations and similar bodies, e.g. the European Union. Countries which do not fall into the aforementioned categories and do not have access to a community tribunal are excluded from these charts.

A. Worldwide

	Specialized IPR Trial Court	Specialized IPR Appeals Court	Specialized IPR Trial Division	Specialized IPR Appeals Division	Commercial Trial Court	Commercial Appeals Court	Trial Court that exclusively hears IP	Appeals Court that exclusively hears IP	Administrative Tribunal	Specialized IP judges on court of general jurisdiction	Considering IP Court/Division/Tribunal	Considering Commercial court
Antigua and Barbuda									•			
Armenia											•	
Australia									•	•		
Austria		•	•						•			
Azerbaijan				•								
Bahamas									•			
Barbados									•			•
Belarus		•	•									
Belgium				•								
Bhutan										•		
Bolivia												
Brazil	•			•								
Cambodia												•
Canada						•				•		
Chile	•	•							•			
China			•	•					•			
Colombia							•					
Costa Rica					•				•			•
Croatia					•							
Czech Republic							•					
Denmark					•					•		
Ecuador									•			•
Egypt					•					•		
El Salvador					•							
Eritrea							•					
Finland			•						•			•
France		•	•									
Germany		•	•						•			
Greece		•	•									
Guatemala												
Guyana					•							

Hong Kong									•		
Hungary			•								
Iceland						•					
India								•			
Indonesia				•					•		
Iran						•	•				
Iraq				•							
Israel									•		
Ireland				•							
Italy			•	•							
Jamaica						•			•		
Japan		•	•	•							
Jordan									•		
Kenya						•			•		
Lithuania						•			•		
Luxembourg			•								
Macedonia									•		
Malawi								•			
Malaysia	•										
Mauritius								•			
Mexico				•							
Morocco					•	•					
Mozambique			•								
Netherlands		•	•								
New Zealand						•		•	•		
Norway						•			•		
Panama		•					•				
Paraguay									•	•	
Philippines						•		•	•		
Peru	•	•							•		
Portugal	•	•									
Romania			•	•							
Russia	•	•				•					
Rwanda					•						
Saudi Arabia									•		
Serbia					•	•					
Singapore									•		
Slovakia						•		•			
Slovenia							•				
South Africa					•						
South Korea		•							•		
Sri Lanka									•	•	
Sudan					•						
Suriname							•	•			
Sweden		•	•	•				•		•	
Switzerland	•					•	•				
Syria				•							
Taiwan	•	•									
Tajikistan						•	•		•		•
Tanzania						•					
Thailand	•			•							
Trinidad and Tobago									•		•
Turkey	•			•							
Uganda					•						

B. Regional

8. Asia and Oceania

	Specialized IPR Trial Court	Specialized IPR Appeals Court	Specialized IPR Trial Division	Specialized IPR Appeals Division	Commercial Trial Court	Commercial Appeals Court	Trial Court that exclusively hears IP	Appeals Court that exclusively hears IP	Administrative Tribunal	Specialized IP Judges on court of general jurisdiction	Considering IP Court/Division/Tribunal	Considering Commercial court
Australia												
Azerbaijan					●							
Bhutan										●		
Cambodia												
China		●	●						●			●
Hong Kong											●	
India									●			
Indonesia				●							●	
Japan	●	●	●	●								
Malaysia	●											
New Zealand						●			●		●	
Philippines						●			●		●	
Singapore									●			
South Korea		●							●			
Sri Lanka						●					●	
Taiwan	●	●										
Tajikistan					●	●			●		●	
Thailand	●		●									
Uzbekistan					●	●						

Australia

Australia has courts of general jurisdiction staffed by specialist judges with IPR backgrounds. IPR cases are heard by special panels of judges in particular Federal Courts.⁴³ There are patent panels in the Federal Courts of Victoria, New South Wales, and Queensland; a copyright, trademark, and design panel in Queensland; and a general IPR

⁴³ Federal Court of Australia, Panels for the Individual Docket System, <http://www.fedcourt.gov.au/how/panels.html#ip> (last visited November 14, 2011).

panel in Victoria.⁴⁴ Appeals from Federal Courts are heard by the High Court of Australia.⁴⁵ Australia also has a specialized tribunal that hears exclusively copyright cases. The Copyright Tribunal, an independent body administered by the Federal Court of Australia, has jurisdiction over statutory (compulsory) licensing and voluntary licensing disputes.⁴⁶ It is made up of a President who must be a sitting Federal Court judge, two Deputy Presidents who must be or have been Federal or state judges, and three members, who are non-judicial copyright experts.⁴⁷

Azerbaijan

Azerbaijan has two specialized commercial courts with nine commercial judges that hear IPR disputes in addition to other business disputes.⁴⁸ Azerbaijan also has an International Commercial Arbitration Court, which handles alternative dispute resolution of international commercial matters.⁴⁹

Bhutan

Although IPR disputes in Bhutan are rare, the Bhutanese High Court always has at least one judge with IPR expertise.⁵⁰

Cambodia

Cambodia is considering establishing a commercial court that would hear IPR matters in addition to business and banking disputes.⁵¹

China

China has courts of general jurisdiction with specialized divisions that hear IPR cases. The Chinese justice system consists of Basic People's Courts, Intermediate People's Courts, High People's Courts, and the Supreme People's Court.⁵² There are specialized IPR divisions in the Supreme People's Court. All High People's Courts, almost all Intermediate People's Courts, and all Primary People's Courts with civil jurisdiction to hear IPR cases have specialized IPR divisions. As of 2008, 2,126 specialized IPR judges had been staffed on

⁴⁴ *Id.*

⁴⁵ High Court of Australia, Operation of the High Court, <http://www.hcourt.gov.au/about/operation> (last visited November 14, 2011).

⁴⁶ Copyright Tribunal of Australia, About the Tribunal, <http://www.copyrighttribunal.gov.au/about/index.html> (last visited November 14, 2011).

⁴⁷ Copyright Law, 1968, § 138-142 (Austl.).

⁴⁸ WORLD BANK, DOING BUSINESS: COMPARING REGULATION IN 181 ECONOMIES 51 (2009).

⁴⁹ Azerbaijan Arbitration and Mediation Center, About AAMC, http://arbitr.az/eng/viewpage.php?page_id=1 (last visited November 14, 2011).

⁵⁰ World Intellectual Property Organization, Legal Framework of the Intellectual Property System in of Bhutan, <http://www.wipo.int/wipolex/en/outline/bt.html> (last visited November 14, 2011).

⁵¹ KHMER INSTITUTE OF DEMOCRACY, THE JUDICIAL SYSTEM OF CAMBODIA 10, available at <http://www.khmerrough.com/pdf/CriticalThinking-Eng/Part1-CriticalThinking.pdf>.

⁵² The Supreme People's Court of the People's Republic of China, Intellectual Property Protection by Chinese Courts in 2009, http://www.court.gov.cn/zscq/znsj/201004/t20100426_4545.html (last visited November 14, 2011).

these specialized divisions.⁵³ Invalidation proceedings are conducted before the Chinese Intellectual Property Organization's reexamination board, a specialized IPR tribunal.⁵⁴ Appeals from reexamination proceedings lie with the People's Courts.⁵⁵ A victim of infringement can also request relief from the administrative organization that deals with the type of IPR infringed, which brings quicker enforcement but lesser penalties.⁵⁶

Hong Kong

Hong Kong has no specialized IPR courts and IPR claims are filed in the Court of First Instance, which hears all civil claims.⁵⁷ Hong Kong has specialist IPR judges in its courts that handle some, but not all, IPR cases.⁵⁸

Indonesia

Indonesia has commercial courts that hear IPR cases in addition to other business disputes.⁵⁹ These courts hear all civil IPR cases. Criminal IPR cases are still heard by standard district courts.⁶⁰ Appeals from decisions of the Commercial Court are heard by the Supreme Court.⁶¹ Commercial Court judges are subject to some specific training in IPR matters.⁶²

India

India has a specialized administrative tribunal that exclusively hears IPR appeals. The Indian Intellectual Property Appeals Board was set up to hear appeals against decisions of the Register of Trademarks in 1999.⁶³ It expanded its jurisdiction to geographical indications in its initial year and to patents in 2007.⁶⁴ It must be staffed by at least one judicial member and one technical member.⁶⁵ It sits in Chennai, Mumbai, Delhi, Kolkata, and Ahmedabad. Infringement trials remain in the High Courts of India.⁶⁶ India also is considering a bill that would establish commercial courts. Although IPR cases would be

⁵³ *Id.*

⁵⁴ Patent Law of the People's Republic of China, Adopted at the 4th Session of the Standing Committee of the Sixth National People's Congress, March 12, 1984, Amended 27th Session of the Standing Committee of the Seventh National People's Congress, September 4, 1992.

⁵⁵ *Id.*

⁵⁶ UNITED KINGDOM INTELLECTUAL PROPERTY OFFICE, INTELLECTUAL PROPERTY RIGHTS PRIMER FOR CHINA 24 (2008).

⁵⁷ Judiciary of Hong Kong, Court Services and Facilities,

http://www.judiciary.gov.hk/en/crt_services/pphlt/html/hc.htm (last visited November 14, 2011).

⁵⁸ Douglas Clark, IP Litigation: What Hong Kong Can Learn From China, HONG KONG LAWYER, February 2011, available at http://www.hk-lawyer.com/InnerPages_features/0/3383/2011/2.

⁵⁹ Andriani Nurdin, "Challenges Faced by Non-Specialised Judicial Systems in Indonesia," EC-ASEAN Intellectual Property Rights Co-operation Programme 1 (2005), http://www.ecap-project.org/archive/fileadmin/ecapII/pdf/en/activities/regional/20051201_ip/PRESEN_1.pdf.

⁶⁰ *Id.*

⁶¹ *Id.* at 2.

⁶² *Id.* at 3 (noting that judges have training in trademark law).

⁶³ Peter Oller, Academics Challenge India's IP Appeals Board, MANAGING INTELLECTUAL PROPERTY (February 11, 2011).

⁶⁴ *Id.*

⁶⁵ *Id.*

⁶⁶ Intellectual Property Appeals Board, <http://www.ipab.tn.nic.in/> (last visited November 14, 2011).

under the ambit of commercial courts, the judges would not necessarily possess IPR expertise.⁶⁷

New Zealand

New Zealand has designated courts which hear IPR disputes in addition to other cases as well as an administrative tribunal that hears copyright licensing disputes. IPR infringement proceedings are usually conducted in the High Court rather than the District Court, and many types of IPR proceedings are required to be filed there.⁶⁸ High Court judges are seen as more knowledgeable regarding IPR than their District Court counterparts.⁶⁹ Patent and trademark oppositions can also be conducted through the Intellectual Property Office of New Zealand.⁷⁰ New Zealand also has a Copyright Tribunal to adjudicate copyright licensing disputes.⁷¹ The Tribunal consists of a president, who must be a barrister or solicitor of the High Court with at least seven years' experience, and two other people, all of whom are chosen by the governor.⁷² The Tribunal can pass questions of law along to the High Court,⁷³ and appeals from decisions of the Tribunal are heard by the High Court.⁷⁴

Philippines

The Philippines established specialized IPR courts in 1995,⁷⁵ but later consolidated them into its Commercial Courts, which hear IPR matters in addition to other commercial disputes.⁷⁶ An October 2011 resolution designated a few commercial courts, including courts in Manila, Quezon City, Makati, and Pasig, to exclusively hear civil and criminal IPR cases.⁷⁷ It also created special procedural rules for IPR cases.⁷⁸ These rules, which entered into force on November 8, 2011, cover such issues as jurisdiction over issuance of writs of search and seizure, the use of alternative dispute resolution, and timeframes for handling

⁶⁷ Commercial Division of High Courts Bill, 2009, §2(a) (India).

⁶⁸ See, e.g., Patents Act of 1953, Public Act 1953 No. 64, Part 1 (New Zealand) (stating that "Court," for purposes of the Act, means "High Court").

⁶⁹ James & Wells Intellectual Property, Information: Litigation, <http://www.jaws.co.nz/information/litigation.aspx> (last visited November 16, 2011).

⁷⁰ Patents Act, *supra* note 68, Part 8 Subpart 21; Trade Marks Act of 2002, Public Act 2002 No. 49, Part 3 Subpart 3.

⁷¹ Copyright Act of 1994, Public Act 1994 No. 43, Part 10 (New Zealand).

⁷² *Id.* § 206.

⁷³ *Id.* § 223.

⁷⁴ *Id.* § 224.

⁷⁵ Administrative Order No. 113-95, 1995 (Philippines).

⁷⁶ Supreme Court of the Philippines Resolution Regarding the Consolidation of Intellectual Property Courts With Commercial Courts, A.M. No. 03-03-03-SC (2003), available at <http://elibrary.judiciary.gov.ph/index6.php?doctype=Amendments%20to%20the%20Rules%20of%20Court&docid=a45475a11ec72b843d74959b60fd7bd6456478847a125>.

⁷⁷ "Rules Governing IPR Cases Released by Supreme Court," Business World Online (October 24, 2011), <http://www.bworldonline.com/content.php?section=TopStory&title=Rules-governing-IPR-cases-released-by-Supreme-Court&id=40475>.

⁷⁸ *Id.*

civil and criminal cases.⁷⁹ The Philippines has advanced IPR training for judges in commercial courts that frequently see IPR cases.⁸⁰ The Philippines also has a specialized administrative tribunal that exclusively hears some IPR cases. The Bureau of Legal Affairs, part of the Philippines Intellectual Property Office, hears cases concerning opposition to and cancellation of trademarks, cancellation of patents, and petitions for compulsory licensing of patents.⁸¹

Singapore

Singapore has no specialized IPR court, but some types of IPR disputes may be brought directly before the High Court. Decisions of the administrative tribunal are appealable to the Court of Appeal or the High Court.⁸² Singapore proposed a specialized IPR court in 2002, but at present, there is no specialized IPR court in Singapore.⁸³ The Intellectual Property Office of Singapore maintains a Copyright Tribunal, an administrative tribunal that hears disputes between licensors and users of copyrights.⁸⁴ The Tribunal consists of a president, two deputy presidents, and up to 15 members.⁸⁵ Each case is heard by a panel of three tribunal members.⁸⁶ The tribunal can refer any case that requires a determination on a matter of law to the High Court.⁸⁷

South Korea

South Korea has an administrative tribunal that exclusively hears IPR cases. It is part of the Korean Intellectual Property Office and is known as the Intellectual Property Tribunal. The Intellectual Property Tribunal consists of a Litigation Division, a Trial Policy Division, and an Appeals Division. The Intellectual Property Tribunal can hear *ex parte* and *inter partes* cases, but only hears cases regarding the scope of IPR and decisions of the Intellectual Property Office regarding the granting of IPR. Infringement cases are still heard by courts.⁸⁸

⁷⁹ International Intellectual Property Alliance, "The Philippines," *2012 Special 301 Report on Copyright Protection and Enforcement* 222 (February 10, 2012), available online at <http://www.iipa.com/rbc/2012/2012SPEC301PHILIPPINES.PDF>.

⁸⁰ Ma. Elisa P. Osorio, "IP Philippines Moves to Protect Inventors' Rights," The Philippine Star (July 6, 2008), <http://www.philstar.com/Article.aspx?articleid=71196>.

⁸¹ Intellectual Property Office of the Philippines, About IP Cases, <http://www.ipophil.gov.ph/main.php?contentid=43> (last visited November 15, 2011).

⁸² Email from Sandy Widjaja, Hearings and Mediation Division, Intellectual Property Organization of Singapore to Eric W. Robbins, II, Legal Fellow, International Intellectual Property Institute (September 26, 2011 09:16 PM EDT) (on file with recipient).

⁸³ *Id.* (stating that, at present, Singapore has no intellectual property court); Supreme Court of Singapore, Media Release announcing Establishment of Intellectual Property Court (September 19, 2002), <http://www.webcitation.org/5m7Uncyoy>.

⁸⁴ Intellectual Property Office of Singapore, Copyright Tribunal, <http://www.ipos.gov.sg/leftNav/cop/Copyright+Tribunal.htm> (last visited November 15, 2011).

⁸⁵ *Id.*

⁸⁶ *Id.*

⁸⁷ *Id.*

⁸⁸ Korean Intellectual Property Office, Appeals and Trials, <http://www.kipo.go.kr/kpo/user.tdf;jsessionid=9863ca6bce5f1332c771f8b4d039b6bb4cd3d125794.oR1JrQjwaxCNaN0LcybtahiM-xyT-x8KawSLa3qImxvAc39y-AnyaQeSn6aSmhqI-huKa30xoR1JrQjwawTFq6XRnk8M->

South Korea has a specialized patent appeals court. The Patent Court of South Korea, in Daejeon, has jurisdiction over appeals from the Intellectual Property Tribunal, including appeals regarding patents, designs, and trademarks.⁸⁹ The Patent Court does not have jurisdiction over infringement proceedings.⁹⁰ The court's subject matter jurisdiction is limited to determining the scope of a patent or trademark.⁹¹ The Patent Court consists of a chief judge, 4 presiding judges, 13 judges, 17 technical examiners, and a secretariat.⁹² Each case is heard by a three judge panel. Infringement proceedings are outside the Patent Court's jurisdiction and are brought before ordinary courts, with appeals to the high court and then the Supreme Court.⁹³ The Supreme Court hears appeals from the Patent Court.⁹⁴

Sri Lanka

Sri Lanka has courts that exclusively hear IPR matters in addition to other disputes. Most IPR proceedings are exclusively conducted before the District Court of Colombo.⁹⁵ Sri Lankan courts have some judges with IPR expertise.⁹⁶

Taiwan

Taiwan has a specialized IPR court that exclusively hears IPR cases. The Intellectual Property Court was established in 2008 and hears civil and administrative cases as well as appeals of criminal IPR cases.⁹⁷ Cases of first instance are heard by one judge and appeals are heard by three.⁹⁸ The court is staffed by judges with experience and expertise in IPR.⁹⁹ The court also employs technical examination officers, who are either former patent examiners or professors in technical disciplines.¹⁰⁰ Technical examiners question and explain legal points to witnesses and make recommendations to judges.¹⁰¹ Taiwan's Intellectual Property Court has been criticized for its slow resolution of cases and its hostility to patentees (less than 1/3 of patents are upheld, according to one study).¹⁰²

AHDq6WInQWIoR8xb30PbxyQax4xf2bRrRqxn6jAmljGr5XDqQLvpAe_?a=user.english.html.HtmlApp&c=30300&catmenu=ek30300 (last visited November 15, 2011).

⁸⁹ Patent Court of South Korea, About The Court,

http://patent.scourt.go.kr/patent_e/intro/intro_01/index.html (last visited November 15, 2011).

⁹⁰ *Id.*

⁹¹ *Id.*

⁹² *Id.*

⁹³ Patent Court of Korea, Organization, http://patent.scourt.go.kr/patent_e/intro/intro_04/index.html (last visited November 15, 2011).

⁹⁴ Patent Court of South Korea, About the Court, *supra* note 89.

⁹⁵ Code of Intellectual Property Act No. 52, 1979, (as amended by Act No. 30 of 1980, No. 2 of 1983, No. 17 of 1990, No. 13 of 1997, and No. 40 of 2000), Chapter XXXII § 186.

⁹⁶See, e.g., "President of the Court of Appeal: Judge S. Sri. Skandarajah," SUNDAY TIMES (July 3, 2011), <http://www.sundayobserver.lk/2011/07/03/new24.asp> (noting that the new president of the Sri Lankan Court of Appeal has written and presented on intellectual property rights).

⁹⁷ Intellectual Property Court Organization Act, 2008, Art. 3 (Taiwan).

⁹⁸ *Id.* Art. 6.

⁹⁹ *Id.* Art. 13.

¹⁰⁰ *Id.* Art. 16.

¹⁰¹ Intellectual Property Case Adjudication Act, 2007, Art. 4 (Taiwan).

¹⁰² Yu Tzu-Chiu, Taiwan *Patent Court a Concern for U.S. Tech Firms*, IEEE SPECTRUM (February 2011), available at <http://spectrum.ieee.org/consumer-electronics/audiovideo/taiwan-patent-court-a-concern-for-us-tech-firms>.

Appeals from the IP court are heard by either the Supreme Court (for civil and criminal actions) or the Supreme Administrative Court (for administrative actions).¹⁰³

Tajikistan

Tajikistan has an administrative board within its National Center for Patents and Information that exclusively hears appeals of decisions to grant or deny IPR.¹⁰⁴ It also has a Supreme Economic Court that hears IPR cases in addition to other business disputes.¹⁰⁵ Tajikistan is considering specialized IPR courts.¹⁰⁶

Uzbekistan

Uzbekistan has Economic Courts that hear IPR matters in addition to other business disputes.¹⁰⁷ The Economic Courts are organized and monitored by the Higher Economic Court, which also can hear cases as a court of first instance.¹⁰⁸ The Higher Economic Court has separate judicial boards for civil and administrative disputes.¹⁰⁹

9. Europe

	Specialized IPR Trial Court	Specialized IPR Appeals Court	Specialized IPR Trial Division	Specialized IPR Appeals Division	Commercial Trial Court	Commercial Appeals Court	Trial Court that exclusively hears IP	Appeals Court that exclusively hears IP	Administrative Tribunal	Specialized IP Judges on court of general jurisdiction	Considering IP Court/Division/Tribunal	Considering Commercial court
Armenia											•	
Austria		•	•						•			
Belarus		•	•									
Belgium				•								
Croatia					•							
Czech Republic							•					
Denmark					•					•		
Finland		•							•		•	
France		•	•									
Germany		•	•						•			
Greece		•	•									
Hungary		•										
Iceland							•					
Italy		•	•									
Ireland					•							

¹⁰³ Taiwan Intellectual Property Court, IP Case Procedures, http://ipc.judicial.gov.tw/_ipc_english/index.php?option=com_content&view=article&id=27&Itemid=51.

¹⁰⁴ Muyassar and Rafieva, National System of Protection of the Objects of Industrial Property of the Republic of Tajikistan, <http://www.mrafieva.com/getText.php?theContent=ipInTajikistan> (last visited November 15, 2011).

¹⁰⁵ Oleg Stalbovskiy and Maria Stalbovskaia, *Law of the Republic of Tajikistan: A Guide to Web Based Resources*, <http://www.nyulawglobal.org/Globalex/Tajikistan.htm> (last visited November 15, 2011).

¹⁰⁶ Muyassar and Rafieva, *supra* note 104.

¹⁰⁷ Constitution of Uzbekistan, Art. 107.

¹⁰⁸ Government Portal of the Republic of Uzbekistan, Higher Economic Court, http://www.gov.uz/en/courts_and_prosecution/1293 (last visited November 16, 2011).

¹⁰⁹ *Id.*

Lithuania					•		•		
Luxembourg			•						
Macedonia								•	
Netherlands		•	•						
Norway					•			•	
Portugal	•	•							
Romania			•	•					
Russia	•	•			•				
Serbia					•	•			
Slovakia						•	•		
Slovenia						•			
Sweden		•	•	•			•		•
Switzerland	•				•	•			
Turkey	•		•						
United Kingdom	•	•					•		
European Union									•

Armenia

Armenia is considering restricting IPR disputes to specific courts of general jurisdiction that would hear other types of cases as well. As part of its effort to reform IPR enforcement in the country, the government of Armenia is planning to introduce new enforcement legislation.¹¹⁰ One of the main changes planned is the specialization of IPR court first instance disputes.¹¹¹ The government plans to submit legislative amendments making it possible to concentrate IP disputes to a limited number of courts and judges.¹¹²

Austria

The Commercial Court of Vienna and the Criminal Court of Vienna have exclusive jurisdiction to hear all patent cases.¹¹³ Civil patent matters are handled by three specialized divisions consisting of three judges, two being professional and one being a lay judge with technical expertise.¹¹⁴ Appeals will also be heard by a three judge panel with one lay technical expert in the Higher Regional Court of Vienna. Final appeals are heard by the five professional judges who make up a patent senate of the Austrian Supreme Court. The Nullity Section of the Austrian Patent Office deals with nullity actions and is made up of three technical experts and two legal experts.¹¹⁵ Appeals against the Nullity Section can be

¹¹⁰ Ministry of Economy of the Republic of Armenia, STRATEGY OF THE REPUBLIC OF ARMENIA ON INTELLECTUAL PROPERTY RIGHTS Protection 11 (2011), <http://www.aipa.am/upload/File/razmavarutjun/IPRStrategyeng.pdf>.

¹¹¹ *Id.*

¹¹² *Id.*

¹¹³ Christian Gassauer-Fleissner & Dominik Goebel, Austria, THE INTERNATIONAL COMPARATIVE LEGAL GUIDE TO PATENTS 2011: A PRACTICAL CROSS-BORDER INSIGHT INTO PATENT WORK 19 (2011), <http://www.iclg.co.uk/khadmin/Publications/pdf/3842.pdf> (citing Patentgesetz [Patent Law] Bundesgesetzblatt fur die Bundesrepublik Osterreich [BGBl] Nos. 159/1970, 581/1973, 349/1977, 526/1981, 201/1982, 126/1984, and 234/1984, § 162 (Austria)).

¹¹⁴ Christian Schumacher, Michael Horak, & Sascha Salomonowitz, *Austria: the Right Place for Effective IP Enforcement*, Mondaq Intellectual Property, (April 12, 2010), <http://www.mondaq.com/article.asp?articleid=97996>.

¹¹⁵ INT'L BAR ASS'N, *supra* note 8, at 16.

made to the Supreme Patent and Trademark Chamber, whose boards consist of a chair, two legal experts, and two technical experts.¹¹⁶

Belgium

Belgium has commercial courts which exclusively hear patent cases. Though it does not have specialized judges with technical backgrounds, Belgium has limited the number of courts in which patent infringement proceedings may be heard to the five courts of commerce.¹¹⁷ The government restricted the number of courts competent to hear patent disputes in order to achieve a level of specialization by the judges in these courts.¹¹⁸

Belarus

The Chamber for Intellectual Property Disputes for the Supreme Court of the Republic of Belarus is a specialized panel of judges that hears cases related to IPR.¹¹⁹ It is the court of first instance and has exclusive jurisdiction over IPR disputes, including appeals against decisions of the patent agency.¹²⁰

Croatia

Croatia has four commercial courts with jurisdiction over civil remedies in IPR cases (Commercial Courts in Zagreb, Rijeka, Osijek and Split).¹²¹

Czech Republic

The Municipal Court in Prague has jurisdiction over cases of IPR infringement, as well as other unspecified IPR matters.¹²² Regional courts have jurisdiction if infringement is claimed along with unfair competition.¹²³

Denmark

¹¹⁶ *Id.*

¹¹⁷ Pierre Sculier & Elisabeth Dehareng, *Belgium*, THE INTERNATIONAL COMPARATIVE LEGAL GUIDE TO PATENTS 2012: A PRACTICAL CROSS-BORDER INSIGHT INTO PATENT WORK 21 (2011), <http://www.iclg.co.uk/khadmin/Publications/pdf/4713.pdf>.

¹¹⁸ *Id.*; Christophe De Groote, *Enforcing Patents in Belgium*, PATENTS IN EUROPE: HELPING BUSINESS COMPETE IN THE GLOBAL ECONOMY 39 (August 2005), available at http://www.kirkpatrick.eu/medias/pdf/press/ENFORCING_PATENTS_IN_BELGIUM.pdf.

¹¹⁹ Belarus National Center for Intellectual Property, http://www.belgospatent.org.by/index.php?option=com_content&view=article&id=134&Itemid=54 (last visited December 10, 2011).

¹²⁰ *Id.*

¹²¹ UNITED NATIONS EDUCATIONAL, SCIENTIFIC, AND CULTURAL ORGANIZATION WORLD ANTI-PIRACY OBSERVATORY, CROATIA 9 (2009) http://www.unesco.org/culture/pdf/croatia_cp_en.

¹²² Zákon č. 221/2006 § 6 Sb. (Czech); Zákon č. 6/2002 § 39(2) Sb. (Czech); Lukas Lorenc, Czech Republic, PATENTS IN EUROPE 49 (2008), available at <http://www.iam-magazine.com/issues/complete.ashx?g=9ae4f4fd-cdf5-492c-997d-05574fbaf6c8>.

¹²³ EUROPEAN PATENT OFFICE, PATENT LITIGATION IN EUROPE: AN OVERVIEW OF THE NATIONAL PATENT LITIGATION SYSTEMS IN EUROPE 22, (2nd Ed., November 2010), http://www.ipfrontline.com/downloads/patent_litigation_in_europe_en.pdf.

Denmark has commercial courts which exclusively hear patent cases. Denmark's Maritime and Commercial Court has two departments, the court department and the administration of estate department.¹²⁴ The court department is the court of first instance for actions concerning patents, design and trademarks.¹²⁵ This includes invalidation lawsuits.¹²⁶ Cases are usually heard by one legally qualified judge assisted by two judges with technical expertise.¹²⁷ The Supreme Court, which is comprised of only legally qualified judges, is obligated to hear appeals.¹²⁸

Finland

The Helsinki District Court is a court of general jurisdiction with a specialized division that exclusively hears IPR cases. It is the court of first instance for most IPR cases and has exclusive jurisdiction over cases concerning patent infringement and invalidation.¹²⁹ It has a specialized division appointed for IPR matters. In patent cases, the judges are assisted by two technical experts that are appointed by the court but do not have voting rights.¹³⁰ In contrast to patent disputes, copyright disputes may be brought before any district court, and registration-related administrative proceedings are handled by the Board of Appeal of the National Board of Patents and Registration.¹³¹ In March 2010, Finland's ministry of Justice published a draft bill to move all civil IPR matters, including copyright and appeals against the IPR decisions of the National Board of Patents and Registrations, from the district courts to the Market Court in 2012.¹³² If the bill becomes law, most IPR cases will be overseen by three legally qualified judges, but in patent and utility model cases, a specialist engineer would also act as a judge and vote on the decision.¹³³

France

The Tribunal de Grande Instance de Paris is a court of general jurisdiction with a chamber that exclusively hears patent disputes. Patent litigation falls under the special jurisdiction of the court of first instance and court of appeal in Paris.¹³⁴ All cases in the first instance are

¹²⁴Danmark's Domstole, A Closer Look at the Courts of Denmark: Other Courts and Institutions, <http://www.domstol.dk/om/publikationer/HtmlPublikationer/Profil/A%20Closer%20Look%20at%20the%20Courts%20of%20Denmark/kap03.htm> (last visited December 10, 2011).

¹²⁵ *Id.*; EUROPEAN PATENT OFFICE, *supra* note 123, at 27.

¹²⁶ EUROPEAN PATENT OFFICE, *supra* note 123, at 27.

¹²⁷ Claus Elmeros & Louise Aagaard, *Denmark*, PATENTS IN EUROPE 2010-11 28 (2010), <http://www.iam-magazine.com/issues/Article.ashx?g=45f518c5-44f2-4d40-b78a-517f299d582e>.

¹²⁸ *Id.*

¹²⁹ Patent Act, No. 550 of December 15 1967 as amended, § 65 (Finland); INT'L BAR ASS'N, *supra* note 8, at 12.

¹³⁰ EUROPEAN PATENT OFFICE, *supra* note 123, at 35-36.

¹³¹ Ella Mikkola & Risto Sandvik, *Finland: Proposal to Establish New Intellectual Property Court*, Bird & Bird (November 8, 2010), http://www.twobirds.com/English/News/Articles/Pages/Finland_to_establish_new_IP_Court.Aspx.

¹³²Marko Rajaniemi, Market Moves: Centralising IP Cases, WORLD INTELLECTUAL PROPERTY REVIEW 80 (September 2010) <http://content.yudu.com/A1p2i2/WIPRSep-Oct2010/resources/80.htm>.

¹³³ *Id.*

¹³⁴Code de la Propriete Intellectuelle [Intellectual Property Code], 1992 as updated, Articles L. 615-17 (France); Herbert Lewitter, Luc Santarelli, Thierry Caen & Bruno Quantin, France, PATENTS IN EUROPE 2010-11 36 (2010), <http://www.iam-magazine.com/issues/article.ashx?g=cec89a12-c0ea-485f-b386-f53ae5dc60bf&q=france+court#search=%22france+court%22>.

handled by the third chamber of the Tribunal de Grande Instance de Paris.¹³⁵ This chamber has four three judge sections which handle only IPR cases.¹³⁶ Two panels of three judges specializing in IPR law handle appeals.¹³⁷ French judges generally are professional judges with no technical qualifications, but they are well versed in IPR law.¹³⁸

Germany

Each German state has district courts competent for hearing patent actions¹³⁹ that have specialized patent infringement chambers to handle all patent infringement cases.¹⁴⁰ As a result of the high number of infringement actions, the competent courts handle patent infringement cases almost exclusively, and the standard of expertise is high.¹⁴¹ Appeal courts have specialized senates with a bench of three judges.¹⁴² Appeals may be made to the Federal Supreme Court, which is composed of five experienced judges selected from the most able patent judges.¹⁴³

Germany also has administrative tribunals that exclusively hear IPR cases. Patent divisions at the German Patent and Trademark Office have competence for opposition proceedings.¹⁴⁴ The divisions are made up of three technical members and sometimes a legal member if there is a legal difficulty.¹⁴⁵ Under certain conditions the Appeal Chamber of the Federal Patent Court, which is made up of three technical members and one legal member may decide on the opposition.¹⁴⁶ The Federal Patent Court is an independent federal court for hearing appeals from decisions of the Examining Sections or Patent Divisions of the German Patent and Trademark Office, actions for declaration of nullity, and compulsory licenses.¹⁴⁷

¹³⁵ Pierre Veron & Isabelle Romet, *On the Way to Fair Balance, The French Approach to Patent Litigation*, Who's Who Legal (May 2011), <http://www.whoswholegal.com/news/features/article/28961/on-fair-balance-french-approach-patent-litigation>.

¹³⁶ *Id.*

¹³⁷ *Id.*

¹³⁸ Lewitter, Santarelli, Caen, & Quantin, *supra* note 134.

¹³⁹ The competent courts, with districts in parentheses, are: LG Mannheim (Baden-Württemberg); LG Munich I and LG Nuremberg-Fürth (Bavaria); LG Berlin (Berlin, Brandenburg), LG Hamburg (Bremen, Hamburg, Mecklenburg-Western Pomerania, Schleswig Holstein), LG Düsseldorf (North Rhine-Westphalia); LG Frankfurt (Hessen, Rhineland-Palatinate); LG Braunschweig (Lower Saxony); LG Leipzig (Saxony); LG Magdeburg (Saxony-Anhalt); LG Erfurt (Thuringia); and LG Saarbrücken (Saarland). EUROPEAN PATENT OFFICE, *supra* note 123, at 23.

¹⁴⁰ Bernd Allekotte & Ulrich Blumenroder, *Germany, PATENTS IN EUROPE 2010-11* 41 (2010), <http://www.iam-magazine.com/issues/article.ashx?g=96ec6fd8-9297-40d3-854e-0193f296ecbf&q=germany+court#search=%22germany+court%22>.

¹⁴¹ *Id.*

¹⁴² INT'L BAR ASS'N, *supra* note 8, fn. 37.

¹⁴³ *Id.*

¹⁴⁴ Patentgesetz [Patent Law], December 16, 1980 as amended BGBI I, § 61 (Germany); EUROPEAN PATENT OFFICE, *supra* note 123, at 23.

¹⁴⁵ EUROPEAN PATENT OFFICE, *supra* note 123, at 23.

¹⁴⁶ Patentgesetz [Patent Law], December 16, 1980 as amended BGBI I, § 61(2) (Germany); EUROPEAN PATENT OFFICE, *supra* note 123, at 23.

¹⁴⁷ Patentgesetz [Patent Law], December 16, 1980 as amended BGBI I, § 65(1) (Germany); EUROPEAN PATENT OFFICE, *supra* note 123, at 23.

Hungary

The Metropolitan Court of Budapest is a court of general jurisdiction which has exclusive jurisdiction as the court of first instance in patent and trademark infringement actions.¹⁴⁸ The Court has a special division known as the Court Special Council, composed of a three judge panel where at least two judges must have a technical degree, which handles the cases.¹⁴⁹ Trademark infringement proceedings are under the exclusive competence of the Metropolitan Court of Budapest.¹⁵⁰ County courts are competent to hear actions for copyright infringement.¹⁵¹

Italy

Italy has courts of general jurisdiction with specialized divisions that exclusively hear IPR disputes at both the trial and appeals levels. Twelve trial and appeals courts have specialized sections that deal exclusively with IPR disputes.¹⁵² In each of these courts there is a specialized IPR division with judges that only hear IPR cases.¹⁵³ First instance decisions can always be appealed to the IPR Division of the Court of Appeal.¹⁵⁴ Appeals are handled by a panel of three judges within specialist divisions of twelve courts of appeal.¹⁵⁵

Iceland

The Reykjavik City Court has exclusive jurisdiction over all patent cases, including verification cases following injunctions.¹⁵⁶ Though increasing, the number of patent cases tried in Iceland is very low, so judicial expertise is limited.¹⁵⁷ Courts can call on experts to assist them with specific cases.¹⁵⁸

Ireland

¹⁴⁸ Gabor Faludi & Gusztav Bacher, *Hungary*, PATENTS IN EUROPE 2008 74 (2008), <http://www.iam-magazine.com/issues/article.ashx?g=70421fec-3892-48e3-a97a-b5e89b9c9aaa&q=hungary+court#search=%22hungary+court%22>.

¹⁴⁹ *Id.*

¹⁵⁰ Georg Pintz and Partners, Trademark Litigation, <http://www.hupatent.com/litigationTrademark.php> (last visited December 12, 2011).

¹⁵¹ Gyula Almasi, Hungary Customs Country Report (2010), http://www.google.com/url?sa=t&rct=j&q=&esrc=s&source=web&cd=2&ved=0CC8QFjAB&url=http%3A%2F%2Fwww.oapi.wipo.net%2Fedocs%2Fmdocs%2Fmdocs%2Fen%2Fwipo_ipr_prg_10%2Fwipo_ipr_prg_10_re_hungary.doc&ei=RenkTuyOFCiz0QG67_mLBg&usg=AFQjCNGc6ZOWtcn1pnvJqyWmoaXXn9xYpA.

¹⁵² These Courts are located in Bari, Bologna, Catania, Florence, Genoa, Milan, Naples, Palermo, Rome, Turin, Trieste and Venice. Legislative Decree No. 168/2003, June 27, 2003, Gazz. Uff. 159 July 11, 2003 (Italy).

¹⁵³ EUROPEAN PATENT OFFICE, *supra* note 123, at 55.

¹⁵⁴ Rossella Solveni & Giuseppe Mercurio, *Italy*, PATENTS IN EUROPE 2011-12 69 (2011), <http://www.iam-magazine.com/issues/article.ashx?g=63ad3129-937b-40c7-99bc-ad126885883a&q=italy+court#search=%22italy+court%22>.

¹⁵⁵ EUROPEAN PATENT OFFICE, *supra* note 123, at 55.

¹⁵⁶ Gunnar Orn Hardarson & Asdis Magnusdottir, Iceland, PATENTS IN EUROPE 2011-12 61 (2011), available at <http://www.iam-magazine.com/issues/article.ashx?g=aa0d7c9b-9713-4db9-913fe7c9f08e84fd&q=iceland#search=%22iceland%22>; Patents Act, No. 17/1991, Art. 64 (2007).

¹⁵⁷ *Id.*

¹⁵⁸ *Id.*

Ireland's High Court has a commercial division which exclusively hears IPR cases. European patents may only be enforced by petition to the High Court in civil proceedings.¹⁵⁹ The Chancery Division of the High Court handles infringement proceedings.¹⁶⁰ A special section of the High Court, known as the Commercial Court, is empowered to hear commercial disputes of high value and all IPR cases.¹⁶¹ Either party to a dispute may transfer the case to the Commercial Court by application.¹⁶² Judges in Commercial Court cases manage the litigation and impose short deadlines, allowing the court to fast-track disputes.¹⁶³

Lithuania

The Vilnius Country Court is a court of first instance with exclusive jurisdiction over disputes concerning the Law of Trademarks.¹⁶⁴ It is also exclusively responsible for disputes regarding decisions of the Appeals Division of the State Patent Bureau; assignment of a patent application or patent ownership to a different person; invalidation of a granted patent in full or in part; infringement of a patent application for which temporary protection is granted; infringement of a granted patent; declaration of non-infringement of a patent; granting, revocation and change of conditions of the licenses referred to as compulsory licenses;¹⁶⁵ and revocation of a patent.¹⁶⁶

Luxembourg

Luxembourg has recently established a specialized IPR division in Luxembourg District Court, a court of general jurisdiction. As a component of its implementation of the EU IP Rights Enforcement Directive (2004/48/EC), Luxembourg centralized competence for patent enforcement in the Luxembourg District Court.¹⁶⁷ There is a special tribunal for IPR cases.¹⁶⁸

Former Yugoslav Republic of Macedonia

¹⁵⁹ Yvonne McKeown, *Ireland*, PATENTS IN EUROPE 2011-12 65 (2011), <http://www.iam-magazine.com/issues/article.ashx?g=d3962316-a0a2-4a0d-9c75-84112bea8dd1&q=ireland+court#search=%22ireland+court%22>.

¹⁶⁰ *Id.*

¹⁶¹ *Id.*

¹⁶² *Id.*

¹⁶³ *Id.*

¹⁶⁴ Jurisdiction of the Courts – Lithuania, EUROPEAN COMMISSION, http://ec.europa.eu/civiljustice/jurisdiction_courts/jurisdiction_courts_lit_en.htm (last visited Dec. 12, 2011).

¹⁶⁵ Law on Patents, No. I-372, Art. 38 (1994).

¹⁶⁶ Law on Patents, Art. 40; EUROPEAN PATENT OFFICE, *supra* note 123, at 61

¹⁶⁷ Didier Lecomte & Jean-Luc Dascotte, *Luxembourg*, PATENTS IN EUROPE 2010-11 57 (2011), <http://www.iam-magazine.com/issues/article.ashx?g=566a633c-acdc-4366-b9ed-7bc4b5913437&q=Luxembourg+court#search=%22Luxembourg+court%22>.

¹⁶⁸Emmanuelle Ragot, *Luxembourg*, THE INTERNATIONAL COMPARATIVE LEGAL GUIDE TO PATENTS 2012: A PRACTICAL CROSS-BORDER INSIGHT INTO PATENT LAW 84 (2011).

http://www.iclg.co.uk/index.php?area=4&country_results=1&kh_publications_id=206&chapters_id=4724.

There are specialized departments in 13 courts of first instance that have extended competence in the area of IPR.¹⁶⁹

Netherlands

The Hague District Court and Court of Appeal have specialized IPR divisions with exclusive jurisdiction over patents, plant breeders' rights, Community trademarks and Community design rights, neighboring rights royalties, private copying charge scheme, and integrated circuit topography law at the first and second instance.¹⁷⁰ The IPR Division has an accelerated procedure for patent proceedings, which take between 12 and 15 months.¹⁷¹ The Court hears both full proceedings, in which judges sit in panels of three, and preliminary injunctions, in which judges sit alone.¹⁷² The vast majority of patent cases heard are combined validity and infringement proceedings.¹⁷³ The Dutch system has a unique interim injunction proceeding called a "Kort gelding" proceeding which is an expedited, informal preliminary procedure before a senior patent judge, and the court is not bound by such decisions in full proceedings.¹⁷⁴

Norway

The Oslo District Court has exclusive jurisdiction over disputes involving cancellation of patents; annulment of decisions of the Second Division of the Patent Office to reject applications for patent registration; transfer of patents to an alleged rightful owner; judicial review of the Second Division's decisions in administrative limitation and re-examination cases; trademark disputes regarding denial of registration and cancellation of invalid registration; and design disputes regarding title to design, denial of registration, and cancellation of invalid registration.¹⁷⁵ Infringement cases can be heard by other district courts.¹⁷⁶ The Oslo District Court has developed a level of expertise in patent cases, because patent cases are normally allocated to one of five or six judges who are interested in these cases and have experience with them.¹⁷⁷

Portugal

¹⁶⁹ EUROPEAN PATENT OFFICE, *supra* note 123, at 71.

¹⁷⁰ *Id.* at 75.

¹⁷¹ E-mail from Robert van Peursem, Senior Judge, District Court The Hague, to Cameron Coffey, Program Attorney, International Intellectual Property Institute (Dec. 13, 2011, 06:00 EST) (on file with author).

¹⁷² Bas Pinckaers and Ricardo Dijkstra, *Netherlands*, in THE INTERNATIONAL COMPARATIVE LEGAL GUIDE TO: PATENTS 2012 103, 103 (2012), available at http://www.iclg.co.uk/index.php?area=4&country_results=1&kh_publications_id=206&chapters_id=4727.

¹⁷³ *Id.*

¹⁷⁴ Robert van Peursem, *supra* note 171.

¹⁷⁵ Amund Brede Svendson & Svein Ruud Johansen, Norway, PATENTS IN EUROPE 2010-11 65 (2010), available at <http://www.iam-magazine.com/issues/article.ashx?g=c16bd0cc-27c7-4634-ac22-441568be3e91&q=norway+court#search=%22norway+court%22>.

¹⁷⁶ *Id.*

¹⁷⁷ *Id.*

Portugal Law No. 46/2011 establishes a specialized IPR court.¹⁷⁸ The court will have competence over actions on copyright and related rights, actions on industrial property, appeals against decisions of the Portuguese Patent and Trademark Office (INPI), actions on domain names, appeals against decisions of the Portuguese NIC Authority (FCCN), actions on firms or corporate names; appeals against decisions of the National Register of Companies (RNPC), actions on acts of unfair competition in the field of industrial property, and interim measures of obtaining and preserving evidence and to provide information under the protection of IPR.¹⁷⁹ The court will also serve as a Community trademark and Community design court.¹⁸⁰ It was planned that the court would be installed in September 2011, but it is now unclear when it will happen.¹⁸¹

Romania

Romania has specialized tribunals of judges that hear cases involving IPR that sit in county courts and courts of appeal.¹⁸² Romanian Tribunals are courts seated in each county.¹⁸³ The High Court has sections for civil and IPR, criminal cases, commercial cases, and cases of administrative and financial disputes.¹⁸⁴

Russia

On November 29, 2011, Russia's Council of the Federation approved two bills establishing a specialized commercial court that will exclusively hear IPR disputes. The "Patent Court" is scheduled to begin operations by February 2013.¹⁸⁵ Normal commercial courts will hear IPR infringement cases at first instances and the first appeal stage.¹⁸⁶ The new IPR court will have competence over the second appeal stage in infringement cases.¹⁸⁷ The IPR court will be the court of first instance for cases involving the granting or termination of IPR, excluding copyright, and will be the first appeal stage for Patent Office decisions.¹⁸⁸

¹⁷⁸ Baptista, Monteverde, & Associados, *Specialised IP Court in Portugal*, Border Measures, <http://www.bordermeasures.com/spip.php?article200> (last visited December 20, 2011).

¹⁷⁹ *Id.*

¹⁸⁰ *Id.*

¹⁸¹ Pedro Malaquias, *Portugal: the Creation of an IP Court II*, Marques Class 46 (June 29, 2011), http://www.marques.org/Class46/Article.asp?D_A=20110629&XID=BHA2436.

¹⁸² European Judicial Network in Civil and Commercial Matters, Jurisdiction of the Courts- Romania, http://ec.europa.eu/civiljustice/jurisdiction_courts/jurisdiction_courts_rom_en.htm (last visited December 11, 2011) (citing Codul de Procedura Civila [Code of Civil Procedure] December 11, 1965 as amended, Art. 2 (Romania)).

¹⁸³ Enescu and Cuc, Overview of Romanian Courts, <http://www.romanianlawoffice.com/courts-romania.htm> (last visited December 11, 2011).

¹⁸⁴ Laurentiu Pachi & Adriana Dobre, Romania, THE INTERNATIONAL COMPARATIVE LEGAL GUIDE TO LITIGATION AND DISPUTE RESOLUTION 2011: A PRACTICAL CROSS-BORDER INSIGHT INTO LITIGATION AND DISPUTE RESOLUTION 214 (2010),

http://www.iclg.co.uk/index.php?area=4&country_results=1&kh_publications_id=181&chapters_id=4298.

¹⁸⁵ Maxim A. Voltchenko, "Russia: Specialized IP Court Will Be Introduced in 2013," 67 INTABULLETIN No. 6, March 15, 2012, available online at <http://www.inta.org/INTABulletin/Pages/RUSSIASpecializedIPCourtWillBeIntroducedin2013.asp>.

¹⁸⁶ COALITION FOR INTELLECTUAL PROPERTY RIGHTS, THE IPREPORT 1-2 (Spring 2011)

http://www.cipr.org/files/IPReports/CIPR_The_IPReport_Spring2011.pdf.

¹⁸⁷ *Id.*

¹⁸⁸ *Id.*

Specifically, the court will consider validity of the Patent Office decisions taken after examining appeals against the grant of patents, trademarks, etc; validity of the Patent Office decisions taken after examining appeals against the grant of patents, trademarks, etc; appeals of the decisions of the body authorized to examine applications for plant and animal varieties; validity of other decisions taken by the above bodies; and disputes concerning ownership of patents.¹⁸⁹

Slovakia

Slovakia has courts of general jurisdiction that exclusively hear IPR cases. The district courts in Bratislava, Banská Bystrica and Košice are competent to hear IPR cases, and the regional courts in Bratislava, Banská Bystrica and Košice are the courts of second instance.¹⁹⁰

Slovenia

Slovenia has courts of general jurisdiction which hear most IPR cases. The district court in Ljubljana has exclusive jurisdiction at first instance over cases concerning IPR, except for disputes between employers and workers in connection with inventions, forms of bodies, pictures, drawings and technical improvements.¹⁹¹ The judges are professional judges and do not have expert knowledge, but they are able to appoint experts.¹⁹²

Sweden

The Stockholm City Court is a court of general jurisdiction with exclusive jurisdiction over patent cases¹⁹³ and Community trademarks.¹⁹⁴ One chamber handles all IPR cases, and some judges are specialized in IPR.¹⁹⁵ Appeals are heard by Svea Appeal Court in Stockholm.¹⁹⁶ The courts have special departments for IPR cases made up of legally trained judges and technical experts.¹⁹⁷ The Court of Patent Appeals addresses disputes on decisions made by the Swedish Patent and Registration Office in matters of patents, trademarks, designs, personal names and authorizations to publish periodicals, as well as

¹⁸⁹ Martha L. Arias, *Internet Law: Patent Courts in Russia by 2012*, INTERNET BUSINESS LAW SERVICES (May 2, 2011), https://ibls.com/internet_law_news_portal_view.aspx?s=latestnews&id=2424.

¹⁹⁰Andrea Povatanova, *Slovak Republic*, PATENTS IN EUROPE 2008 102 (2008), <http://www.iam-magazine.com/issues/article.ashx?g=02af8783-1fd0-4f29-9f52-0f04e60df40b>.

¹⁹¹ Intellectual Property Act ZIL-1-UPB3 of May 23, 2001 as amended, Art. 121 (Slovenia); Maja Carni and Spela Kosak, *A Guide to the Republic of Slovenia Legal System and Legal Research*, Hauser Global Law School Program (September 2006), <http://www.nyulawglobal.org/globalex/slovenia.htm>.

¹⁹² Nina Selih and Luka Grasselli, *Slovenia*, PATENTS IN EUROPE 2010-11 73 (2010), <http://www.iam-magazine.com/issues/article.ashx?g=46663aa6-1ee2-4e92-99e1-9394e552665c&q=slovenia#search=%22slovenia%22>.

¹⁹³ EUROPEAN PATENT OFFICE, *supra* note 123, at 91.

¹⁹⁴ Eric Alvsing & Karolina Martensson, Sweden: Protection and Enforcement of IP Rights, IP VALUE 2006 (2006), http://www.vinge.se/upload/bocker_artiklar/p.263-266_Vinge.pdf.

¹⁹⁵ EUROPEAN PATENT OFFICE, *supra* note 123, at 91.

¹⁹⁶ *Id.*

¹⁹⁷ Patents Act No. 837 of 1967 as amended, § 66 (Sweden); Peter Kenamets & Fabian Edlund, *Sweden*, PATENTS IN EUROPE 2011-12 97 (2011), <http://www.iam-magazine.com/issues/article.ashx?g=fb83703e-df45-4a8a-8fb0-5db500fbab81&q=sweden#search=%22sweden%22>.

decisions by the Board of Agriculture in matters of plant varieties.¹⁹⁸ Appeals may be made to the Supreme Administrative Court.¹⁹⁹

Switzerland

Switzerland currently has commercial courts that have exclusive jurisdiction in IPR matters and is planning to implement a specialized IPR court. Switzerland has created a Federal Patent Court of First Instance that began hearing cases in January 2012.²⁰⁰ The court will have both legal and technical judges.²⁰¹ Currently, Swiss law requires that each court designate a competent court for hearing patents.²⁰² Four of the 26 designated courts are commercial courts located in Argovia, Berne, St Gaul and Zurich, which hear the majority of patent cases and have experience in this area.²⁰³

Turkey

Civil cases involving IPR can be brought to Turkey's specialized IPR courts in Ankara, Istanbul and Izmir and to the general civil courts of first instance where specialized IPR courts do not exist.²⁰⁴ Criminal IPR cases can be brought to Turkey's specialized IPR courts in Ankara, Istanbul and Izmir and to the general criminal court of first instance where specialized IPR criminal courts do not exist.²⁰⁵ Turkey has a total of 23 specialized courts: 7 civil and 7 criminal in Istanbul, 4 civil and 2 criminal in Ankara, and 1 civil and 2 criminal in Izmir.²⁰⁶ The Eleventh Civil Chamber of the Supreme Courts examines appeals to IPR civil decisions and the Seventh Criminal Chamber examines appeals to IPR criminal decisions.²⁰⁷ The judges at the specialized courts are trained in IPR disputes but do have technical expertise.²⁰⁸ In patent cases, the court usually appoints a panel of independent experts usually comprised of three professionals.²⁰⁹

¹⁹⁸ The Swedish Court System, <http://ulr.unidroit.org/mm/TheSwedishJudicialSystem.pdf> (last visited December 11, 2011); Patentbesvarsratten: Patent Court of Appeals, Welcome to the Patent Court of Appeals, <http://www.pbr.se/english.htm> (last visited December 11, 2011).

¹⁹⁹ The Swedish Court System, *supra* note 198.

²⁰⁰ Isabeelle Eichenberger, "New Court Aims to Cut Through Patent Nonsense," http://www.swissinfo.ch/eng/business/New_court_aims_to_cut_through_patent_nonsense.html?cid=31951096, January 16, 2012; Regula Ruedi & Rainer Schalch, *Switzerland*, PATENTS IN EUROPE 2011-12 101 (2011), <http://www.iam-magazine.com/issues/article.ashx?g=c926b786-8248-41f5-88b8-fb066efa0e8b&q=switzerland#search=%22switzerland%22>.

²⁰¹ *Id.*

²⁰² EUROPEAN PATENT OFFICE, *supra* note 123, at 15.

²⁰³ *Id.*

²⁰⁴ *Id.* at 99.

²⁰⁵ *Id.*

²⁰⁶ REPUBLIC OF TURKEY GENERAL DIRECTORATE OF AGREEMENTS, PROTECTION OF INTELLECTUAL PROPERTY RIGHTS IN TURKEY at 1-2 (February 2011), <http://user1927995.sites.myregisteredsite.com/sitebuildercontent/sitebuilderfiles/2011republicofturkeyundersecretariatforforeigntrade.pdf>.

²⁰⁷ EUROPEAN PATENT OFFICE, *supra* note 123, at 99.

²⁰⁸ Ersin Deriligiil and Otay Simsek, *Turkey*, PATENTS IN EUROPE 2011-12 105 (2011), <http://www.iam-magazine.com/issues/article.ashx?g=da95625c-e548-443c-a405-0d7816cdf725&q=turkey#search=%22turkey%22>.

²⁰⁹ *Id.*

European Union

The European Union is considering implementing a specialized division within the European Court of Justice to hear patent disputes. The European Union has proposed the establishment of the “Community Patent Court,” a judicial panel within the Court of Justice that would have jurisdiction at the first instance over disputes relating to the Community patent.²¹⁰ Appeals by decision of the panel could be heard by a Patent Appeal Chamber within the court of first instance.²¹¹ The European Patent Organization is also working to create a European Patent Court and a European Patent Court of Appeal that would have exclusive jurisdiction over proceedings related to validity and infringement of European Patents in any of the protocol countries.²¹² National courts would retain jurisdiction over interlocutory injunctions and other provisional matters.²¹³ The European Patent Court would be comprised of a Court of First Instance that has a Central Division and several Regional Divisions, along with a court of Appeal.²¹⁴ The European Appeal Court would act as a “Facultative Advisory Council.”²¹⁵

The Court of Justice of the European Union handed down a judgment in March 2011 stating that the proposed court was incompatible with European Union law, because such a court would deprive the courts of contracting countries power related to the interpretation of European Union law.²¹⁶ The Hungarian EU Council presidency published a revised version of the draft agreement on the European and EU Patents Court on what is now called the “Unified Patent Court.”²¹⁷ The UPC will comprise a Court of First Instance, a Court of Appeal and a Registry.²¹⁸ The Court of First Instance will have a central division and local and regional divisions in the protocol countries.²¹⁹

²¹⁰Europa: Summaries of EU Legislation, Establishment of the Community Patent Court, http://europa.eu/legislation_summaries/internal_market/businesses/intellectual_property/l26056a_en.htm (last visited December 11, 2011); Commission of the European Communities, PROPOSAL FOR A COUNCIL DECISION CONFERRING JURISDICTION ON THE COURT OF JUSTICE IN DISPUTES RELATING TO THE COMMUNITY PATENT 6, COM (2003) 827 final; Commission of the European Communities, PROPOSAL FOR A COUNCIL DECISION ESTABLISHING THE COMMUNITY PATENT COURT AND CONCERNING APPEALS BEFORE THE COURT OF FIRST INSTANCE 6-9, COM (2003) 828 final.

²¹¹Europa: Summaries of EU Legislation, *supra* note 210.

²¹² *Id.*

²¹³ *Id.* See generally European Patent Office, epo.org (last visited December 11, 2011).

²¹⁴ Europa: Summaries of EU Legislation, *supra* note 210.

²¹⁵ *Id.*

²¹⁶Jeff Wold, *European Patent Court Breakthrough as Commission Plans for First EU Patent Grants in 2013*, Intellectual Asset Management Blog (June 3, 2011) <http://www.iam-magazine.com/blog/detail.aspx?g=3e360316-3cc6-4d23-9ecd-c7391944b655&q=european+union#search=%22european+union%22>; Jim Singer, *EU High Court Says Single European Community Patent Court Would Break Law*, IP Spotlight (March 9, 2011), <http://ipsspotlight.com/2011/03/09/eu-high-court-says-single-european-community-patent-court-would-break-law/>.

²¹⁷ European Patent Office, Unitary Patent/EU Patent, <http://www.epo.org/law-practice/legislative-initiatives/eu-patent.html> (last updated November 15, 2011).

²¹⁸ *Id.*

²¹⁹ *Id.*

10. Middle East and North Africa

	Specialized IPR Trial Court	Specialized IPR Appeals Court	Specialized IPR Trial Division	Specialized IPR Appeals Division	Commercial Trial Court	Commercial Appeals Court	Trial Court that exclusively hears IP	Appeals Court that exclusively hears IP	Administrative Tribunal	Specialized IP judges on court of general jurisdiction	Considering IP Court/Division/Tribunal	Considering Commercial court
Egypt				•						•		
Iran							•	•				
Iraq				•								
Israel										•		
Jordan										•		
Morocco				•	•							
Saudi Arabia				•				•				
Syria												
United Arab Emirates										•		

Egypt

Egypt has commercial courts that hear IPR cases in addition to other business disputes. In 2008, Egypt established economic courts with jurisdiction over listed economic and commercial matters, including those involving IPR.²²⁰ The economic court has original jurisdiction over criminal proceedings arising out of the law governing IPR.²²¹ IPR cases are heard by judges specially trained in IPR.²²²

Iran

Iran has courts to which some IPR matters must be brought. Appeals from rejections of Patent Office and Trademark Office decisions must be made to the General Court of Tehran.²²³ Other disputes implicating IPR laws are within the jurisdiction of designated sections of the General Court of Tehran.²²⁴ When a Minister of a relevant government agency determines a compulsory license may be necessary for the public interest or because of anti-competitive behavior by the patentee or his licensees, the matter is adjudicated by a committee made up of the Head of the State Organization for the Regulation of Deeds and Properties, a Supreme Court Justice, and the Prosecutor General.²²⁵

Iraq

²²⁰ See Int'l Trade Admin., U.S. Dep't. of Commerce, IPR Toolkit Egypt, STOPFAKES.GOV, http://www.stopfakes.gov/toolkits/egypt_toolkit.asp (last visited Dec. 5, 2011). See generally Law No. 120 of 2008 (Law on the Creation of Economic Courts), Al-Jarida Al-Rasmiyya, 22 May 2008 (Egypt).

²²¹ TAREK FOUAD RIAD, KOSHERI, RASHED & RIAD, LITIGATION IN EGYPT IN COMMERCIAL MATTERS 8 (2006).

²²² INT'L INTELLECTUAL PROP. ALLIANCE, EGYPT: 2010 SPECIAL 301 REPORT ON COPYRIGHT PROTECTION AND ENFORCEMENT 173-175 (2010), available at <http://www.iipa.com/rbc/2010/2010SPEC301EGYPT.pdf>.

²²³ Patents, Industrial Designs, and Trademarks Registration Act of the Islamic Republic of Iran, 2008, Art. 17(i).

²²⁴ *Id.* at Art. 59.

²²⁵ *Id.* at Art. 17.

Iraq has commercial courts that hear IPR cases in addition to other business disputes. The Commercial Court was established in 2010 and has jurisdiction over cases arising in Baghdad province that involve trademarks and IPR.²²⁶ The Higher Judicial Council is considering establishing commercial courts in other provinces.²²⁷

Israel

Israel has specialist judges with expertise in IPR cases. Although district courts do not have official branches specialized in IPR cases, patent cases will typically be heard by judges with experience in patents.²²⁸ The Israeli government has been commended for its efforts in continuing legal education programs and other awareness programs for its judges.²²⁹

Jordan

Jordan has specialist judges with expertise in IPR cases. The Judicial Council has assigned a specialized IPR judge in the court of first instance.²³⁰ Specialized IPR training programs are also coordinated for judges.²³¹

Morocco

Morocco has commercial courts that hear IPR cases in addition to other business disputes. Morocco's commercial courts and commercial courts of appeal have exclusive jurisdiction over criminal and civil infringement cases violating the Law on the Protection of Industrial Property.²³² Currently, there are eight commercial courts and three commercial courts of appeals in Morocco.²³³ The government is considering the creation of new commercial courts in the near future.²³⁴ Decisions of commercial courts may be appealed to the Commercial Court of Appeal and then on to the Supreme Court.²³⁵ Increasingly, judges in commercial courts are hearing cases related to IPR and have undergone training to improve their understanding of these issues.²³⁶

²²⁶ U.S. DEPT. OF STATE, IRAQ STATUS REPORT 2 (2011), available at <http://www.state.gov/documents/organization/158784.pdf>.

²²⁷ *Id.*

²²⁸ INT'L BAR ASS'N, *supra* note 8

²²⁹ See, e.g., WORLD INT'L PROP. ORG., THE PROTECTION OF INTELLECTUAL PROPERTY RIGHTS IN ISRAEL 19, 25 (2004).

²³⁰ WORLD ANTI PIRACY OBSERVATORY, UNESCO, JORDAN 15 (2009), available at

http://www.unesco.org/new/fileadmin/MULTIMEDIA/HQ/CLT/diversity/pdf/WAPO/jordan_cp_en.pdf.

²³¹ Elizabeth Mirza Al-Dajani, *Post Saddam Restructuring of Intellectual Property Rights in Iraq Through a Case Study of Current Intellectual Property Practices in Lebanon, Egypt, and Jordan*, 6 J. MARSHALL REV. INTELL. PROP. L. 250, 267 (2007).

²³² Protection of Industrial Property Act, Dahir No. 1-00-91, Feb. 15, 2000, Art. 15 (Morocco). See also Dahir No. 1-97-65, Feb. 12, 1997, Art. 5 (Morocco).

²³³ ARAB CENTER FOR THE DEVELOPMENT OF THE RULE OF LAW AND INTEGRITY, NATIONAL REPORT ON THE STATE OF THE JUDICIARY IN THE KINGDOM OF MOROCCO 5 (2004).

²³⁴ *Id.*

²³⁵ WORLD TRADE ORG., CHECK-LIST OF ISSUES ON ENFORCEMENT: REPLIES FROM MOROCCO 1 (2001), available at <http://www.google.com/url?sa=t&rct=j&q=&esrc=s&source=web&cd=7&ved=0CEgQFjAG&url=http%3A%2F%2Fwww.wtcenter.org.tw%2FSmartKMS%2Ffileviewer%3Fid%3D34899&ei=Qv3YTtz8BOHi0gG67KjBDQ&usg=AFQjcNGFQCG5b-KjNFMQ4DFyMb2e81X2Sg>.

²³⁶ See, e.g., USAID, Improved Understanding of Trademark Law Render Judgments More Promptly, USAID MOROCCO, http://www.usaid.gov/ma/programs/eg_stories_adrj.html (last visited Dec. 5, 2011).

Saudi Arabia

Saudi Arabia has administrative courts that hear IPR cases in addition to other disputes. The Board of Grievances, an independent administrative judicial board in Saudi Arabia,²³⁷ has jurisdiction over commercial disputes,²³⁸ including IPR matters.²³⁹ The Minister of Culture and Information of Saudi Arabia also established a committee to review violations of copyright law.²⁴⁰ The committee consists of at least three members, including a legal advisor and a Shari'ah advisor.²⁴¹ Committee decisions are made by majority and endorsed by the Minister of Culture and Information.²⁴²

Syria

Syria has a court of general jurisdiction with a specialized division that exclusively hears IPR cases. Article 119 of the Trademark and Design Law of 2007 established a specialized court dedicated to settling IPR cases and regulating IPR agents in Syria.²⁴³ One chamber of the first instance court examines all IPR disputes.²⁴⁴ The designated chamber of the civil court of Damascus hears appeals to decisions of the Directorate of Commercial and the Industrial Property and the Committee which examines objections to the Directorate's decisions.²⁴⁵ However, UNESCO reports that civil and summary courts hear copyright disputes.²⁴⁶

In 2008, Syria introduced a new draft patent law that is awaiting ratification by its respective government officials.²⁴⁷ According to the draft patent law, a chamber at the first instance civil court of Damascus is assigned to settle all IPR disputes. Disputes are then appealed to a civil court of appeal.

United Arab Emirates

²³⁷ Abdullah F. Ansary, *A Brief Overview of the Saudi Arabian Legal System*, GLOBALEX (JULY 2008),

HTTP://WWW.NYULAWGLOBAL.ORG/GLOBALEX/SAUDI_ARABIA.HTM#_EDNREF177.

²³⁸ Bureau of Economic, Energy and Business Affairs, 2011 Investment Climate Statement – Saudi Arabia, U.S. DEPT. OF STATE (March 2011), <http://www.state.gov/e/eeb/rls/othr/ics/2011/157351.htm>.

²³⁹ See, e.g., The Law of Trade Names, Royal Decree No. M/15, 12 Sa'ban 1420, Art. 18, Nov. 20, 1999 (Saudi Arabia); Law of Patents, Layout Designs of Integrated Circuits, Plant Varieties, and Industrial Designs; Copyright Law, Royal Decree No. M/41, 2 Rajab 1424, Art. 23, Aug. 30, 2003 (Saudi Arabia).

²⁴⁰ Copyright Law, Royal Decree No. M/41, 2 Rajab 1424, Art. 25, Aug. 30, 2003 (Saudi Arabia). See also WORLD ANTI PIRACY OBSERVATORY, UNESCO, SAUDI ARABIA 13 (2009), available at http://www.unesco.org/culture/pdf/saudiarabia_cp_en.

²⁴¹ WORLD ANTI PIRACY OBSERVATORY, *supra* note 240, at 13.

²⁴² *Id.*

²⁴³ Trademarks, Geographical Indications and Industrial Designs and Models, Law No. 8, March 12, 2007, Art. 119 (Syria). See also Hala Shamwali, Syria: New Intellectual Property Law, INTERNATIONAL TRADEMARK ASSOCIATION (May 15, 2007), <http://www.inta.org/INTABulletin/Pages/SYRIANewIntellectualPropertyLaw.aspx>.

²⁴⁴ Trademarks, Geographical Indications and Industrial Designs and Models, Law No. 8, March 12, 2007, Art. 119 (Syria).

²⁴⁵ *Id.*

²⁴⁶ WORLD ANTI PIRACY OBSERVATORY, UNESCO, SYRIAN ARAB REPUBLIC 5 (2009), available at http://www.unesco.org/new/fileadmin/MULTIMEDIA/HQ/CLT/diversity/pdf/WAPO/syria_cp_en.pdf.

²⁴⁷ Meyer-Reumann & Partners, New Draft Patent Law in Syria, LEX ARABIAE (April 12, 2011), <http://lexarabiae.meyer-reumann.com/new-draft-patent-law-in-syria/>.

The United Arab Emirates has explored and contemplated the potential of specialized IPR courts. The Ministry of Justice of the United Arab Emirates announced plans to establish IPR courts by 2010.²⁴⁸ Plans were also made to send judges to Europe and the United States for IPR training.²⁴⁹ Abu Dhabi is also considering establishing a specialized IPR court.²⁵⁰

11. North America and South America and Caribbean

	Specialized IPR Trial Court	Specialized IPR Appeals Court	Specialized IPR Trial Division	Specialized IPR Appeals Division	Commercial Trial Court	Commercial Appeals Court	Trial Court that exclusively hears IP	Appeals Court that exclusively hears IP	Administrative Tribunal	Specialized IP Judges on court of general jurisdiction	Considering IP Court/Division/Tribunal	Considering Commercial court
Antigua and Barbuda									•			
Bahamas									•			
Barbados									•		•	
Bolivia												
Brazil	•			•								
Canada						•				•		
Chile	•	•							•			
Colombia							•					
Costa Rica								•			•	
Ecuador					•				•		•	
El Salvador												
Guatemala												
Guyana				•								
Jamaica					•				•			
Mexico				•								
Panama		•				•					•	•
Paraguay											•	
Peru	•	•					•	•	•			
Suriname						•	•					
Trinidad and Tobago									•		•	
United States of America							•	•	•	•		
Andean Community							•			•		
Organization of Eastern Caribbean States					•					•		

Antigua and Barbuda

Antigua and Barbuda has a specialized tribunal that exclusively hears matters involving copyright royalties. In Antigua and Barbuda, a copyright tribunal acts as a quasi-judicial

²⁴⁸ Bureau of Economic, Energy and Business Affairs, 2011 Investment Climate Statement – United Arab Emirates, U.S. DEPT. OF STATE (March 2011), www.state.gov/e/eeb/rls/othr/ics/2011/157379.htm.

²⁴⁹ *Id.*

²⁵⁰ Haseeb Haider, *Abu Dhabi to Set Up Intellectual Property Rights Court*, KHALEJ TIMES (November 6, 2010), http://www.khalejtimes.com/darticlen.asp?xfile=data/business/2010/November/business_November158.xml§ion=business.

body regarding licensing schemes for copyrights in protected works.²⁵¹ The tribunal hears and determines any matter relating to a licensing scheme or license.²⁵²

Bahamas

The Bahamas has a specialized tribunal that exclusively hears matters involving copyright royalties. The Copyright Royalty Tribunal in the Bahamas works with rights holders to establish a proper royalty rate structure for the compulsory licensing for free over-the-air broadcasts.²⁵³ The Tribunal has the authority to enquire into the appropriateness of such rates and make any such recommendations to the Minister.²⁵⁴

Barbados

Barbados has a specialized tribunal that exclusively hears matters involving copyright royalties. Outside recommendations have also been made urging Barbados to create a specialized IPR court. In Barbados, a copyright tribunal acts as a quasi-judicial body regarding licensing schemes for copyrights in protected works.²⁵⁵ In 2007, the World Intellectual Property Organization urged Barbados to strengthen their IPR protection beyond the copyright tribunal and improve judicial knowledge with the establishment of a specialized IPR court.²⁵⁶

Bolivia

Bolivia is a member of an international appellate court that exclusively hears IPR cases and also hears other types of appeals. This court also has specialist judges with expertise in IPR cases. Bolivia is a member of the Andean Court of Justice. As of 2007, 97% of the court's rulings concerned IPR.²⁵⁷ Although the Andean Court of Justice is the world's third most active international court with over 1400 issued rulings,²⁵⁸ Bolivian courts have only referred three cases in twenty years.²⁵⁹ This is due to the lack of economic development and demand for IPR protection in the country.²⁶⁰

Brazil

²⁵¹ Copyright Act, No. 22, § 103-104 (2003) (Ant. & Barb.).

²⁵² Copyright Act § 104.

²⁵³ INT'L INTELLECTUAL PROP. ALLIANCE, BAHAMAS: 2003 SPECIAL 301 REPORT ON COPYRIGHT PROTECTION AND ENFORCEMENT 4 (2003), available at <http://www.iipa.com/rbc/2003/2003SPEC301BAHAMAS.pdf>.

²⁵⁴ Copyright Act, c. 323, § 86-87 (1998) (Bah.).

²⁵⁵ Overview of the Role of the Copyright Tribunal, Remarks by the Registrar, Corporate Affairs and Intellectual Property Office at a Press Launch for Copyright Tribunal (Feb. 24, 2005), available at <http://www.reform.gov.bb/page/profiles/Copyright%20Tribunal.pdf>. See also Copyright Act, No. 4 § 102 (1998) (Bar.).

²⁵⁶ CHARLES LEACOCK, WORLD INTELLECTUAL PROP. ORG., A COMPARATIVE ANALYSIS OF THE LEGAL ENFORCEMENT OF INTELLECTUAL PROPERTY OFFENCES IN BARBADOS AND TRINIDAD AND TOBAGO 6 (2007), available at http://www.wipo.int/edocs/mdocs/enforcement/en/wipo_ace_4/wipo_ace_4_8.pdf.

²⁵⁷ Laurence R. Helfer & Karen J. Alter, *The Andean Tribunal of Justice and its Interlocutors: Understanding Preliminary Reference Patterns in the Andean Community*, 41 J. Int'l L. 871, 893 (2009).

²⁵⁸ Laurence Helfer et al., *Islands of Effective International Adjudication: Constructing an Intellectual Property Rule of Law in the Andean Community*, 103 Am. J. Int'l L. 1 (2009).

²⁵⁹ Laurence R. Helfer & Karen J. Alter, *supra* note 257, at 877.

²⁶⁰ *Id.*

Brazil has state courts of general jurisdiction with a specialized division that exclusively hears IPR cases. Brazil also has appellate courts that have exclusive jurisdiction over IPR cases, but also hear other types of appeals. In Brazil, IPR infringement actions must be filed in the state where the infringement took place or where the infringer is domiciled.²⁶¹ Many of the larger jurisdictions in Brazil assign IPR cases to designated courts in that state.²⁶² In fact, the Brazilian Industrial Property Law gives the judiciary authority to “create special courts to settle issues involving intellectual property.”²⁶³ For example, in Rio de Janeiro, there are twelve specialized courts having jurisdiction over IP cases.²⁶⁴ Rights owners having to go outside the major states to file an action may find it more challenging because of lack of IPR experience.²⁶⁵

Various federal appellate courts have specialized chambers that have exclusive jurisdiction over IPR cases. The Federal Court of Appeals for the Second Circuit, hearing appeals from Rio de Janeiro and Espírito Santo, has two chambers that specialize in IPR matters as well as criminal and social security cases.²⁶⁶ The Federal Court of Appeals for the First Circuit, hearing appeals from the Federal District and thirteen other states, has two chambers that specialize in IPR cases.²⁶⁷ The Federal Court of Appeals for the Third Circuit, hearing appeals from São Paulo and Mato Grosso do Sul States, has three specialized IPR chambers.²⁶⁸

Brazil also has federal courts of first instance located in each state capital and the federal district.²⁶⁹ Only decisions by federal government agencies (in this case, the Brazilian Patent and Trademark Office) are heard by these federal courts.²⁷⁰

Canada

Canada has courts of general jurisdiction that exclusively hear IPR cases and specialist judges with IPR backgrounds and expertise in IPR cases. The Canadian judicial system consists of two sets of courts – the Federal Court and the provincial courts.²⁷¹ Both courts have jurisdiction over IPR infringement actions,²⁷² but impeachment (revocation) actions

²⁶¹ Ivan B. Ahlert & Joaquim Eugenio Goulart, *The Enforcement of Patent Rights in Brazil*, PATENT ENFORCEMENT WORLDWIDE: A SURVEY OF 15 COUNTRIES 449, 455 (Christopher Heath & Laurence Petit eds., 2005). See also UK INTELLECTUAL PROP. OFFICE, INTELLECTUAL PROPERTY RIGHTS PRIMER FOR BRAZIL 23 (2008), available at <http://www.ipo.gov.uk/ipr-guide-brazil.pdf>.

²⁶² UK INTELLECTUAL PROP. OFFICE, *supra* note 261, at 23.

²⁶³ Lei No. 9.279, Art. 241, de 14 de maio de 1996, D.O.U. de 15.05.1996. (Brazil).

²⁶⁴ Ivan B. Ahlert & Joaquim Eugenio Goulart, *supra* note 261, at 455.

²⁶⁵ UK INTELLECTUAL PROP. OFFICE, *supra* note 261, at 23.

²⁶⁶ INTELLECTUAL PROP. OWNERS ASS'N, 5TH INTERNATIONAL JUDGES CONFERENCE ON INTELLECTUAL PROPERTY LAW 7 (2009), available at <http://www.ipo.org/AM/Template.cfm?Section=Home&Template=/CM/ContentDisplay.cfm&ContentID=22046>.

²⁶⁷ *Id.*

²⁶⁸ *Id.*

²⁶⁹ Ivan B. Ahlert & Joaquim Eugenio Goulart, *supra* note 261, at 455.

²⁷⁰ *Id.*

²⁷¹ LADAS & PARRY, PATENT LITIGATION IN CANADA (2002),

http://www.ladas.com/Litigation/ForeignPatentLitigation/Canada_Patent_Litigation.html.

²⁷² BLAKE, CASSELS, & GRAYDON, TRADEMARK COPYRIGHT AND PATENT 63 (2010), available at http://www.blakes.com/DBIC/guide/Dispute/html/trade-mark_copyright_and_pate.html.

may only be brought before the Federal Court.²⁷³ The Federal Court also has exclusive jurisdiction over decisions of the Commissioner of Patents and the Registrar of Trademarks.²⁷⁴ The Federal Court is preferred in most instances because of its nationwide jurisdiction and its judges' expertise in IPR matters.²⁷⁵ Trade-secret and breach of contract cases, however, must be brought before the provincial courts.²⁷⁶

Chile

Chile has an administrative appellate court that exclusively hears IPR cases. Chile's Patent and Trademark Office (INAPI) can act as an administrative court for cases involving registrations, oppositions, cancellations, etc.²⁷⁷ Appeals from INAPI are heard by the Industrial Property Appeals Court.²⁷⁸ This court is also court of the first instance for trademark/patent oppositions and any other IPR claims.²⁷⁹ The court was initially created in 1991 with exclusive jurisdiction over industrial property cases.²⁸⁰ That authority has since expanded to plant variety and plant breeders' rights cases.²⁸¹ Chile is considering a further expansion to copyright cases.²⁸²

Colombia

Colombia has an appellate court that exclusively hears IPR cases and also hears other types of appeals. Colombia is also a member of an international appellate court that exclusively hears IPR cases and also hears other types of appeals. This court has specialist judges with expertise in IPR cases.

IP registrations with the Superintendency of Industry and Commerce of Colombia are reviewed by the Council of State.²⁸³ This court is not a part of the country's judicial system, but is a first- and last-instance administrative court that reviews all governmental and administrative decisions.²⁸⁴ Colombia is also a member of the Andean Court of Justice. Referrals from Colombian courts make up 64% of the Andean Court of Justice's preliminary referrals,²⁸⁵ and most of these referrals come from the Council of State.²⁸⁶

Costa Rica

²⁷³ LADAS, *supra* note 271.

²⁷⁴ BLAKE, *supra* note 272.

²⁷⁵ INTERNATIONAL BAR ASSOCIATION, INTERNATIONAL SURVEY OF SPECIALIZED INTELLECTUAL PROPERTY COURTS AND TRIBUNALS 12 (2007) (quoting GOODMAN, INTELLECTUAL PROPERTY ENFORCEMENT IN CANADA: THE TIME IT TAKES TO MOVE A CASE THROUGH THE COURTS 28 (2003)).

²⁷⁶ *Id.*

²⁷⁷ PANNONE LAW GROUP, PROTECTION OF IP: CHILE 3 (2010), available at <http://www.plgworldbook.eu.com/Resources/l/l/y/Chile%20-%20IP.pdf>.

²⁷⁸ *Id.*

²⁷⁹ INAPI, Propiedad Industrial,

http://www.inapi.cl/index.php?option=com_content&view=article&id=89&Itemid=87&lang=es.

²⁸⁰ Law No. 19039, Art. 17, Enero 24, 1991, DIARIO OFICIAL [D.O.] (Chile).

²⁸¹ Law No. 19342, Art. 40, Noviembre 3, 1994, DIARIO OFICIAL [D.O.] (Chile).

²⁸² INT'L BAR ASS'N, INTERNATIONAL SURVEY OF SPECIALISED INTELLECTUAL PROPERTY COURTS AND TRIBUNALS 17 (2007).

²⁸³ Laurence R. Helfer & Karen J. Alter, *supra* note 257, at 902.

²⁸⁴ *Id.*

²⁸⁵ *Id.* at 899.

²⁸⁶ *Id.*

Costa Rica has explored and contemplated the potential of specialized IPR courts. Costa Rica has a specialized administrative tribunal that exclusively hears IPR cases. In 2000, Costa Rica enacted Law No. 8039 on Procedures for Enforcement of Intellectual Property Rights that created the Court of Administrative Registration.²⁸⁷ This court has national jurisdiction over appeals to final resolutions and Office Actions issued by the National Registry and any of its dependencies.²⁸⁸ The Registry of Industrial Property also has access to the case law of the Third Division of the Higher Court of Administrative Challenge, the former appellate court to decisions of the Directorate of the Registry of Industrial Property before the Court of Administrative Registration was created.²⁸⁹ This case law is available in digital form.²⁹⁰

Ecuador

Ecuador has explored and contemplated the potential of specialized IPR courts. Ecuador is also a member of an international appellate court that exclusively hears IPR cases and also hears other types of appeals. This court has specialist judges with expertise in IPR cases. In 1998, Ecuador enacted §294 of the Intellectual Property Act that required the creation of specialized IP courts.²⁹¹ Although required, these have not yet been established by the Ecuadorian government.²⁹² Administrative courts, however, are available for appeals to decisions of the patent and trademark office.²⁹³

Ecuador is also a member of the Andean Court of Justice. The second largest number of referrals to the Andean Court of Justice comes from Ecuador.²⁹⁴ Ecuadorian referrals make up 27% of all referrals to the court.

El Salvador

El Salvador has a set of commercial courts that hear IPR cases in addition to other business disputes. In the judicial district of San Salvador, an IPR action must be filed at the Complaint Distribution Office.²⁹⁵ This office then sends the claim to one of the five mercantile courts.²⁹⁶ In all other jurisdictions, such actions must be brought before a court with jurisdiction over commercial matters.²⁹⁷

²⁸⁷ Law No. 9.279, c. 3, Octubre 5, 2000, DIARIO OFICIAL [D.O.] (Costa Rica).

²⁸⁸ Decreto No. 35456-J, Art. 2, Marzo 30, 2009, DIARIO OFICIAL [D.O.] (Costa Rica).

²⁸⁹ JUDGE CARMEN MARIA ESCOTO, INTELLECTUAL PROPERTY RIGHTS AND TRADE ENFORCEMENT PROCEDURES IN COSTA RICA 9 (2008), available at www.wipo.int/edocs/mdocs/enforcement/en/wipo_ace_2/wipo_ace_2-www_33725.doc.

²⁹⁰ *Id.*

²⁹¹ Law No. 83, §294, mayo 8, 1998, REGISTRO OFICIAL [R.O.] (Ecuador).

²⁹² OFFICE OF THE U.S. TRADE REPRESENTATIVE, 2011 SPECIAL 301 REPORT 34 (2011), available at http://www.ustr.gov/webfm_send/2841.

²⁹³ Latin Lawyer, Intellectual Property, <http://www.latinlawyer.com/reference/topics/52/intellectual-property>.

²⁹⁴ Laurence R. Helfer & Karen J. Alter, *supra* note 257, at 889.

²⁹⁵ Marcela Mancia Dada & Jose Roberto Romero Mena, El Salvador, in TRADEMARKS IN 43 JURISDICTIONS WORLDWIDE 43, 44 (Joseph Nicholson & Stuart Sinder eds., 2009), available at <http://www.romeropineda.org/downloads/el%20salvador.pdf>.

²⁹⁶ *Id.*

²⁹⁷ *Id.*

Guatemala

Guatemala has explored and contemplated the potential of specialized IPR courts through judicial training. Guatemala recently established an interagency IPR working group focused on increasing IPR enforcement actions.²⁹⁸ This year, the interagency IPR working group centered its efforts on training judges in substantive IPR law.²⁹⁹

Guyana

Guyana has a commercial division that hears IPR cases in addition to other business disputes. In 2006, Guyana established a commercial court that has jurisdiction over all commercial claims.³⁰⁰ The commercial court is a division of the high court.³⁰¹ Appeals may be filed with Guyana's Court of Appeal.³⁰² The Caribbean Court of Justice, an international court with jurisdiction over cases involving members of the Caribbean Community,³⁰³ is the final court of appeal over cases in Guyana.³⁰⁴

Jamaica

Jamaica has a specialized tribunal that exclusively hears matters involving copyright royalties. It also has a commercial division that hears IPR cases in addition to other business disputes. Jamaica's Copyright Tribunal hears disputes regarding licensing schemes or licenses for copyrights in protected works.³⁰⁵ Appeals go directly to the Supreme Court.³⁰⁶ There is also a Commercial Division of the Supreme Court that hears all commercial matters.³⁰⁷ This court has dealt with copyright administration, royalty distribution, trademark infringement, and copyright infringement matters.³⁰⁸ Most of these matters have been decided in favor of the rightsholder at the interlocutory stage and have not proceeded to trial.³⁰⁹

Panama

Panama has specialized courts with exclusive jurisdiction over IPR cases as well as other types of cases. It also has a specialized appellate court that exclusively hears IPR cases.

²⁹⁸ OFFICE OF THE U.S. TRADE REPRESENTATIVE, 2011 NATIONAL TRADE ESTIMATE REPORT ON FOREIGN TRADE BARRIERS 163 (2011), available at http://www.sice.oas.org/cityindex/USA/USTR_Reports/2011/NTE/NTE_Final_e.pdf.

²⁹⁹ OFFICE OF THE U.S. TRADE REPRESENTATIVE, *supra* note 298, at 35.

³⁰⁰ WTO Secretariat, Trade Policy Review: Guyana 12, **ERROR! UNKNOWN DOCUMENT PROPERTY NAME.** (2009), available at http://www.wto.org/english/tratop_e/tpr_e/tp318_e.htm (follow "Trade and investment regimes" hyperlink).

³⁰¹ *Id.* at 13.

³⁰² *Id.*

³⁰³ See generally Caribbean Court of Justice, About the Caribbean Court of Justice, <http://www.caribbeancourtofjustice.org/about.htm>.

³⁰⁴ WTO Secretariat, *supra* note 300, at 13.

³⁰⁵ Foga Daley, Copyright Law (April 2009), <http://fogadaley.com/laws.html>. See also Copyright Act, No. 5, § 103-104 (1993) (Jam.).

³⁰⁶ Copyright Act § 106.

³⁰⁷ Ministry of Justice of Jamaica, The Annual Court Report of Jamaica 15 (2002), <http://www.moj.gov.jm/pdf/acr/acr11-30.pdf>.

³⁰⁸ Foga Daley, *supra* note 305.

³⁰⁹ *Id.*

There are a number of specialized IPR courts in Panama. Article 141 of Law No. 29 created three civil circuit courts that specialize in IPR matters in the First Judicial Circuit of Panama – the Eighth, Ninth and Tenth Courts of the First Judicial Circuit.³¹⁰ It also created a circuit court in Colón and civil circuit courts in Coclé (the Coclé Second Court), Chiriquí (the Chiriquí Fourth Court) and Los Santos (the Los Santos Second Court).³¹¹ In addition to IPR matters, these courts hear cases related to antitrust, consumer protection, and unfair trade practices, among others.³¹² Although Law No. 29 created these courts, only the Eighth and Ninth Courts were actually established because of budgetary considerations.³¹³ The Third Superior Court of Justice of the First Judicial Circuit of Panama is the appellate court for all IPR matters.³¹⁴

Paraguay

Paraguay has explored and contemplated the potential of specialized IPR courts in the country. In 2010, Paraguay appointed its first IPR judge.³¹⁵ The country has also made progress toward the education and involvement of judges in IPR matters. In Paraguay, a judge is required to be present during all IPR raids and container inspections in Ciudad del Este.³¹⁶ Two specific judges also have the exclusive authority to issue raid warrants or authorize container inspections in trademark and Customs cases.³¹⁷ These judges must personally attend these raids and inspections.³¹⁸

Peru

Peru has special trial and appellate courts that exclusively hear IPR cases. In 2006, Peru established four trial courts and one appellate court with national jurisdiction over IPR crimes.³¹⁹ That same year, Federal Ordinance No. 122/2006 also gave federal jurisdiction to some courts over customs and tax crimes against IPR.³²⁰ For civil matters, rights holders may file a claim with the administrative review board of the National Institute for the Defense of Competition and Intellectual Property (INDECOPI).³²¹ Appeals from the administrative review board go directly to one of the chambers of the Supreme Court.³²²

³¹⁰ Law No. 29, § 141, febrero 1, 1996, GACETA OFICIAL [G.O.] (Panama).

³¹¹ *Id.*

³¹² *Id.*

³¹³ JULIO CESAR CONTRERAS, A LAWYER'S GUIDE TO PANAMA 51 (2006), available at <http://dowlinglegal.com/sitebuildercontent/sitebuilderfiles/panama.legal.guide.full.pdf>; Council for Trade-Related Aspects of Intellectual Property Rights, Checklist of Issues on Enforcement: Replies from Panama, IP/N/6/PAN/1 (June 23, 1998).

³¹⁴ Law No. 29, § 143.

³¹⁵ OFFICE OF THE U.S. TRADE REPRESENTATIVE, *supra* note 298, at 43.

³¹⁶ INT'L INTELLECTUAL PROP. ALLIANCE, PARAGUAY: 2011 SPECIAL 301 REPORT ON COPYRIGHT PROTECTION AND ENFORCEMENT 283 (2011), available at <http://www.iipa.com/rbc/2011/2011SPEC301PARAGUAY.pdf>.

³¹⁷ *Id.*

³¹⁸ *Id.*

³¹⁹ INT'L INTELLECTUAL PROP. ALLIANCE, PERU: 2010 SPECIAL 301 REPORT ON COPYRIGHT PROTECTION AND ENFORCEMENT 267 (2010), available at <http://www.iipa.com/rbc/2010/2010SPEC301PERU.pdf>.

³²⁰ *Id.*

³²¹ Law No. 1033, Art. 14, junio 24, 2008, DIARIO OFICIAL [D.O.] (Peru).

³²² Decreto No. 807, Art. 17, abril 16, 1996, DIARIO OFICIAL [D.O.] (Peru).

Peru is also a member of the Andean Court of Justice. Peru refers only 9% of the preliminary referrals sent to the Andean Court of Justice from member countries.³²³

Suriname

Suriname has an appellate and trial court that exclusively hears IPR cases and also hears other types of appeals. The High Court of Suriname has exclusive jurisdiction over IPR matters.³²⁴ The High Court is the court of first and last instance for IPR matters and the judiciary body with the highest authority in the country.³²⁵

Trinidad and Tobago

External recommendations have been made urging Trinidad and Tobago to create a specialized IPR court. There is no specialized court established solely for the purpose of dealing with IPR matters in Trinidad and Tobago.³²⁶ Currently, the Intellectual Property Office of Trinidad and Tobago (IPO), is mandated to conduct opposition hearings regarding trademark applications, industrial designs, integrated circuits and new plant varieties.³²⁷ Patent matters are not heard by the IPO, but referred, instead, to the High Court, with appeals going to the Court of Appeal and then the Judicial Committee of the Privy Council.³²⁸ Infringement actions are also brought before the same courts.³²⁹ Due to growing incidences of piracy, the World Intellectual Property Organization (WIPO) advised Trinidad and Tobago in 2007 to establish a specialized IPR court on a limited scale.³³⁰

Andean Community

The Andean Community Court of Justice is described in section III.A of this study.

Organization of Eastern Caribbean States (OECS)

³²³ *Id.* at 889.

³²⁴ Council for Trade-Related Aspects of Intellectual Property Rights, Review of Legislation: Suriname 2, IP/Q/SUR/1 (JUNE 8, 2004), available at http://www.wto.org/english/tratop_e/trips_e/intel8_e.htm. (follow “Review of any legislation”; search “Suriname”).

³²⁵ Embassy of the Republic of Suriname, Government Structure, <http://www.surinameembassy.org/government.shtml>. *See also* ORG. OF AM. STATES, OUTLINE OF THE CRIMINAL JUSTICE SYSTEM AND THE PROSECUTION IN SURINAME http://www.oas.org/juridico/mla/en/sur/en_sur-int-desc-outline_cjs.pdf.

³²⁶ LEACOCK, *supra* note 256, at 6.

³²⁷ Council for Trade-Related Aspects of Intellectual Property Rights, Trade Policy Review Trinidad and Tobago 71, WT/TPR/S/151/Rev. 1 (Oct. 15, 2005), available at http://www.sice.oas.org/cityindex/TTO/WTO/S151R1_3_e.doc. *See also* Trade Marks Act, No. 31, § 21-22 (1997) (Trin. & Tobago); Protection of New Plant Varieties Act, No. 7, c. 82:75, § 32 (1997) (Trin. & Tobago).

³²⁸ Council for Trade-Related Aspects of Intellectual Property Rights, *supra* note 327, at 71. *See also* Patents Act, No. 21 § 80-81 (1996) (Trin. & Tobago).

³²⁹ Council for Trade-Related Aspects of Intellectual Property Rights, *supra* note 327, at 74. *See also* Patents Act, *supra* note 328, § 50.

³³⁰ LEACOCK, *supra* note 256, at 6.

The Eastern Caribbean Supreme Court has explored and contemplated the potential of a specialized IP court. It also has a commercial division that hears IPR cases in addition to other business disputes.

Established in 1967, the Eastern Caribbean Supreme Court (ECSC) is a superior court of record for nine OECS Member States: Antigua and Barbuda, Dominica, Grenada, St. Kitts and Nevis, St. Lucia, St. Vincent and the Grenadines, Anguilla, the British Virgin Islands and Montserrat.³³¹ In 2009, the ECSC created a Commercial Court in the British Virgin Islands as a response to increased commercial litigation.³³² The court has jurisdiction over all Member States.³³³ The ECSC also worked with the World Intellectual Property Organisation (WIPO) to train judges on IPR matters by coordinating a colloquium for judges of the Court on “The Protection of Intellectual Property Rights.”

12. Sub-Saharan Africa

	Specialized IPR Trial Court	Specialized IPR Appeals Court	Specialized IPR Trial Division	Specialized IPR Appeals Division	Commercial Trial Court	Commercial Appeals Court	Trial Court that exclusively hears IP	Appeals Court that exclusively hears IP	Administrative Tribunal	Specialized IP Judges on court of general jurisdiction	Considering IP Court/Division/Tribunal	Considering Commercial court
Eritrea							•					
Kenya							•		•			
Malawi									•			
Mauritius									•			
Mozambique			•									
Rwanda					•							
South Africa					•							
Sudan					•							
Tanzania					•							
Uganda					•				•			
Zimbabwe												

Eritrea

Eritrea has courts of general jurisdiction that exclusively hear IPR cases in addition to other types of cases. The High Court, which also acts as an appellate court, has exclusive jurisdiction over cases concerning IPR.³³⁴ Suits for infringement of trademarks, patents, and copyright must be brought to the High Court.³³⁵

Malawi

³³¹ Keithley Lake & Associates, *EC Supreme Court Celebrates 40 Years* (2006), <http://www.anguilla-attorney.com/ec-supreme-court-celebrates-40-years>.

³³² Conyers Dill & Pearman, *British Virgin Islands Commercial Court Update* (2009), http://www.conyersdill.com/publication-files/Article_207_BVI_Commercial_Court_Update.pdf.

³³³ *Id.*

³³⁴ Liwum Dirar and Kibrom Tesfagabir, INTRODUCTION TO THE ERITREAN LEGAL SYSTEM AND RESEARCH (March 2011), http://www.nyulawglobal.org/Globalex/Eritrea.htm#_edn62; World Intellectual Property Organization, AN EXPLANATORY NOTE ON THE RATIFIED ERITREAN CONSTITUTION OF 1997 AND THE CURRENT ERITREAN INTELLECTUAL PROPERTY REGULATORY FRAMEWORK (2011). <http://www.wipo.int/wipolex/en/outline/er.html>.

³³⁵ Amendment Proclamation 25 of 1992 as amended by Proclamation 113 of 2003, Art. 2(b) (Eritrea); World Intellectual Property Organization, *supra* note 334.

Appeals from decisions of the Registrar concerning patents,³³⁶ registered designs,³³⁷ and trademarks³³⁸ are made to the Patents Tribunal.³³⁹ The Tribunal has the power to hear applications for extensions,³⁴⁰ opposition,³⁴¹ compulsory licenses in respect to patents relating to food or certain other commodities,³⁴² revocation of a patent,³⁴³ and disputes as to government use.³⁴⁴ Decisions of the Tribunal may be appealed to the High Court.³⁴⁵

Mauritius

The Industrial Property Tribunal is competent to hear appeals under any industrial property law or regulation.³⁴⁶ The Tribunal has jurisdiction over appeals from decisions of the Controller of the Industrial Property Office.³⁴⁷ The Tribunal may also hear applications for an Order of Invalidation of a patent.³⁴⁸ Under the Layout Designs Act, the Tribunal has jurisdiction to hear appeals,³⁴⁹ entertain an application for an Order of Invalidation,³⁵⁰ issue a ruling on the interpretation of the Layout Designs Act,³⁵¹ and authorize an application to exploit a layout design or integrated circuit.³⁵² The Tribunal has jurisdiction under the Geographical Indication (GI) Act to hear appeals,³⁵³ entertain an application for an Order of Invalidation,³⁵⁴ issue a ruling on the interpretation of the GI Act and authorize an application to exploit a GI.³⁵⁵ Appeals against decisions of the Tribunal may be made to the Supreme Court.³⁵⁶

Mozambique

IPR disputes may be heard by Customs Courts or any ordinary court; and in some areas, arbitration is an option.³⁵⁷ In addition, Mozambique's Civil Court has a special Commercial

³³⁶ Patents Act of 1986, Ch. 49:02, § 73 (Malawi).

³³⁷ Registered Designs Act of 1985, Ch. 49:05, § 35 (Malawi).

³³⁸ Trade Marks Act of 1967, Ch. 49:01, § 51 (Malawi).

³³⁹ Patents Act, *supra* note 336, §§ 73, 74.

³⁴⁰ *Id.* § 30.4.

³⁴¹ *Id.* § 22.8.

³⁴² *Id.* § 38.

³⁴³ Patent Tribunal Rules of 1967, Ch. 49:02, § 14(1) (Malawi).

³⁴⁴ Patent Tribunal Rules of 1967, Ch. 49:02, § 13(1) (Malawi).

³⁴⁵ Patents Act, *supra* note 10, § 78.

³⁴⁶Industrial Property Act, No. 25 of 2002, 9(b)(2) (Mauritius).

³⁴⁷ *Id.* §§ 10(1)(a), 10(2).

³⁴⁸ *Id.* § 25(2).

³⁴⁹ Layout Designs Act, No. 24 of 2002, § 19(2) (Mauritius).

³⁵⁰ *Id.* § 13.

³⁵¹ *Id.* § 19(1).

³⁵² *Id.*

³⁵³ Geographical Indications Act, No. 23 of 2002, § 17(2) (Mauritius).

³⁵⁴ *Id.* § 12.

³⁵⁵*Id.* § 17.

³⁵⁶Industrial Property Act, *supra* note 346, § 50.

³⁵⁷ United States Agency for International Development, AN ASSESSMENT OF MOZAMBIQUE'S INTELLECTUAL PROPERTY SYSTEM, 76 (May 2009), [http://www.speed-program.com/library/resources/documents/IPRAssessmentofMozambique\(Draft\).pdf](http://www.speed-program.com/library/resources/documents/IPRAssessmentofMozambique(Draft).pdf).

Section that hears cases involving IPR.³⁵⁸ Currently, there are two IPR sections in the Maputo City Judiciary Court and one in the Sofala Provincial Judiciary Court.³⁵⁹

Rwanda

In 2008, Rwanda enacted a new law establishing commercial courts.³⁶⁰ The Commercial Court branch of the High Court of Rwanda has jurisdiction to hear all commercial cases, including most IPR cases.³⁶¹

Sudan

In 2002, the Khartoum Commercial and Intellectual Property Rights Court was established as a special court for IPR and other commercial law cases.³⁶² The court hears a number of cases under the Copyright and Neighboring Rights Protection Act of 1996 and the Trade Marks Act of 1969.³⁶³ Those found guilty of infringement can be penalized by a fine or imprisonment.³⁶⁴

Tanzania

Tanzania has a commercial division of the High Court composed of three judges.³⁶⁵ It shares jurisdiction with the general division of the High Court, and cases may be transferred from the general division to the commercial court.³⁶⁶ Most of the IPR cases heard by the commercial court pertain to trade and service marks, and as of this writing, there has been no report of a patent or copyright case being heard by the commercial court.³⁶⁷

³⁵⁸ Elio Teixeira, *Mozambique, GETTING THE DEAL THROUGH: TRADEMARKS IN 43 JURISDICTIONS WORLDWIDE* 114 (Joseph Nicholson and Stuart Snider eds. 2009)

<http://www.adamsadams.com/images/uploads/Mozambique.pdf>.

³⁵⁹ United States Agency for International Development, AGCLIR MOZAMBIQUE: COMMERCIAL LEGAL AND INSTITUTIONAL REFORM IN MOZAMBIQUE'S AGRICULTURE SECTOR 8 (August 2011),
http://www.google.com/url?sa=t&rct=j&q=&esrc=s&source=web&cd=13&ved=0CDUQFjACOAo&url=http%3A%2F%2Fagrifuturoproject.com%2Findex.php%3Foption%3Dcom_docman%26task%3Ddoc_download%26id%3D16&ei=vbHTTqHsIMPz0gGPrbmwDw&usg=AFQjCNGN3r1h9Ci7A6bCldJJBRgHG83KCA.

³⁶⁰ Organic law no. 59/2007 of 2007 (Rwanda) (establishing the commercial courts and determining their organization, functioning and jurisdiction).

³⁶¹ *Id.* Ch. 2, Art. 3; Rwandan Ministry of Trade and Industry, RWANDA INTELLECTUAL PROPERTY POLICY § 2.4 (November 2009), http://193.5.93.81/wipolex/fr/text.jsp?file_id=215633.

³⁶² Benjamin Deng, THE ROLE OF JUDICIARY IN THE PROTECTION OF INTELLECTUAL PROPERTY IN SUDAN (2002),
<http://sjsudan.org/details.php?id=45&lang=ar&target=r&title=THE%20ROLE%20OF%20JUDICIARY%20IN%20THE%20PROTECTION%20OF%20INTELLECTUAL%20PROPERTY%20IN%20SUDAN>.

³⁶³ *Id.*

³⁶⁴ *Copyrights*, ABU GAZALEH INTELLECTUAL PROPERTY SUDAN OFFICE,
http://www.agip.com/Agip_Country_Mainpage.aspx?country_key=170&lang=en (last visited December 1, 2011).

³⁶⁵ Dory Reiling, COURT SPECIALIZATION OR SPECIAL COURTS,

<http://home.hccnet.nl/a.d.reiling/html/court%20specialization.htm> (last visited December 1, 2011).

³⁶⁶ *Id.*

³⁶⁷ Paul Faustin Klhwelo, *The Commercial Division of the High Court and the Milestones Reached in Intellectual Property Law Matters* 33 (2009) <http://www.comcourt.go.tz/comcourt/wp->

Uganda

The Commercial Court is a branch of the High Court of Uganda.³⁶⁸ Like all specialized divisions of the High Court, the Commercial Court has an independent registry headed by a Deputy Registrar.³⁶⁹ In order to expedite cases and reduce cost, there is a mandatory mediation session for all commercial disputes.³⁷⁰ The number of IPR disputes heard by the Commercial Court is growing.³⁷¹

Zimbabwe

The Intellectual Property Tribunal has jurisdiction for hearing and determining references, applications, appeals and other matters over the Industrial Designs Act, the Patents Act, the Trade Marks Act, the Copyright and Neighboring Rights Act, the Geographical Indications Act, or the Integrated Circuit Layout-Designs Act.³⁷² The Tribunal does not have jurisdiction over criminal cases,³⁷³ and appeals may be made directly to the Supreme Court.³⁷⁴

content/uploads/2010/09/Commercial-Court-and-IP.pdf (Noting that since its inception, the commercial court has not handled a single complaint on copyright or patents).

³⁶⁸ Dick Kawooya, Ronald Kakungulu, and Jeroline Akubu, *Country Report: Uganda*, AFRICAN COPYRIGHT AND ACCESS TO KNOWLEDGE PROJECT 20 (May 2009),

http://www.aca2k.org/attachments/154_Uganda_Country_Report.pdf.

³⁶⁹ Office of the Auditor General of the Republic of Uganda, VALUE FOR MONEY AUDIT REPORT ON DISPOSING OF CASES IN THE JUDICIARY 7 (March 2011),
http://www.oag.go.ug/uploaded_files/1305698769Disposing%20of%20Cases%20in%20the%20Judiciary.pdf.

³⁷⁰ U.S. Department of State, 2009 INVESTMENT CLIMATE STATEMENT- UGANDA (2009),
<http://www.state.gov/e/eeb/rls/othr/ics/2009/117174.htm>.

³⁷¹ See, e.g., Kawooya et al., *supra* note 42, at 20-22.

³⁷² Intellectual Property Tribunal Act of 2001, Ch. 26:08, § 3(1) (Zimbabwe).

³⁷³ *Id.* § 7(2).

³⁷⁴ *Id* §17.

III. CASE STUDIES

A. Andean Community

The Andean Community Tribunal of Justice

Dr. Ana María Pacón

1. Background

The Cartagena Agreement was adopted in 1969.³⁷⁵ It created the Andean Pact. The initial members of the Andean Pact were Bolivia, Colombia, Chile, Ecuador, and Peru. In 1973, Venezuela acceded to the Agreement. In 1976, Chile withdrew over differences with the economic policy of openness in place at that time. In 1997, according to the Protocol of Trujillo,³⁷⁶ a reorganization of the Andean Pact was introduced. The Andean Pact was renamed the "Community of Andean Nations" (CAN) or "Andean Community" (AC).³⁷⁷ A new institutional framework, the Andean Integration System (AIS), was created.³⁷⁸ In April 2006, Venezuela withdrew from CAN in protest to the negotiations that some Andean countries were undertaking bilaterally with third countries.³⁷⁹ In addition to its Member States, CAN includes five associate Members: Argentina, Brazil, Paraguay, Uruguay, and Chile.³⁸⁰

The Cartagena Agreement's founding treaty provided for a "Commission" of national executives that adopted Andean legislation (known as "Andean Decisions") and a regional administrative body (the "Junta") that supervised the implementation of those Andean

³⁷⁵ Andean Sub-Regional Integration Agreement, May 26, 1969 8 I. L. M. 910.

³⁷⁶ Modifying Protocol of the Andean Subregional Integration Agreement ("Protocol of Trujillo"), March 10, 1996, published in Official Gazette of the Cartagena Agreement No. 273.

³⁷⁷ Since 1969 the AC has experienced numerous changes. In 1993, the Andean Countries formed a free trade area. Trade in services, particularly transportation, was also liberalized. The Protocol of Trujillo introduced several changes. The Andean Community was created and replaced the Andean Pact. See RUTH MACKENZIE ET AL., THE MANUAL ON INTERNATIONAL COURTS AND TRIBUNALS 290-301 (Oxford Univ. Press ed., 2nd ed. 2010).

³⁷⁸ The main bodies of the AIS currently include: the Andean Council of Presidents; the Andean Council of Foreign Affairs Ministers; the Andean Community Commission; The Andean Community Secretariat-General; the Andean Parliament; the Andean Development Corporation; the Latin American Reserve Fund; and the Andean Community Tribunal of Justice.

³⁷⁹ In the last years, some Andean Countries – Colombia and Peru – have negotiated Free Trade Agreements (FTAs), especially with the United States and the European Union (EU). These FTAs contain, respectively, a chapter on intellectual property rights (IP). The FTAs do not deal with all IPR-related subject matters. They focus on a few but important ones. They usually begin with a general preamble followed by different sections dealing, respectively, with general provisions, trademarks, domain names on the internet, geographical indications, copyrights, related rights, obligations common to copyright and related rights, protection of encrypted program-carrying satellite signals, patents, measures related to certain regulated products, enforcement of intellectual property rights and final provisions. In trademark law, the FTAs expand on the provisions contained in the TRIPS Agreement. As a consequence of the Peru-US FTA new regulations have been enacted in Peru. Previously, Andean Decision 689, which allows the Andean countries to amend and develop their domestic IP regulations, was enacted.

³⁸⁰ Associate Members may be invited to participate in meetings of the Andean Integration System, either at the initiative of the organ or institution itself, or in response to request by the Association Member, in order to address issues of common interest. See Art.1and 2 Andean Decision 613.

Decisions. The original Andean Pact did not include a court, and the Andean Decisions were not directly applicable.

The aim of the Cartagena Agreement was to accelerate the growth of its members through integration with a view to the gradual formation of a Latin American common market. One of the main tools for achieving this goal has been the gradual creation of an autonomous Community law that prevails over the domestic law of each country and that has direct and uniform application, expressed through the different Andean Decisions that have been issued in different areas.

While the Andean Countries have significant areas of shared interests, there are major differences in individual country goals, policies, economic development and social growth. Even in the last thirty years, new elections in the four democratic Andean Countries have often resulted in dramatic changes in political ideology and policy.

Disputes concerning the interpretation of the Andean Pact or the decisions of the Commission should begin with a settlement, in accordance with Article 23 I of the Cartagena Agreement. In the event of failure, Art. 23 II refers to the Protocol on Dispute Settlement, signed in 1967 under the former Latin American Free Trade Association (LAFTA). This Protocol has been ratified by the Member States of the Andean Pact (Art. 23 IV). Since Peru and Venezuela did not fulfill this commitment, the Andean Pact lacked a binding dispute settlement procedure.³⁸¹ This gap was filled by the Andean Community Tribunal of Justice (ACTJ).

The ACTJ was created in 1979³⁸² and was expressly modelled on the European Court of Justice (ECJ).³⁸³ It became operative in 1984. In 1996, Andean officials adopted a series of institutional reforms intended to make the ACTJ more effective.³⁸⁴ The ACTJ's jurisdiction was expanded to labor disputes, arbitration, and actions for failure to act.³⁸⁵ Since then, the ACTJ has become the third most active international court,³⁸⁶ having heard over 1,900 cases between its inception and the end of 2010.

2. The Andean Community Tribunal of Justice

a. Introduction

The Andean Community Tribunal of Justice is located in Quito, Ecuador.³⁸⁷ The ACTJ consists of four Judges,³⁸⁸ each representing one of the Member Countries, and has

³⁸¹ This situation has resulted in the supremacy of the Andean rules being contested by national courts. For instance, in Colombia two lawsuits raised fundamental questions about the legality of the Andean Decisions within the Member States' national legal systems. See Karen J. Alter & Laurence R. Helfer, *Legal Integration in the Andes: Law-Making by the Andean Tribunal of Justice*, 17 Eur. L. J. 5, 701, 702 (2011).

³⁸² Treaty Creating the Andean Tribunal of Justice, May 28, 1979, 18 I.L.M. 1203 [hereinafter ACTJ Treaty].

³⁸³ The ACTJ is one of 11 functioning copies of the ECJ and the most active of these. See Alter, *supra* note 381, at 702-703.

³⁸⁴ Protocol of Cochabamba Amending the Treaty Creating the Court of Justice of the Cartagena Agreement, May 28, 1996, available at

http://www.wipo.int/wipolex/en/other_treaties/text.jsp?doc_id=170388&file_id=224429.

³⁸⁵ Andean Decision 500 (2001) (embodies the Statute of the Court, and provides considerably more detail regarding the processes outlined by the ACTJ Treaty).

³⁸⁶ See Alter, *supra* note 381, at 702.

³⁸⁷ Calle Juan de Dios Martínez Mera N° 34 -380 y Portugal
Tel: (593 2) 3331417

territorial jurisdiction in the four countries, with permanent headquarters in Quito, Ecuador.

The duties of the ACTJ include ensuring the legality of the AC provisions, maintaining compliance with Andean Community law by Member States and community institutions, and interpreting AC laws to ensure that they are applied uniformly in the territories of the Member Countries.

b. Organization

The judges are appointed by unanimous decision of the Andean Countries. Candidates must possess a good moral reputation and fulfill the general conditions for exercising the highest judicial function in their countries or be highly competent jurists.³⁸⁹

Judges are appointed for a six-year term and may be re-elected only once.³⁹⁰ They carry out the function of President by rotation.³⁹¹ The judges appoint the Registrar (Secretario) for a once renewable three-year-term.³⁹² All Member Countries rotate to have one of their citizens as Registrar. Currently, the Registrar is Isabel Leguizamón Palacios (Colombia).

c. Jurisdiction

The ACTJ has exclusive jurisdiction to interpret Andean law. According to Art. 42 of the Treaty Creating the Tribunal, "Member Countries shall not submit any dispute that may arise from the application of provisions comprising the legal system of the Andean Community to any court, arbitration system or proceeding whatsoever except for those stipulated in this Treaty." Member Countries or bodies and institutions of the Andean Integration System also have the option to submit disputes regarding their relations with outside countries to the court.³⁹³

d. Actions for Annulment (Acciones de Nulidad)

The ACTJ is competent to void decisions of the Andean Council of Foreign Ministers, the Commission, Resolutions of the Secretariat-General, and agreements concluded between Member States within the framework of the community when inconsistent with the Andean legal system. Actions for annulment can be submitted by Member States, the Council of Foreign Ministers, the Commission, the Secretariat-General, or private parties.³⁹⁴ Through the end of 2010, the ACTJ has considered 50 actions for annulment.³⁹⁵

Fax: (593 2) 3331443

P.O.BOX: 17079054

E-mail: tjca@tribunalandino.org.ec

Web-site: www.tribunalandino.org.ec

³⁸⁸ Currently, the judges are Ms. Leonor Perdomo Perdomo, Mr. Carlos Jaime Villarroel Ferrer, Mr. Ricardo Vigil Toledo, Mr. José Vicente Troya Jaramillo.

³⁸⁹ ACTJ Treaty, *supra* note 382, Art. 6.

³⁹⁰ *Id.* Art. 8.

³⁹¹ *Id.* Art. 17.

³⁹² *Id.* Art. 14.

³⁹³ *Id.* Art. 42.

³⁹⁴ *Id.* Art. 17.

³⁹⁵ See TRIBUNAL DE JUSTICIA DE LA COMUNIDAD ANDINA, <http://www.tribunalandino.org.ec> (last visited Dec. 12, 2011).

e. Actions for Failure to Fulfill Obligations (Acciones de Incumplimiento)

Actions for failure to fulfill Andean obligations can be submitted by the Andean Secretariat-General against any Member State, by any Member State against another Member State, and by natural and legal persons against Member States. The action must be submitted via the Andean Secretariat-General and the Member State given an opportunity to respond to the allegations.³⁹⁶

A Member State fails to fulfill its Andean obligation when it adopts national laws inconsistent with the Andean legal system, does not implement norms of the Andean legal system, or hinders or blocks the implementation of the Andean legal system, among other ways.³⁹⁷

Actions for annulment must be submitted before the ACTJ within two years from the date the decision or agreement becomes effective.³⁹⁸ After two years, acts and other decisions can still be challenged, but only via a national court. The national court then requests a preliminary ruling from the ACTJ regarding the legality of the given act. The case must be suspended until the ACTJ has issued its decision.³⁹⁹ Until the end of 2010, the ACTJ has considered 116 actions for failure to fulfill obligations.⁴⁰⁰

f. Actions for Failure to Act (Recursos por Omisión)

The Council of Foreign Affairs Ministers, the Andean Commission, the Secretariat-General, the Member States, and natural or legal persons whose subjective rights and legitimate interests are affected may request the ACTJ to issue a ruling ordering the Council of Foreign Affairs Ministers or the Andean Commission or the Secretariat-General to fulfill an obligation expressly mandated under any of the instruments of the Andean Community legal system.⁴⁰¹ The ACTJ must issue a ruling on the matter within 30 days, which must be published in the Official Gazette of the Cartagena Agreement (OGCA). The ruling must state the form, way, and period in which the body in question must fulfill its obligations.⁴⁰² Until the end of 2010, the ACTJ had considered six actions for failure to act.⁴⁰³

g. Preliminary Rulings (Interpretaciones Prejudiciales)

In order to ensure the uniform application of the legal system of the AC, the ACTJ is competent to interpret the Andean provisions when requested by national judges.⁴⁰⁴ The ACTJ's ruling is limited to specifying the contents and scope of provisions on the basis of relevant facts in the case pending before the national court.⁴⁰⁵ However, the ACTJ is not

³⁹⁶ *ACTJ Treaty*, *supra* note 382, Art. 23; Andean Decision 500, *supra* note 385, Art. 107-120.

³⁹⁷ Andean Decision 500, *supra* note 385, Art. 107.

³⁹⁸ *ACTJ Treaty*, *supra* note 382, Art. 20.

³⁹⁹ *Id.*

⁴⁰⁰ See TRIBUNAL DE JUSTICIA DE LA COMUNIDAD ANDINA, <http://www.tribunalandino.org.ec>.

⁴⁰¹ *ACTJ Treaty*, *supra* note 382, Art. 37; Andean Decision 500, *supra* note 385, Art. 129-134.

⁴⁰² *Id.* Art. 38.

⁴⁰³ See TRIBUNAL DE JUSTICIA DE LA COMUNIDAD ANDINA, <http://www.tribunalandino.org.ec>.

⁴⁰⁴ *ACTJ Treaty*, *supra* note 382, Art. 32; Andean Decision 500, *supra* note 385, Art. 121.

⁴⁰⁵ *ACTJ Treaty*, *supra* note 382, Art. 34.

competent to interpret the contents and scope of national law, nor may it judge the facts in dispute.⁴⁰⁶

National courts may request preliminary rulings by the ACTJ if they are not the last instance of jurisdiction.⁴⁰⁷ If the ACTJ does not render the preliminary ruling before the national court's decision is due, the national court may rule without waiting for the decision of the ACTJ.⁴⁰⁸ However, if the national court is a court of last instance, then it must suspend proceedings and request a preliminary ruling from the ACTJ.⁴⁰⁹ The failure of a national court of last instance to request a preliminary ruling from the ACTJ might be considered a violation of due process, which could render null and void the judgment of the national court. At the regional level, this would amount to a failure of the correspondent State to fulfill its obligations under the AC agreements.

Preliminary rulings are, by far, the largest part of the ACTJ's docket. Until the end of 2010, the ACTJ has considered 1,813 requests for a preliminary ruling.⁴¹⁰ The ACTJ has used early preliminary rulings to assert the direct effect and supremacy of Andean law.

h. Arbitration

The ACTJ may arbitrate disputes arising from the application or interpretation of contracts or agreements concluded between institutions of the Andean Integration System between these and third parties, or between private parties.⁴¹¹ To date, the ACTJ has not yet exercised this kind of jurisdiction.

i. Administrative Jurisdiction

The ACTJ also has jurisdiction to hear disputes between the institutions of the AC and its employees.⁴¹² There are no appeals against the decisions of the ACTJ or various levels of jurisdiction within the ACTJ. All decisions of the ACTJ are final and binding, once published in the OGCA.

j. Procedural Aspects

The official language of the ACTJ is Spanish. Once a decision of the ACTJ has been published in the Official Gazette, it is final and binding and has direct effect in the territories of the Member States without need for further incorporation. Judgments on actions for failure to fulfill obligations brought by legal or natural persons can be brought before a national judge with a request for damages.⁴¹³

Once the ACTJ has decided that a Member State has not complied with its Andean obligations, the Member State has 90 days to take the necessary steps to give effect to the judgment. Should it fail to give effect to the ACTJ's decision, the ACTJ can summarily decide what benefits accruing from the Cartagena Agreement the other Member States can

⁴⁰⁶ *Id.*

⁴⁰⁷ *ACTJ Treaty*, *supra* note 382, Art. 33, Andean Decision 500, *supra* note 385, Art. 122.

⁴⁰⁸ *ACTJ Treaty*, *supra* note 382, Art. 33; Andean Decision 500, *supra* note 385, Art. 123.

⁴⁰⁹ *ACTJ Treaty*, *supra* note 382, Art. 33; Andean Decision 500, *supra* note 385, Art. 123.

⁴¹⁰ See TRIBUNAL DE JUSTICIA DE LA COMUNIDAD ANDINA, <http://www.tribunalandino.org.ec>.

⁴¹¹ *ACTJ Treaty*, *supra* note 382, Art. 38.

⁴¹² *ACTJ Treaty*, *supra* note 382, Art. 40; Andean Decision 500, *supra* note 385, Art. 135-39.

⁴¹³ Andean Decision 500, Art. 110.

suspend, in whole or in part.⁴¹⁴ Should the restriction or suspension of the benefits of the Cartagena Agreement worsen the situation to be resolved or fail to be effective, the ACTJ is free to order the adoption of other measures.⁴¹⁵

Decisions of the ACTJ cannot be appealed. The national laws of the Andean Countries control the extent to which national legislation can impinge on the ACTJ's powers, thereby confirming the ACTJ's supranational role in the Sub-region.

Neither the ACTJ Treaty nor the Statute establish the principle of precedence, so interpretations apply only to the case subject to consultation and do not relieve the national court of the obligation to formulate the query in similar cases. Parties appearing before the ACTJ must be either lawyers or assisted by a lawyer licensed to practice under the laws of an Andean Country.⁴¹⁶

k. Relationship between the ACTJ and the National Courts

The relationship between the ACTJ and the national courts is a relationship of cooperation and not of hierarchy. It is a peer relationship. However, the preliminary rulings are binding for the national courts, and they have an obligation when their decisions are not subject to an appeal to submit a preliminary ruling to the ACTJ.⁴¹⁷

The collaboration between the ACTJ and national judges proceeds in three stages. In the first phase, the national court must determine if there is a problem of Community law that results in the formulation of a pre-judicial question. In the second phase, the ACTJ examines the question that has been raised by the national court. In the third and last phase, the judge trying the case in the national court must adopt the ACTJ's interpretation of the Andean community law.⁴¹⁸

Regarding the preliminary rulings, Art. 34 of the ACTJ Treaty imposes limits on the work of the ACTJ, which can be summarized as follows:

- a) The ACTJ is unable to interpret national law. The interpretation of this law is the sole responsibility of the national judges.
- b) The ACTJ cannot apply Community law. It is limited to interpreting. Applying its interpretation to the case is entirely the responsibility of national courts.
- c) The ACTJ cannot rule on the facts, check its accuracy or decide on scope, as this exercise is in the exclusive competence of the national judge in the corresponding case.⁴¹⁹

⁴¹⁴ *ACTJ Treaty*, *supra* note 382, Art. 27, Andean Decision 500, *supra* note 385, Art. 119.

⁴¹⁵ *ACTJ Treaty*, *supra* note 382, Art. 27, Andean Decision 500, *supra* note 385, Art. 119.

⁴¹⁶ Andean Decision 500, *supra* note 385, Art. 39.

⁴¹⁷ See RICARDO VIGIL TOLEDO, *La Cooperación entre los Órganos Jurisdiccionales Nacionales y el Tribunal de Justicia de la Comunidad Andina: La Consulta Prejudicial*, in REFLEXIONES EN TORNO A LA CONSTRUCCIÓN DE LA COMUNIDAD SUDAMERICANA DE NACIONES 20-23 (2006).

⁴¹⁸ See BALDO KRESALJA, *La Política en Materia de Propiedad Industrial en la Comunidad Andina*, in DERECHO COMUNITARIO ANDINO 264 (2003).

⁴¹⁹ However, the ACTJ may refer to the facts of the case when essential for the requested interpretation. See *ACTJ Treaty*, *supra* note 382, Art. 34. See also, CHRISTIAN LEATHLEY, INTERNATIONAL DISPUTE RESOLUTION IN LATIN AMERICA. AN INSTITUTIONAL OVERVIEW 124 (Kluwer Law Int'l ed., 2007).

3. Intellectual Property in the Andean Community

Industrial property rights (i.e. patents, utility models, designs, trademarks, commercial names, geographical indications) in the Andean Community are to a large extent harmonized. Industrial property is the only area subject to five Andean Decisions in the last forty years (Andean Decisions 85, 311, 313, 344 and 486). In addition, the Andean Community has adopted common regional legislation concerning other IPR issues, including copyright and neighboring rights (Andean Decision 351), the rights of breeders of new plant varieties (Andean Decision 345), and access to genetic resources (Andean Decision 391).

The rationale behind Andean Decisions on IPR has changed radically over the years. Andean Decision 85 corresponds with the import substitution policy and the protection of the national industry practiced by the Andean Countries in the 1970s. Patents and trademarks were treated as vehicles for transferring technology from foreign firms.⁴²⁰ In the early 1990s, market-oriented reforms were implemented in the region. Particularly, the unilateral trade liberalization measures introduced by most of the Andean Countries set the groundwork for a reactivation of the Andean integration efforts. Andean Decisions 311, 313, and 344 were adopted.

These Andean Decisions progressively enhanced the level of IPR protection⁴²¹ and reflected the market liberalization goals of the Andean Countries. But other factors reinforced the impetus for change: the inclusion of IPR rules in the Uruguay Round of Multilateral Trade Negotiations and the threat of trade sanctions by the United States. In 1994, the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) was adopted in the framework of the World Trade Organization (WTO). In order to implement the commitments of the TRIPs Agreement, a new reform of the Andean IPR rules began. On September 14, 2000, Andean Decision 486, the current Common Regime on Industrial Property, was adopted.⁴²²

At the national level, the Andean Countries can only regulate aspects that are not contained in the Andean Decisions on IPR.⁴²³ In case of conflict between the Common Regime and the national laws, the Andean Decision prevails. The Andean Decision 486 aims to ensure that domestic IPR registered before the Andean countries' respective Industrial Property Offices⁴²⁴ are subject to the same standards of registrability and enjoy the same protection in all Andean Countries. The national courts have to refer questions relating to the application and interpretation of the Andean Decision 486 to the ACTJ.

⁴²⁰ See Laurence Helfer et al., *Islands of Effective International Adjudication: Constructing an Intellectual Property Rule of Law in the Andean Community*, 103 Am. J. Int'l L. 1 (2009).

⁴²¹ For instance, pharmaceutical products could now be patented, the duration of the patent rights was extended, the protection of well-known trademarks was enhanced. For a general overview of these changes. See Kresalja, *supra* note 418.

⁴²² Andean Decision 486 (2000); OGCA No. 600 of September 19, 2000, valid up December 1, 2000.

⁴²³ For Bolivia: Ley General sobre Marcas y Registros Industriales y Comerciales, Law 15-01-1918, of January 15, 1918; for Colombia: Decreto No. 2591, diciembre 13, 2000 DIARIO OFICIAL [D.O.]; for Ecuador: Law No. 83, mayo 8, 1998, REGISTRO OFICIAL [R.O.]; for Peru: Decreto No. 1075 junio 27, 2008, DIARIO OFICIAL [D.O.] and Law No. 29316 enero 13, 2009 DIARIO OFICIAL [D.O.].

⁴²⁴ For Bolivia: Servicio Nacional de Propiedad Intelectual (SENAPI); for Colombia: Superintendencia de Industria y Comercio (SIC); for Ecuador: Instituto Ecuatoriano de la Propiedad Intelectual (IEPI); for Peru: Instituto Nacional de Defensa de la Competencia y de la Propiedad Intelectual (INDECOPI).

a. The ACTJ and IPR

The ACTJ has experienced a growing demand for preliminary rulings over time. Ninety-six percent of all preliminary rulings involve IPR disputes.⁴²⁵ What are the specific areas where the ACTJ has issued more preliminary rulings? Undoubtedly, cases concerning trademark rights (87%) and to a much lesser extent, patents (8%), and copyrights (less than 1%), with other IPR, such as utility models and industrial designs, comprising less than 2%.⁴²⁶ In particular, the ACTJ has resolved the vast majority of preliminary rulings in the field of registrability and the risk of confusion of trademarks.

The domestic origin of these decisions is uniform: 1,285 cases began as challenges to an intellectual property offices' decision to grant or deny an application to register a trademark, patent or other intellectual property right. Private litigants have rarely invoked Andean rules to challenge national laws that do not directly relate to the implementation of community policies.⁴²⁷

b. Explaining Trends in the ACTJ and IPR

The growing demand for preliminary rulings corresponds with the increased number of trademark and patent registrations granted by the national Andean IP offices in the last ten years and the resulting increased number of appeals to challenge those decisions in the national courts.

Parallel with the above mentioned fact, a change in the attitude of national courts toward requesting preliminary rulings from the Andean Court can be observed. In the early years of the ACTJ's existence, national courts of last instance ignored their obligations under the ACTJ Treaty and did not refer preliminary rulings to the ACTJ. National judges had no experience in referring cases to international courts, and they were concerned that doing so would involve a loss of sovereignty.⁴²⁸

In 1987, Colombia submitted the first case, and it is responsible for nearly two-thirds of all preliminary rule requests. The Ecuadorian Court submitted their first preliminary ruling in 1994 after informal lobbying by ACTJ judges and a General Secretariat resolution holding Ecuador in violation of Andean law for its failure to refer cases. The Peruvian Supreme Court began to make referrals in 2005, after two noncompliance decrees from the General Secretariat. Bolivia and Venezuela have together referred only three cases.⁴²⁹ National courts are exclusively entitled to bring a preliminary ruling, and there are no public consultation activities that allow private parties to directly submit a preliminary ruling. A case of particular interest was the Belmont case, in which Venezuela filed against Ecuador.⁴³⁰

If one has to judge the performances of the ACTJ's preliminary rulings related to IP, it cannot be said that they are in-depth and original. On the contrary, the ACTJ's case law is highly repetitive and unclear. In many cases it is not easy to understand the rationale

⁴²⁵ Alter, *supra* note 381, at 703.

⁴²⁶ See Helfer, *supra* note 420, at 14.

⁴²⁷ Alter, *supra* note 381. at 703.

⁴²⁸ See Helfer, *supra* note 420, at 14.

⁴²⁹ *Id.* at 15-16.

⁴³⁰ Process 2-AI-96, Judgment of June 20, 1997.

behind the criteria used. According to an interview with a former lawyer of the ACTJ, ACTJ judges are expressly mandated not to change the already-approved criteria. This repetition and the low level of the decisions are a source of frustration for the Andean IP bar.

However, the lack of clarity and repetition also serve to overcome domestic judicial resistance. National judges are reluctant to cede sovereignty or to provoke controversy by challenging domestic decrees or laws.⁴³¹

It is fair to indicate that, over time, the ACTJ has been fine-tuning its work and improved the argumentation of its decisions. It is also true that the disputes of trademark law that were submitted to a preliminary ruling are in general not suitable for an interpretation that can achieve a great legal significance. But the preliminary rulings are guidelines that cannot be ignored by specialized professionals or by the titleholders of IPR.⁴³²

It is conceivable that the ACTJ could issue rulings in arbitration proceedings concerning IPR matters. However, until now, no such disputes have been submitted.

⁴³¹ *Id.* at 21-22.

⁴³² Kresalja, *supra* note 418, at 265.

B. Greece

Greece's Specialized Intellectual Property Courts Regime Dionysia Kallinikou

1. Introduction

In Greece, judicial powers are exercised by courts of law and the decisions are executed in the name of the Greek People.⁴³³ No person may be deprived of the judge assigned to him by law against his will. Judicial committees or extraordinary courts are prohibited.⁴³⁴ Courts are distinguished into administrative, civil, and criminal courts, and they are organized by special statutes.⁴³⁵ Civil Courts have jurisdiction over private disputes.⁴³⁶ Ordinary Criminal Courts have jurisdiction over the punishment of crimes and the adoption of all measures provided by criminal laws.⁴³⁷ Final appeals in civil and criminal cases are heard by the Supreme Court (called "Areios Pagos").⁴³⁸ Every court judgment must be specifically and thoroughly reasoned and must be pronounced in a public sitting.⁴³⁹

Disputes concerning infringement of intellectual property rights (IPR) are mainly disputes of private law belonging to the jurisdiction of civil courts. Criminal proceedings can also be applied against all acts that constitute infringement of IPR, according to provisions regulating criminal sanctions. Disputes related to administrative grant of certain IPR (trademarks or patents) belong to the jurisdiction of administrative courts.⁴⁴⁰

"Specialized IPR divisions" are created within the jurisdiction of civil courts which deal with IPR cases.

2. Copyright Divisions

According to Art. 3 Par. 26a of Law 2479/1997, the first instance courts of Athens, Piraeus, and Thessaloniki comprise a special division that hears copyright⁴⁴¹ cases.⁴⁴² Regular judges specialized in copyright matters are appointed to this division, which is set up in the said courts according to the procedure provided for by the law on the constitution of courts' divisions in general.⁴⁴³ The judges of these courts have served at least five years as judges in other first instance courts.⁴⁴⁴ The term of service in this special division is two

⁴³³ 2008 Syntagma [SYN] [Constitution] Art. 26 Pt. 3 (Greece).

⁴³⁴ *Id.* Art. 8.

⁴³⁵ *Id.* Art. 93 Pt. 1.

⁴³⁶ *Id.* Art. 94 Pt. 2.

⁴³⁷ *Id.* Art. 96 Pt. 1.

⁴³⁸ K.KERAMEUS & P. KOZYRIS, INTRODUCTION TO GREEK LAW 342 – 344 (3rd ed. 2007).

⁴³⁹ 2008 Syntagma [SYN] [Constitution] Art. 93 Pt. 3 (Greece).

⁴⁴⁰ A. LIAKOPoulos, INTELLECTUAL PROPERTY LAW IN GREECE 51 (1999).

⁴⁴¹ The term "copyright" refers to authors' rights and related rights.

⁴⁴² Nomos (1997:2479) Supreme Special Court, Expedition of Proceedings, Procedural Simplifications and Other Provisions, Official Gazette, Art. 3 Pt. 26(a) (Greece).

⁴⁴³ *Id.*

⁴⁴⁴ *Id.*

years and can be renewed.⁴⁴⁵ The specialization of the judges serving in the special copyright divisions may be achieved through the training programs of the National School for Judges.⁴⁴⁶ Appeals against the decisions of the first instance courts are tried before the Special Division of the Court of Appeal of Athens.⁴⁴⁷

3. Community Trademarks Divisions

Special divisions have been established for Community trademarks, pursuant to law 2943/2001 (articles 6-11).⁴⁴⁸ Specifically, in implementation of Article 91 of Council Regulation 40/94/EC, special divisions are established in the civil first instance and appeals courts of Athens and Thessaloniki, as first- and second-instance courts for Community trademarks, which exercise all powers entrusted by the Regulation to Community trademark courts (Article 6 of Law 2943/2001).⁴⁴⁹

For the hearing of Community trademark cases, the local competence of the special Community trademark division of the First Instance and the Appeal Court of Athens is extended to the regions of the Courts of Appeal of Athens, Aegean, Dodecanese, Corfu, Crete, Lamia, Nafplio, Patras, and Piraeus; and the local competence of the special Community trademark division of the First Instance and the Appeal Court of Thessaloniki is extended to the regions of the Courts of Appeal of Thessaloniki, Western Macedonia, Thrace, Ioannina, and Larissa.⁴⁵⁰

The competence *ratione materiae* is determined by the provisions of national law, pursuant to the Code of Civil Procedure.⁴⁵¹

Cases that are subject to the Community trademark division but are introduced to other divisions of the same court are referred to the Community trademark division. Cases that are not subject to the Community trademark division but are introduced thereto may be heard by such division or referred to the competent division. The provisions of the Code of Civil Procedure apply *mutatis mutandis* to all other matters.⁴⁵²

Community trademark divisions also hear cases relating to patents, utility model certificates, technology transfer, topographies of semiconductor products and supplementary protection certificates, industrial designs and models, and, generally, all invention cases subject to the jurisdiction of civil courts.⁴⁵³

Community trademark divisions of the First Instance and Appeal Courts of Athens and Thessaloniki also hear domestic trademark cases, since these courts are competent *ratione loci* pursuant to the provisions of national law.⁴⁵⁴ Other commercial law cases can also be introduced for hearing to Community trademark divisions, provided that they are

⁴⁴⁵ *Id.*

⁴⁴⁶ *Id.*

⁴⁴⁷ *Id.*

⁴⁴⁸ Nomos (2001:2943) Serving Sentences of Drug Dealers and Other Provisions in the Competency of the Ministry of Justice, Official Gazette, Art. 6-11 (Greece).

⁴⁴⁹ *Id.* Art. 6.

⁴⁵⁰ *Id.* Art. 7.

⁴⁵¹ *Id.*

⁴⁵² *Id.* Art. 8.

⁴⁵³ *Id.* Art. 9.

⁴⁵⁴ *Id.* Art. 10.

competent *ratione loci*, if so dictated by official requirements in the opinion of the judge or the court's administration council.⁴⁵⁵

Community trademark divisions are preferably staffed by judges with specialisation or expertise in trademarks, patents, and commercial law.⁴⁵⁶

The Internal Service Regulations of the courts have been issued, supplemented, or amended to accommodate the above legislative provisions.

4. First Instance Court of Athens

For the First Instance Court of Athens, the current Regulation stipulates that the 3rd Civil Division is competent to hear copyright and Community trademark cases.⁴⁵⁷ This division is also competent to hear domestic trademark cases and cases relating to patents, utility model certificates, technology transfer, topographies of semiconductor products and supplementary protection certificates, industrial designs and models, and, generally, all invention cases subject to civil courts.⁴⁵⁸ This division is also competent to hear cases relating to commercial law.⁴⁵⁹ The cases of the special division, falling into the competence of the Multimember First Instance Court, are entered solely in dockets ST1 regular and XST1 special and are tried by the judges of the 1st and 7th Commercial Divisions alternately.⁴⁶⁰ The cases falling within the competence of the One-member First Instance Court are entered solely in dockets ST1 regular and XST1 special and are tried by one of the judges serving in the divisions of A and Z composition of the Commercial Division.⁴⁶¹

Legislative provisions for the special divisions do not bring about any amendments to the provisions stipulating the competence *ratione materiae* of first instance courts. Therefore, actions are referred to Justices of the Peace who are competent *ratione materiae* and *loci*, when the request made by the action relates to economic rights and falls short of the maximum limit of competence *ratione materiae* of the Justice of the Peace.⁴⁶² It has been accepted by the case law that the request to demand the cessation of the infringement and its prohibition in the future does not have an economic dimension, and, therefore, it is referred to the special division of the Multimember First Instance Court of Athens.⁴⁶³

⁴⁵⁵ *Id.*

⁴⁵⁶ *Id.*

⁴⁵⁷ (45058/2010) Amendment, Supplementation and Rewording of the Internal Service Regulation of the First Instance Court of Athens, Official Gazette B 693/2010 (Greece).

⁴⁵⁸ *Id.*

⁴⁵⁹ *Id.*

⁴⁶⁰ *Id.*

⁴⁶¹ *Id.*

⁴⁶² One-Member First Instance Court of Athens 1729/2010 (Greece); K. PAMBOUKIS, EPISKOPISI EMBORIKOU DIKAIOU 917-918 (2010).

⁴⁶³ One-Member First Instance Court of Athens 3432/2010 (Greece); Pamboukis, *supra* note 462, at 919-921. For trademarks, see Multimember First Instance Court of Athens 5795/2010 (Greece); Pamboukis, *supra* note 462, at 921-926.

5. Court of Appeal of Athens

As regards the Court of Appeal of Athens, the Internal Service Regulation provides for the allocation of Community trademark and copyright cases to two divisions.⁴⁶⁴ Specifically, the 17th division of the Court of Appeal of Athens is responsible for Community trademark cases and any cases relating to Articles 6-11 of Law 2943/2001, while copyright cases are subject to the 18th division of the Court. In the event that a copyright or Community trademark case is entered in a division other than the competent one, the case is referred to the relevant division (Art. 5 Par. 5 of the Internal Service Regulation of the Court of Appeal of Athens).

The Internal Service Regulations of the other Courts provide for similar arrangements. By way of example, the Service Regulation of the Court of Appeal of Thessaloniki stipulates that the 8th civil division is competent to hear copyright cases,⁴⁶⁵ while the 8th division of the Multimember First Instance Court of Thessaloniki and the 4th division of the One-member First Instance Court of Thessaloniki are competent to hear copyright and Community trademark cases, respectively.

According to the established case law of the Court of Appeal of Athens, cases introduced in divisions other than those that are exclusively competent to hear copyright and trademark cases shall be referred to the special division determined as competent to try appeals on such cases for the main reason that the judges of such divisions have special preparation and training in such matters.⁴⁶⁶

The main conclusion drawn by case law is that copyright and industrial property cases are referred to the special divisions for hearing.

6. Judicial Expertise

The operation of an IPR judicial system is very important because Greek judges are specialized and updated about the IPR developments. IPR training programs and courses are organised by the National School of Judges. Conferences and seminars are also held by Ministries and State Organisations. Practically, however, it is impossible for judges to work only on IPR cases and to be relieved from other duties because of the excessive work they have to accomplish.

IPR law has been introduced in the curriculum of the Faculties of Law in Greece, and, as a result, young judges already have the required education in this field of law. Students are interested in intellectual property law and pursue master's degrees or doctoral theses. A corpus of specialist advocates has been developed in the last decade.

⁴⁶⁴ Internal Service Regulation of the Court of Appeal of Athens, Ministerial Decision 7336/2005, Official Gazette B 290/2005 (Greece).

⁴⁶⁵ Amendment to the Internal Service Regulation of the Court of Appeal of Thessaloniki, Ministerial Decision 4140/2007, Official Gazette B 134/2007 (Greece).

⁴⁶⁶ For copyright cases, see Elliniki Dikaisoyini [ED] [Athens Court of Appeal] 4568/2000 (Greece); Elliniki Dikaiosyni [ED] [Athens Court of Appeal] 309/2007 pp. 874-875 (Greece); Elliniki Dikaiosyni [ED] [Athens Court of Appeal] 3020/2008 pp. 536-538 (Greece); Athens Court of Appeal 2064/2009 [Elliniki Dikaiosyni] [ED] pp. 138-139 (Greece).

7. Consistency of Case Outcomes

The consistency in the decision-making process is a potential benefit, but it should be noted that the judicial power is independent. According to Article 87 Par. 1 of the Constitution, justice is administered by courts composed of regular judges who enjoy functional and personal independence. As in other Civil Law countries, no binding force of judicial precedents is formally recognised. However, courts usually follow the holdings of prior decisions.⁴⁶⁷

8. Commercial Impact

Enforcement of IPR has to be efficient for economic and fiscal reasons, for consumer protection, and for public health reasons. Industry is combating counterfeiting and piracy by pursuing infringers in courts. The efficacy of enforcement authorities has positive consequences for businesses, because illegal products are removed from the market and IPR holders are focused on creation of new products and services expanding economic and social development.

9. Lessons for Other Countries

The creation of IPR divisions in Greece was decided in the framework of efforts to provide adequate and effective protection of IPR and in particular of copyright. The special judicial system concerns only civil procedure in order to enforce IPR. However it may be considered as one of the best enforcement practices to take in order to improve protection of copyright. Judges have a better understanding and positive approach to legal problems, showing increased sensitivity to IPR cases. Specialized judges would also be more efficient at resolving cases concerning digital technology and new forms of infringements, such as internet piracy, which are very difficult to combat. The adaptation of legislation to the digital environment is not enough if the judicial opinions cannot follow the developments of technology. However, there are delays in the decision-making process because judges have excessive work and it is impossible for them to focus only on IPR cases.

⁴⁶⁷ Kerameus & Kozyris, *supra* note 438, at 345-363.

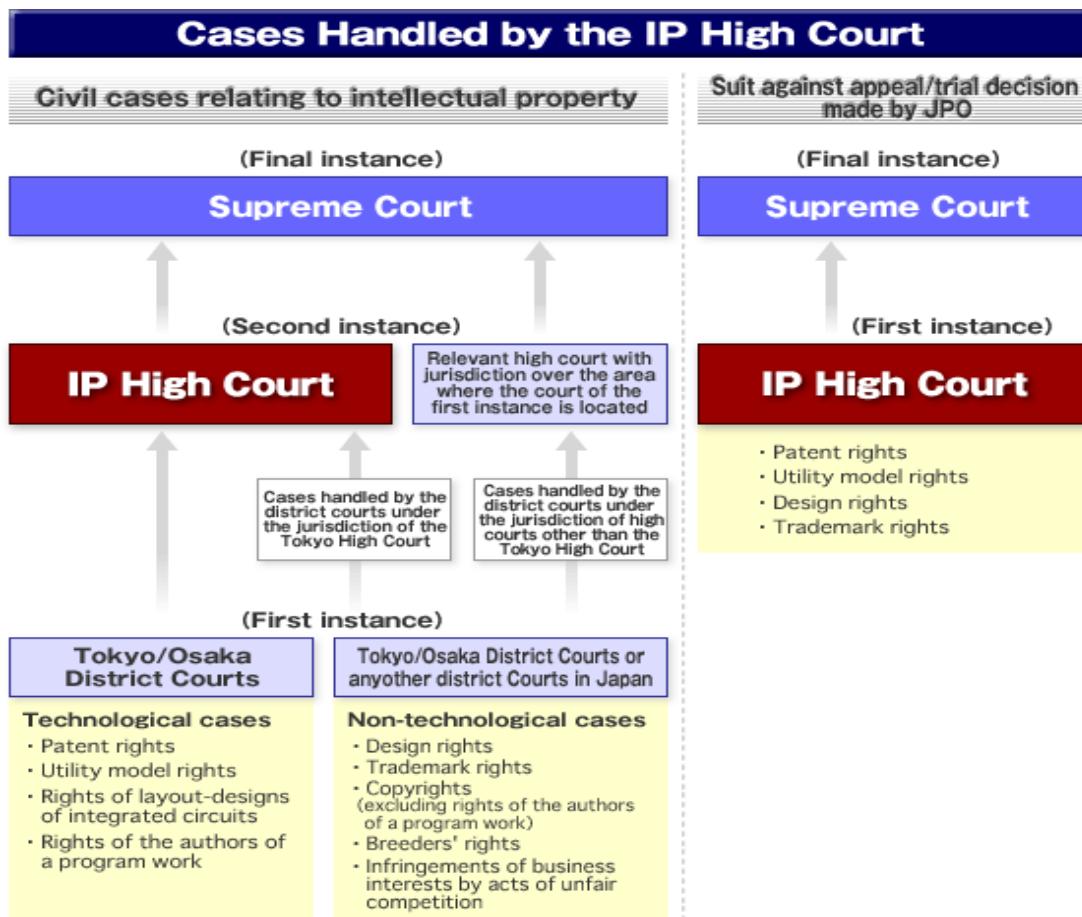
C. Japan

Intellectual Property High Court of Japan: Establishment & Development Ryoichi Mimura and Shinjiro Ono

1. Introduction

The Intellectual Property High Court of Japan (“IP High Court”) was established on April 1, 2005 as a “special branch” of the Tokyo High Court.⁴⁶⁸ Establishment of the IP High Court was, as can easily be imagined, a highly significant development in Japan’s intellectual property rights (IPR) regime.

2. The Current Patent Litigation System in Japan⁴⁶⁹



⁴⁶⁸ Intellectual Property High Court- History, <http://www.ip.courts.go.jp/eng/aboutus/history.html> (last visited January 9, 2012).

⁴⁶⁹ Intellectual Property High Court- Jurisdiction, <http://www.ip.courts.go.jp/eng/aboutus/jurisdiction.html> (last visited January 9, 2012).

There are two kinds of litigation related to patent rights in Japan. The first is patent infringement litigation.⁴⁷⁰ As far as patent infringement litigation is concerned, the Code of Civil Procedure prescribes exclusive jurisdiction. Specifically, only two District Courts, namely, the Tokyo District Court and the Osaka District Court, have first instance jurisdiction over patent infringement litigation.⁴⁷¹ Also, only the IP High Court has second instance (or appellate) jurisdiction for patent infringement litigation.⁴⁷²

The second type of litigation is suits against decisions issued by the Japan Patent Office (JPO) including decisions on patent invalidation. It should be noted that, strictly speaking, this kind of litigation is not a civil lawsuit but an administrative lawsuit. With respect to litigation against decisions issued by the JPO, the Patent Law prescribes exclusive jurisdiction. Only the IP High Court (strictly speaking, the Tokyo High Court) has first instance jurisdiction over litigation against decisions issued by the JPO.⁴⁷³

a. Background and Intellectual Property Court Structure

According to the amendment of the Patent Law in 1948, the Tokyo High Court was given exclusive jurisdiction over litigation against decisions issued by the JPO.⁴⁷⁴ After this amendment, the Tokyo High Court has four Divisions which specialize in handling IPR cases; which are IPR infringement appeal cases and administrative cases against decisions issued by the JPO.⁴⁷⁵ The Tokyo High Court had only two Special Intellectual Property Divisions from the 1950s through 2002,⁴⁷⁶ when this number was increased to four.⁴⁷⁷

There was no exclusive jurisdiction for patent infringement litigation until 2004. There are fifty District Courts and eight High Courts in Japan;⁴⁷⁸ and, until 2004, all District Courts had first-instance jurisdiction over patent infringement litigation and all High Courts had second-instance jurisdiction. However, in practice, over 90 percent of all cases were filed with the Tokyo District Court and the Osaka District Court. In 1999, both the Tokyo and Osaka District Courts had only one Special Division for IPR infringement cases, respectively. The number of Special Divisions has since increased. Since 2004, the Tokyo District Court has had four Divisions and the Osaka District Court has had two Divisions.⁴⁷⁹

A technical court researcher system was introduced in the 1950s. Technical court researchers (or judicial research officials) are full-time court officials.⁴⁸⁰ They are deployed

⁴⁷⁰ Patent Act, No. 121 of 1959, Art. 100, 101, 102 (Japan).

⁴⁷¹ Code of Civil Procedure, No. 109 of 1996, Art. 6 (Japan).

⁴⁷² *Id.*

⁴⁷³ Patent Act, *supra* note 470, Art. 178.

⁴⁷⁴ *Id.*; Intellectual Property High Court- History, *supra* note 468.

⁴⁷⁵ Intellectual Property High Court- History, *supra* note 468.

⁴⁷⁶ *Id.*

⁴⁷⁷ *Id.*

⁴⁷⁸ Supreme Court of Japan- Overview of the Judicial System in Japan, <http://www.courts.go.jp/english/system/system.html> (last visited January 9, 2012).

⁴⁷⁹ Intellectual Property High Court- History, *supra* note 468.

⁴⁸⁰ Intellectual Property High Court- Current Status, <http://www.ip.courts.go.jp/eng/aboutus/current.html> (last visited January 9, 2012).

at the Tokyo High court, the Tokyo District Court, and the Osaka District Court to support judges by conducting research on technical matters.⁴⁸¹

b. Supreme Court Decision on Fujitsu Semiconductor Case (Kilby Patent Case)

Under the traditional system, a court could not decide the validity of a patent in a patent infringement suit. Instead, a court was only able to stay the proceeding until the patent was held invalid through decisions made by the JPO at invalidation trials.

However, the Supreme Court Decision in the Fujitsu Semiconductor Case (or Kilby Patent Case) on April 11, 2000 substantially changed this precedent, ruling that a court in an infringement suit can decide whether or not to invalidate a patent and disallow any claim made based upon such an invalid patent as an abuse of right.⁴⁸²

i. Economic Circumstances and Government Industrial Policy

Japan was one of the most economically successful nations in the world in the 1980s.⁴⁸³ However, triggered by the collapse of the economic bubble, Japan's economy fell into stagnation.⁴⁸⁴ Under such circumstances, intellectual property rights seemed an effective tool to reactivate industries and revive the economy. Developing a court system to protect IPR became part of the industrial policy of the Japanese government.

The Judicial System Reform Council was established in July 1999 and published "Recommendations of the Judicial System Reform Council" in June 2001.⁴⁸⁵ These "Recommendations" consist of fundamental measures necessary to make the judicial system more convenient for the citizens (the users) and produce higher quality verdicts.⁴⁸⁶ In addition, the Judicial System Reform Council specifically discussed the reform of IPR litigation and recommended granting to the Tokyo and Osaka District Courts exclusive jurisdiction over cases related to patent and utility model rights.⁴⁸⁷

In March 2002, the Strategic Council on Intellectual Property was set up as a specialized council within the Cabinet. This Council announced the "Intellectual Property Policy Outline."⁴⁸⁸ The Intellectual Property Policy Outline proposed policies to activate industries and economy through protecting IPR.⁴⁸⁹ Specifically, the Outline proposed centralization of the second (or appeal) instance jurisdiction to the Tokyo High Court over

⁴⁸¹ *Id.*

⁴⁸² Texas Instruments Inc. v. Fujitsu Ltd., 54 MINSHU 1368 (Sup. Ct. Japan, April 11, 2000), available at http://www.softic.or.jp/en/cases/Texas_Inst_v_Fujitsu.html.

⁴⁸³ See Central Intelligence Agency World Factbook: Japan, <https://www.cia.gov/library/publications/the-world-factbook/geos/ja.html> (last updated November 15, 2011).

⁴⁸⁴ *Id.*

⁴⁸⁵ Justice System Reform Council, *Recommendations of the Justice Reform Council for a Justice System to Support Japan in the 21st Century* (June 12, 2001), available at http://www.kantei.go.jp/foreign/policy/sihou/singikai/990612_e.html.

⁴⁸⁶ *Id.*

⁴⁸⁷ *Id.* Ch. 2.

⁴⁸⁸ Strategic Council on Intellectual Property, *Intellectual Property Policy Outline* (July 3, 2002), available at http://www.kantei.go.jp/foreign/policy/titeki/kettei/020703taikou_e.html.

⁴⁸⁹ *Id.*

cases related to patent and utility model rights, and also recommended reinforcement of specialized proceedings to deal with IPR cases.⁴⁹⁰

In March 2003, the Intellectual Property Policy Headquarters was established within the Cabinet. In July, Headquarters adopted the “Strategic Program for the Creation, Protection and Exploitation of Intellectual Property,” stating the necessity to expand the proceedings for IPR cases and to develop the system for prompt proceedings.⁴⁹¹

The Legislative Council of the Ministry of Justice and the Office for Promotion of Judicial System Reform worked simultaneously on separate topics to achieve these proposals. The Legislative Council of the Ministry of Justice worked on issues such as (a) introduction of a legal provision which only allows specific courts to handle cases concerning patent rights and (b) introduction of a Technical Advisor system.⁴⁹² Meanwhile, the Office for Promotion of Judicial System Reform worked on the issues such as (c) establishment of the IP High Court, (d) the relationship between a patent infringement suit, in which a court can decide the validity of a patent, and an invalidation trial handled by the JPO, and (e) improvement and expansion of expert knowledge in IPR litigation.⁴⁹³

ii. Revision of the Code of Civil Procedure in 2003

The Law for Revising the Code of Civil Procedure, established in July 2003, stipulates measures to expand and reinforce the proceedings for IPR litigation.⁴⁹⁴ The Revised Code of Civil Procedure has been enforced since April 1, 2004.

Several revisions of the Code are related to IPR litigation. The first of these grants exclusive jurisdiction over cases related to patents or other IPR to specified courts. The Code stipulates that cases concerning patents, utility models, software-related copyrights, etc. must be exclusively brought before the Tokyo or Osaka District Courts, and appeals are heard exclusively by the Tokyo High Court. This ensures that experienced judges and technical court researchers are assigned to those cases, promoting prompt trials and informed decisions.⁴⁹⁵ Another revision introduces additional jurisdiction over cases concerning copyrights (except for software-related copyrights), unfair competition, industrial design, trademark, etc. This permits plaintiffs to file suit with the Tokyo or Osaka District Court regardless of where the dispute occurred.⁴⁹⁶ A third revision establishes the Grand Panel of the Intellectual Property High Court, a panel consisting of five judges.⁴⁹⁷ Grand Panel Decisions are expected to provide guidelines for similar cases that may arise in the future, which should increase legal stability in the field of IPR.⁴⁹⁸ A

⁴⁹⁰ *Id.* Ch. 3(2).

⁴⁹¹ Intellectual Property Policy Headquarters, *Intellectual Property Strategic Program 2004*, Ch. 2(I)(4) (May 27, 2004), available at http://www.kantei.go.jp/foreign/policy/titeki/kettei/040527_e.html.

⁴⁹² Toshiaki Imura, *Intellectual Property Infringement Litigations and Recent Movement Toward System Reforms*, 29 AIPPI J. 279 § 1 (Sept. 2004).

⁴⁹³ *Id.*

⁴⁹⁴ *Id.* § 2.

⁴⁹⁵ Code of Civil Procedure, *supra* note 471, § 6; Imura, *supra* note 492, § 2.

⁴⁹⁶ Imura, *supra* note 492, § 2.

⁴⁹⁷ *Id.*

⁴⁹⁸ *Id.*

fourth revision introduces the Technical Advisor System.⁴⁹⁹ Through this system, experts such as professors at universities and researchers at research institutes can participate in the proceeding, and judges can obtain advice from such experts.⁵⁰⁰

iii. Amendment of the Patent Law in 2004

The Law for Amending the Patent Law, enacted in June 2004, provides courts with the ability to decide the validity of patents in infringement suits. The Amended Patent Law has been enforced since April 1, 2005.

The Amended Patent Law added Article 104(3), which reads:

Where, in litigation concerning the infringement of a patent right or an exclusive license, the said patent is recognized as one that should be invalidated by a trial for patent invalidation, the rights of the patentee or exclusive licensee may not be exercised against the adverse party.⁵⁰¹

Article 104(3) codifies the Supreme Court Decision in the Fujitsu Semiconductor Case on April 11, 2000. This decision granted courts the power to determine the validity of patents in infringement suits.⁵⁰²

c. Establishment and Development of Intellectual Property High Court

i. Establishment of Intellectual Property High Court in April 2005

On June 11, 2004, the “Act for Establishing Intellectual Property High Court”⁵⁰³ was enacted, and has been enforced since April 1, 2005.

The Law for Establishing Intellectual Property High court declares a necessity for a specialized high court to deal with intellectual property cases.⁵⁰⁴ The IP High Court was established formally as a special branch of the Tokyo High Court.⁵⁰⁵ However, the IP High Court has its own Chief Judge, its own judicial conference and own administrative secretariat, and has been given independent authority over its administrative matters.⁵⁰⁶

Within the Tokyo High Court, the IP High Court handles appeals related to IPR that require expertise and first instance claims against decisions by the JPO.⁵⁰⁷

ii. Organization of Intellectual Property High Court

The IP High Court consists of a Chief Judge, other judges, technical court researchers (or judicial research officials), court clerks, and court secretaries.⁵⁰⁸ Expert Advisors may also be involved in IP cases as part-time officials on a case-by-case basis.⁵⁰⁹

⁴⁹⁹ *Id.*

⁵⁰⁰ *Id.*

⁵⁰¹ Patent Act, *supra* note 470, Art. 104(3).

⁵⁰² Texas Instruments Inc. v. Fujitsu Ltd., *supra* note 482.

⁵⁰³ No. 119 of 2004.

⁵⁰⁴ *Id.* Art. 1.

⁵⁰⁵ *Id.* Art. 2.

⁵⁰⁶ *Id.* Art. 3(5).

⁵⁰⁷ *Id.* Art. 2.

The IP High Court has seventeen judges (including a Chief Judge) in four divisions.⁵¹⁰ Only a few of the IP High Court Judges have studied technology or science. Beneath the IP High Court, the Tokyo District Court has sixteen judges in four Specialized Divisions to hear first-instance cases related to IPR, and the Osaka District Court has six judges in two Specialized Divisions.⁵¹¹

iii. Grand Panel Cases

Intellectual property disputes often involve important legal issues, and court decisions with respect to intellectual property disputes tend to have a heavier economic impact than other ordinary cases. Accordingly, there were stronger needs for reliable rules and consistency of judicial decisions in the field of IPR. In response to this need, the Grand Panel system, in which a five-judge panel hears cases and makes decisions, was introduced in April 2004.⁵¹² The Grand Panel cases are decided by a five-judge panel, but the decisions are, in practice, based on discussions by the whole IP High Court.⁵¹³

Since the establishment of the IP High Court, the Grand Panel has heard and rendered the following important judgments:

(1) Ichitaro Case (September 30, 2005): an appeal case of patent infringement suit, concerning the legal issue of indirect infringement and patent validity.

(2) Parameter Case (November 11, 2005): a first-instance case of suit against decision by the JPO, concerning the legal issue of disclosure requirements imposed by the Patent Law.

(3) Ink Cartridge Case (January 31, 2006): an appeal case of patent infringement suit, concerning the legal issue of patent exhaustion on recycled products.

(4) Solder Resist (Disclaimer) Case (May 30, 2008): a first instance case of suit against decision by the JPO, concerning the legal issue of disclaimer possibility.

(5) Pravastatin Sodium Case: an appeal case of patent infringement suit, concerning the legal issue of product-by-process-claimed patent.

⁵⁰⁸ Intellectual Property High Court- Organization,
<http://www.ip.courts.go.jp/eng/aboutus/organization.html> (last visited January 10, 2012).

⁵⁰⁹ *Id.*

⁵¹⁰ Intellectual Property High Court- List of Divisions and Judges,
<http://www.ip.courts.go.jp/eng/info/list.html> (last visited January 10, 2012).

⁵¹¹ Intellectual Property High Court- History, *supra* note 468.

⁵¹² Ichiro Otaka, *Recent Developments Regarding the Intellectual Property High Court of Japan*, RECENT DEVELOPMENTS IN INTELLECTUAL PROPERTY LAW & POLICY IN ASIA (2006), available at http://www.ip.courts.go.jp/documents/pdf/thesis/060420_21.pdf (last visited January 10, 2012).

⁵¹³ *Id.*

D. Kenya

Kenya's Specialized Intellectual Property Rights Court Regime

Nicholas Ombija

1. Background

This case study seeks to analyze the existing specialized intellectual property rights (IPR) court system in Kenya to determine its level of effectiveness, its ability to handle contentious IPR disputes, and its effects on IPR matters. This study proceeds on the assumption that protection of all the major forms of IPR⁵¹⁴ involves the protection of intangible things such as ideas and/or inventions of the human brain. Therefore, though their protection may be cast in the law, IPR is forever evolving and the law equally evolves with it. However the law, more often than not, does not adapt as fast as human ingenuity would like. This directly reflects on the manner of protection in mainstream courts which in Kenya are of the adversarial/common law system. While the role played by these courts, and their contribution in the protection and enforcement of IPR, cannot be ignored, their static and/or rigid traditions and processes, *vis-à-vis* the fluidity and dynamism of IPR, undoubtedly calls for change of process. This has in turn rendered the service of justice by mainstream courts rather unsatisfactory to millions of IPR owners who have increasingly felt disenfranchised. It is therefore hoped that this survey will provoke discussion and contribute to the enhanced use of specialized IPR courts for the enforcement and adjudication of IPR disputes in Kenya.

2. Intellectual Property Rights in Kenya

In Kenya, IPR are conferred either by statute or common law and they include:

- a) Patents under the Industrial Property Act
- b) Copyright and related rights under the Copyright Act
- c) Trademarks under the Trade Marks Act
- d) Industrial designs under the Industrial Property Act
- e) Utility models under the Industrial Property Act
- f) Technovations under the Industrial Property Act
- g) Geographical indications under the Trade Marks Act and Geographical Indications Act (pending)
- h) Trade secrets by Common Law
- i) Plant breeders rights under the Seeds and Plant Varieties Act
- j) Traditional knowledge under the Constitution

The above categories of IPR are granted by various institutions in Kenya established by their respective legislation. There are three main institutions in Kenya including: the Kenya Industrial Property Institute (KIPI), the Kenya Plant Health Inspectorate Services (KEPHIS) and the Kenya Copyright Board (KECOBO).

⁵¹⁴ Patents, Trademarks, Copyrights, Trade Secrets, Plant Breeders Rights, and Geographical Indications

With regard to the above categories of IPR, various legal mechanisms, general and specialized, exist under Kenyan law to ensure their protection and enforcement i.e. to compel recognition, compliance and respect for IPR conferred by patent, trademark, industrial design, or other categories of IPR.⁵¹⁵

3. Court Structure in Kenya

Courts in Kenya are created under Chapter 10 of the Constitution of Kenya (the "Constitution").⁵¹⁶

a. Superior Courts

Under the Constitution of Kenya the superior courts are:⁵¹⁷

- a) the Supreme Court
- b) the Court of Appeal
- c) the High Court and
- d) such courts as may be established by Parliament to hear cases related to employment and labor relations as well as the environment and the use and occupation of, and title to, land.

b. The Court of Appeal

The Court of Appeal is created by Article 164 of the Constitution. It is comprised of the President of the Court, elected by the Judges of the Court of Appeal, and not less than 12 Judges including the President.

In its appellate jurisdiction, the Court of Appeal has rendered several landmark decisions touching on a number of significant questions on IPR law.⁵¹⁸

c. The High Court

In specific regard to its jurisdiction on IPR law, the High Court exercises a wide scope of jurisdiction over disputes involving unfair competition, trade secrets, trade dress, and passing off and infringement of copyrights and trademarks. In particular, the High Court has exclusive jurisdiction over passing off and infringement of trademarks in Kenya.

In this regard, the High Court has rendered several landmark decisions that have crystallized jurisprudence on various principles of IPR law in line with international best practices and standards. These principles have now come to be recognized as part of the law of Kenya and its IPR regime.

d. Subordinate Courts

⁵¹⁵ See OTIENO ODEK, ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS IN KENYA, (2010).

⁵¹⁶ See CONSTITUTION, Art. 159(1) (2010) (Kenya) ("Judicial authority is derived from the people and vests in, and shall be exercised by, *the courts and tribunals established by or under this Constitution.*"); CONSTITUTION, Art. 161(1) ("The judiciary consists of the judges of the superior courts, magistrates, other judicial officers and staff.").

⁵¹⁷ CONSTITUTION, Art. 162.

⁵¹⁸ See Sanitam Serv. v. Rentokil and Kentainers, (2004) (Kenya).

Subordinate Courts are established under Article 169 of the Constitution or by an Act of Parliament in accordance with that Article and they include:

- a) the Magistrates Courts;
- b) the Kadhi's' Courts;
- c) the Courts Martial; and
- d) any other Court or local tribunal as may be established by an Act of Parliament

The jurisdiction, functions and powers of these subordinate Courts are conferred by the Act of parliament establishing them.

i. The Magistrates' Courts

Magistrates Courts are created under the Magistrates Courts Act Chapter 10 of the laws of Kenya. They handle both civil and criminal matters.

There are currently 105 Magistrates Courts in the country that are stationed at either the district or divisional levels, and there are over 300 Magistrates for the various Magistrates' Courts in the country.

The Magistrates Courts adjudicate on all criminal matters involving infringement of copyright or false representation of trademarks including counterfeits whereas the High Court hears IPR infringement cases brought by parties seeking civil remedies e.g. award of damages. To this extent, Magistrates' courts exercise jurisdiction over prosecution of offenders of IPR in Kenya.⁵¹⁹

ii. Other Courts/Tribunals Established by an Act of Parliament

In addition to the subordinate Courts above, other Courts and tribunals are established by Acts of Parliament to supplement the ordinary Courts in the administration of justice. Tribunals on the other hand are established under various laws made by Parliament to deal with disputes that arise in the course of the regulation and administration of specific matters.

4. Specialized Intellectual Property Rights Courts in Kenya

As stated above, IPR tribunals are established under specific laws made by Parliament to deal with "special" disputes that arise in the course of the regulation and administration of specific IPR matters.

The main specialized IPR tribunals in Kenya include:

- a) The Managing Director of the Kenyan Intellectual Property Institute (KIPI)
- b) The Industrial Property Tribunal (IPT)
- c) The Registrar of Trademarks
- d) The Seeds and Plant Varieties Tribunal

⁵¹⁹ In Kenya, the fact that any matter in issue in any criminal proceedings is also directly or substantially in issue in any pending civil proceedings shall not be a ground for any stay, prohibition or delay of the criminal proceedings. Criminal Procedure Code, (2010) Ch. 75 § 193A (Kenya). A civil suit may be filed against the defendant of a criminal proceeding, increasing the speed and efficiency of court processes.

e) The Competent Authority

a. The Managing Director

The Managing Director is appointed by the Board of Directors of the Institute.⁵²⁰ The Managing Director is responsible for the day-to-day management of the affairs of the Institute. The Institute is charged with the responsibility to consider applications for grant of industrial property rights and to screen technology transfer agreements and licenses.

In the discharge and implementation of the functions of the Institute, the Managing Director makes the decisions to grant or refuse the grant of IPR. He also makes the decisions to register or refuse to register technology transfer agreements and licenses. In addition, formal and substantive examination of patents is done under the name of the Managing Director for and on behalf of the Institute.

The Managing Director also conducts opposition hearings against industrial design applications whenever an application to register a design is opposed.⁵²¹ Any party aggrieved by the decision of the Managing Director pertaining to the grant or refusal to grant an application may appeal to the IPT.⁵²²

The role of the Managing Director in enforcement of patents, industrial designs, and utility models is very limited. The role is purely administrative with regards to making the decision to grant or refuse to grant the respective rights. With regard to industrial design applications, the Managing Director has a very limited enforcement role in opposition proceedings where the application forms part of prior art of an existing industrial design. Substantively, it can be stated that the Managing Director of the Institute has no role to play in enforcement of patent rights, utility model rights, and industrial design rights.⁵²³

b. The Industrial Property Tribunal

The IPT is established under Section 113 of the Industrial Property Act (IPA) for two main purposes:

- a) Hearing and determining appeals where provision is made for appeals from the decisions of the Managing Director under the IPA and
- b) Exercising the other powers as conferred on it by the IPA.

The IPT consists of a chairman and four members appointed by the Minister for Industrialization.⁵²⁴ The chairman of the Tribunal should be a person who has been a judge or who is qualified to be appointed as a judge of the High Court of Kenya, i.e., a person with at least ten years of experience as a superior court judge or professionally qualified Magistrate or at least ten years of experience as a distinguished academic or legal practitioner or any other such relevant legal field.

At least two members of the Tribunal should be persons who have, for not less than seven years, been qualified and entitled to practice as advocates in Kenya; and the other two members must have experience and/or expertise in industrial, scientific, and technological fields.

⁵²⁰ The Industrial Property Act, (2001) § 11 (Kenya).

⁵²¹ The Industrial Property Regulations, (2002) §§ 49(1)-(20) (Kenya).

⁵²² The Industrial Property Act, § 47.

⁵²³ ODEK, *supra* note 515, at 65.

⁵²⁴ The Industrial Property Act, §§ 113(2)-(3).

The sittings of the Tribunal are discretionary, as it sits at such times as it may appoint.⁵²⁵

i. Jurisdiction

The Tribunal has exclusive jurisdiction to hear appeals from the decisions of the Managing Director of KIPI in matters relating to registration of patents, industrial designs, utility models, and technovations. The Tribunal also adjudicates on proceedings relating to applications for patent licenses, applications for revocation or invalidation, and infringement of patents, industrial designs, utility models, and technovations.⁵²⁶

ii. Powers of the Tribunal

The IPT has judicial powers to make any order for the purposes of securing the attendance of any person, the discovery or production of any document, or the investigation or punishment for any contempt of Court, which the High Court has power to make.⁵²⁷

In addition, upon any appeal to the IPT under the IPA, the IPT may

- a) confirm, set aside, or vary the order or decision in question;
- b) exercise any of the powers which could have been exercised by the Managing Director in the proceedings in connection with which the appeal is brought; or
- c) make such orders as to costs as it may deem fit.

iii. Appeals to the High Court

Any party to the proceedings before the IPT may appeal⁵²⁸ from any order or decision of the IPT, to the High Court and upon the hearing of such an appeal the High Court may:

- a) confirm, set aside, or vary the order or decision in question;
- b) remit the proceedings to the IPT with such instructions for further consideration, report, proceedings, or evidence as the High Court may deem fit to give;
- c) exercise any of the powers which could have been exercised by the Tribunal in proceedings in connection with which the appeal is brought; or
- d) make such order as it may deem fit as to the costs of the appeal or of the costs of earlier proceedings in the matter before the IPT.⁵²⁹

Unfortunately, the High Court has not lived up to critics' expectations in this regard and has, according to critics, shied away from addressing itself on technical IPR issues involving industrial designs and patents cases brought before it on appeal.⁵³⁰ Critics have argued that such cases brought before the High Court on appeal end up being returned to the IPT under the High Court's powers to "remit proceedings to the Tribunal with such instructions for

⁵²⁵ The Industrial Property Act, § 113(4).

⁵²⁶ See The Industrial Property Act No. 3 of 2001, § 66, § 71, § 72, § 73, § 76, § 77, § 79(5), § 80(10), § 80(11), § 101, § 103, § 106, § 107, § 108, § 118.

⁵²⁷ The Industrial Property Act, § 114.

⁵²⁸ *Id.*

⁵²⁹ The Industrial Property Act, § 115(2).

⁵³⁰ ODEK, *supra* note 515.

further consideration, report, proceedings or evidence as the High Court may deem fit to give.”

c. The Registrar of Trademarks

The Managing Director appointed under Section 11(1) of the IPA also doubles as the Registrar of Trademarks (the Registrar).⁵³¹ Although it may seem counterintuitive, tribunals are defined under the Trademark Act (TMA) as including, *inter alia*, the Registrar.⁵³²

The Registrar is assisted in discharging his duties under the TMA by a deputy registrar and assistant registrars and other persons who must practice as advocates in IPR matters for at least 7 years. Assistants to the Registrar may be appointed by the Minister of Trade on the recommendation of the Board of KIPI to assist the Registrar in the performance of any of the functions or the exercise of any of the powers conferred upon the Registrar under the TMA with respect to the conduct of hearings relating to opposition to applications for registration or rectification of the register.⁵³³

i. Jurisdiction of the Registrar

The Registrar presides over both contentious and non-contentious matters involving specific aspects of trademarks in Kenya. The TMA prescribes the scope of the Registrar's powers and mandate and provides for channels of appeal from the decisions of the Registrar.

The jurisdiction of the Registrar over non-contentious trademarks matters is mainly administrative and involves matters regarding the registration of trademarks, trademarks searches, screening of trademarks licenses and licensing of trademarks, assignment of trademarks, and general advisory opinions on registrability of trademarks.

The Registrar's jurisdiction over contentious matters relating to trademarks on the other hand is comparatively wider than that of the Managing Director because the Registrar is endowed with a great deal of discretion in the exercise of his powers in such instances. In particular, the Registrar's jurisdiction extends to the following circumstances:

- a) The Registrar has the power, upon request by an applicant for a trademark, to hear submissions against citations or conditions raised by the registry (read examiner)⁵³⁴ under Section 20(2) of the TMA.
- b) Any person may, within the prescribed time from the date of the advertisement of a trademark application in the Industrial Property Journal (IPJ), give notice to the Registrar that he or she wishes to oppose the registration of the mark in Kenya.⁵³⁵ The Registrar presides over such opposition hearings in accordance with the Trademarks Rules (the “rules”).⁵³⁶

⁵³¹ The Trademarks Act, (2002) Ch. 506 § 3 (Kenya).

⁵³² The Trademarks Act, § 2.

⁵³³ The Trademarks Act, § 3(6).

⁵³⁴ The Trade Marks Rules, (1982) § 32 (Kenya).

⁵³⁵ Trademarks Act, § 21(2).

⁵³⁶ The Trade Marks Rules, §§ 46-54.

- c) The Registrar can hear an application by any aggrieved person to remove a registered trademark from the register with respect to any of the goods or services for which it is registered on the grounds that either
 - a. the applicant registered the trademark without any *bona fide* intention to use trademark in relation to those goods or services, and, in fact, neither the applicant nor any proprietor has made *bona fide* use of the trademark in relation to those goods or services for the time being up to the date one month before the date of the application; or
 - b. neither the applicant nor any proprietor made *bona fide* use of the trademark for those goods and services over a continuous period of five years or longer, during which the trademark was a registered trademark.⁵³⁷
- d) The Registrar has the jurisdiction to cancel the registration of a person as a licensee on the application in writing under Section 35 of the TMA.⁵³⁸
- e) Any person aggrieved by the non-insertion in or omission from the register of an entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the Court or, at the option of the applicant, to the Registrar. The Court or the Registrar may make such order for making, expunging, or varying the entry as the Registrar may think fit.⁵³⁹ As with Section 29(1), the procedures to be followed under Section 35(1) are those under rules 82 to 83 and 48 to 57 of the rules.⁵⁴⁰
- f) On application by any person aggrieved to the Registrar, the Registrar may make such order as the Registrar may think fit for expunging or varying the registration of a trademark on the ground of any contravention of, or failure to observe, a condition entered on the register in relation thereto.⁵⁴¹

In all proceedings before the Registrar under the TMA, the Registrar has power to award to any party such costs as he or she may consider reasonable, and to direct how and by which parties they are to be paid. Any such order may, by leave of the Court or a judge thereof, be enforced in the same manner as a judgment or order of the Court to the same effect.⁵⁴²

In exercise of his or her jurisdiction, the Registrar of Trademarks has made several decisions that have greatly influenced the protection of trademarks, particularly those belonging to vulnerable foreigners, in a way that has increased vigilance in the protection and IPR enforcement in the country.

⁵³⁷ The Trademarks Act, § 29(1).

⁵³⁸ The Trademarks Act, § 31(8).

⁵³⁹ The Trademarks Act, § 35(1).

⁵⁴⁰ Note: In proceedings for rectification or expungement under Sections 29, 35, or 36 of the Trade Marks Act, an applicant has an option to make an application either to the High Court or to the Registrar. However, if an action concerning the Trade Mark in question is pending, the application shall be made to the Court and if in any other case the application is made to the Registrar, he may, at any stage of the proceedings, refer the application to the Court, or he may after hearing the parties determine the question between them, subject to appeal to the Court.

⁵⁴¹ The Trademarks Act, § 36.

⁵⁴² The Trademarks Act, § 45(1).

ii. Appeals from the decisions of the Registrar

Decisions of the Registrar may be appealed to the High Court under certain circumstances. In any such appeal, the High Court has – and indeed has exercised – the same discretionary powers that the TMA confers upon the Registrar. The following are the circumstances under which a decision may be appealed:

- a) An appeal may be made in the prescribed manner from the decision of the Registrar on submissions made against citations or conditions raised by the registry (read examiner) under Section 20(2) of the TMA.⁵⁴³ On the appeal, the Court shall, if required, hear the applicant and the Registrar and shall make an order determining whether, and subject to what amendments, modifications, conditions, or limitations, if any, the application is to be accepted.
- b) The decision of the Registrar arising from an opposition hearing is subject to appeal to the High Court.⁵⁴⁴
- c) A decision of the Registrar under Section 31(8) above is subject to appeal to the High Court.⁵⁴⁵

The Registrar has no jurisdiction to hear disputes relating to passing off or infringement of unregistered and registered trademarks respectively. Such disputes can only be brought before the High Court.

d. The Seeds and Plant Varieties Tribunal (SPV Tribunal)

The SPV Tribunal is established under Section 28(1) of the Seeds and Plant Varieties Act Chapter 326 Laws of Kenya (SPVA). However, Section 28(1) was not operational until recently, in 2006, when the Seed and Trade Association of Kenya (STAK) petitioned for its operationalization. The Minister for Agriculture responded and appointed an SPV Tribunal.⁵⁴⁶ Further appointments were made in August 2009 for a period of 3 years.

According to the sixth schedule of the SPVA, the Minister for Agriculture is mandated to appoint a chairman for the Tribunal who must be an advocate.⁵⁴⁷

In addition to the chairman, the Minister for Agriculture appoints other members of the SPV Tribunal selected from a panel of persons who have wide general knowledge in the field of agriculture, horticulture, or forestry; and a panel of persons who have specialized knowledge of particular species or group of plants.

i. Jurisdiction

The SPV Tribunal hears appeals against decisions on the grant of plant breeders' rights.⁵⁴⁸

- a) any person may appeal to the Tribunal where he/she is aggrieved by any decision:
 - i. to allow or refuse the grant of plant breeders' rights; or

⁵⁴³ The Trademarks Act, § 20(5).

⁵⁴⁴ The Trademarks Act, § 21(6).

⁵⁴⁵ The Trademarks Act, § 31(11).

⁵⁴⁶ Kenya Gazette Notice No. 7308 (Sept. 15, 2006).

⁵⁴⁷ The Seeds and Plant Varieties Act, (1991) Ch. 326 Sched. 6 § 1(1). (Kenya).

⁵⁴⁸ The Seeds and Plant Varieties Act, (1991) § 29.

- ii. to cancel the grant of plant breeders' rights; or
 - iii. to allow or refuse an application for extension of the period of plant breeders rights or to terminate such an extension granted; or
 - iv. to allow or refuse any application made for voluntary issuance of compulsory licences against plant breeders' rights
- b) In addition to the above jurisdiction, under Section 29(4), the SPV Tribunal in addition to the above jurisdiction can hear and determine any matters agreed to be referred to the Tribunal by any arbitration agreement relating to the infringement of plant breeders' rights, or to matters which include such infringement. No right of appeal lies from a decision of the SPV Tribunal under this subsection.
- c) The SPV Tribunal, in exercising its statutory jurisdiction, may order any party to the proceedings to pay to any other such party either a specified sum in respect of the costs incurred by the second party or the taxed amount of those costs. Any costs required to be taxed for that purpose shall be taxed in the same manner and on the same scale as costs in a subordinate Court of the first class.⁵⁴⁹
- d) The chairman of the Tribunal has power to administer oaths to witnesses in any proceedings before the Tribunal.

As of this writing, the Tribunal has not made a decision on any of the cases submitted before it. This has been blamed on a procedural technicality regarding the Tribunal's rules of procedure which are yet to be approved by the Chief Justice as required by the SPVA. The Chief Justice of Kenya under the new constitution was only recently sworn in, and the rules are therefore expected to be approved soon.

ii. Appeals

Generally, a decision of the Tribunal is final and conclusive except on a question of law, in which case a final appeal to the High Court, from a decision of the Tribunal, may be made.⁵⁵⁰

e. Competent Authority

Under Section 48(1) of the Copyright Act No. 12 of 2001 ("the Act"), the Attorney General may appoint a Competent Authority for the purpose of exercising jurisdiction under the Act where any matter is required to be determined by such authority.

The "Competent Authority" means an authority of not less than three and not more than five persons, one of whom shall be a person qualified as an advocate of the High Court of Kenya of not less than seven years' standing or a person who holds or has held judicial office in Kenya who shall be the chairman, appointed by the Attorney General for the purpose of exercising jurisdiction under the Act where any matter requires to be determined by such authority.⁵⁵¹

⁵⁴⁹ The Seeds and Plant Varieties Act, Sched. 6, § 6(1).

⁵⁵⁰ The Seeds and Plant Varieties Act, § 29(3).

⁵⁵¹ The Copyright Act, (2009) Ch. 130 § 48(4) (Kenya).

i. Jurisdiction

The jurisdiction of the Competent Authority is generally narrow and extends only to specific issues under the Act, such as disputes related to the establishment of a collecting society.

The Competent Authority may adjudicate in any case where it appears to it that:

- i. the Kenya Copyright Board (“the Board”) is unreasonably refusing to grant a certificate of registration in respect of a collecting society; or
- ii. the Board is imposing unreasonable terms or conditions on the granting of such a certificate; or
- iii. a collecting society is unreasonably refusing to grant a licence in respect of a Copyright work; or
- iv. a collecting society is imposing unreasonable terms or conditions on the granting of such a licence.⁵⁵²

The Competent Authority may direct that, in respect to any act relating to work with which the collecting society is concerned or with respect to the granting of a certificate to operate as a collecting society, a licence or a certificate shall be deemed to have been granted by the collecting society or the Board at the time the act is done or the application is made, provided the appropriate fees are paid or tendered before the expiration of such period or periods as the Competent Authority may determine.

f. The ARIPO Board of Appeal

The Board of Appeal (“the Board”) was established under Section 4bis of the Harare Protocol on Patents and Industrial Designs Within the Framework of the African Regional Intellectual Property Organization (1982) (ARIPO Protocol).

The Board consists of five members who are experienced in IPR matters, two of whom are examiners and are appointed by the Administrative Council.

The functions of the Board are:

- a) to consider and decide on any appeal lodged by an applicant arising from the refusal of an application at the formality or substantive examination stage.
- b) to review any final administrative decision of the Office in relation to the implementation of the provisions of this Protocol, the Banjul Protocol on Marks or any other Protocol within the framework of ARIPO.

The decisions of the Board are final.

It is instructive to note that under the ARIPO protocol, where an applicant appeals to the Board in the terms set out above, Kenya as a designated country may communicate to ARIPO before the expiry of 6 months after the notification of appeal to the Board that where the patent is granted by the Board, it will not recognize that patent. However, if no such communication is received within 6 months after the notification of appeal to the Board, and the ARIPO Office grants a patent resulting from an appeal from the Board, then Kenya will henceforth be bound by the decision of the Board to the extent that a patent, industrial design, utility model, or trademark granted by the ARIPO office will be recognized and protected in Kenya. The Industrial Property Act makes patents granted by

⁵⁵² The Copyright Act, § 48.

ARIPO as effectual and binding in Kenya as any patent that would ordinarily be granted by KIPI.⁵⁵³

5. General effect of the decisions of specialized IPR courts and tribunals in Kenya

Except for the Competent Authority and the SPV Tribunal, which are yet to effectively take off in terms of full operations, the above specialized tribunals have, since their establishment, handled numerous disputes in their respective areas of jurisdiction and rendered equally numerous landmark and trendsetting decisions that have radically transformed the legal and commercial landscape in Kenya with respect to IPR.

6. Effect of the decisions of specialized IPR courts and tribunals on the level of IP expertise in the judiciary in Kenya

The membership of specialized IPR courts and tribunals in Kenya is mainly drawn from persons who have impeccable academic and practical credentials in the country. For example the past⁵⁵⁴ and current⁵⁵⁵ Managing Directors of KIPI, Registrar of Trademarks, chairpersons of the IPT and SPV Tribunal,⁵⁵⁶ and members of the Competent Authority⁵⁵⁷ are persons who have exhibited a proven track record in IP practice and/or are distinguished academics in that field. For that reason, their decisions, on pure principles and points of law, are rarely interfered with by appellate courts of superior record.

That notwithstanding, most judges of the superior courts have very little or no training in IPR law and may not be able to appreciate certain core issues that affect IPR. IPR disputes have, for years, generally not been prioritised by the superior courts. This is apparent even from the administrative divisions of the judiciary where IPR disputes are lumped together with general commercial law disputes.

In essence, decisions of specialized IPR tribunals in Kenya are only persuasive and mainly serve to guide judges of superior courts in their considerations of disputes.⁵⁵⁸ Decisions cannot equip them with the required level of expertise to effectively deal with IPR disputes before them. For instance, it has been the case in Kenya that members of superior courts shy away from rendering judgements in disputes involving technical IPR matters. According to Professor Otieno Odek, the former Managing Director of KIPI, issues on IPR litigation at the High Court and Court of Appeal have not yielded definitive

⁵⁵³ The Industrial Property Act. § 59.

⁵⁵⁴ Professor Otieno Odek for instance is a respected scholar and authority in intellectual property law matters with great experience in IP issues. He is the former chair of the Madrid union of WIPO, Vice chair of the WIPO standing Committee on Trademarks, Industrial Designs and Geographical indications.

⁵⁵⁵ The current Managing Director of KIPI and the Registrar of Trademarks holds two masters degrees and a PhD in Intellectual Property law and is a former lecturer of Intellectual Property law in one of Kenya's oldest Universities- Moi University, faculty of law.

⁵⁵⁶ Professor Patricia Kameri Mboote is the first and current chair of the SPV Tribunal. Professor Mboote is a respected legal scholar and has published widely on intellectual property matters involving biotechnology and plant breeders rights.

⁵⁵⁷ The Current members of the Competent authority are highly experienced and respected legal practitioners in intellectual property law in Kenya.

⁵⁵⁸ Kenya being a common law jurisdiction, judges of the superior courts are not bound to follow the decisions of inferior courts and tribunals.

jurisprudence on Kenyan IPR law, but rather have seen courts refer IPR litigants, particularly on patent and industrial design infringement disputes to the IPT. There seems to be reluctance on the part of the High Court to deal with patent issues.⁵⁵⁹

However, in other instances the principle of *stare decisis* coupled with the Kenya Judicature Act Chapter 8 laws⁵⁶⁰ have meant that Kenya's Superior Courts still rely heavily on the decisions of specialized IPR courts in England on similar factual situations occurring in Kenya. Reliance on those cases is further reinforced by the provisions of some of the statutes in Kenya, especially the 1938 Trade Marks Act, which were transplanted verbatim from England, hence making commentaries, cases, and decisions made on the provisions of those statutes highly persuasive in Kenya. In that regard, Reports on Patent Cases (R.P.C.) and Fleet Street Reports (FSR) are very highly regarded in the country's judiciary and have in a special way helped develop Kenya's jurisprudence on IPR law.

Similarly, very few law firms in Kenya have fully-fledged departments that offer exclusive services on IPR law. As a result, the number of expert legal practitioners is very low. However, the few advocates who practice in this area have contributed immensely to the development of jurisprudence in the decisions of the tribunals and have equally benefited from the expertise of their counterparts at the tribunals.

7. Effect of Specialized IPR courts and tribunals on the conduct of commerce in IP dependent sectors in Kenya

Generally, specialized IPR courts have greatly improved the enforcement of IPR in Kenya by creating a quicker and more effective decision-making process. In view of the high expertise of members of these tribunals *vis-à-vis* the expertise of the mainstream courts, the time spent on litigation has greatly reduced, which, in turn, has encouraged vigilance by rightsholders in protecting their rights. More and more companies and individuals are, as a result, able to invest in enhancing the value of their IPR because of the certain and expert legal environment, the reduced costs of litigation, and hence higher revenues, etc.

Specialized IPR courts have also ensured continuity in innovation in the IP sector which has translated to improved quality of goods and higher standards of living. In economic terms, an improvement in the standard of living of a populace directly impacts the spending power of that populace, creating a robust commercial environment for more investment.

Moreover, as a result of the foregoing achievements, companies with a high net worth of IPR have successfully influenced the credit sector of financial institutions which have now shown willingness to hold certificates of grant of patents, trademarks, industrial designs, etc., as collateral security for loan facilities through debentures and floating charges. This has greatly shifted over-reliance on traditional securities for financing.

Finally, specialized IPR courts and tribunals have greatly ensured public and consumer protection by rendering decisions that prevent protection for similar marks or industrial

⁵⁵⁹ ODEK, *supra* note 515, at 97.

⁵⁶⁰ This applies to the substance of the common law, the doctrines of equity and the statutes of general application in force in England on August 12, 1897, and the procedure and practice observed in the courts of justice in England at that date subject to and so far as written laws do not extend or apply. Kenya Judicature Act Cap 8, Section 3(1)(c).

designs or the protection of patents in methods of treatment. These are mainly public policy issues that the tribunals have sought to protect especially in cases where human health is concerned.

That IPR are a function of commerce and trade cannot be over-emphasized. IPR contribute millions of Kenyan Shillings to the local economy in the form of employment, government revenue, and consumer spending on branded and new commodities that are the result of IPR. This aspect of commerce is most certainly, directly or indirectly, attributable to the favorable legal environment within which rightsholders operate, including the existing enforcement mechanisms provided by specialized tribunals. Indeed some of the benefits arising from IPR can be credited to the decisions of these tribunals and are summarized below.

- a) Improved certainty of the legal implications and consequences of certain offending acts or omissions in relation to IPR.
- b) Increased foreign direct investment in IPR-intensive industries in Kenya, buoyed by the confidence of certainty and consistency of IPR principles and laws and compliance with international treaties and agreements to which Kenya is a party.
- c) Efficiency of time and resource in litigation, which has greatly improved the cost of doing business in Kenya and improved investor confidence and assurance of returns for innovation.

8. The positive Impact of Specialized Intellectual Property Tribunals in Kenya

The legal and socio-economic impact thus far of specialized IPR tribunals in Kenya cannot be gainsaid. IPR tribunals in Kenya have provided fora for the settlement of disputes, albeit with a number of hiccups at various stages. The fact though, as may be gleaned from the forgoing discussions, is that they have provided a foundation upon which improvement can be built on. A number of milestones have been achieved in the protection of IPR, and they are discussed below.

a. Enforcement of IPR

Rights have no value unless they can be enforced. To this extent, IPR as intangible rights to creativity and innovation have been protected in Kenya thanks to the enforcement powers granted to them by their respective constitutive legislation. Although these powers have not performed to their optimal best, they have achieved great milestones in compelling recognition, compliance, and respect of IPR conferred by patent, trademark, industrial designs, copyright, and soon plant breeders' rights and geographical indications.

In essence, through the enforcement of IPR, these tribunals have achieved the following:

- a) The legal validity of IPR have been preserved by preventing passing off and infringements of industrial designs and patents and registration of offending trademarks;
- b) The rights of IPR holders and consumers have been protected and upheld through the screening of trademark licenses, prevention of registration of similar trademarks that are bound to cause confusion, screening of technology transfer

- agreements and licenses in patents to prevent archaic and oppressive agreements that may stifle availability of vital products in the market, etc.
- c) The tribunals have ensured that IPR holders do not abuse their exclusive rights, for instance, through expungement of trademarks that are not used or industrial designs and trademarks that are registered without sufficient cause.
 - d) The tribunals have, by some of their decisions, encouraged vigilance in the protection and enforcement of IPR and therefore indirectly enhanced innovative space in Kenya.

b. Efficiency of time and resources

Due to the specialized nature of the tribunals, they have managed to develop some jurisprudence on various procedural and substantive IPR law issues which have helped hasten decision making on whether or not to litigate for IPR holders. In addition, the tribunals have tremendously assisted in reducing the backlog of cases before the mainstream courts, which has translated to quicker and lesser expensive litigation. The time it generally takes to conclude a case before a tribunal is approximately six months. It would take almost three years for a similar case to be concluded in the mainstream court. This efficiency is attributable mainly on the following special attributes of the tribunals in Kenya:

- a) The procedure for instituting and prosecuting a dispute is clearly provided for with strict timelines. This makes the process self propelling in the sense that one process automatically initiates the next as soon as the prescribed timelines are met.⁵⁶¹
- b) All the pleadings necessary for the institution or notification of a dispute and subsequent filings are prescribed by the relevant statutes. This makes the process far simpler and less complicated than the procedure in the mainstream courts and hence easily accessible even to lay people. In addition, this makes the process far cheaper for litigants.

Bearing in mind the commercial nature of these decisions, the significance of the timely manner with which they are made cannot be gainsaid.

In most, if not all, tribunals, evidence is tendered by way of statutory declarations whose formats are themselves prescribed, and *viva voce* evidence is sparingly used and only when required by the tribunal. To this end, costs of litigation are greatly reduced because witnesses are not required to attend hearings in person. In practice, this has proven to be of great benefit to foreign litigants who would otherwise spend millions of shillings travelling to and from their countries of residence to attend hearings in Kenya

c. Expertise

Whereas mainstream courts are run by judges of general legal expertise, the technical nature of IPR law sometimes requires expert handling, which has been readily available at the tribunals. In the IPT and the SPV Tribunal, persons with special scientific and technical expertise and persons who have wide general knowledge in the field of agriculture,

⁵⁶¹ See The Trade Marks Rules, §§ 46-54, 82-83; The Industrial Property Regulations, §§ 49(1)-(2). (oppositions on industrial designs before the Managing Director). See generally The Industrial Property Act, §§ 112-118 (disputes before the Industrial Property Tribunal).

horticulture, or forestry or specialized knowledge of particular species or group of plants sit as members.⁵⁶² Because of this, they are able to assist lawyers in interpreting technical and scientific issues arising in disputes before them. In addition, the IPT has powers to call in assessors of special expertise to assist them in their decision making.⁵⁶³ For those reasons, specialized IPR tribunals have offered litigants fora that properly and effectively understand their issues without the need for the litigants to spend more money hiring expert witnesses to help with their cases. In addition, the comprehensive understanding of and familiarity offered by such expertise provides greater consistency in the decision-making process hence providing litigants with a more predictable outcome of the proceedings.⁵⁶⁴

Finally, IPR tribunals have clearly spelt out mandates and jurisdictions. They are able to focus on only the relevant issues within their express mandate, saving them the precious time and resources in dealing with omnibus suits that are characteristic of mainstream Courts. In addition, more and more advocates are encouraged to specialize in this area of law and hence provide effective quality service to IPR owners.

d. Compliance with International Standards

The challenges outlined below notwithstanding, the specialized tribunals in Kenya have done comparatively well in attracting confidence and investment into East Africa by international investors. Kenya is a signatory to the Patent Cooperation Treaty (PCT),⁵⁶⁵ the Madrid Agreement and Protocol concerning the International Registration of Marks,⁵⁶⁶ the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS),⁵⁶⁷ the ARIPO Protocol,⁵⁶⁸ the 1993 Banjul Protocol on Marks and Regulations for Implementing the Banjul Protocol,⁵⁶⁹ and the Paris Convention for Protection of Industrial Property Rights of 1883.⁵⁷⁰

These specialized tribunals have therefore ensured that Kenya reciprocates in its international responsibilities under the international trade law principle of national treatment through the equal protection and enforcement of IPR belonging to non-nationals.

⁵⁶² The Industrial Property Act, § 113(3); The Seeds and Plant Varieties Act, Sched. 6 § 3.

⁵⁶³ The Industrial Property Act, § 116.

⁵⁶⁴ Ibid note 4 at Para 4.2.

⁵⁶⁵ See Patent Cooperation Treaty, June 19, 1970, 29 U.S.T. 7645, available at <http://www.wipo.int/pct/en/texts/articles/atoc.htm>.

⁵⁶⁶ See generally WORLD INTELLECTUAL PROP. ORG., MADRID AGREEMENT AND PROTOCOL CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS (2011) (electronic communication between the International Bureau of the World Intellectual Property Organization and holders of international registrations), available at http://www.wipo.int/edocs/madrdocs/en/2011/madrid_2011_36.pdf.

⁵⁶⁷ See generally Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, 1869 U.N.T.S. 299, available at http://www.wto.org/english/docs_e/legal_e/27-trips_01_e.htm.

⁵⁶⁸ See generally African Regional Intellectual Property Organization, <http://www.aripo.org> (last visited Nov. 22, 2011).

⁵⁶⁹ See generally Banjul Protocol on Marks Within the Framework of the African Regional Industrial Property Organization, Nov. 19, 1993, available at

http://www.wipo.int/wipolex/en/other_treaties/details.jsp? treaty_id=203.

⁵⁷⁰ See generally Paris Convention for the Protection of Industrial Property, March 20, 1883, 828 U.N.T.S. 305, available at http://www.wipo.int/treaties/en/ip/paris/trtdocs_wo020.html.

For that reason, thousands of foreign investors have set up shop in Kenya as their destination of choice with the belief in the system of IPR protection and enforcement.

9. The weaknesses and challenges of specialized Intellectual Property Tribunals in Kenya

The effectiveness of the specialized tribunals discussed above has not been without blemish. Whilst they offer the common advantages and efficiencies of specialization and technical expertise free from the rigours of mainstream courts of law, they have also experienced challenges and weaknesses in their operations that have hindered their realisation of expectations of players in the IPR arena.

Both in theory of the law and resultant practice, these specialized tribunals are dogged by a number of challenges that affect their output and these challenges are the function of various political, economic, and legal factors and are inextricably intertwined. Most of these challenges are common to all the specialized IPR tribunals and they include the following;

- a) Methods and procedures of appointment and removal of tribunal members
- b) Organization and qualifications of tribunal members
- c) Terms and period of service of tribunal members
- d) Resource allocation to the tribunals
- e) Law reporting system of the tribunals
- f) Public ignorance.

10. Conclusion and Recommendations

In conclusion, it is fundamental to recognize that specialized IPR tribunals are vital relative to the socio-economic development of a country – hence the need to invest in them for the development of strong IPR laws in the country. A strong and predictable system of laws, developed over time by well-structured tribunals, will easily win over the confidence of the masses and inspire innovation and invention buoyed by the security that exists for the protection of economic interests in IPR.

This may not necessarily be the case in Kenya at the moment because of the challenges identified above. However, the status quo may be changed with a focused review of the challenges cited above with a view to improving the legal status and mode of operation of these tribunals into highly efficient, qualitative, and reliable specialized tribunals.

A right without a remedy is a fantasy. If judicial support for IPR is feeble, mobilization of creativity wanes. Innovators will not invest in the inventing, developing, implementing, and marketing of a new technology unless they believe that the IPR system is real. If inventors find that patents, trademarks, or copyrights are only licenses to spend money pursuing court cases, IPR will fail to fulfil their promise to stimulate innovation and creativity⁵⁷¹

In summary, the following recommendations for reform are proposed for Kenya's specialized IPR tribunals:

- a) A developed law reporting system to ensure consistency in the development of the law

⁵⁷¹ ODEK, *supra* note 515.

- b) Greater resource allocation in financial terms and expertise to enhance the specialized tribunals' capacity to handle the dynamism of IPR and the challenges that comes with the same
- c) Amendment of the various IPR laws to grant greater autonomy to the specialized tribunals in order to enhance efficiency and better service delivery
- d) Improved terms of service of tribunal members in order to assure commitment to their duties
- e) Enhanced public awareness initiatives to sensitize the public on IPR and to encourage vigilance in enforcement
- f) Provision of training to investigators and inspectors to enhance effective surveillance of forged or counterfeited trademarks in the country and to ensure effective prosecution of criminal offenders

E. Malaysia

The Establishment of the Intellectual Property Court in Malaysia

Assoc. Prof. Rohazar Wati Zuallcoble

1. Background

In Malaysia, the following legislation provides for the protection of intellectual property rights (IPR):

- a) The Copyright Act 1987;⁵⁷²
- b) The Optical Disc Act 2000;⁵⁷³
- c) Patent Act 1983;⁵⁷⁴
- d) Trade Marks Act 1976;⁵⁷⁵
- e) Industrial Designs Act 1996;⁵⁷⁶
- f) Geographical Indications Act 2000;
- g) Layout Designs of Integrated Circuit Act 2000; and
- h) Trade Descriptions Act 2011.⁵⁷⁷

Additionally, common law protections, under the laws of passing-off and breach of confidential information, support the aforementioned legislation, hereinafter referred to collectively as “Intellectual Property Laws.”

Intellectual Property Laws provide a platform for the enforcement of any breach of IPR, whether in civil or criminal actions. At present, criminal action can only be initiated for infringement of copyright and trademark. Civil actions for copyright infringement can be taken under Section 36 of the Copyright Act and criminal provisions are provided for under Section 41 of the same Act. Trademark rights can be enforced by civil action under Section 38 of the Trade Marks Act 1976 and criminal prosecution under Section 8 of the Trade Description Act 2011.⁵⁷⁸ As for protection of rights under the laws relating to patent, industrial design, and geographical indications, only civil actions are available to the owner.

The provisions of the Intellectual Property Laws in Malaysia are in harmony with the obligations required of member countries under the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS). Article 61 of the TRIPS Agreement provides that, “Members shall provide for criminal procedures and penalties to be applied at least in cases of willful trademark counterfeiting or copyright piracy on a commercial scale. Remedies available shall include imprisonment and/or monetary fines sufficient to provide a deterrent, consistently with the level of penalties applied for crimes of a corresponding gravity.”

⁵⁷² Enforced 1987. A new Copyright Amendment Act 2011 has been passed by the House of Representatives in Parliament and, as of writing, awaits the decision of the Senate. The government is optimistic that this Amendment will be enforced in 2012.

⁵⁷³ Provides for the licensing of Optical Disc manufacturers.

⁵⁷⁴ Enforced 1986.

⁵⁷⁵ Enforced September 1, 1983.

⁵⁷⁶ Enforced 1999.

⁵⁷⁷ Enforced November 2011.

⁵⁷⁸ The section provides for “Prohibition on False trade description in relation to trade mark.”

Even though the enforcement mechanisms and structure of the Intellectual Property Laws in Malaysia are sufficiently provided by the Government, the problem of piracy is still serious enough to prompt the United States to place Malaysia on its the Special 301 Watch List in 2006.⁵⁷⁹ At the same time, Malaysia must deal with counterfeit products in its own domestic market.

The laudable effort by the Malaysian government to provide sufficient enforcement mechanisms and structure for Intellectual Property Laws, coupled with the harmonization of obligations required by TRIPS and international conventions, make its independent Intellectual Property Court a positive move forward. This effort provides the courts with a system that enables cases involving IPR infringement to be dealt with effectively.

The findings made by the Technical Committee,⁵⁸⁰ based on its study tour to the Intellectual Property Courts in South Korea, Thailand, Japan, and the United Kingdom, suggested that it is useful to establish an Intellectual Property Court in Malaysia. Their findings included the following:

1. The establishment of an Intellectual Property Court will ensure efficient and speedy trials of IPR cases because the Intellectual Property Court will be manned by staff with adequate IPR exposure and expertise. The judges who preside over cases in Intellectual Property Courts will be chosen from those who have the necessary experience, and long standing involvement with the technical aspects of IPR, to dispose of IPR cases with precise and correct interpretations of the relevant Intellectual Property Laws. The Technical Committee findings also suggest that the decisions made by judges with IPR backgrounds and expertise will reduce the possibility of appeal considerably and this will ultimately save the court's time and public money.
2. An Intellectual Property Court will enhance the National coordination in the interpretation of the provisions of Intellectual Property Laws through specialized training that can be conducted for Intellectual Property Court judges and staff to enable them to deal with difficult and complex IPR issues. This is because IPR cases sometimes involve highly technical and complex matters which require high levels of understanding and expertise on the subject to be able to resolve them. Only judges with adequate IPR exposure and expertise can correctly interpret the relevant Intellectual Property Laws and thus, make the right and just decision on the matter before them. The Committee emphasized the important function of judges in providing protection in IPR cases to encourage commercial exploitation of IPR and to further enhance economic development in modern society.
3. The establishment of the Intellectual Property Court will not only provide a speedy process of settlement in IPR cases, but will also encourage awareness and confidence by the general public on the legal protection afforded to IPR.
4. Further, the establishment of the Intellectual Property Court will bring confidence to the country's commercial and business community and ultimately contribute to the

⁵⁷⁹ OFFICE OF THE U.S. TRADE REPRESENTATIVE, 2006 SPECIAL 301 REPORT 8 (2006), available at http://www.usit.gov/archive/assets/Document_Library/Reports_Publications/2006/2006_Special_301_Review/asset_upload_file473_9336.pdf.

⁵⁸⁰ The Technical Committee was established by the Ministry to write the White Paper for the establishment of the Intellectual Property Court in Malaysia.

country's economic growth from the international foreign investment perspective. The study indicates that the flow of foreign investment will increase whenever the government gives priority towards the enforcement of IPR. Thus, the establishment of the Intellectual Property Court will provide a strong indication to the international community about the seriousness of the Malaysian government to provide effective protection for IPR.

5. Referring to the keynote address made by Deputy Prime Minister of Malaysia at the launching ceremony of the Malaysian Intellectual Property Day 2006, which was held at Kuala Lumpur Convention Centre (KLCC) on April 27, 2006, His Honor, the Deputy Prime Minister, expressly stated that Malaysia should endeavor to become a producing country or innovating country and not merely as an innovation user. He further aspired to make the Malaysian biotechnology industry develop in parallel to the international development of the industry. Both of these aspirations can only be achieved if the Government provides an adequate platform for the enforcement and protection of the IPR. The actual realization of the Intellectual Property Court by the Government of Malaysia is undoubtedly a very strong indication of the government support to achieve those aspirations.
6. Currently, Malaysia does not have many judges with adequate technical knowledge and expertise in IPR matters. The establishment of the Intellectual Property Court will provide an opportunity for judges and interested practitioners to specialize in the field of IPR and ultimately, will produce highly knowledgeable and expert judges and practitioners required to manage and preside over matters of IPR. This will directly and/or indirectly promote the image of Malaysia in the eyes of the international community as a country with a serious outlook to develop and enforce IPR in this region.
7. The establishment of an Intellectual Property Court will gradually develop judges into high-caliber experts with the capacity to dispose of complex cases with ease. Judges with specific knowledge in IPR matters can appreciate the economic implications of the IPR infringement. Furthermore, their decisions would reflect the government aspiration to give effective protection to IPR while ensuring that the country's obligations under international treaties are properly observed.
8. The establishment of an Intellectual Property Court would provide the necessary platform for the Court to become the country's IPR research center capable of resolving complex IPR matters. The resource center will provide judges and interested practitioners with modern and well-equipped knowledge and research facilities for continuous practical training. This will enhance Malaysia's reputation amongst the leading members of the international IPR community.

2. Establishing the Malaysian Intellectual Property Court

Based on the research conducted, the Technical Committee submitted a proposal for the establishment of an Intellectual Property Court in Malaysia. The proposal was for the Intellectual Property Court to be given exclusive jurisdiction to hear and determine issues on criminal and civil infringement of IPR matters. To assess the viability of the intended court, a pilot project commenced whereby one Criminal Session Court, known as Criminal Session Court 4 in Kuala Lumpur, was designated as a court that would exclusively try

criminal IPR cases starting January 1, 2006. This pilot project ran for 6 six months. The findings of the pilot project noted the following:

1. The dedicated Intellectual Property Court was able to try cases more effectively and at a faster rate. Since the specialization of the court is on criminal prosecution of IPR matters, the disposal rate for each case was faster. The court was no longer burdened with hearing other criminal cases.
2. The presiding judge and supporting staff must be knowledgeable in IPR matters for the court to run effectively.

3. The Outcome

On 17 July 2007, the Malaysian government launched the Intellectual Property Court. A total of fifteen Intellectual Property Session Courts with exclusive jurisdiction over IPR cases were established. Malaysia is a Federation of fourteen states comprising Sabah, Sarawak, Kelantan, Trengganu, Pahang, Johore, Malacca, Penang, Perlis, Kedah, Negeri Sembilan, Perak, Selangor and the Federal Territory. One Intellectual Property Session Court was established for each state and two Intellectual Property Session Courts were established for the Federal Territory, namely one court in Kuala Lumpur and the other in Putrajaya. For civil IPR cases, five Intellectual Property High Courts were established, three for West Malaysia and one each for Sabah and Sarawak.

4. The Jurisdiction of the Courts

In order to understand the jurisdiction and power of the Intellectual Property Session Court, it is best to understand the administration of justice in Malaysia, which is divided between the Superior Courts and the Subordinate Courts.

The Superior Courts consist of the Federal Court, Court of Appeal and the High Courts. These courts are established by the Federal Constitution and their jurisdiction is provided in the Courts of Judicature Act 1964.

The Subordinate Courts consist of the Sessions Courts, Magistrates' Courts and (in West Malaysia) Penghulu's Courts. The establishment and jurisdiction of the Subordinate Courts are provided in the Subordinate Courts Act 1948.

The distribution of jurisdiction and powers of the courts is based on the types of offenses and punishments that can be given by the court.

In Malaysia, as part of its common law heritage, the trial of a legal action is based on the adversarial principle. In addition to the above mentioned courts, there are other judicial and quasi-judicial bodies with specific jurisdiction. These are specialized bodies established by specific statutes primarily to spare the courts from additional work or to decide disputes of a technical nature. Unlike courts, these quasi-judicial bodies are generally not presided over by lawyers and are not required to strictly observe the rules of evidence and procedure.

a. The Federal Court

The Federal Court is established under Article 121(2) of the Federal Constitution. It consists of the Chief Justice of the Federal Court (as the president of the court), the President of the Court of Appeal, the two Chief Judges of the High Courts, and four other

judges and such additional judges as may be appointed. The current number of Federal Court judges is seven. All judges of the Federal Court are appointed by the Yang di-Pertuan Agong (head of state), acting on the advice of the Prime Minister after consultation with the Conference of Rulers. Except for the appointment of the Chief Justice himself, the appointment of all other judges is done in consultation with the Chief Justice. Every proceeding of the Federal Court is heard and disposed of by three judges or such number as the Chief Justice may determine. The Federal Court, as a final court of appeals, normally sits in a full bench of five judges, although in very rare and important cases it may sit as a full bench of seven.

The Federal Court has the following jurisdiction:

- 1) Original jurisdiction;
- 2) Appellate jurisdiction;
- 3) Referral jurisdiction; and
- 4) Advisory jurisdiction.
- 5) Original Jurisdiction

i. Original Jurisdiction

The Federal Court has unlimited jurisdiction in both civil and criminal matters. It can try any civil case of any value or any criminal case, no matter how grave. In addition, the Federal Court has exclusive original jurisdiction under Article 128(1) Federal Constitution to:

- (a) determine whether a law made by Parliament or by the legislature of a state is invalid on the grounds that it deals with a matter in which it has no power to legislate; and
- (b) decide disputes on any other question between the States of the Federation or between the Federation and a State; and in such a dispute, the Federal Court may give only a declaratory judgment.

The Federal Court may in its original jurisdiction also exercise a consultative jurisdiction when the need arises.

ii. Appellate Jurisdiction

The bulk of the Federal Court's work is hearing and determining civil and criminal appeals.

In civil cases, Section 96 Court of Judicature Act 1964 provides that an appeal may be made from the Court of Appeal to the Federal Court with leave of the Federal Court. Such an appeal can be made on any final judgment or order of the Court of Appeal, or on a matter decided by the High Court in the exercise of its original jurisdiction in the following matters:

- (i) the matter in dispute amounts to or is of the value of RM250,000 or more; or
- (ii) the appeal involves directly or indirectly a claim of respective property or some civil right of comparable amount or value.

The Federal Court may also hear appeals arising from any decision as to the effect of any provision of the Federal Constitution, including the validity of any written law concerning any such provision.

In criminal cases, the Federal Court has jurisdiction to hear and determine any appeal against any decision of the Court of Appeal in its appellate jurisdiction concerning any criminal matter decided at first instance by the High Court. Under Section 90 of the Court of Judicature Act 1964, the Federal Court may summarily dismiss an appeal that comes before it. It may also confirm, reverse, or vary the decision of the Court of Appeal, or order a retrial or remit the matter with its opinion to the High Court, or make such other order as it may deem just.

iii. Referral Jurisdiction

The Federal Court may determine constitutional provisions which have arisen in proceedings in the High Court or in any of the subordinate courts, but which are referred to it for a decision by way of a special case. When the Federal Court decides a case, it remands the case to the trial court to be disposed of in accordance with the decision. Pending a decision by the Federal Court, the trial court may stay proceedings.

iv. Advisory Jurisdiction

Under Article 130 of the Constitution, the Federal Court may give its opinion on any question which has arisen, or appears likely to arise, and which has been referred to it by the Yang di-Pertuan Agong, concerning the effect of any provision of the Constitution. The Federal Court then pronounces its opinion in open court on the question so referred.

b. Court of Appeal

The Court of Appeal was established by Article 121(1B) of the Federal Constitution. Created in 1994 by the Constitution (Amendment) Act 1994 and the Courts of Judicature (Amendment) Act 1994, the Court of Appeal provides an additional level of appeal and relieves the workload of the Federal Court. The jurisdiction of the Court of Appeal is:

1. to determine appeals arising from the decisions of a High Court or a judge thereof, and
2. to determine any other case as may be conferred by or under federal law.

In civil cases, Section 67 of the Court of Judicature Act (1964) provides the Court of Appeal with jurisdiction to hear and determine appeals from any High Court in any civil cause or matter, whether made in the exercise of its original or its appellate jurisdiction.

However, Section 68 of the Court of Judicature Act provides that appeals may not be made to the Court of Appeal in the following cases:

- (1) where the amount or value of the subject-matter of a claim (exclusive of interest) is less than RM250,000, except with leave of the Court of Appeal;
- (2) where the judgment or order is made by consent of the parties;
- (3) where judgment or order relates to costs only, which by law, are left to the discretion of the court except with the leave of the Court of Appeal; and
- (4) where the judgment or order of the High Court is expressly declared to be final by any written law.

An appeal to the Court of Appeal is essentially a case rehearing, in which the Court of Appeal has all the powers and duties of a High Court. The Court of Appeal may order a new trial, reverse, or alter the decision of the High Court.

In criminal cases, the Court of Appeal may hear and determine an appeal against any decision made by the High Court in the exercise of its original jurisdiction. In addition, the Court of Appeal may hear and determine an appeal against decisions made by the High Court in the exercise of its appellate or revisionary jurisdiction in respect to any criminal matter decided by the Session Court.

The Court of Appeal has power to:

- 1) summarily dismiss appeals;
- 2) confirm, reverse, or alter the decision of the trial court;
- 3) order a retrial or remit the matter with its opinion thereon to the trial court; or
- 4) make such other order in the matter as is just and may, by that order, exercise any power which the trial court might have exercised.

c. High Court

There are two High Courts of equal jurisdiction and status: the High Court of Malaya and the High Court in Sabah and Sarawak. They are constituted under Article 121(1) of the Constitution and their powers are conferred by Federal law.

i. Original Jurisdiction

The High Court has unlimited jurisdiction in both civil and criminal matters. However, the High Court normally tries cases that the subordinate courts cannot due to their jurisdictional limits. Civil cases constitute the bulk of the High Court's work. In practice, it tries cases where the amount involved exceeds RM250,000. The High Court tries few criminal cases compared to the subordinate courts. These cases involve offences which are punishable by death and a few other very serious offences.

The civil jurisdiction of the High Court is set out in Section 23 of the Court of Judicature Act (1964), which gives the High Court power to try all civil matters as follows:

- (1) where the cause of action arose within the local jurisdiction of the court;
- (2) where the defendant or one of several defendants resides or has his place of business within its local jurisdiction;
- (3) where the facts on which the proceedings are based exist or are alleged to have occurred within its local jurisdiction; and
- (4) where any land, the ownership of which is disputed is situated within its local jurisdiction.

Section 24 enumerates the matters of which the High Courts have jurisdiction:

- (1) divorce and matrimonial causes;
- (2) admiralty matters;
- (3) bankruptcy and companies;
- (4) appointment and control of guardians of infants, generally over the persons and property of infants;
- (5) appointment and control of guardians and keepers of the persons and estates of mentally disabled persons and persons of unsound mind; and
- (6) granting, altering, or revoking probates of wills and letters of administration of the estates of deceased persons leaving property within the court's territorial jurisdiction.

The Criminal jurisdiction of the High Court is embodied in the general rule that the High Court has jurisdiction over people (citizen and non-citizen) and offences committed within its territory. This rule is set out in Section 22(1)(a)(i) of the Court of Judicature Act (1964). Thus, the High Court in Malaya tries only offences committed in Peninsular Malaysia, and its counterpart in Sabah and Sarawak tries offences committed in East Malaysia.

The High Courts also have extraterritorial jurisdiction over people (citizens and permanent residents) and offences committed outside Malaysia. Section 22(1)(a) of the Court of Judicature Act confers the High Court with jurisdiction to try offences that occur:

1. on the high seas on board any ship or on any aircraft registered in Malaysia;
2. by any citizen or any permanent resident on the high seas on board any ship or on any aircraft; and
3. by any person on the high seas where the offence is piracy under the law of nations.

ii. Appellate Jurisdiction

The High Courts hear appeals from subordinate courts in both civil and criminal matters. They can also hear appeals from quasi-judicial bodies if so authorized by law.

iii. Revisionary and Supervisory Jurisdiction

The High Courts have revisionary jurisdiction over criminal and civil proceedings in the subordinate courts.

Section 31 of the Court of Judicature Act 1964 gives the High Courts power to revise criminal proceedings in subordinate courts in accordance with any law in force concerning criminal procedure.

Section 32 gives power to the High Courts to call for and examine the record of any civil proceedings before any subordinate court to satisfy itself as to the correctness, legality, or propriety of any decision recorded or passed, and as to the regularity of any proceedings of any such subordinate court.

iv. Review of the Decisions of other Judicial and Quasi-Judicial Bodies

The High Courts also have jurisdiction to review decisions of quasi-judicial bodies or administrative tribunals. This power is given under Section 25(2) of the Court of Judicature Act (1964).

d. Sessions Courts

Session Courts are established under Section 59 of the Subordinate Courts Act 1948.

i. Jurisdiction

The Sessions Courts are courts of general jurisdiction, with authority to try both civil and criminal cases within the local limits of its assigned jurisdiction, or if no such local limits have been assigned, arising from any part of the local jurisdiction of the respective High Court. The Sessions Courts have both original and supervisory jurisdiction.

Original Jurisdiction is as follows: The Sessions Courts' civil jurisdiction is set out in Sections 65-70 of the Subordinate Court Act (1948). Generally, the Sessions Courts' jurisdiction covers matters where the amount in dispute does not exceed RM250,000. Except in matters of motor vehicles accidents, landlord and tenant law, and distress, the Sessions Courts have unlimited jurisdiction to try all actions.

Section 69 of the Subordinate Court Act provides for matters outside the jurisdiction of the Sessions Courts even if the amount involved is less than RM250,000. They include:

1. injunctions;
2. specific performance or rescission of contracts;
3. cancellation or rectification of instruments;
4. enforcement of trusts;
5. probate and administration of estate;
6. legitimacy of any person, guardianship, or custody of infants;
7. the validity or dissolution of marriage; and
8. declaratory decrees.

The Sessions Courts' criminal jurisdiction covers all offences other than those punishable by death, and they may pass any sentence allowed by law except the sentence of death as provided under Sections 63-64 of the Subordinate Court Acts (1948).

Supervisory Jurisdiction: Under Section 54 of the Subordinate Court Acts (1948), the Sessions Courts are vested with a limited supervisory role over the Magistrates' Court. A Sessions Court judge may call for and examine the record of any proceedings before the Magistrates' Court or within the local limit of their jurisdiction to satisfy himself as to the correctness, legality, or propriety of any decision recorded or passed and to determine whether any proceeding of that court involves any irregularity.

If the judge of the Sessions Court is of the view that any decision of the Magistrates' is illegal or improper, or that any such proceedings are irregular, the judge must forward the record, with such remarks as he thinks fit, to the High Court. Then, the High Court may give such orders as are necessary to ensure that justice is done.

ii. Appeals

Appeals from the Sessions Courts in civil and criminal cases go to the High Court.

e. Magistrates' Courts

The Magistrates' Courts are established under Section 76 of the Subordinate Courts Act (1948).

They may be presided over by first class magistrates or second class magistrates. The first class magistrates are legally qualified and must be members of the Judicial and Legal Service of the Federation. The second class magistrates are not legally qualified; they are civil servants and court officials who do magisterial work in addition to their administrative duties.

The Magistrates' Courts have general jurisdiction to try civil and criminal cases within the local limits of jurisdiction assigned to them. They may issue summons, writs, warrants, or other process and make interlocutory or interim orders including orders concerning adjournment, remand, and bail. They may also conduct inquests or inquiries of death. The Magistrates' Courts also have specific jurisdiction depending on whether they

are the first class magistrate or the second class magistrates. First Class Magistrate courts have original jurisdiction and appellate jurisdiction.

In exercising their original jurisdiction in civil cases, Section 90 of the Subordinate Courts Act (1948) states that they have jurisdiction to try all actions where the amount in dispute or value of the subject-matter does not exceed RM25,000.

In exercising their original jurisdiction in criminal cases, the magistrate may try all offences with up to ten years of imprisonment or a fine. The sentencing powers of the first class magistrate are prescribed in Section 87 of the Subordinate Courts Act (1948), which gives the authority to the first class magistrate to pass any sentence allowed by law not exceeding:

1. 5 years imprisonment;
2. a fine of RM10,000;
3. whipping up to 12 strokes; or
4. any of the above sentences combined.

In exercising its appellate jurisdiction, a first class magistrate has jurisdiction to hear and determine both civil and criminal appeals from any decision of the Penghulu's Court within the local limits of his jurisdiction.

Second class magistrates have only original jurisdiction. In exercising their original jurisdiction in civil cases, Section 92 of the Subordinate Courts Act (1948) states that second class magistrates have jurisdiction to try all actions of a civil nature where the plaintiff seeks to recover a debt or liquidated demand in money not exceeding RM3,000.

In exercising their original jurisdiction in criminal cases, the second class magistrates may hear offences for which the maximum penalty is twelve months imprisonment or which are punishable with a fine only. The sentencing powers of a second class magistrate are to pass any sentence allowed by law:

- 1) not exceeding 6 months imprisonment;
- 2) a fine not exceeding RM1,000; or
- 3) any of the above sentences combined

Appeals against the decision of the Magistrates' Courts, both in civil and criminal matters, go to the High Court.

5. The Exclusive Jurisdiction of the Intellectual Property Court

The Session Courts were given exclusive jurisdiction to try IPR infringement cases. This includes all offences committed under Section 41 of the Copyright Act (1987) and the Trade Descriptions Act (2011). Though the Session Court can pass any sentence that it deems fit except for the death sentence, as an Intellectual Property Court, its power of sentencing is limited by the Intellectual Property Laws itself. Section 41 provides that a person will be guilty of an offense, unless a person is able to prove that he acted in good faith and had no reasonable grounds for supposing that the copyright or performers' rights would – or might – be infringed if he or she does any of the following:

- a.) makes for sale or hire any infringing copy;
- b.) sells or lets for hire, or by way of trade, exposes or offers for sale or hire any infringing copy;
- c.) distributes any infringing copies;
- d.) possesses, otherwise than for his private and domestic use, any infringing copy;

- e.) by way of trade, exhibits in public any infringing copy;
- f.) imports into Malaysia, otherwise than for his own private and domestic use, an infringing copy;
- g.) makes or has in his possession any contrivance used or intended to be used for the purposes of making infringing copies;
- h.) circumvents or causes the circumvention of any effective technological measures;
- i.) removes or alters any electronic rights management information without authority;
- j.) distributes, imports for distribution, or communicates to the public without authority, works or copies of works in respect of which electronic rights management information has been removed without authority;

The criminal penalties imposed by this same section are a fine between RM2000 and RM20,000 per infringing copy, imprisonment for a term not exceeding five years, or both a fine and imprisonment. For the conviction of a subsequent offence, the penalties are a fine of between RM4000 and RM40,000 per infringing copy, imprisonment for a term not exceeding ten years, or both a fine and imprisonment. For example, in one case where the infringer was found guilty and convicted for distributing 1,195 DVDs of a Japanese animated film, the Intellectual Property Court judge fined the offender a total amount of RM2.39 million.

6. The Supporting Mechanism for the Intellectual Property Court

a. Dedicated Deputy Public Prosecutor

To support the Intellectual Property Court, the Ministry of Domestic Trade, Consumerism, and Cooperatives and the Attorney General Chambers created the position of dedicated Deputy Public Prosecutor for the purpose of prosecuting IPR cases in the Intellectual Property Court. At present, there are twenty Deputy Public Prosecutors that have been tasked to prosecute in this court.

b. The Assistant Given by the Enforcement Division

The organizations involved in apprehending the infringer are also very important in the effective implementation of the Intellectual Property Court. These include the following:

- iv. The Enforcement Division of the Ministry of Domestic Trade, Consumerism and Cooperatives
- v. Royal Malaysian Police
- vi. Royal Malaysian Customs
- vii. Local Authorities

c. Capacity Building

Capacity building must be given to all Intellectual Property Court officers and their entire supporting staff. After the launch of the Intellectual Property Court, intensive training was conducted by the Malaysian Intellectual Property Organization in collaboration with the Court. A total of 128 personnel comprising session court judges,

enforcement officers, deputy public prosecutors, and the police participated in the training funded by the Biotechnology Corporation of Malaysia.

d. Building and Other Structures

To save costs, the current building was utilized to house the Intellectual Property Court.

e. Resource and Reference Center

A well equipped resource center for research needs to be established. Currently, all courts are supplied with online journals as well as a legal library.

f. Support from the industry.

The support from the industry is very important. Since IPR govern private property, support from IPR owners is of top priority. There must be complaints from the owner, and the owner must be willing to submit evidence of ownership to support such prosecution or else the prosecution will fail.

g. The Disposal Rate of Cases

To ensure that the Intellectual Property Court will achieve one of its objectives, namely the speedier resolution of cases, a key performance indicator (KPI) was introduced to measure the performance of the court. The KPI set by the government for the Intellectual Property Court requires that cases be disposed of within six months from the date of mention in court.

7. Conclusion

The Malaysian Intellectual Property Court is now over four years old. In States where there are fewer IPR infringement cases, the Deputy Public Prosecutor handles only about three to four cases a month. But in major cities, such as Kuala Lumpur and Shah Alam, IPR cases are mentioned in court every day.⁵⁸¹

⁵⁸¹ See, e.g., Aventis Farma SA (m) Sdn Bhd v. Rohibul Sabri bin Abbas, 3 MLJ 451 (2008).

F. Mexico

The Intellectual Property Regime in Mexico

Hon. Jorge Amigo

Intellectual property rights (IPR) protection and enforcement in Mexico has dramatically developed in the past 25 years. Compared to other countries' regimes, Mexico's is unique due to the legal structure and the means available to the rights-holder to enforce his or her rights.⁵⁸² This transition began in 1986, when Mexico signed the General Agreement on Tariffs and Trade of 1947 (GATT),⁵⁸³ and accelerated from 1989 to 1992, when Mexico engaged with the United States and Canada to conclude the North American Free Trade Agreement (NAFTA).⁵⁸⁴

The NAFTA negotiations were running parallel with the negotiations in Geneva under GATT.⁵⁸⁵ Consequently, most of the obligations proscribed in NAFTA Chapter XVII (Intellectual Property Rights) are similar or equivalent to the TRIPS provisions.⁵⁸⁶ However, by 1992, NAFTA negotiations were over and the Parties were working with their respective legislatures to ratify and implement the agreement. In the meantime, negotiators in Geneva, under the auspices of GATT, continued discussions to establish a multilateral regime. The texts evolved and adapted to different economic realities.

Negotiators realized that Mexico desperately needed to raise the bar for IPR protection in order to succeed and agree on common goals within the US and Canada. As a result, the Law for the Protection and Development of Industrial Property of 1991 replaced the Law on Inventions and Trademarks of 1976.⁵⁸⁷ Further reforms to this law were required to fully implement the commitments made by Mexico in both NAFTA and TRIPS. In October 1994, the title of the Act was changed to the Industrial Property Law, and modifications were enacted to make it compliant with the obligations acquired by Mexico.⁵⁸⁸

⁵⁸² See generally, JAIME ABOITES, INTELLECTUAL PROPERTY RIGHTS AND NATIONAL INNOVATION SYSTEMS IN MEXICO (2003).

⁵⁸³ See *The 128 Countries that had Signed GATT by 1994*, WORLD TRADE ORGANIZATION, http://www.wto.org/english/thewto_e/gattmem_e.htm (last visited Dec. 11, 2011) (Mexico signs GATT on August 24, 1986). See generally The General Agreement on Tariffs and Trade, October 30, 1947, Oct. 30, 1947, 61 Stat. A-11, 55 U.N.T.S. 194, available at http://www.wto.org/english/docs_e/legal_e/gatt47_01_e.htm.

⁵⁸⁴ See *North American Free Trade Agreement (NAFTA)*, OFFICE OF THE U.S. TRADE REPRESENTATIVE, <http://www.ustr.gov/trade-agreements/free-trade-agreements/north-american-free-trade-agreement-nafta> (last visited Dec. 11, 2011). See generally North American Free Trade Agreement, Dec. 17, 1992, U.S.-Can.-Mex., 107 Stat. 2057, 32 I.L.M. 289, available at <http://www.sice.oas.org/trade/naftatce.asp>.

⁵⁸⁵ The Marrakesh Agreement Establishing the World Trade Organization, signed on April 15, 1994 gave rise to the Trade Related Aspects of Intellectual Property Rights Agreement. See generally, Marrakesh Agreement Establishing the World Trade Organization, Jan. 1, 1995, 1867 U.N.T.S. 410, available at http://www.wto.org/english/res_e/booksp_e/analytic_index_e/wto_agree_04_e.htm.

⁵⁸⁶ See generally, North American Free Trade Agreement, c. 17.

⁵⁸⁷ See, e.g., Alejandro Perez Serrano, *Overview of Intellectual Property Enforcement in Mexico*, NATIONAL LAW CENTER FOR INTER-AMERICAN FREE TRADE, <http://www.natlaw.com/pubs/spmxip13.htm> (last visited Dec. 11, 2011).

⁵⁸⁸ *Mexico – Industrial Property Law Amended & Joins PCT*, LADAS & PARRY INFO. NEWSL. (Ladas & Parry, New York, N.Y.), Nov. 1994, available at http://www.ladas.com/BULLETINS/1994/1194Bulletin/Mexico_IPLawAmendJoinsPCT.html.

Although NAFTA and TRIPS also mandate higher standards for copyrights, the 1956 Copyrights Law was amended on December 24, 1996, but did not enter into force until March 24, 1997.⁵⁸⁹

The procedure for the registration of IPR is administered by two separate agencies of the executive branch. The Mexican Institute for Industrial Property (Instituto Mexicano de la Propiedad Industrial or IMPI) handles patents, trademarks, industrial designs, and utility models.⁵⁹⁰ IMPI was created by decree published on the Mexican official gazette (Diario Oficial de la Federación or DOF) on December 10, 1993, and was constituted as a decentralized, financially-independent public agency. It is self-financed from the collection of fees and has complete autonomy in its decisions.⁵⁹¹

On the other hand, the National Institute for Copyrights (Instituto Nacional del Derecho de Autor or Indautor) handles all matters related to the registration of copyrights and related rights.⁵⁹² Indautor was founded in the last quarter of 1996 as a decentralized agency, under the jurisdiction and authority of the Ministry of Public Education (Secretaría de Educación Pública).⁵⁹³ Indautor is empowered to promote creativity, and to control and administer the copyrights public registry.⁵⁹⁴ It is important to highlight that Indautor, compared to IMPI, has no financial autonomy or independence and depends upon the annual budget allocation to the Ministry of Public Education.⁵⁹⁵

With regard to the enforcement of copyrights, one of the most notable changes in the provisions on the Copyrights Law was that enforcement was assigned to IMPI.⁵⁹⁶ As a result, IMPI gained jurisdiction over infringement actions on trade matters.⁵⁹⁷

One of the arguments and rationales given to the Mexican congress to make IMPI the sole administrative enforcer of all intellectual property rights – *sensu lato* – is that between 1994 and 1996, IMPI had generated expertise in the enforcement of patents and trademarks, and it would be easier to merely attach the copyrights to the same enforcing agency. This would provide consistency in the criteria and final decisions issued by the authority, avoiding contradictions that diminish legal certainty in the system.

It is important to distinguish between the procedures available to IMPI and those available to Indautor. IMPI has jurisdiction to resolve administrative infringements on

⁵⁸⁹ See Federal Ley Federal del Derecho de Autor [Federal Law on Copyright], *as amended*, Diario Oficial de la Federación [DO], 5 de Diciembre de 1996 (Mex.).

⁵⁹⁰ Ley de la Propiedad Industrial [Industrial Property Law], *as amended*, Art. 1, Diario Oficial de la Federación [DO], 5 de Diciembre de 2005 (Mex.).

⁵⁹¹ Ley de la Propiedad Industrial [Industrial Property Law], Art. 6.

⁵⁹² Ley Federal del Derecho de Autor [Federal Law on Copyright], *as amended* c. 1, Art. 2, Diario Oficial de la Federación [DO], 5 de Diciembre de 1996 (Mex.).

⁵⁹³ Ley Federal del Derecho de Autor [Federal Law on Copyright], Art. 208.

⁵⁹⁴ Ley Federal del Derecho de Autor [Federal Law on Copyright], Art. 209.

⁵⁹⁵ Ley Federal del Derecho de Autor [Federal Law on Copyright], Transitional Provisions, Eighth.

⁵⁹⁶ Ley Federal del Derecho de Autor [Federal Law on Copyright], Art. 232, 234-35. On December 14, 2011, the Senate of Mexico approved an amendment to the Industrial Property Law and article 232 of the Federal Law on Copyright that strengthens IMPI's authority against piracy. Pending the President's approval, the new law will toughen IMPI's administrative procedures and evidence gathering during on-site inspections, allowing inspectors the use of images or video as evidence. It will also increase the maximum fine for piracy to 40,000 times the minimum daily wage. See *Gaceta del Senado*, SENADO DE LA REPUBLICA, <http://www.senado.gob.mx/index.php?ver=sp&mn=2&sm=2&id=12625&lg=61> (last visited Dec. 19, 2011).

⁵⁹⁷ *Id.*

economic rights.⁵⁹⁸ Indautor is empowered to resolve certain administrative violations to the Copyright Law, including protection of moral rights of paternity and integrity.⁵⁹⁹

The characteristics of the Mexican framework do not stop in this instance. It is important to highlight that IMPI is responsible for granting patents and trademarks⁶⁰⁰ as well as resolving, at the first instance, challenges filed by practitioners.⁶⁰¹ The practice in the U.S., for example, is different. Although the agency responsible for granting patents and trademarks is the United States Patent and Trademark Office (USPTO),⁶⁰² the offices responsible for resolving the challenges filed against determinations issued by USPTO are the Under Secretary of Commerce for Intellectual Property and Director of USPTO, the Board of Patent Appeals and Interferences,⁶⁰³ and the Trademark Trial and Appeal Board.⁶⁰⁴

1. Legal recourses available to the rights holder

As explained briefly at the outset of this section regarding Mexico's legal regime for intellectual property rights protection and enforcement, the government has provided rights-holders a series of legal recourses to protect and enforce their rights. To further comply with the commitments agreed to by Mexico under international agreements, particularly Article 1714 of NAFTA and TRIPS, which mandate that contracting parties provide administrative, civil, and criminal procedures,⁶⁰⁵ Mexico undertook necessary legal reforms. In order to provide a clear understanding of the different legal avenues a rights-holder can take to enforce his rights in Mexico, we will address these administrative, civil and criminal procedures in compliance with the applicable international agreements.

2. Administrative procedures

Administrative procedures or remedies should be filed before IMPI, regardless of whether the infringement is on patents, trademarks or copyrights.⁶⁰⁶ As explained above, during President Zedillo's administration, IMPI was given the authority to preside over cases relating to the infringement of industrial property rights and commercial use of copyrights.

The main goal was to provide an expedited administrative procedure and to stop the illegal use of protected rights. The alleged infringer could face administrative sanctions

⁵⁹⁸ Ley Federal del Derecho de Autor [Federal Law on Copyright], Art. 232, 234-35.

⁵⁹⁹ See, e.g., Ley Federal del Derecho de Autor [Federal Law on Copyright], Art. 230.

⁶⁰⁰ Ley de la Propiedad Industrial [Industrial Property Law], Art. 6, § 3.

⁶⁰¹ Ley de la Propiedad Industrial [Industrial Property Law], Art. 188.

⁶⁰² *The USPTO: Who We Are*, UNITED STATES PATENT AND TRADEMARK OFFICE, <http://www.uspto.gov/about/index.jsp> (last visited Dec. 11, 2011).

⁶⁰³ 35 U.S.C. § 6(b) (2006).

⁶⁰⁴ See *Trademark Trial and Appeal Board*, United States Patent and Trademark Office, <http://www.uspto.gov/about/offices/ogc/ttab.jsp> (last visited Dec. 11, 2011).

⁶⁰⁵ North American Free Trade Agreement, Art. 1714; Trade-Related Aspects of Intellectual Property Rights, April 15, 1994, 33 I.L.M. 1197, 1869 U.N.T.S. 299.

⁶⁰⁶ See, e.g., Ley Federal del Derecho de Autor [Federal Law on Copyright], Art. 232.

resulting in fines of up to approximately US\$44,000.⁶⁰⁷ This administrative procedure also grants IMPI the authority to implement provisional measures as defined in Article 1716 of NAFTA to prevent further damages by the alleged infringer to the rights-holder. These measures can be:

- The seizure of the alleged infringing goods
- Order to suspend the manufacturing of such goods
- Order to suspend the retail and surrender the goods
- Order to Customs Authority to withhold the alleged infringing merchandise and consign it to an authorized warehouse.⁶⁰⁸

In order for IMPI to undertake such measures, the rights holder is requested to post a bond for an amount determined by IMPI.⁶⁰⁹ Another unique characteristic of the Mexican regime is that it is the only country worldwide that allows for the alleged infringer to post a counter bond for the release of the goods.⁶¹⁰ The purpose of the bond and counter bond is to cover any further claims for civil damages. This is to provide protection for the alleged infringer if the infringement is not proven, or for the rights holder if the infringement is confirmed and the goods are at any point released through the channels of commerce.

After a final determination by IMPI regarding IPR infringements, the losing party can file an appeal before the Federal Court for Tax and Administrative Affairs or before a district court.⁶¹¹ In order for the rights holder to have the ability to submit a civil claim to be economically compensated, it is mandatory to obtain a final determination issued by IMPI declaring the infringement of IPR.⁶¹²

3. Recourse before the Federal Court for Tax and Administrative Affairs

The final determinations or resolutions issued by IMPI regarding the enforcement of IPR, such as the determination of infringement, can be appealed before an administrative justice court.⁶¹³

The Federal Court for Tax and Administrative Affairs (FCTAA) is the result of a judicial evolution of more than 75 years. It began with the Federal Tax Tribunal (FTT), established in 1937.⁶¹⁴ At that time, the Federal Tax Tribunal consisted of five courts and 15 administrative magistrates that could act in plenary sessions or within their respective jurisdictions organized by court. At that time, it was impossible to explain why the executive branch was establishing an administrative court independent from the judiciary whose members were designated by the President. It is important to highlight that there is

⁶⁰⁷ The fines are calculated on number of days of minimum daily wage in Mexico. The fines can be for up to 10,000 days and the rate used was 13.59 pesos per dollar. Ley de la Propiedad Industrial [Industrial Property Law], Art. 214, §§ 1-2.

⁶⁰⁸ Ley de la Propiedad Industrial [Industrial Property Law], Art. 199Bis.

⁶⁰⁹ Ley de la Propiedad Industrial [Industrial Property Law], Art. 199Bis 1.

⁶¹⁰ *Id.*

⁶¹¹ Alejandro Luna & Cesar Ramos, Jr., *Mexico, in THE INTERNATIONAL COMPARATIVE LEGAL GUIDE TO: PATENTS 2012 96, 96* (Gerry Kamstra ed., 2011), available at <http://www.iclg.co.uk/khadmin/Publications/pdf/4726.pdf>.

⁶¹² *Id.* at 98

⁶¹³ *Id.* at 96.

⁶¹⁴ Aurora Cortina González-Quijano, *Autonomía del tribunal Federal de Justicia Fiscal y Administrativa y la Creación de la Carrera Jurisdiccional*, 2 REVISTA DEL POSGRADO EN DERECHO DE LA UNAM 3, 129, 129-130 (2006), available at <http://www.juridicas.unam.mx/publica/librev/rev/posder/cont/3/cnt/cnt7.pdf>.

no dependency or subordination in the relationship between the Court and the executive branch.⁶¹⁵ In other words, neither the President nor any other administrative authority can interfere in the cases and issues put forward before the administrative court.⁶¹⁶

In the early stages of the FTT, its jurisdiction was limited to resolving matters related to taxes enforced by the tax authority (Secretary of Finance and Public Credit).⁶¹⁷ As the Court gained strength, it oversaw other issues in the financial sector, such as pensions and foreign trade.⁶¹⁸ In 2000, the FTT legal framework experienced a significant overhaul that began with the legislation establishing the FTCAA.⁶¹⁹ With these reforms, the FTCAA acquired jurisdiction to resolve any dispute filed against any alleged wrongful determination or resolution issued by any agency of the executive branch.⁶²⁰ These reforms also allowed the Plenary to determine the regional and material distribution of its courts.⁶²¹

Since its foundation, the FTCAA has undergone a radical transformation, including a comprehensive expansion in its jurisdiction, budgetary independence (in 2010), establishment of specialized courts, possibilities of summary judgment, possibilities to establish provisional measures to protect the constituents' rights, and, most recently, the online trial procedure.

Currently, the FTCAA has jurisdiction to issue a final and binding decision regarding any alleged wrongful act or determination issued by any federal agency of the executive branch, including, but not limited to, fines imposed by the authorities.⁶²²

As previously explained, the Mexican agencies responsible for administering the intellectual property registry and issuing their determinations on the cases presented before them have acquired a high level of sophistication and expertise. Many of the cases had no precedents in the Mexican system. Consequently, the agencies were challenged to resolve extremely complicated and not easily comprehensible cases. Judges were not always knowledgeable or cognizant of the importance of IPR violations, since many of them involved intangible rights.

Due to (1) the diversity of issues that the FTCAA had to deal with on a daily basis, (2) the challenges that litigants and authorities faced in explaining the value of IPR to the administrative magistrates, and (3) the contradictory adjudications of the FTCAA relating to intellectual property matters, the Superior Court of the FTCAA established the Regional Specialized Court on Intellectual Property Matters (CIP) on March 5, 2008, pursuant to an agreement reached by in plenary session.⁶²³ The specialized court is authorized to “...resolve the trials against final determinations issued in accordance with the Industrial

⁶¹⁵ *Id.*

⁶¹⁶ *Id.*

⁶¹⁷ *Id.*

⁶¹⁸ *Id* at 130.

⁶¹⁹ *Id.*

⁶²⁰ *Id.*

⁶²¹ *Id.*

⁶²² Ley Organica del Tribunal Federal de Justicia Fiscal y Administrativa [Federal Tax and Administrative Court Law] *as amended*, Art. 14, Diario Oficial de la Federación [DO], 6 de Marzo de 2011 (Mex.).

⁶²³ See Francisco Cuevas Godinez, President Magistrate of the FTCAA, Address at the event “The Specialization of the Administrative Procedure, Specialized Intellectual Property Court” (March 19, 2009), available at <http://www.tff.gob.mx/DGCS/Discursos/2009/DiscMagCuevasGodinezEspecializacionJuicioContenciosoAdministrativo.pdf>.

Property Law, the Copyrights Law, the Plant Variety Law, as well as any other regulation that deals with matters of intellectual property rights.”⁶²⁴ The CIP was formed with three administrative magistrates.⁶²⁵

The creation of the CIP also responded to the need to have a dedicated and specialized court that could meet the international obligations acquired by Mexico and have the institutional framework required to have the sufficient technical and legal expertise to resolve the disputes filed before the FTCAA.⁶²⁶ It is not surprising that the reasons to establish the CIP were absolutely justified. The number of IPR cases handled at different regional courts by the Administrative Magistrates at FTCAA was overwhelming. In 2004, the FTCAA handled only 706 trials on IPR matters.⁶²⁷ Meanwhile, in 2008, 1,892 cases were received, an increase of 204% over 4 years.⁶²⁸.

The CIP became fully operational in January 2009, when almost 3,000 cases that were due before other FTCAA Administrative Magistrates were transferred to it. The December 10, 2008 resolution issued by the FTCAA dictates that all the trials in due course and those filed, or to be filed from now on, should be resolved by the specialized court.⁶²⁹ In 2011, 2,733 IPR cases were filed in the court.⁶³⁰ This was made up of 2,148 new cases, 354 cases transferred from other courts, and 231 other cases. The total number of cases decided by CIP in 2011 was 2,796. This was made up of 2,317 cases decided on the merits, 44 dismissals, 91 cases where charges were dropped or parties were not present, and 344 other cases.

There are countless advantages brought to the legal regime of Mexico by establishing the CIP. Other nations can benefit from a specialized IPR court in the same way. The following illustrates a few of the advantages and benefits:

- Increased legal certainty and quality in the resolutions issued by the CIP
- Efficiency and effectiveness of the training courses
- Uniformity of the criteria and understanding of the different aspects of IPR
- Expertise – the litigants, authorities and magistrates will speak the same language, although they differ in their arguments
- Less time for the CIP to resolve trials

⁶²⁴ Acuerdo G/17/2008, mediante el cual se crea una Sala Regional en Materia de Propiedad Intelectual [Agreement G/17/2008, that creates the Regional Specialized Court on Intellectual Property Matters], Diario Oficial de la Fedearcion [DO], 8 de Marzo de 2008 (Mex.).

⁶²⁵ Acuerdo G/17/2008, mediante el cual se crea una Sala Regional en Materia de Propiedad Intelectual [Agreement G/17/2008, that creates the Regional Specialized Court on Intellectual Property Matters], Transitorios, Segundo.

⁶²⁶ Cuevas, *supra* note 623.

⁶²⁷ See Francisco Cuevas Godinez, President Magistrate of the FTCAA, Address at the event “The Second International Intellectual Property Conference” (March 27, 2009), available at <http://www.tff.gob.mx/DGCS/Discursos/2009/DiscMagFranciscoCuevasGodinez2doEncuentroInternacionaldePropiedadIntelectual.pdf>.

⁶²⁸ *Id.*

⁶²⁹ Alberto Huerta Bleck Tomas Arankowsky, Mexico: The Federal Tax and Administrative Court Creates a Specialized Court for Intellectual Property Matters (2011), available at <http://www.avahlegal.com/downloads/003.PDF>.

⁶³⁰ E-mail from Judge Maria Anaya, President, Regional Specialized Court on Intellectual Property Matters, to Salvador Behar, Legal Counsel for International Trade, The Mexican Embassy (Jan. 6, 2012, 3:45 EST) (on file with author).

Innovation is very important for Mexico. This is one of the reasons why its regime is unique. The FTCAA has noted that in order to be at the vanguard in technology, there must be some changes in judicial procedures, including the establishment of an online trial system.⁶³¹ This online trial system was launched at the 75th anniversary of the Tax Justice Act which established the FTT.⁶³² In order to make this a success, the Plenary of the FTCAA decided to create, as they did with the CIP, a specialized court to handle all the cases filed online.⁶³³ This did not include those cases involving IPR, since they are also handled by the CIP.

It is noteworthy to mention that the judgments issued by the CIP can be appealed at the Federal Circuit Court (of the Judiciary).⁶³⁴ The judgments issued by the Federal Circuit Court will be final and binding to the involved parties.⁶³⁵

4. Civil Procedure

The Industrial Property Law expressly gives jurisdiction to the Federal Courts to deal with criminal cases as well as commercial, civil, and provisional measures that derive from the statute.⁶³⁶ Article 227 of the Industrial Property Law provides the legal means to the rights-holder to request prosecution under the criminal code against the infringer, but also to claim damages.⁶³⁷

In cases of violation or infringement of IPR, the rights holder is entitled to claim compensatory damages in accordance with the Civil Code.⁶³⁸ This procedure must be filed before a civil court. Although the claims are brought under the Civil Code, the minimum threshold is fixed under the Industrial Property Law. Articles 221 and 221 Bis provide that the sanctions imposed by the enforcement authority (IMPI) are independent of the compensation for damages due to the violation of IPR protected under the law.⁶³⁹ Article 221 Bis, expressly states that:

“Compensation for material damages or indemnification for damages and harm due to violation of the rights conferred by this Law shall in no case be less than 40 per cent of the public sale price of each product or the price of the rendering of services where infringement of any one or more of the industrial property rights provided for in this Law is involved.”⁶⁴⁰

⁶³¹ See generally, *El SAT Listo para Utilizar el Juicio en Linea*, COMUNICACIÓN SOCIAL BOLETIN DE PRENSA (Tribunal Federal de Justicia Fiscal y Administrativa, Mexico D.F.), Aug. 26, 2011, available at http://www.tff.gob.mx/DGCS/bp/2011/Boletin_TFJFA_033_2011.pdf.

⁶³² *Id* at 1.

⁶³³ See generally, *Inaugura el TFJFA la “Sala Virtual” del Juicio en Linea*, COMUNICACIÓN SOCIAL BOLETIN DE PRENSA (Tribunal Federal de Justicia Fiscal y Administrativa, Mexico, D.F.), Marzo 24, 2011, available at http://www.tff.gob.mx/DGCS/bp/2011/Boletin_TFJFA_010_2011.pdf;

⁶³⁴ *Federal Tax and Administrative Tribunal Specialized Chamber in Intellectual Property Matters*, INTELLECTUAL PROPERTY NEWSLETTER (Basham, Mexico, D.F.).

⁶³⁵ *Id*.

⁶³⁶ Ley de la Propiedad Industrial [Industrial Property Law], Art. 227.

⁶³⁷ *Id*.

⁶³⁸ Ley de la Propiedad Industrial [Industrial Property Law], Art. 187.

⁶³⁹ Ley de la Propiedad Industrial [Industrial Property Law], Art. 221-221Bis.

⁶⁴⁰ Ley de la Propiedad Industrial [Industrial Property Law], Art. 221Bis.

In addition to this, there is a condition precedent to file a civil claim for damages. The claim cannot be brought to civil courts until the enforcement authority has determined the infringement.⁶⁴¹ Before 2004, there were no clear criteria governing the need for a final determination from the authority to file the civil lawsuit. However, in 2004, the Supreme Court established the criteria using rationale similar to that justifying the creation of the CIP under the FTCAA. This decision resulted from the civil courts lack of expertise with respect to IPR and the principle of administrative deference (Chevron Doctrine under the US law) to the authority.

5. Criminal Procedure

The Federal Criminal Code in Mexico establishes the types of crimes, their scope, their prosecution, the body authorized to enforce their prosecution, whether a crime can be prosecuted *ex parte*; or if a body has *ex officio* authority to prosecute, give recourse, sanction and/or penalize based on the law.⁶⁴² Crimes committed against copyrights are regulated and sanctioned under Section 26 of the Criminal (also known as Penal) Code.⁶⁴³ Nevertheless, IPR crimes are listed under Article 223 of the Industrial Property Law.⁶⁴⁴ The agency responsible for prosecuting the criminal cases is the Office of the Attorney General,⁶⁴⁵ and the cases are litigated before the Federal Criminal Court.

In recent years, there have been some substantial changes in the criminal code. First, sanctions and jail time were increased depending on the type of crime and severity of the violation. The most recent modification to the criminal code allows the Attorney General's office to prosecute *ex officio* (with or without rights holders' request) IPR violations, such as piracy and the sale of counterfeit items in flea markets or those discovered during customs clearance procedures on imports of goods.⁶⁴⁶ In these types of cases, again, it is mandatory to have an infringement determination issued by IMPI, as an expert report of the IPR infringement or violation.

6. Overview and Conclusion

The IPR regime in Mexico transformed when the nation became a NAFTA and GATT signatory. It brought on notable IPR law reform, spawning unique institutions such as IMPI and Indautor. In Mexico, one has the ability to bring forth a claim of infringement regarding patents, trademarks and commercially-used copyrights to IMPI. Thus, the court of first instance for IPR infringement is, by nature, an expert court, as it is also one of the two agencies that grants and administers IPR. Although there is no specialized IPR court for criminal procedures in Mexico, IMPI must submit a finding of infringement before a trial may commence. This is then used as an expert report at trial.

⁶⁴¹ Ley de la Propiedad Industrial [Industrial Property Law], Art. 199Bis 4.

⁶⁴² See generally Código Penal Federal [CPF] [Federal Criminal Code], as amended, Diario Oficial de la Federación [DO], 14 de Agosto de 1931 (Mex.).

⁶⁴³ *Id.*

⁶⁴⁴ Ley de la Propiedad Industrial [Industrial Property Law], Art. 223.

⁶⁴⁵ Juan Carlos Amaro, *Fighting the Counterfeitors: The Mexican Solution*, WORLD INTELLECTUAL PROP. REV. 26, 28 (2011).

⁶⁴⁶ *Id.*

In 2000, the FCTAA was given the jurisdiction to preside over appeals of decisions issued by an agency of the executive branch, including those issued by IMPI. IPR cases soon became overwhelming in number and sophistication with judicial knowledge and capabilities lagging behind. It was then that Mexico created the CIP – the specialized IPR chamber within the FCTAA that is authorized to resolve appeals of IMPI decisions and is led by three administrative magistrates.

There are many potential benefits to this system: increased legal certainty in the decisions issued by the CIP, greater awareness of IPR, and greater sophistication among litigants and magistrates. The court's efficiency significantly increases as judges are already experts on the subject they are presiding over. While this system may not benefit every nation in the way it has benefited Mexico, it is a system that has created a sense of trust among innovators and investors alike. With the globalization of trade, IPR enforcement is becoming increasingly important. An informed judiciary and an efficient court system and predictable outcomes are key elements within a strong IPR enforcement system.

G. South Africa

South Africa's Specialized Intellectual Property Courts Regime

Louis Harms & Owen Dean⁶⁴⁷

1. General court structure

South Africa possesses two judicial streams: the magistracy and the high courts.⁶⁴⁸ Magistrate courts are primarily criminal courts with extensive criminal jurisdiction.⁶⁴⁹ Their criminal jurisdiction is of importance because they hear most, if not all, counterfeit cases. There are special commercial crime courts within this structure and counterfeit cases, if important, are supposed to be heard by these courts. Their civil jurisdiction is, as far as IPR is concerned, of little consequence because they do not have jurisdiction to hear many IPR cases, and IPR owners and specialist practitioners have shown little or no interest in utilising them in IPR cases. The antipathy to utilising this court for civil IPR litigation stems mainly from an adverse perception of the legal expertise, in particular relating to IPR, of magistrates and their ability to deal properly with IPR. In principle, trademark infringement and copyright cases may fall within the jurisdiction of magistrates' courts⁶⁵⁰ but it is unlikely that any such case will be initiated in that court, and this it can safely be discounted for all practical purposes. The judicial officers in these courts are career judges but called 'magistrates'. They constitute a second and lower tier of the judiciary and are in practice regarded in that light. Appeals are heard by high courts.⁶⁵¹

The country is divided into nine provinces, each having (or supposed to have) its own high court. Judges to these courts are appointed by the Judicial Services Commission (JSC) and the President of the country.⁶⁵² They are generally required to 'retire' (are released from active service) at the age of 70, but their appointment is otherwise for life.⁶⁵³ High courts perform many functions:

- They are courts of first instance in civil matters of consequence. Such cases are heard by a single judge without jury or assessors.⁶⁵⁴
- They are also courts of first instance in serious criminal matters. These cases, too, are heard by a single judge without a jury, but the judge is entitled to make use of two assessors.⁶⁵⁵

⁶⁴⁷ Owen Dean is an IPR practitioner and professor of intellectual property law at Stellenbosch University. Louis Harms is Acting President of the Supreme Court of Appeal of SA and professor extra-ordinary at the Universities of Pretoria and the Free State.

⁶⁴⁸ Constitution of the Republic of South Africa, Act 108 of 1996 s 166 (hereafter 'Constitution').

⁶⁴⁹ Magistrates' Courts Act, 32 of 1944 sections 89-93ter.

⁶⁵⁰ *Id.* § 89.

⁶⁵¹ Supreme Court Act 59 of 1959 § 20.

⁶⁵² Constitution, § 174(6).

⁶⁵³ Judges' Remuneration and Conditions of Employment Act 47 of 2001.

⁶⁵⁴ Constitution, § 168; Supreme Court Act, 59 of 1959 § 13.

⁶⁵⁵ Constitution, § 168; Criminal Procedure Act, 51 of 1977 § 145.

- They are courts of appeal from the magistrates' courts in both civil⁶⁵⁶ and criminal⁶⁵⁷ matters. Such appeals are heard by two judges and, if they disagree, by three.⁶⁵⁸
- They may also sit as court of appeal against a judgment of a single judge of that court. This type of appeal is heard by a bench of three judges.⁶⁵⁹

Appeals from the high courts are heard by the Supreme Court of Appeal (SCA) which is, according to the Constitution, the final court in all non-constitutional issues.⁶⁶⁰ The court has a possible membership of 25, but sits in panels of five.⁶⁶¹ The court used to have a strong IPR contingent but the last IPR specialist has retired and there is no indication that this gap will be closed.

Although one would assume that IPR cases are non-constitutional, this is apparently not the case because the Constitutional Court, which is the highest court in constitutional matters,⁶⁶² has been prepared to take an appeal in a trademark dilution case from the SCA. The constitutional grounds for this are not entirely clear.⁶⁶³ Generally, there is no IPR expertise and limited commercial litigation skills in the ranks of the membership of the Constitutional Court, which makes it ill-suited for dealing with IPR litigation.

There are a number of specialist tribunals in South Africa, namely courts with a limited and exclusive jurisdiction in one or more defined fields of the law.⁶⁶⁴ Most important are the labour courts and the Labour Appeal Court,⁶⁶⁵ the Land Claims Court,⁶⁶⁶ the Competition tribunal and the Competition Appeal Court,⁶⁶⁷ and the income tax courts.⁶⁶⁸ Their judges are specially appointed on the assumption that they have specialist knowledge of the respective fields. More often than not, they are judges who have simply been seconded on a temporary basis from the high court commuting between courts.

2. IPR matters

a. Patents

The 1952 Patents Act (since repealed) created a special patent court of first instance. It is called the Court of the Commissioner of Patents.⁶⁶⁹ It had, until the early

⁶⁵⁶ Supreme Court Act, 59 of 1959 § 13(2).

⁶⁵⁷ Criminal Procedure Act, 51 of 1977 § 309.

⁶⁵⁸ Supreme Court Act, 59 of 1959 § 17.

⁶⁵⁹ *Id.* § 13 read with § 20.

⁶⁶⁰ Constitution, § 168.

⁶⁶¹ Supreme Court Act, 59 of 1959 § 12.

⁶⁶² Constitution, § 167.

⁶⁶³ *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and Another* [2005] ZACC 7; 2006 (1) SA 144 (CC); 2005 (8) BCLR 743 (CC) (27 May 2005) at <http://www.saflii.org/za/cases/ZACC/toc-L.html>. See also O.H. Dean, "Trade Mark Dilution Laughed Off", 2005 (October) *De Rebus* 18

⁶⁶⁴ *Id.* s 166(e).

⁶⁶⁵ Labour Relations Act 66 of 1995 §§ 157(1) and 158.

⁶⁶⁶ Restitution of Land Rights Act 22 of 1994, § 36(2); Land Reform (Labour Tenants) Act 3 of 1996, §§ 13 and 32.

⁶⁶⁷ Competition Act, 89 of 1998, §§ 26 and 36.

⁶⁶⁸ Income Tax Act 58 of 1962, § 83.

⁶⁶⁹ Patents Act 57 of 1978, § 8.

1960s, a single so-called patent judge.⁶⁷⁰ The incumbents from time to time were general legal practitioners with no IPR background. But that was to be expected. At the time patent litigation was rare and there were hardly any (if any) persons qualified in that field.

Upon the death of what transpired to be the last titular Commissioner it became apparent that someone deemed unqualified by the IPR profession would fill the vacancy. Lobbying by the profession led to an amendment of the Act.⁶⁷¹ Although the court and position remained, high court judges designated by the head of the local high court (in Pretoria, the administrative capital) became *pro tem* Commissioners of Patents to hear the occasional patent case. This is still the case.⁶⁷² In effect the so-called "Commissioner of Patents" is nothing but a judge of the high court in Pretoria who is appointed on an *ad hoc* basis to hear an enrolled patent case.

It used to be the practice to designate a judge with an IPR background – and the numbers of candidates increased and a strong jurisprudence was created. Many of these judges became in due course judges of the SCA.⁶⁷³ However, it would appear that there has been a change in approach: all judges are currently presumed to be equally fit to try all cases and it is thus inappropriate to allocate cases to judges according to their experience.⁶⁷⁴

A senior practitioner commented on the court as follows:

I am of the view that the designation of the Court of the Commissioner of Patents as being "a specialized IPR court" has become a misnomer, or at least not appropriate in all cases enrolled for hearing by that court. While judges with experience in patent matters are fortunately still sometimes allocated to sit as Commissioners, this is no longer necessarily the case as was in earlier years. I recently had the unpleasant and most embarrassing experience of having a recently promoted senior advocate with absolutely no patent law experience as acting judge, on the first day of his first appointment as acting judge, allocated to hear an application for an interim interdict [injunction] argued before him by [very senior practitioners with vast IP experience on both sides]. He was clearly way out of his depth. The matter was settled between the parties some eight months later without a judgment or order having been handed down. The head of the patent department of the multinational company whose patent we tried to enforce was impressed by counsel but utterly unimpressed by the Commissioner. She commented that it would be difficult to come to decision in future to seek to enforce their rights in South Africa, and that also meant that they would be circumspect about filing for patent protection in our country. The blame for this situation

⁶⁷⁰ Patents Act 37 of 1952, § 4, which was amended by the General Law Amendment Act 80 of 1964, § 17.

⁶⁷¹ General Law Amendment Act, 80 of 1964, § 17. Oral communication from the late Dr JR Steyn.

⁶⁷² Southern African Legal Information Institute, New Edition: South Africa- Court of the Commissioner of Patents, <http://www.saflii.org/content/new-addition-south-africa-court-commissioner-patents> (last visited December 6, 2011).

⁶⁷³ Some of those that come to mind were Trollip JA, Nicholas JA, Galgut AJA, Plewman JA, Colman J, and Van Reenen J.

⁶⁷⁴ According to a confidential communication, depending who the head of the particular court is, this is not necessarily true.

should be placed at the door of the then Deputy Judge President who allocated this case to such an inexperienced acting judge.⁶⁷⁵

There has also been another retrogressive change: the Commissioner of Patents is appointed from the ranks of the judges of the high court in Pretoria and during the last 15 years only one person with some patent experience has been appointed to this court.⁶⁷⁶ The expert on the court, Southwood J, will soon retire leaving the pool from which the Commissioner is appointed rather devoid of patent expertise.

Because the Court of the Commissioner has the same status as a high court, appeals from that court are heard by either three judges of the high court or by the SCA.⁶⁷⁷

As often happens with specialist courts, a conflict of jurisdiction may arise. Patent licence cases belong to the high court and infringement cases to the Commissioner's court.⁶⁷⁸

b. Trademark matters

The Registrar of Trademark may perform, in addition to administrative duties, judicial functions mainly in connection with the registration and cancellation of registered trademarks and issues relating to ownership and licensing of registered trademarks.⁶⁷⁹ In the performance of judicial functions, the registrar has the same powers and jurisdiction as a high court judge.⁶⁸⁰ An appeal lies against such a decision to the high court (with a panel of three) and from there to the SCA.⁶⁸¹

The incumbent of the office of Registrar is required to have general legal qualifications, but experience has shown that in recent years the level of knowledge of trademark law has left much to be desired. This in turn has led to reluctance on the part of trademark proprietors and other parties to disputes to have recourse to the court of the Registrar.⁶⁸²

It is possible to have a judge, retired judge, or a practitioner appointed to perform these functions on behalf of the Registrar.⁶⁸³ This has been the preferred option of interested parties and wherever possible *ad hoc* hearing officers sitting as the Registrar are utilised. These hearing officers have generally acquitted themselves reasonably well, which has served to restore a measure of confidence in the Registrar's Court. Where an *ad hoc* hearing officer is not appointed, in practice the Registrar generally delegates the judicial functions to a hearing officer on his or her staff. The shortcomings of the Registrar as a hearing officer described above apply equally, if not more so, to these subordinate hearing officers.

⁶⁷⁵ Allocation of cases in SA is not necessarily on a random basis and takes place only when the case is ready for hearing.

⁶⁷⁶ Johan Louw J.

⁶⁷⁷ Patents Act, 57 of 1978, § 76.

⁶⁷⁸ Precismeca Ltd. V. Melco Mining Supplies (Pty) Ltd. 2003 (1) SA 664 (SCA), available at <http://www.saflii.org/za/cases/ZASCA/2002/119.html>.

⁶⁷⁹ Trade Marks Act, 194 of 1993, § 23(2).

⁶⁸⁰ *Id.* § 45.

⁶⁸¹ *Id.* § 53.

⁶⁸² These observations are based on personal experience and were confirmed by confidential emails from senior practitioners at prestigious IP law firms.

⁶⁸³ Trade Marks Act, 194 of 1993, § 6(3).

Trademark infringement cases are invariably heard by a single judge as a civil case in the high court (see above).⁶⁸⁴ Matters pertaining to the cancellation of registered trademarks and the rectification of the Register of Trademarks generally can, at the election of the party initiating the litigation, be brought alternatively in the high court.⁶⁸⁵ Although the majority of these cases are heard in one high court (in Pretoria), they may, depending on where the infringement took place or where the defendant resides, be heard in any high court, some of which have no general exposure to commercial cases of note, let alone to IPR cases. It is an increasingly rare occurrence that a trademark case is heard by a judge who has any trademark expertise, particularly in high courts besides the Pretoria high court.

c. Registered designs

Design infringement litigation is dealt with as civil litigation heard by a high court as set out above, and the comments concerning that court are equally applicable in this instance.⁶⁸⁶

d. Copyright

As mentioned, copyright cases may be heard by magistrates' courts, but they are in practice dealt with in the high court as ordinary civil litigation. The comments above concerning trademark litigation in the high court apply equally to copyright litigation.

The Copyright Act provides for a Copyright Tribunal to decide licensing disputes.⁶⁸⁷ The Copyright Tribunal is constituted by the Commissioner of Patents,⁶⁸⁸ and the comments above relating to the Commissioner apply equally to this tribunal. It is possible for the copyright in cinematograph films to be registered and the Registrar of Trademarks (using the designation Registrar of Copyright) operates a parallel system for registering this form of copyright.⁶⁸⁹ The registration system and the Registrar's powers are substantially the same as for trademarks, and the comments concerning the Registrar of Trademarks' court apply *mutatis mutandis* to the court of the Registrar of Copyright.

3. Counterfeiting and Piracy

Criminal counterfeiting and piracy cases are invariably heard in the magistrates' courts.⁶⁹⁰ Cases of lesser importance are heard by the ordinary magistrates and prosecuted by general practitioners. The willingness to prosecute is often absent because of the prosecutor's lack of knowledge and experience. The strict time limits are not appreciated. The magistrates, too, are not seen as to be capable of dispensing justice in opposed cases. Fortunately, these cases are seldom opposed but, in the case of a plea of guilty one does

⁶⁸⁴ See Trade Marks Act, 194 of 1993, Part VIII.

⁶⁸⁵ *Id.* § 59.

⁶⁸⁶ Designs Act, 195 of 1993, § 35.

⁶⁸⁷ Copyright Act, 98 of 1978, §§ 29-36.

⁶⁸⁸ *Id.* § 29(1).

⁶⁸⁹ See Registration of Copyright of Cinematographic Films Act, No. 62 of 1977.

⁶⁹⁰ See Magistrates' Courts Act, 32 of 1944, § 89. The court has two divisions. The "ordinary" division has "jurisdiction over all offences, except treason, murder, rape and compelled rape" while the "court of a regional division shall have jurisdiction over all offences except treason."

find that some magistrates regard these offences in the same light as traffic offences, which leads to the imposition of inappropriate sentences.

In a few large metropolitan areas there are special commercial criminal courts.⁶⁹¹ There, the prosecutors are of a higher calibre than the conventional and as a rule have sufficient understanding of the issues. Because they work closely with the relevant investigating authorities, cases are generally well prepared and receive the necessary attention and precedence.⁶⁹² Magistrates in these courts are generally well equipped to deal with the cases and the success rate is relatively high.⁶⁹³

4. The Judicial Officers

It ought to be immediately apparent that IPR litigation is dealt with by a generalist judiciary:

- most have had no IPR training at university level;
- nearly all have had no practical experience of IPR litigation in private practice;
- it is unlikely that anyone has any technical background;
- there is no judicial training programme relating to IPR⁶⁹⁴ and all attempts to introduce one has failed thus far;
- judges, generally, do not have clerks and if they have, these are not IPR specialists, nor even generalists.⁶⁹⁵

There is no indication that the JSC considers specialist knowledge as a factor in the assessment of judicial appointees.

It is arguable that the Registrar of Trademarks, when sitting in a judicial capacity, is a specialist court but, as discussed above, save when an *ad hoc* hearing officer has been appointed to act in the capacity of the Registrar, the Registrar's court is not held in high regard and does not warrant having the stature of a credible specialist court. Indeed, it is also possible for a matter falling within the jurisdiction of the Registrar's court to be referred to the high court by agreement between the parties. This is also an option preferred by parties rather than have the Registrar or one of his subordinates deal with the matter.

5. General Assessment

The question that arises is whether the problems with IPR litigation are due to structural defects or due to organizational defects. As indicated, there is a great level of

⁶⁹¹ See Antony Altbeker, JUSTICE THROUGH SPECIALISATION 35-47, available at <http://www.iss.co.za/pubs/monographs/no76/chap4.pdf>.

⁶⁹² *Id.* at 37-38.

⁶⁹³ Emails from Ms Amanda Lotheringen, Department of Trade and Industries, and Mr S Yeates, Adams & Adams, IP Attorneys.

⁶⁹⁴ There were for magistrates, often on subjects that fall beyond their jurisdiction. At least two of these were hosted by USAID and the author Harms did part of the course. The author Dean has also participated in officially organised courses aimed at imparting IPR knowledge to magistrates.

⁶⁹⁵ See Constitutional Court of South Africa, Law Clerks Programme, <http://www.constitutionalcourt.org.za/site/lawclerks/southafricanlawclerks.htm> (last visited December 6, 2011) (noting that the Constitutional Court is the first court in South Africa where all judges have law clerks). It is in fact the only court. The Supreme Court of Appeal, with 25 judges, has six researchers.

dissatisfaction about the two existing supposed IPR specialist courts. The simple truth of the matter is that there is a lack of true IPR expertise in all tribunals that are, or can be, seized with IPR matters. It serves no purpose to change the structure if the judges, the organization, and the procedures remain the same. Although we adhere to the principles of *stare decisis* and although we have a relatively strong legislation and body of case law, the problems lie with the assessment of fact and the application of legal principles. Although lapses may be rectified on appeal, that is hardly a consolation for any litigant. Lack of experience is especially a problem when dealing with urgent matters.

The establishment of specialized IPR courts may be justified on the ground of the complex nature of IPR infringements, particularly patent infringements. As a practitioner mentioned, ‘it is in the interest of South Africa as a potential investment destination that quality and consistent judgments in patent matters be obtainable’.

A commission in South Africa chaired by Mr. Justice Hoexter, a number of years ago, considered the creation of such courts but decided that they were not justified.⁶⁹⁶ His view, pithily expressed, was that although the subtleties of IPR law are not for the mentally sluggish, they can be mastered by ordinary mortals; that the complexity of patent law resides not in grasping its principles but in arriving at the substratum of facts to which they have to be applied; and that specialization may lead to tunnel vision.⁶⁹⁷

With respect, although his views may have been valid at the time when he expressed them, circumstances have changed in the meantime. There is no longer a body of judges in the general system that has any IPR background, nor is there a willingness amongst the powers that be to create any form of IPR expertise amongst the general body of judges. There may be a good case for the issue to be revisited.

A number of aspects have to be considered in assessing the justification for specialist IPR courts.⁶⁹⁸ Specialist IPR courts are not always affordable or feasible. In a given country there may be a general lack of resources, a low IPR case load, and little IPR expertise. A centralized IPR court may make access to justice illusory. There is locally a strong political aversion against centralized courts, and circuit IPR courts are not feasible. There is also the issue of priorities. IPR does not appear to be a governmental priority. Less so, special courts for IPR.

Sometimes common sense may be more important than expertise because it is a moot point of whether all IPR work is specialist work. Can a judge, who can read, not see

⁶⁹⁶ The Commission’s Recommendations in Regard to Proposals that There Should Be Established in South Africa A) A Specialist Court for Intellectual Property Matters and B) A Specialist Insolvency Court, <http://www.polity.org.za/polity/govdocs/commissions/r3v1b2.pdf> (last visited December 6, 2011). The author, Harms, testified before the Commission on behalf of the judges of the Appeal Court (now the Supreme Court of Appeal).

⁶⁹⁷ *Id.*

⁶⁹⁸ The author, Harms, dealt with this issue in detail in a paper delivered at the 15th Annual International Judicial Conference in Ann Arbor, Michigan, May 16-18, 2007. Louis Harms, Session 4: Specialized Courts of Functions in Complex Corporate and Commercial Adjudication: Corporate, Capital markets, Tax, Labour/Employment and Intellectual Property: The South African Perspective (2007). He also dealt with it at the World Intellectual Property Organisation Advisory Committee on Enforcement Second Session 28-30 June 2004. Louis Harms, The role of the judiciary in enforcement of intellectual property rights: Intellectual property litigation under the common law system with special emphasis on the experience in South Africa (2004), available at www.wipo.int/meetings/en/doc_details.jsp?doc_id=29590.

whether one book is a copy of another? Can a judge, who can hear, not find that one piece of music is a copy of another? And can a judge, who lives in a real world, not decide whether or not one trademark is confusingly similar to another? Counterfeit cases are, as one commentator put it:

The striking feature about counterfeit cases is that they are legally very simple: they do not involve serious disputes over the boundaries of the trademark owner's rights. In mimicking the goods and the trademarks, the conduct of counterfeiters clearly falls within the ambit of conduct that a trademark owner is entitled to prevent.⁶⁹⁹

Being an expert in a particular field does not necessarily make one a good judge and does not mean that one is able to manage cases and litigants. Technology is so wide ranging that no judge can be expert in more than one technical field. It is said that even Court of Appeals for the Federal Circuit in the United States is not particularly specialized not only because its jurisdiction extends beyond patents but also because the majority of judges have no technical background.⁷⁰⁰

IPR lawyers do not have a monopoly on IPR litigation and any advantage gained by having expert judges is often diluted when lawyers without a smattering of IPR knowledge try their hand at an IPR case. On the other hand, general trial lawyers who in ordinary practice conduct technical cases (building contracts, professional negligence, etc.) and have to deal with experts of all kind are often better than IPR lawyers or technically trained lawyers in conducting IPR trials even though it may take them longer to get a grip on the case. They are experts in courtroom tactics and in examining witnesses.

What cannot be disputed is that IPR cases in the general court system ought to be diverted to judges with some specialist knowledge of the subject. It is not hereby suggested that IPR experts do not err – they do – but they are at least able to control the litigation and to steer practitioners with no understanding of the subject in more or less the right direction.

Cases before experienced IPR judges ought to be shorter and cheaper than those run by novices although there is no empirical evidence to support this supposition.

As Jennifer Widner said, there are as many reasons for exercising caution in creating specialized courts as there are for enthusiasm.⁷⁰¹ As is the case with pharmaceuticals, a placebo is often as effective as the real thing, and, one can argue, a specialized court is simply placebo with no special therapeutic value. And there is the danger of 'disjunctions' and discrepancies: the special area may develop in isolation, ignoring or being unaware of the greater legal and social landscape. As pointed out elsewhere, 'sound decision making results from exposure to a wide range of problems and issues' and 'adjudicative bodies with limited subject matter jurisdiction may lack this generalist perspective'.⁷⁰²

⁶⁹⁹ Jason Bosland, Kimberlee Weatherall and Paul Jensen, "Trademark and counterfeit litigation in Australia," Melbourne Law School Legal Studies Research Paper No. 208 6 (February 2006), available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=961527.

⁷⁰⁰ See Timothy Holbrook, "Patents, Presumptions, and Public Notice," 86 IND. L.J. 779 at Fn. 14 (2011), noting that only 5 of 17 judges on the U.S. Court of Appeals for the Federal Circuit have technical backgrounds.

⁷⁰¹ U.S. Agency for International Development, Office of Democracy and Governance, GUIDANCE FOR PROMOTING JUDICIAL INDEPENDENCE AND IMPARTIALITY 43-52 (2002).

⁷⁰² Recommendations of the Administrative Conference of the USA, 1 C.F.R. § 305.91-9 (1991).

Finally, all these cases potentially end in a supreme court where generalist judges have the ultimate say.

On the other hand, the present situation where IPR cases are increasingly being heard by judges of indifferent quality with no IPR expertise is undesirable and untenable in the longer term. Perpetuating this situation will impact adversely on the entire IPR regime in South Africa. There may be some merit in taking a leaf out of the book of the court of the Registrar of Trademarks and providing for a system where *ad hoc* judicial officers with IP expertise (e.g. retired judges or acting judges with IPR experience) are appointed to adjudicate selected IPR matters.

6. Conclusion

Having dealt with many of the points that we have been requested to address during the course of a general discourse, we will now deal specifically with the particular points.

a. Overview of South Africa's judicial system

There are two IPR courts in South Africa, one for patents and one for trademarks. Practitioners are not satisfied with the performance of these courts. Otherwise, IPR cases are dealt with by courts of general jurisdiction, and the problems experienced in IPR cases are no different from those experienced by litigants and practitioners in other specialist fields. This is also not a satisfactory situation and the interests of IPR are not being properly served. The result is that, unless the situation is improved by increasing the level of IPR expertise in the judicial system, there is likely to be increasingly a move to diversion to arbitration in such cases.

b. Consistent case outcomes in similar factual situations

The two IPR courts have country-wide jurisdiction and it is therefore unlikely that similar factual situations can arise before the same court. The issue can arise in for instance trademark infringement cases but there is no evidence that inconsistent judgments are more likely in IPR cases than in any other case.

c. Level of IP expertise in South Africa's judiciary

The decisions of the Registrar of Trademarks in practice have little or no precedential value and in particular have had no effect on high court judges who have to deal with trademark cases. Since there is only one patent court for the whole of the country, its judgments cannot affect other courts. Judgments from this court are binding on judges sitting in the same court and have, in that context, an important effect. Authoritative judgements from that court are accepted as authority in the SCA. If *ad hoc* specialist tribunals were to be introduced as mooted, the decisions of such a tribunal could have an effect on the judiciary in general.

d. The effect of specialized IPR courts on the conduct of commerce in IP-dependent sectors

The lack of expertise in these courts has given rise to an increase in diversion to arbitration or has obliged parties to settle on terms that are commercially not justifiable. The introduction of *ad hoc* specialist tribunals could lead to an increased estimation of the value of, and confidence in, IPR litigation. This would in turn benefit the IPR regime in South Africa and the conduct of commerce as part of it.

e. Advantages and disadvantages of the country's regime

This question has been discussed during the general discourse above. The lack of adequate adjudication in IPR matters has the inevitable effect of making the IPR regime somewhat ineffective, as borne out by the quotation from the patent law expert above. The view expressed is symptomatic of the malaise that is developing in the adjudication of IPR disputes generally, not only in the field of patents.

f. Recommendations for other countries

The situation in South Africa is not such that any other country should seek to emulate it. South Africa cannot be held up as an example to be followed, save perhaps that the approach of appointing *ad hoc* specialist tribunals to adjudicate selected IPR disputes mooted above may resonate in other countries where the general adjudication system is not adequate for IPR disputes but the circumstances of the country are not such that a fully-fledged specialist IPR court system is feasible or viable.⁷⁰³

⁷⁰³ The facts and opinions that have not been referred are facts known and opinions held by both authors. Mr. Owen Dean, as partner of the IPR law firm Spoor & Fischer, litigated for the whole of his professional life before the Registrar and the High courts and the Supreme Court of Appeal. Hon. Mr. Louis Harms served as independent counsel, appearing in all the courts mentioned, for 20 years. Thereafter, he sat as judge of the high court and as Commissioner of Patents for about five years until appointed to the Supreme Court of Appeal where he more often than not has been in charge of the IPR docket for the last 20 years. This paper was put to senior IPR practitioners for comment and they all concurred with the content. They are Mr. C. Job, senior partner at Adams & Adams, an IPR law firm, Mr. At van Wyk partner at DM Kisch, an IPR law firm, who wrote on behalf of the firm (by email), and Adv. L. Bowman SC, independent IPR counsel and member of the Pretoria Bar (orally).

H. Thailand

Case Study of Thailand's IPR Court Regime Kiat Poonsombudlert

1. Introduction

Thailand's judicial system consists of three main branches as follows:

1. The Constitutional Court, which has jurisdiction over constitutional controversies.⁷⁰⁴
2. The Administrative Court, which has jurisdiction over administrative disputes. The Administrative Court consists of the courts of first instance located in major provinces in Thailand including Bangkok.⁷⁰⁵
3. The Court of Justice, which has jurisdiction over all kinds of civil, criminal, and bankruptcy cases.⁷⁰⁶ The Court of Justice contains a number of specialized courts:
 - 3.1 Juvenile and Family Courts;⁷⁰⁷
 - 3.2 Labour Courts;⁷⁰⁸
 - 3.3 Central Tax Court;⁷⁰⁹
 - 3.3.1 Central Bankruptcy Court;⁷¹⁰
 - 3.3.2 Central Intellectual Property and International Trade Court (IPIT Court).⁷¹¹

For the purpose of this study, this paper will focus on the structure of the IPIT Court.

a. Jurisdiction of the IPIT Court

Under Section 7 of the Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E. 2539 (1996), "the Intellectual Property and International Trade Court [has] jurisdiction over the following matters:

1. Criminal cases regarding trademarks, copyrights and patents;
2. Criminal cases regarding offences under Sections 271-275 of the Criminal code;
3. Civil cases regarding trademarks, copyrights, patents and cases arising from agreements on technology transfers or licensing agreements;
4. Civil cases in connection with offences under Sections 271-275 of the Criminal Code;
5. Civil cases regarding international sale, exchange of goods or financial instruments, international services, international carriage, insurance and other related juristic acts;

⁷⁰⁴ Constitution of Thailand §§ 211-212.

⁷⁰⁵ Constitution of Thailand § 223.

⁷⁰⁶ Constitution of Thailand §§ 218-219.

⁷⁰⁷ Central Intellectual Property and International Trade Court and Institute of Developing Economies, Japan External Trade Organization, "The Judicial System in Thailand: An Outlook for a New Century," 15 (2001), available at http://www.aseanlawassociation.org/docs/Judicial_System_in_Thailand.pdf.

⁷⁰⁸ *Id.*

⁷⁰⁹ *Id.*

⁷¹⁰ *Id.*

⁷¹¹ The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court B.E. 2539 (1996); hereinafter called "the Act".

6. Civil cases regarding letters of credit issued in connection with transactions under (5), inward or outward remittance of funds, trust receipts, and guarantees in connection therewith;
7. Civil cases regarding arrest of ships;
8. Civil cases regarding dumping and subsidization of goods or services from abroad;
9. Civil or criminal cases regarding disputes over layout-designs of integrated-circuits, scientific discoveries, trade names, geographical indications, trade secrets and plant varieties protection;
10. Civil or criminal cases that are prescribed to be under the jurisdiction of the intellectual property and international property and international trade courts;
11. Civil cases regarding arbitration to settle disputes under (3)-(10).

Cases falling under the jurisdiction of the juvenile and family court shall not be under the jurisdiction of intellectual property rights (IPR) and international trade courts.⁷¹²

b. Judges in the IPIT Court

Judges in the IPIT shall be appointed from the judicial officials who possess competent knowledge of the matters relating to IPR or international trade.⁷¹³ Associate judges shall be appointed from IPR or international trade proficiencies selected by the Judicial Service Commission. They, among other requirements, cannot be attorneys.⁷¹⁴ At least two judges and one associate judge shall be present to form a quorum for adjudication.⁷¹⁵ Judgment or order of the Court shall require a majority vote.⁷¹⁶

In a criminal case where a single act violates several offenses or several acts violate several related offenses, and one or some of the offenses are not within the jurisdiction of the IPIT Court, the Court shall also accept other offenses.⁷¹⁷

An appeal against any judgement or order of the IPIT Court shall be submitted to the Supreme Court.⁷¹⁸ The president of the Supreme Court shall set up an Intellectual Property and International Trade Court Division in the Supreme Court.⁷¹⁹

2. Consistency of the case outcomes in similar factual situations

Thailand's legal system is a civil law system as opposed to a common law system.⁷²⁰ The Courts of Justice are empowered to only interpret and apply the laws passed by the legislature.⁷²¹ The courts, however, rely on the precedents of the Supreme Court's decisions to

⁷¹² Act § 7(1-11).

⁷¹³ Act § 14.

⁷¹⁴ Act § 15.

⁷¹⁵ Act § 19.

⁷¹⁶ *Id.*

⁷¹⁷ Act §§ 35-36.

⁷¹⁸ Act § 38

⁷¹⁹ Act § 43

⁷²⁰ Jurist Legal Intelligence, *Thailand*, <http://jurist.law.pitt.edu/world/thailand.htm> (last visited November 30, 2011).

⁷²¹ Constitution of Thailand § 218.

maintain consistency and predictability.⁷²² In civil cases, the courts cannot deny giving a ruling due to lack of or ambiguity of laws.⁷²³

The following comments are based primarily on the Supreme Court's published decisions during the past five years.

The Court has been consistent on the issue regarding rights to appeal the Trademark Board's unreasonable decisions, although the Trademark Act provides that the Trademark Board's decisions are final.⁷²⁴ The Court's decisions have laid down broader perspectives in determining registerability of marks than the strict criteria employed by the examiners and the Trademark Board.

The Court has helped clarify the law with respect to "non-conventional" marks, which were not previously familiar to the Trademark Office. The Court found the spiral design of the Coke bottle and the dimple design of the Sprite bottle were being inherently registrable and overturned the Trademark Board's rejections of those marks.⁷²⁵ The Court also found that a combination of colors (red and yellow) can be distinctive and again overturned the Trademark Board's rejection of that mark.⁷²⁶

Although the Court seems to be consistent with its criteria in determining registrability, the Trademark Office and Trademark Board have been slow in adopting the Court's criteria. In the author's view, the effect of the IPIT Court's decisions and the Supreme Court's decisions has brought about the advancement of the development of IPR laws in Thailand.

3. The Level of IPR Expertise in the Thai Judiciary

IPIR Court judges are required to possess competent knowledge on IPR, and, because of the complexity of cases handled by the IPIT Court,⁷²⁷ they are faced with legal issues not available in other branches of judiciary.

Although Thai judges are familiar with disputes over trademark rights since trademark rights have been protected in Thailand for a relatively long time, disputes over copyrights and patents require judges to supplement their expertise.

Disputes regarding originality and sufficiency to obtain copyrights are increasing. The court referred to "skill, judgment and effort" in determining "originality."⁷²⁸ In the same case, the court expressly referred to the difference between "expression" and "idea" in obtaining copyrights.⁷²⁹ In determining a copyright infringement, the court aptly considered whether the "substantially part" was infringed.⁷³⁰

It should be noted that the Thai Court ruled that formats for a reality show were not protected under the copyright law.⁷³¹ The court found that the set for the show was not

⁷²² *Id.* § 219.

⁷²³ Civil Procedures Code, 1935, § 134 (Thailand).

⁷²⁴ Trademark Act B.E.2534 of 1991, § 18.

⁷²⁵ The Supreme Court's decision Nos. 7024/2549 (2006) and 630/2551 (2008).

⁷²⁶ The Supreme Court's decision No. 2183-4/2553 (2010).

⁷²⁷ Act § 15.

⁷²⁸ The Supreme Court's decision No. 11047/2551 (2008).

⁷²⁹ *Id.*

⁷³⁰ The Supreme Court's decision No. 5469/2552 (2009).

⁷³¹ The Supreme Court's decision No. 268/2553 (2010).

protected as “works of applied art,” or “artistic works.”⁷³² The show formats were not protected as “dramatic work” because the players were free to do any acts under the rule of the show.⁷³³

In the author’s view, the above decisions must have been derived from international practices, although the court did not expressly refer to any such practicesm, indicating that the court found itself in need of expertise.

Disputes regarding patent rights also require the court to decide on “obviousness” of an invention to determine the “inventive step.”⁷³⁴ Although it seemed that the court relied heavily on experts adduced by both parties, the court’s expertise on technical points should increase corresponding to increasingly complicated issues of dispute. Another Supreme Court decision shows that citing a foreign decision on the same issue of dispute had an impact on the outcome of the case.⁷³⁵

Unfortunately, as the IPIT Court is only a part of the judicial system. Judges are rotated among several branches of the system.⁷³⁶ The IPIT Court judges are judges who start their career from general criminal and civil courts and become judges in the IPIT Court without any formal training in IPR law, provided they are considered qualified for such positions⁷³⁷ by the Judicial Commission.

The term of judges in the IPIT Court is limited to seven years.⁷³⁸ Therefore, just when they begin to be familiar with the IPR law, it is time for them to rotate for the advancement in their careers. The process of familiarizing new judges with the IPR law starts again. Recently, all judges in the IPIT Court were rotated and replaced with new judges from other branches of the judicial system, causing a certain degree of concern for the practitioners.

Although trademark counterfeiting and imitation of trademarks registered in Thailand are offenses under the Trademark Act, some judges feel that the law provides undue protection to rightsholders.⁷³⁹ They see criminal liability as too harsh in light of their opinion that IPR infringement is a private matter in which only damages can be claimed.⁷⁴⁰ Judges with this attitude tend to issue search and arrest warrants requested by police investigators less frequently, which can make pursuing criminal actions against infringers extremely difficult.⁷⁴¹

It should be noted that Rule 13 of the IPIT Court’s rules for Provisional Measures of Protection Prior to Instituting an Action stipulates that a provisional measure can be granted if the nature of damages cannot be restituted by monetary measures or other form of

⁷³² *Id.*

⁷³³ *Id.*

⁷³⁴ The Supreme Court’s decision No. 3113/2553 (2010).

⁷³⁵ The Supreme Court’s decision No. 8993/2547 (2004).

⁷³⁶ Constitution of Thailand §§197 and 220, the Act on Administration of Judicial Officers B.E. 2543 (2000) Section 18.

⁷³⁷ Regulation of Judicial Commission regarding criteria for appointment, promotion, transfer and increase of salaries and stipend of judges B.E. 2554 (2011) (hereinafter called “Regulation”), Clause 11.

⁷³⁸ Table for tenure attached to the Regulation.

⁷³⁹ Charan Pakdeethanakul, “Intellectual Property Laws as existed in Thai Court”, 6 DULLPAK 10 (November-December 1993).

⁷⁴⁰ Jumpot Pinyosinwat, Criminal Enforcement of IPR: The Problem of Over-Criminalization, INTELLECTUAL PROPERTY AND INTERNATIONAL TRADE FORUM 90 (2003). In his article he made references to United State Code 2319 and the Copyright Act § 506. See Page 89.

⁷⁴¹ For example, the court refused to issue a search warrant due to the fact that infringing goods were displayed in the shop of the accused. Therefore, a police raid could be done without a search warrant.

indemnity.⁷⁴² As IPR infringement normally causes monetary damages, such provisional measures are hardly granted if ever. Since the IPIT Court's dismissals of requests for provisional measures are final,⁷⁴³ the Supreme Court has been deprived of chances to lay down criteria. Therefore, in practice, it is difficult to obtain provisional measures in light of the IPIT Court's rules. The same principal also applies in case of requests for provisional measure after instituting an action.

Because of the limited number of judges who are experts in the IPR law, cases may be pending in the Supreme Court for at least a couple of years.

4. Effect of specialized IPR Court on the conduct of commerce in IP dependent sectors

There are a number of organizations of IP-dependent sectors, for example, the Business Software Alliance, the Inventor Association, the Motion Picture Association (Thailand) Ltd, the Music Copyright (Thailand). They actively participate in cooperation with concerned Thai authorities, such as the Department of Intellectual Property, the police, and the IPIT Court. Nevertheless, there is no special treatment for these kinds of organizations. The effects below apply to all IPR right owners.

a. Trademark Prosecution

The Trademark Office and Trademark Board tend to determine similarity of disputed marks by comparing the marks and goods/services in dispute,⁷⁴⁴ although the court will also consider the surrounding circumstances, including length of use of the marks, notoriety, bad faith, and goods involving any circumstances which show public confusion or lack of it.⁷⁴⁵ In the case of important marks, the disputes are often brought to court despite the high costs involved.

b. Civil Action

Due to the difficulty of obtaining provisional measures, the high costs, and especially the level of awards granted by the court, the number of civil actions against infringement is limited. The statistics below will show that criminal actions against IPR infringement are preferable choices.

International trade cases ⁷⁴⁶											
1999	2001	2002	2003	2004	2005	2006	2007	2008	2009	2010	
548	771	520	370	339	352	366	370	411	390	434	
IP cases (Civil)											
1999	2001	2002	2003	2004	2005	2006	2007	2008	2009	2010	
70	102	138	157	173	212	191	199	209	194	128	

⁷⁴² Rules for Intellectual Property and International Trade Cases B.E. 2540, Rule 13 (1997).

⁷⁴³ *Id.*

⁷⁴⁴ The Trademark Board's decision No. 201/2554 (2011), No. 204/2554 (2011), No. 210/2554 (2011).

⁷⁴⁵ The Supreme Court's decision No. 5594/2551 (2008) held that all elements including potential confusion of relevant consumers must be taken into account in considering similarity.

⁷⁴⁶ IP&IT 12th Anniversary, Special Issue 2010, The Central Intellectual Property and International Trade Court.

IP cases (Criminal)										
1999	2001	2002	2003	2004	2005	2006	2007	2008	2009	2010
1721	2141	3252	3582	4001	5354	5565	6851	6466	6383	6697

The number of civil cases includes not only infringement cases but other kinds of civil actions as well.

In granting damages, the Court requires solid proof of actual damage.⁷⁴⁷ Loss of expected benefits is rarely granted but is instead viewed as speculation. Damages for tarnishment of fame are restrictively limited. Costs for conducting an investigation to identify the infringers are rarely granted.⁷⁴⁸ Compensation for unauthorized use of a copyrighted song is compared to the normal compensation the right owner could have had.⁷⁴⁹ It should be noted that Thai courts do not normally award “punitive damages.”⁷⁵⁰ Nevertheless, the Trade Secret Act B.E. 2544 (2001) grants the court with power to set a punitive damage in the amount of not more than twice the damages awarded for infringing the trade secret if it is clearly evident that the infringer intentionally commits an act to cause the secret to cease to exist [Section 13 (3)]. Legal expenses are considered not directly caused by the infringement. Therefore, infringers are not liable for such costs.⁷⁵¹ According to the Civil Procedure Code, the Court awards only “statutory attorney fees” to the prevailing party in accordance with the scales attached to the Code, which have a maximum of 5% of the award.⁷⁵² The Court does not award the full lawyers cost to the prevailing party.

c. Criminal Action

Because of complications, delays, and low damages awards, rightsholders tend to seek criminal actions as their measures to deal with infringers, especially small ones, such as street vendors and retail vendors in cases of blatant infringement. In case of non-blatant infringement, where the authorities concerned may not accept right owners’ complaints to start investigation, rightsholders can initiate criminal actions by filing complaints directly to the IPIT Court.⁷⁵³ The Court holds preliminary hearings to determine whether there is enough proof of infringement to proceed with a full trial.⁷⁵⁴

Under the Trademark Act, criminal offenses include counterfeiting or imitating a mark registered in Thailand and importing, selling, or offering for sale goods bearing a counterfeit or imitation trademark registered in Thailand.⁷⁵⁵

Under the Copyright Act, any act of reproduction or adaptation or communication to the public of works enjoying copyright without a license from the copyright owners is a criminal offense.⁷⁵⁶

⁷⁴⁷ Banterng Sutharnorn, *Burden of Proving Damages in Trademark Infringement Cases*, Master of Law thesis, Chulalongkorn University (2001).

⁷⁴⁸ The Supreme Court’s decision No. 3085/2553 (2010).

⁷⁴⁹ The Supreme Court’s decision No. 5469/2552 (2009).

⁷⁵⁰ The Civil Code, § 438.

⁷⁵¹ The Supreme Court’s decision No. 905/2480 (1937), and No. 2608/2508 (1965).

⁷⁵² Table 6th: Attorney Fee Rates attached to the Civil Procedural Code B.E. 2478 (1935).

⁷⁵³ The Criminal Procedural Code, § 28.

⁷⁵⁴ The Criminal Procedural Code, § 162.

⁷⁵⁵ Trademark Act, *supra* note 22, §§ 108-110.

⁷⁵⁶ Copyright Act, B.E. 2537 of 1994, §§ 15, 27, 69 (Thailand).

Under the Patent Act, production, use, sale, offer to sell, and importation of patented products without permission of the patentee are criminal offenses.⁷⁵⁷ The same applies to those who use the patented process to produce, use, sell, have for sale, offer for sale, or import products made by the patented process.⁷⁵⁸

Although taking criminal action is the preferred choice, the IPIT Court very rarely imposes imprisonment on retail sellers or street sellers of infringing goods. The fines imposed are also moderate. The real effect is confiscation of infringing goods, which can cause serious financial damages to infringers.

5. Advantages and Disadvantages of the Thailand's Regime

In the author's view, having a specialized court is ideal for developing the laws that fall under its jurisdiction. It would also develop the expertise of its judges and those involved: practitioners, authorities concerned, and academics.

Thailand's creation of a specialized court dealing exclusively with IPR matters also resulted in its creation of specialized units of police and public prosecutors. Thus, creation of a specialized court may have repercussions for other branches that deal with IPR matters. For example, the Customs Department has now become the major player in border enforcement against trafficking of infringing goods.

Due to the bureaucratic system of the Thai government, officers involved in administration and enforcement of IPR are always shuffled and rotated. This causes discontinuation of developments in expertise of officers, which also happens to the judges in the IPIT Court.

The establishment of the IPIT Court has helped develop the IPR law in Thailand. Nevertheless, in terms of court proceedings, having one more specialized court means having one more special court proceeding, which sometimes can cause confusion to practitioners not specialized in IPR. As mentioned at the beginning of this chapter, the IPIT Court is one of several specialized courts which have their own court proceedings.

6. Recommendations for Other Countries

The establishment of a specialized court is proof of the need to rapidly deal with fast-changing IPR laws on the international scale. For countries in which IPR laws have not been developed fully-fledged, the establishment of such a court could speed up the development. In countries where IPR laws are fully developed, there may be no need for a specialized court.

A specialized court should be independent from other branches of the judicial system to provide a full career path to judges in that court. Unlike the U.S. system in which judges are appointed or elected, Thai judges are career judges who begin as judges in trial courts. Judges are rotated to all branches of the judicial system, leaving them with limited opportunities to become experts in any particular kind of law.

⁷⁵⁷ Patent Act, B.E. 2522 of 1979, §§ 36, 63, and 85 (Thailand).

⁷⁵⁸ *Id.*

I. United Kingdom

Intellectual Property and Particularly Patent Litigation in the United Kingdom

Hon. Michael Fysh, QC SC

1. Historical Background

The English judicial system has developed several systems of courts over the centuries. The most important distinction between courts has historically been between the “common law” courts and the Court of Chancery. The Court of Chancery came into being in the late mediaeval period⁷⁵⁹ to ameliorate deficiencies in the existing legal order—particularly where someone had acted unconscionably but there was no remedy at law.⁷⁶⁰ It was responsible for many legal innovations, including the remedy of the injunction. The law administered by the Court of Chancery was, and still is, known as “equity.”⁷⁶¹

Under this system, the infringement of a patent was considered a contempt of the Royal Command.⁷⁶² In turn, the attack on the validity of a patent amounted to an assertion that the Crown had been deceived in its grant. These were matters for adjudication by the Court of Kings Bench, a common law court. However, since the remedy of the injunction was an equitable remedy, a rightsholder could only obtain a final injunction against infringement from the Court of Chancery—but only after suing and adjudicating the issue through Kings Bench. This was highly inefficient.

Eventually practitioners developed a practice to circumvent this elaborate route. In cases where infringement was reasonably plain the rightsholder would first go to Chancery and obtain a temporary injunction pending full trial at common law. In cases where the outcome was in doubt, however, the Court of Chancery would require the rightsholder to wait until he or she had established his or her case at law.

This situation was generally regarded as unsatisfactory. For example, William Hindmarch, one of the first scholars of patent law, asserted in 1851 that:

Many persons entertain an opinion that the courts of law of this country are not fitted to determine questions respecting patent rights, and they contend that peculiar tribunals ought therefore to be erected with exclusive jurisdiction over all suits respecting patents.⁷⁶³

In particular, he criticized trial by jury:

But with respect to questions of fact arising in patent suits, there can be no doubt that juries are rarely, if ever, found to be fully competent to determine such questions. In the absence of a thorough understanding of the facts brought before them in such cases, juries are too prone to swayed more by appeals to their feelings

⁷⁵⁹ PHILIP H. PETTIT, EQUITY AND THE LAW OF TRUSTS 3 (11th ed. 2009).

⁷⁶⁰ *Id.*

⁷⁶¹ *Id.* It has this precise technical meaning in the so-called “common law” world (e.g. Australia, India, the US, and Canada).

⁷⁶² See, e.g., ROGER WILLIAM WALLACE & JOHN BRUCE WILLIAMSON, THE LAW AND PRACTICE RELATING TO LETTERS PATENT FOR INVENTIONS 21-22 (1900).

⁷⁶³ W.M. HINDMARSH, THE DEFECTS OF THE PATENT LAWS OF THIS COUNTRY WITH SUGGESTIONS FOR REFORMING THEM, 19 (1851).

and prejudices than by their reason, and consequently the party having the last word at a trial is almost certain to obtain a verdict.⁷⁶⁴

2. The Beginnings of Specialization

The Judicature Acts 1873-75 modernised the old and inefficient court system by combining all of the previous courts into the High Court of Justice.⁷⁶⁵ The High Court had three divisions. These included: Chancery, which took cases which would have gone to the former Court of Chancery; Queens Bench, which took cases which would have gone to any of the former common law courts; and Probate Divorce and Admiralty, which handled other matters.⁷⁶⁶ In addition, all previous courts of appeal were subsumed into the Court of Appeal.⁷⁶⁷ Appeal from that Court went to the House of Lords.⁷⁶⁸ Although this was a legislative body, specially qualified legally trained and professionally members of the House were created – the “Lords of Appeal.”⁷⁶⁹

In the newly devised system, patents disputes were assigned to the Chancery Division even though questions of validity and infringement had traditionally been considered common law matters. This ensured trial by the Chancery Judges who were experienced with the remedy of the injunction. Although these judges had no particular patent or technological expertise, it resulted in the Judges becoming experienced with the subject as there were only a few Chancery Judges.

The system remained largely unchanged until after the Second World War. There was a steady stream of patent cases, though in the 1930s a distinctly ant-patent mood had set in. By then there were five Chancery Judges, some of whom became quite experienced in patent cases. Meanwhile, in 1932, the Patents Appeal Tribunal was set up to hear appeals from decisions of the Patent Office.⁷⁷⁰ It was staffed by one of the Chancery Judges, thus keeping the expertise somewhat concentrated.⁷⁷¹

In 1946 a Government Committee⁷⁷² was concerned that the lack of expertise and specialization in the Judges was leading to longer trials, due to the difficulties involved with having a non-technical judge decide between rival expert testimonies. The Committee asserted:

107. We have had no hesitation therefore in coming to the conclusion that the principal reform necessary in the trial of patent actions is that all such cases should come before Judge appointed, as at present, from members of the Bar, but who also possesses technical or scientific qualifications, at least sufficient to enable him to grasp the broad technical principles of a case without the necessity of extensive

⁷⁶⁴ *Id.*

⁷⁶⁵ PETTIT, *supra* note 759, at 8.

⁷⁶⁶ MOHAMED RAMJOHN, TEXT, CASES AND MATERIALS ON EQUITY AND TRUSTS 2 (4th ed. 2008). Some wag said “Wills, wives and wrecks.”

⁷⁶⁷ See *The Judicature Acts of 1873 and 1875*, UK PARLIAMENT, <http://www.parliament.uk/about/living-heritage/transformingsociety/laworder/court/overview/judicatureacts/> (last visited Dec. 9, 2011).

⁷⁶⁸ *Id.*

⁷⁶⁹ *Id.*

⁷⁷⁰ KLAUS BOEHM, THE BRITISH PATENT SYSTEM 154 (1967).

⁷⁷¹ *Id.*

⁷⁷² K.R. SWAN, UK BOARD OF TRADE, PATENTS AND DESIGNS ACTS, SECOND INTERIM REPORT OF THE DEPARTMENTAL COMMITTEE, 1945-46 [CMD 6789] (known as the “Swan Committee”).

preliminary explanation or instruction in the elements of the science with which the invention is concerned. In addition to this qualification, he should preferably also have had some previous experience in patent litigation.⁷⁷³

The Committee recommended that two such judges be appointed. If the judges did not have enough patent work to keep them busy, they could also take other IPR cases and could sit on the Patents Appeal Tribunal.⁷⁷⁴ They could also sit on other Court of Appeal decisions.⁷⁷⁵ The Committee's suggestion that special patents judges be appointed was affirmed by the Patents Act 1949, which provided that:

(1) Subject to the provisions of this Act relating to Scotland, Northern Ireland and the Isle of Man, any petition under section twenty-three or section twenty-four of this Act and any reference or application to the court under this Act shall, subject to rules of court, be dealt with by such judge of the High Court as the Lord Chancellor may select for the purpose.⁷⁷⁶

In 1950, George Lloyd-Jacob,⁷⁷⁷ who had specialised in patent work at the Bar, was appointed as the first specialist patents judge.⁷⁷⁸ Under his watch, patent litigation ran at a very low level, as the Judge was frequently called on to do other work. His main responsibility consisted of sitting at the Patents Appeal Tribunal⁷⁷⁹ in order to hear appeals from the Patent Office. With the appointment of a second patents judge in 1968, Patrick Graham,⁷⁸⁰ things changed quite rapidly. Lloyd-Jacob died shortly thereafter and John Whitford was appointed to replace him.⁷⁸¹ Litigation increased with a noticeably more pro-patent approach.

A further Government Committee considered the problems of patent litigation during its review of patent law in 1970.⁷⁸² It is noted that there were still long delays in litigation, both in coming to trial and on appeal, accompanied by considerable costs.⁷⁸³ The Committee's most significant recommendation was that a Patents Court should be established as part of the Chancery Division of the High Court, and that appeals from the Patent Office should go to that court instead of the Patents Appeal Tribunal, which would be abolished.⁷⁸⁴ This recommendation was significant because it was an explicit public recognition that a specialist court was required for effective and efficient patent litigation.

⁷⁷³ *Id.*

⁷⁷⁴ *Id.*

⁷⁷⁵ *Id.*

⁷⁷⁶ The Patents Act, 1949, 12, 13 & 14 Geo. 6, c. 87, § 84 (Eng.).

⁷⁷⁷ No relation!

⁷⁷⁸ RICHARD ARNOLD, THE COST OF PATENT LITIGATION: A HISTORICAL PERSPECTIVE 3-4 (2009), available at http://www.ipla.org.uk/papers/20090423/Costs_in_Patent_Litigation.pdf.

⁷⁷⁹ *Id.*

⁷⁸⁰ *Id.* at 4.

⁷⁸¹ *Id.*

⁷⁸² M.A.L. BANKS, UK COMMITTEE OF INQUIRY, THE BRITISH PATENT SYSTEM, 1970-1971 [Cmd 4407] UK COMMITTEE OF INQUIRY, MAL BANKS The British Patent System, Cmnd.4407 "The Banks Report".

⁷⁸³ *Id.*

⁷⁸⁴ *Id.*

3. The Patent Court of the High Court

In 1977, a new Patents Act⁷⁸⁵ re-cast the whole of patent law to bring it into accord with the European Patent Convention and the new European Patent. The Act implemented the 1970 Committee's recommendation providing:

96(1) There shall be constituted, as part of the Chancery Division of the High Court, a Patents Court to take such proceedings relating to patents and other matters as may be prescribed by rules of court.

(2) The judges of the Patents Court shall be such of the puisne judges of the High Court as the Lord Chancellor may from time to time nominate.⁷⁸⁶

This provision still applies today. All of the approximately ninety judges of the High Court have formal jurisdiction in patent cases. However, in practice only the High Court's patent specialists, the judges of the Patents Court, adjudicate these cases.

Other 1970s judicial reforms allowed for pre-trial expert and witness reports in order to reduce the length of patent litigation. In the 1980s and 90s, patent judges such as Judge Aldous, Judge Laddie, and myself proactively limited discovery, resulting in a significant reduction in the time to trial. Currently, it takes about a year to make it to trial and urgent cases can be heard more quickly.

The Patents Court continues to be very busy. There are currently two main judges, Judge Floyd and Judge Arnold, both of whom possessed degrees in science and experience practicing patent law before their appointment. A third judge is expected to be appointed in May 2012.⁷⁸⁷ Although other Chancery judges sometimes adjudicate patent cases due to the volume of the work, they tend not to take the more technologically difficult cases. In addition, judges throughout the Division⁷⁸⁸ can and do take other IP cases.

The volume of patent litigation has increased over the years. Currently, about thirty cases per year are resolved through a full trial.⁷⁸⁹ Many other cases are settled before they reach trial. Costs remain a problem, although practitioners say that the English system is not much more expensive than other systems. For example, in one case the court fees of the German Federal Patent Court alone were greater than the entire cost of the corresponding English proceedings.⁷⁹⁰

4. The Patents County Court

In 1990, the Patents County Court was created in order to address continuing concerns about the costs of patent litigation.⁷⁹¹ The idea behind the Patents County Court was that smaller patent cases would be adjudicated there using a fast and truncated procedure.

⁷⁸⁵ See generally Patents Act 1977, c. 37 (Eng.).

⁷⁸⁶ Patents Act, §§ 96(1)-(2).

⁷⁸⁷ To replace Kitchin J who has been appointed to the Court of Appeal to succeed me.

⁷⁸⁸ 18 plus the Head of the Division, the Chancellor.

⁷⁸⁹ See 2011 *England and Wales Patents County Court*, BRITISH AND IRISH LEGAL INFORMATION INSTITUTE, <http://www.bailii.org/ew/cases/EWPCC/2011/> last visited Dec. 9, 2011.

⁷⁹⁰ See, e.g., GRÜNECKER, KINKELDEY, STOCKMAIR Y SCHWAN HÄUSSER, TIME FRAME FOR AND COSTS OF PATENT LITIGATION IN GERMANY 2 (2001), available at <http://www.grunecker.com/download/publications/liticost.pdf>.

⁷⁹¹ INNOVATE LEGAL, GUIDE TO INTELLECTUAL PROPERTY DISPUTES IN THE PATENTS COUNTY COURT 1 (2010).

Although the Patents County Court started with great expectations, with over 300 actions in the first year, it was virtually moribund by 2000. Larger companies—which were not the intended beneficiaries of the Patents County Court—discovered that they could litigate in the Patents County Court, which they believed would be more pro-plaintiff than the Patents Court of the High Court. Hence, the first judge of the Patents County Court had difficulty controlling proceedings, and his decisions often ended in reversal.⁷⁹²

In 2000, HHJ Judge Fysh took over the Patents County Court. He found that it was disadvantaged by the Woolf reforms of civil procedure.⁷⁹³ The idea of the reforms was that all civil courts should have the same procedural rules, which meant that there was little difference between the Patents County Court and the High Court.⁷⁹⁴

Since then, the rules of the Patents County Court have been amended to allow for a fast and more truncated procedure. Damages are limited to £500,000 and there is a cap on the amount of legal costs that the winner can recover.⁷⁹⁵ These reforms are expected to lower the cost of litigation in small value cases.

The Patents County Court has jurisdiction in all other kinds of IPR litigation as well and it is expected to be a success under its new Judge, HHJ Birss. Already over 200 cases have been started there, about twenty of them being patent infringement cases.

5. Closing Remarks

It is worth adding a few remarks about the place of the Patents Court in the English system. Patents judges are a part of the general judicial system and play an active role in deciding non-IPR cases. Depending on the workload, patent judges may spend a third of their time on other work. In the Court of Appeal, about two-thirds of the judges' time is unrelated to IPR. This approach, where judges are both specialists and generalists, has worked well. It provides judges with a wider perspective which helps them to balance IPR laws in the context of broader commercial law.

It should also be noted that patent judges are selected from patent law practitioners with extensive experience and are not career judges, a usual practice in common law systems. This method produces better judges: a gamekeeper would likely to be better at his or her job if he or she were first a poacher.

Another benefit of the specialist court is its greater predictability. This allows potential litigants to know where they likely stand without going to court. While sometimes the outside chance of a win may be worth the gamble of bringing a weak case to court, fewer of these cases make it before a specialist court than a general court.

Of course, one possible weakness of the specialist court is that if a person is appointed as a specialist judge and proves to be ineffective, the fact that he or she will often adjudicate proceedings can be a problem, as the early years of the Patents County Court demonstrated. However, the benefits of specialist courts are well worth the risk given that poor judges tend to be rare.

⁷⁹² Of the first 10 appeals from him, 9 resulted in reversal with the 10th being upheld by a hairsbreadth.

⁷⁹³ The result of Lord Woolf's recommendations in Access to Justice - Final Report. See, e.g., HARRY WOOLF, ACCESS TO JUSTICE – FINAL REPORT (1996).

⁷⁹⁴ *Id.*

⁷⁹⁵ ALASDAIR POORE, A CASE FOR COMPETITION, CAN LITIGATION BE SIMPLE – EXPLORING THE UK PATENTS COUNTY COURT? 6 (2011).

In summation, the English Patent Court is highly esteemed and its judgments form a significant part of the world's patent jurisprudence. It serves as a good example of the benefits that accrue from having a specialized patent court.

J. United States

The Specialized IPR Court Regime in the United States Ahmed Davis⁷⁹⁶

In this case study, we are asked, among other things, to gather and examine information on the intellectual property rights (IPR) courts of the United States and to assess the effect of this country's specialized IPR courts on producing consistent case outcomes in similar factual situations. We consider the effect of specialized IPR courts on the level of intellectual property (IP) expertise in the nation's judiciary and the effect of specialized IPR courts on the conduct of commerce in IP-dependent sectors. In addressing the effectiveness of the United States' IPR court regime, we focus on the basic background of the U.S. judicial system, the unique place of the Federal Circuit within that system, and future possibilities for specialized IPR trial courts that might augment the country's present patent system.

1. A Brief Introduction to the United States Judicial System

The judicial branch of the United States has the authority to decide the constitutionality of federal laws and resolve disputes over them. The patent laws of the United States are grounded in the U.S. Constitution and implemented through federal statutory mandate, and thus are within the exclusive province of the federal courts.⁷⁹⁷ Generally, those courts are arranged in three levels: district courts, appellate courts, and the United States Supreme Court. A brief discussion of each is set forth below.

a. District Courts

District courts are the trial courts in the federal system.⁷⁹⁸ There are a total of 94 judicial districts spread across the 50 states, the District of Columbia and other U.S. territories.⁷⁹⁹ Each district court has jurisdiction to hear nearly all categories of federal cases, both criminal and civil.⁸⁰⁰ The judges in these courts are generalists, but often can develop a certain level of expertise when they are faced with a certain type of case.⁸⁰¹ Judges in jurisdictions near a United States border, for example, may develop much experience dealing with U.S. immigration issues. Likewise, judges in the District of Columbia may become extremely well-versed in issues of U.S. administrative law because

⁷⁹⁶ The views expressed herein are those of the author only, and should not be attributed either to Fish & Richardson P.C. or its clients.

⁷⁹⁷ 28 U.S.C. § 1338 (2006)

⁷⁹⁸ United States Courts, District Courts, <http://www.uscourts.gov/FederalCourts/UnderstandingtheFederalCourts/DistrictCourts.aspx> (last visited December 15, 2011).

⁷⁹⁹ There are U.S. district courts in the Virgin Islands, Puerto Rico, Guam, and the Northern Mariana Islands. See Candace Chun, Comment, *The Use of § 1983 as a Remedy For Violations of the Individuals With Disabilities Education Act: Why It Is Necessary and What It Really Means*, 72 ALB. L. REV. 461, 491 n. 297 (2009).

⁸⁰⁰ George C. Beighley, Jr., *The Court of Appeals for the Federal Circuit: Has It Fulfilled Congressional Expectations?*, 21 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 671, 734 (Spring 2011).

⁸⁰¹ Megan Woodhouse, Note, *Shop 'til You Drop: Implementing Federal Rules of Patent Litigation Procedure to Wear Out Forum Shopping Patent Plaintiffs*, 99 GEO. L.J. 227, 246 (2010).

they sit in a court that is in the seat of the federal government. As further discussed below, certain district judges may also become well-versed in patent law based on where they are located.

With very few exceptions, there is a right to a jury trial in patent cases in the United States.⁸⁰² That is, in the ordinary case having a charge of patent infringement, the case will be tried to a jury so long as any party requests it.⁸⁰³ The district court judge is responsible for determining what the claims of the patent at issue mean and instructing the jury on that meaning, but the jury is charged with determining infringement, validity and the appropriate measure of damages.⁸⁰⁴ However, the trial judge always has the authority to substitute her own judgment before trial (on summary judgment)⁸⁰⁵ or to set aside jury determinations (through judgment as a matter of law) if she believes the facts so warrant.⁸⁰⁶

b. United States Courts of Appeal

No matter the ultimate fact-finder, a party that does not prevail on an issue in the case may appeal to one of the United States Courts of Appeal.⁸⁰⁷ There are 13 such courts—12 regional courts of appeal and the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”).⁸⁰⁸ This level of appeal is taken “as of right,” meaning that once a party files the appeal, the appellate court must consider it (assuming that the court has jurisdiction to hear the case in the first place).⁸⁰⁹

The jurisdiction of the regional circuits is geographic—they hear cases of all types that flow from the district courts in their circuit.⁸¹⁰ Thus, for example, the 4th Circuit U.S. Court of Appeals hears appeals from district courts in Maryland, Virginia, West Virginia, North Carolina and South Carolina.⁸¹¹ Similarly, the 11th Circuit U.S. Court of Appeals would hear those cases arising from district courts in Florida, Georgia and Alabama.⁸¹² Because these regional appeals courts consider similar issues of law (e.g., copyright law or criminal law) but make decisions that are only binding on the courts in their respective circuits, it is

⁸⁰² Wesley A. Demory, Note & Comment, *Patent Claim Obviousness in Jury Trials: Where's the Analysis*, 6 J. BUS. & TECH. 449, 457-58 (2001).

⁸⁰³ *Id.*

⁸⁰⁴ *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996).

⁸⁰⁵ See Fed. R. Civ. P. 56.

⁸⁰⁶ See Fed. R. Civ. P. 50.

⁸⁰⁷ United States Courts, Courts of Appeals,
<http://www.uscourts.gov/FederalCourts/UnderstandingtheFederalCourts/CourtsofAppeals.aspx> (last visited December 15, 2011).

⁸⁰⁸ Eric Hansford, Note, *Measuring the Effects of Specialization with Court Split Resolutions*, 63 Stan. L. Rev. 1145, 1149-50 (May 2011).

⁸⁰⁹ United States Courts, Understanding Federal and State Courts,
<http://www.uscourts.gov/EducationalResources/FederalCourtBasics/CourtStructure/UnderstandingFederalAndStateCourts.aspx> (last visited December 15, 2011).

⁸¹⁰ United States Courts, *supra* note 807.

⁸¹¹ See United States Courts, Geographic Boundaries of United States Courts of Appeals and United States District Courts, <http://www.uscourts.gov/uscourts/images/CircuitMap.pdf> (last visited December 14, 2011).

⁸¹² See *id.*

possible for case law to develop non-uniformly—or sometimes in outright conflict—across the country.⁸¹³

There is one significant exception. Created by Congress in 1982, the Federal Circuit is unique in that it is the only U.S. appellate court whose jurisdiction is limited by subject matter rather than geography.⁸¹⁴ Located in Washington, D.C., the Federal Circuit has exclusive jurisdiction over certain types of appeals—most notably, in patent cases—regardless of where the district court that heard the case is located.⁸¹⁵ Thus, while appeals in copyright infringement trials from Virginia or Florida would go to the 4th Circuit and 11th Circuit, respectively, patent appeals from trial courts in both states go to the Federal Circuit.⁸¹⁶ The exclusive subject matter jurisdiction of the Federal Circuit in patent cases thus eliminates the inter-circuit conflicts that can arise in other areas of the law and, at its best, enhances uniformity and predictability of the patent law.⁸¹⁷

All of the appellate courts hear cases sitting in three-judge panels.⁸¹⁸ In most instances, a panel decision is binding on all subsequent panels and can be overturned only by the appellate court sitting *en banc*—a unique circumstance where every active judge at the court sits together to hear the case.⁸¹⁹

The Federal Circuit presently is comprised of 11 active judges (with one vacancy) and five senior judges.⁸²⁰ Though it is regarded as a specialized IP court, the Federal Circuit judges come from surprisingly disparate backgrounds. Judges Newman and Lourie, two of the longest-serving active judges, have doctoral degrees in Chemistry and had previous careers in the bio-pharma industry.⁸²¹ Judges Bryson and Prost do not have technical degrees, and were long-time government attorneys.⁸²² Judges Linn, Dyk and Reyna had long careers in private practice.⁸²³ Judge Moore was a law professor who wrote extensively on patent law issues.⁸²⁴ Chief Judge Rader, together with recently-appointed Judges O’Malley and Wallach, each were elevated to the Federal Circuit from trial court judgeships.⁸²⁵

c. United States Supreme Court

Comprised of nine justices, the United States Supreme Court is the highest Court in the federal judiciary.⁸²⁶ It decides only important issues of Constitutional and federal law so,

⁸¹³ See Eric Hansford, *supra* note 808, at 1152-53.

⁸¹⁴ See George C. Beighley, Jr., *supra* note 800, at 673.

⁸¹⁵ *Id.*

⁸¹⁶ *Id.*

⁸¹⁷ *Id.* at 704.

⁸¹⁸ See The Honorable John M. Roll, *Splitting the Ninth Circuit*, 42 Ariz. Att’y 34, 37 (Sept. 2005).

⁸¹⁹ *Id.*

⁸²⁰ Court of Appeals for the Federal Circuit, Judges, <http://www.cafc.uscourts.gov/judges> (last visited December 14, 2011).

⁸²¹ *Id.*

⁸²² *Id.*

⁸²³ *Id.*

⁸²⁴ *Id.*

⁸²⁵ *Id.*

⁸²⁶ United States Courts, Supreme Court of the United States, <http://www.uscourts.gov/FederalCourts/UnderstandingtheFederalCourts/SupremeCourt.aspx> (last visited December 15, 2011).

unlike the U.S. Courts of Appeal, it is not required to hear every appeal.⁸²⁷ And it rarely does: the Court grants petitions for *writ of certiorari*—meaning it will hear and rule on the case—in fewer than 150 of the 10,000-plus petitions it receives each year.⁸²⁸ When a petition is denied, the ruling of the appellate court from which it arose becomes final.⁸²⁹ If it is granted, the nine justices hear the case and eventually issue an opinion that resolves an inter-circuit dispute, determines whether a law is Constitutional, or clarifies some other ambiguity in the law.⁸³⁰

Since the inception of the Court of Appeals for the Federal Circuit, the Supreme Court has rarely agreed to hear appeals from patent cases, but that number has been increasing in the last decade. For example, the Court recently has issued opinions on issues such as the standards of patentability,⁸³¹ the requirements for proving induced infringement,⁸³² the burden of proving a patent invalid,⁸³³ and the circumstances in which a permanent injunction against patent infringement is warranted.⁸³⁴

2. The Rise of the Court of Appeals for the Federal Circuit

a. Background

One of the principal reasons for assigning all patent appeals to a single appellate court was to achieve greater predictability through uniformity of decisions and doctrinal stability.⁸³⁵ Before the formation of the Federal Circuit, the regional appellate courts heard patent cases.⁸³⁶ Perhaps because of the complex nature and subject matter of these cases, those regional courts were all over the map in their rulings. But complexity alone could not be the entire explanation, as these regional courts also dealt with complex issues in other areas of the law without the same disparate decisions.

Practitioners who were active in patent litigation in the 1970s have said that the regional circuits at that time were “widely variant” in the way they looked at patent cases, with some being “notoriously pro-patent” and others being “notoriously anti-patent.”⁸³⁷

⁸²⁷ *Id.*

⁸²⁸ Supreme Court of the United States, The Justices’ Caseload, <http://www.supremecourt.gov/about/justicecaseload.aspx> (last visited December 15, 2011).

⁸²⁹ See Miles Feldman & Daniel Fiore, *Copy Caveats: Two Recent Cases Show the Extent and Limitations of Time Shifting as a Defense to Copyright Infringement*, 33 L.A. LAW 38 (May, 2010) (noting that when the Supreme Court denied certiorari in *Cartoon Network LP v. CSC Holdings, Inc.*, 536 F. 3d 121 (2d Cir. 2008), *cert denied* 129 S.Ct 2890 (2009), the Second Circuit’s ruling became final).

⁸³⁰ See Timothy S. Bishop & Jeffrey W. Sarles, *Petitioning and Opposing Certiorari in the U.S. Supreme Court*, Findlaw for Legal Professionals (1999), <http://library.findlaw.com/1999/Jan/1/241457.html>.

⁸³¹ *Bilski v. Kappos*, 130 S. Ct. 3218 (2010).

⁸³² *Global-Tech Appliances v. SEB S.A.*, 131 S. Ct. 2060 (2011).

⁸³³ *Microsoft Corp. v. i4i ltd. p’ship*, 131 S. Ct. 2238 (2011).

⁸³⁴ *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006).

⁸³⁵ John B. Pegram, *Should There Be a U.S. Trial Court with a Specialization in Patent Litigation?*, 82 J. PAT. & TRADEMARK OFF. SOC’Y 765, 790 (2000).

⁸³⁶ See Janice M. Meuller & Daniel Harris Brean, *Overcoming the “Impossible Issue” of Nonobviousness in Design Patents*, 99 KY. L.J. 419, 501 (2010-2011) (noting that, upon its founding, the Federal Circuit “inherited . . . the regional circuits’ patent jurisdiction”).

⁸³⁷ The Federalist Society for Law & Public Policy 2008 National Lawyers Convention, *Panel Discussion on Specialized Courts: Lessons From The Federal Circuit*, 8 CHI. KENT. J. INT. PROP. 317, (2009) (comments of Mr. Martens).

Patent decisions depended as much upon geography as upon the merits of the case, which caused forum shopping to become rampant.⁸³⁸ Patent owners had no confidence in their patent right until they knew where it was going to be litigated, and competitors had the same problem in deciding whether or not they had a freedom to operate.⁸³⁹ Lawyers could spend significant time counselling clients not only on patent enforcement issues, but on the foundational issue of whether it was worth getting patents *at all*.⁸⁴⁰

During this same time, the country was in the early stages of the transition to a global economy, and there was a fear among economists and in Congress that the United States was losing its innovative edge.⁸⁴¹ The situation was described well years later in reflections offered by then-Senior Federal Circuit Judge Marion T. Bennett:

Some of the regional circuit courts, expressing strong feelings about the dangers of monopoly and having a low regard for the expertise of the Patent Office, tended not to give any deference to the administrative examination process and invalidated many patents. It thus became important to make sure, where possible, that a patent suit be brought in the least inhospitable forum. This became a high-risk game of forum-shopping. If an inventor could not be sure that his patent rights would be respected in the market place, or enforced in the courts, he was deprived of important incentives to research and development. The risk factor in technological development was too great. This uncertainty plus the high cost of marketing something new contributed to the decline in innovation experienced in the late 1970s, especially for research institutions and technology-based industry.⁸⁴²

After significant and extended Congressional consideration, the Federal Circuit came into being.⁸⁴³ In order to protect against the court becoming so specialized that it began to take a myopic view of the law, Congress granted the Federal Circuit authority over other areas of the law—among them, appeals for the International Trade Commission, the Court of International Trade, the Court of Federal Claims, and the Merit Systems Protection Board.⁸⁴⁴ However, it was understood that its real specialty—and critical importance—lay in the uniformity to be gained from its exclusive jurisdiction over patent cases.⁸⁴⁵

b. Effect of the Court

⁸³⁸ *Id.*

⁸³⁹ *Id.*

⁸⁴⁰ *Id.*

⁸⁴¹ *Id.*

⁸⁴² The Honorable Marion T. Bennett, *Introduction to KRISTEN YOHANNAN, THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT: A HISTORY (1990-2002)*, at 11 (2004); see also *id.* at 12, quoting H.R. Rep. No 312, 97th Cong., 1st Sess. 17 (1981) (“This is not a crisis for the courts alone. It is a crisis for litigants who seek justice, for claims of human rights, for the rule of law, and it is therefore a crisis for the Nation.”).

⁸⁴³ See Jacob H. Rooksby, *University Initiation of Patent Infringement Litigation*, 10 J. MARSHALL REV. INTELL. PROP. L. 623, 630 (Summer 2011).

⁸⁴⁴ S. REP. NO. 97-275 at 6 (1981), reprinted in 1982 USSCAN 11, 16 (“The Federal Circuit will not be a specialized court as that term is normally used . . . [I]t will have a varied docket spanning a broad range of legal issues The judges will have no lack of exposure to a broad variety of legal problems.”).

⁸⁴⁵ Rooksby, *supra* note 843.

The generally-accepted view is that, in the almost 30 years since its inception, the Federal Circuit has greatly improved the reliability and predictability of patent litigation in the United States. In that way, the purpose of its creation has been realized. Shortly after the court was formed, academics began studying its jurisprudence and quickly determined that the court had in its first five years “articulated rules that [were] consistent with the underlying philosophy of patent law and that [were] easy for the lower courts and the research community to apply.”⁸⁴⁶

Practitioners, too, agree that the court has improved reliability and predictability, sitting *en banc* where appropriate and resolving differences in the rule of law as best they can.⁸⁴⁷ Perhaps most importantly in this post-dot com era, the relative stability in U.S. patent law wrought by the Federal Circuit has spurred innovation, significant investment in research and development, and helped the economy overall.⁸⁴⁸ However, the Federal Circuit has not been without its criticisms—most notably, in the area of claim construction.⁸⁴⁹

Since the Supreme Court ruled in *Markman v. Westview Instruments, Inc.*⁸⁵⁰ that claim construction was an issue of law for the Court to decide, that issue has dominated academic writings and judicial comments on patent issues, and on the focus of the Court. Various scholarly studies have determined that between 1996-2004, the Federal Circuit reversed between 37% and 58% of all district court claim constructions.⁸⁵¹ District judges at times have decried the way in which claim construction rulings are made and the difficulties that it presents for them,⁸⁵² an issue that has not gone unnoticed by the Federal Circuit judges themselves:

The way the language of claims is construed is often outcome-determinative in a patent infringement a suit. Though there are exceptions, the structure of the accused device usually is not hard to determine; the question is always whether the claims read on . . . that structure. So reading claims is an art of

⁸⁴⁶ Rochelle Cooper Dreyfus, *The Federal Circuit: A Case Study In Specialized Courts*, 64 N.Y.U. L. REV. 1, 8 (1989).

⁸⁴⁷ The Federalist Society for Law & Public Policy 2008 National Lawyers Convention, *supra* note 837.

⁸⁴⁸ “A primary purpose for which our court was formed was to provide judicial stability that supports commercial investment . . . a nationally uniform, consistent, and correct patent law is an essential foundation of technological innovation, which is today the dominant contributor to our nation’s economy.” *Pfizer, Inc. v. Apotex, Inc.*, 488 F. 3d 1377, 1379 (2007) (Newman, J., dissenting in denial of the petition for rehearing *en banc*).

⁸⁴⁹ See, e.g., Shin Chang, *The Proper Role of Functionality in Design Patent Infringement Analysis: A Criticism of the Federal Circuit Decision in Richardson v. Stanley Works, Inc.*, 19 TEX. INTELL. PROP. L.J. 309 (Spring 2011); Colleen Murphy, Comment and Casenote, *Are Humans Animals?: Patent Claim Construction in Martek Biosciences v. Nutrinova, Inc.*, 579 F.3d 1363 (Fed. Cir. 2009), 79 U. CIN. L. REV. 1213 (Spring 2011).

⁸⁵⁰ *Supra* note 804.

⁸⁵¹ Donna M. Gitter, *Should The United States Designate Specialist Patent Trial Judges? An Empirical Analysis of H.R. 628 In Light of the English Experience and the Work of Professor Moore*, 10 COLUM. SCI. & TECH. L. REV. 169 n. 5 (2009).

⁸⁵² James Holderman & Halley Guren, *The Patent Litigation Predicament in the United States*, 2007 U. ILL. J.L. TECH. & POL’Y 1, 5-6 (2007) (“Without a technical background to help us parse the respective parties’ arguments, we judges are sometimes drawn to the wrong conclusion more than we otherwise would be if the factual premises underlying the factual basis of the dispute had a familiar ring based upon our prior experience or education.”).

sorts, involving half technology and half linguistics. To many trial judges, it is a foreign art; understandably, they are not batting 1.000 (more like .500).⁸⁵³

What makes this situation both unique and challenging is that the specialized intellectual property court in the United States is an *appellate* court rather than a *trial* court. “When you have a specialist appellate-level court, they are going to be less likely to use the ordinary rules of civil procedure and rely upon them to defer . . . to the trial court on questions of fact-finding [and] as a consequence, certainty and predictability are sacrificed, even though the Federal Circuit was set up to create certainty and predictability.”⁸⁵⁴ Critics suggest that this inhibits rather than promotes certainty and predictability because the appellate court weighs in very late in the adversarial process:

The uncertainty of patent infringement cases until after appeal is highly problematic for several reasons. First, uncertainty at the trial level is inefficient because it stimulates appeals rather than settlements. Second, it creates doubt about the ability of district court judges to adjudicate complex technical patent infringement cases . . . [which] may even have the far-reaching effect of stifling innovation.⁸⁵⁵

As U.S. patent litigation has proliferated and the attendant costs skyrocketed, these concerns have increased. One extended effort to address this issue thus has been consideration of a specialized patent trial court in the United States.

3. A Modest Proposal for Specialized Patent Trial Courts in the United States

For various reasons, certain district courts and judges have become relatively well-versed in U.S. patent law than others. The district judges in the Northern District of California have as a group heard a significant number of patent cases, perhaps because that is the locus of many technology companies and because the court has a defined set of Local Patent Rules that can better frame the litigation.⁸⁵⁶ The Eastern District of Virginia, whose Alexandria courthouse sits across the street from the Patent Office, has long been the location of many patent filings because of its favorable “rocket docket”—in which plaintiffs typically can get to trial in under a year.⁸⁵⁷ Similarly, the Eastern District of Texas has long been viewed as a desirable location by patentee-plaintiffs because of the Local Patent Rules, experienced judges, and a belief that jurors were disinclined to invalidate patents and more likely to award large damages amounts.⁸⁵⁸

⁸⁵³ Donna M. Gitter, *supra* note 851, at 175 (quoting S. Jay Plager, *Challenges for Intellectual Property in the Twenty-First Century: Indeterminacy and Other Problems*, 2001 U. ILL. L. REV. 69, 71 (2001)).

⁸⁵⁴ The Federalist Society for Law & Public Policy 2008 National Lawyers Convention, *supra* note 837. (comments of Prof. Rai)

⁸⁵⁵ *Id.*

⁸⁵⁶ United States District Court for the Northern District of California, Local Patent Rules (December 1, 2009), available at <http://www.cand.uscourts.gov/localrules>.

⁸⁵⁷ Kevin A. Meehan, *Shopping for Expedient, Inexpensive & Predictable Patent Litigation*, 2008 B.C. INTELL. PROP. & TECH. F. 102901, *3 (2008).

⁸⁵⁸ Julie Creswell, *So Small a Town, So Many Patent Suits*, NY TIMES (September 24, 2006), available at <http://www.nytimes.com/2006/09/24/business/24ward.html?pagewanted=all>.

But these courts are not the norm; the average U.S. District Court judge presides over a patent case that goes to trial about once every seven years.⁸⁵⁹ Seeking to address the concerns raised by District Judge Holderman and Senior Federal Circuit Judge Plager mentioned above, there has been much scholarly debate regarding whether the United States should have a specialized patent trial court.

Some have suggested that a specialized trial court would remedy the shortcomings in the U.S. patent system and bring them into line with how the rest of the world is trending, despite the obvious problems with implementation.⁸⁶⁰ There likewise have been arguments in favor of a specialized Article III court having “scientific jurisdiction” that would not be limited to patent cases but rather any case in which it might be important to have a judge with technical knowledge.⁸⁶¹ Others have argued that the Court of International Trade, an extant trial court, is well-suited to be transformed into a specialized patent trial court.⁸⁶² There also have been arguments in favor of a specialized trial court that relies principally on expert consultants or special masters for its technical expertise.⁸⁶³ Finally, at least one commentator has suggested the creation of a patent small claims court specifically to address those entities that feel the high costs of patent litigation act as a bar to the protection of their IPR.⁸⁶⁴

The United States Congress has, to date, taken a middle ground. While not fully in agreement with the proposals for a specialized trial court (and the attendant logistical issues that would come with that), U.S. lawmakers are not ignorant of the promise that specialized patent trial courts with experienced patent judges could provide. To that end, a 10-year pilot program was established “to encourage enhancement of expertise in patent cases among district judges.”⁸⁶⁵ While the program is still nascent after having been signed into law by President Obama in January 2011, scholars anticipate that this program will result in lower Federal Circuit reversal rates based on a study of reversal trends in analogous English patent courts.⁸⁶⁶

4. Looking Back, Looking Forward

A century ago, perhaps one of the most revered U.S. district court judges assessed the difficult intersection of science and law that faced the judiciary:

I cannot stop without calling attention to the extraordinary condition of the law which makes it possible for a man without any knowledge of even the rudiments of [science] to pass upon such questions as these... How long we

⁸⁵⁹ Cono A. Cerrano et al., *Patent Rocket Dockets: Coming Soon to a Venue Near You?*, Intellectual Property Today 11 (December 2006).

⁸⁶⁰ Eric B. Cheng, Note, *Alternatives To District Court Patent Litigation: Reform By Enhancing The Existing Administrative Options*, 83 S. CAL. L. REV. 1135, 1170-1171 (2010).

⁸⁶¹ See, e.g., Andrew W. Jurs, *Science Court: Past Proposals, Current Considerations, and a Suggested Structure*, 15 VA. J.L. & TECH. 1 (2010).

⁸⁶² John B. Pegram, *Should There Be a U.S. Trial Court with a Specialization in Patent Litigation?*, 82 J. PAT. & TRADEMARK OFF. SOC'Y 765, 790 (2000).

⁸⁶³ Arti Rai, *Specialized Trial Courts: Concentrating Expertise on Fact*, 17 BERKELEY TECH. L.J. 877 (2002).

⁸⁶⁴ Robert P. Greenspoon, *Is the United States Ready for a Patent Small Claims Court?*, 10 MINN. J.L. SCI. & TECH. 549 (2009).

⁸⁶⁵ See Pub. L. No. 111-349, 124 Stat. 3674 (2011).

⁸⁶⁶ Donna M. Gitter, *supra* note 851.

shall continue to blunder along without the aid of unpartisan and authoritative scientific assistance in the administration of justice, no one knows; but all fair persons not conventionalized by provincial legal habits of mind ought, I should think, unite to effect some such advance.⁸⁶⁷

In the 100 years since judge Learned Hand wrote these words, and in the 30 years since the inception of the Federal Circuit, the United States has seen a marked increase in the reliability and stability of its patent law jurisprudence. The number of patent filings is up significantly and patent-related lawsuits have grown steadily.⁸⁶⁸ In fact, an entire industry has emerged in which entities seek to monetize their patent assets through auctions, patent pooling or similar practices. This suggests a baseline trust in the system as a whole that did not exist before the creation of the Federal Circuit. In addition, the frequency with which the Federal Circuit has heard *en banc* cases and the number of recent patent cases for which there has been Supreme Court review suggest a now-robust system for considering relevant issues that provides certainty to litigants, innovators, and technologists.

At the same time, there remain issues that must be addressed to make the U.S. patent system attain maximal efficiency. A key component in maintaining the trend is to educate and develop trial-level judges in the vagaries and intricacies of patent law, with the hope that fewer trial court decisions will be overturned on appeal by the Federal Circuit. Continuing the distinguished thinking of pre-eminent legal minds, considered judgment of a legislature aware of changing market dynamics, and giving due attention to the comparative models in other countries that have been successful, should keep the United States on a path towards a coherent patent jurisprudence both in its articulation and application.

⁸⁶⁷ Rochelle Cooper Dreyfus, *The Federal Circuit: A Case Study In Specialized Courts*, 64 N.Y.U. L. Rev. 1, 8 (1989) (quoting *Parke-Davis & Co. v. H.K. Mulford Co.*, 189 F. 95, 115 (S.D.N.Y. 1911) (Hand, J.).

⁸⁶⁸ Jay P. Kesan & Gwendolyn G. Ball, *How Are Patent Cases Resolved? An Empirical Examination of the Adjudication and Settlement of Patent Disputes*, 84 WASH. U. L. REV. 237, 250 (2006).

IV. CONTRIBUTORS

Hon. Jorge Amigo Castañeda

The Honorable Jorge Amigo is the Vice Chairman of the International Intellectual Property Institute. He served as Director General of the Mexican Institute for Industrial Property (IMPI) from January 1994 until April 2011. During his service, he headed the Mexican delegation for the negotiation of the Investment Chapter of the North American Free Trade Agreement (NAFTA) and coordinated the negotiation of the Anti-Counterfeiting Trade Agreement (ACTA). He served as lead intellectual property spokesman and negotiator for many international bodies, including Free Trade Area of the Americas (FTAA). Amigo also chaired and participated in numerous committees and assemblies of the World Intellectual Property Organization (WIPO).

Amigo has received many awards during his career, among others, the Motion Picture Association's (MPA) Anti-piracy Government Leadership Award, WIPO's Gold Medal for promoting intellectual property and competitiveness around the world, and the City of Venice's Venice Intellectual Property Award. He also received a special recognition from then-President Vicente Fox for his contrition to Mexico. Prior to his appointment as Director General, Amigo held several positions within the Ministry of Commerce. Amigo holds a M.A. in Economics from the University of the Americas, and has taught at the Anahuac University and University of the Americas.

Ahmed J. Davis

Ahmed J. Davis is a Principal in the Washington, D.C., office of Fish & Richardson. His practice focuses on copyright, trade secret, and complex patent litigation in a vast range of technical areas, with a particular focus in the areas of chemistry, biotechnology, medical devices, and mechanical and electrical engineering. A trial attorney experienced in all phases of litigation, Mr. Davis has appeared and argued in the *Markman* and summary judgment contexts in numerous federal district courts. He has tried cases in federal district court, the Court of Federal Claims, and the United States International Trade Commission, and has argued before the United States Court of Appeals for the Federal Circuit.

Mr. Davis is an active speaker and a frequent lecturer on issues relevant to the patent bar, and has received numerous accolades and awards for his work. Before joining Fish & Richardson, Mr. Davis was a law clerk for the Honorable Leonie M. Brinkema in the Alexandria Division of the United States District Court for the Eastern District of Virginia (1999-2000). He also was a law clerk for the Honorable Paul R. Michel at the United States Court of Appeals for the Federal Circuit (2001-2002). He received his J.D. at the Georgetown University Law Center. He also received a M.S. in Chemistry from Emory University and a B.S. from Morehouse College.

Owen Dean

Owen Dean is a consultant, and was previously a Senior Partner, of Spoor and Fisher, a leading IPR law firm providing services throughout Africa, the Middle East, and

the Caribbean. He served on the Government's Advisory Committee on Intellectual Property Law where he conceived, and chaired the Drafting Committee of, the Counterfeit Goods Act and Section 15A of the Merchandise Marks Act on ambush marketing.

Mr. Dean has authored numerous works on South African copyright law, and is a frequent speaker on intellectual property matters at seminars and conferences. He attended the University of Stellenbosch where he received his B.A. (Law), LL.B. and LL.D. degrees. Mr. Dean is admitted as an attorney in Namibia and Botswana. He was appointed in 2011 as a Professor of Law at Stellenbosch University, where he is the Anton Mostert Chair of Intellectual Property Law.

Hon. Michael Fysh QC, SC

His Honour Judge Fysh was called to the Bar by the Inner Temple in 1963 and practiced as a barrister in the field of intellectual property in England and Ireland for 25 years. He has also practiced extensively in Commonwealth countries. He was called to the Bar in New South Wales and admitted to practice as an advocate in both India and Pakistan. In 1999 Judge Fysh was appointed a Deputy High Court judge (Chancery Division) and later, in 2001, was made Senior Circuit Judge having responsibility for the Patents County Court in England and Wales. He also served as a judge of the Technology and Construction Court and a deputy High Court judge. In 2005 he was appointed Chairman of the UK Copyright Tribunal.

Judge Fysh retired from both the Bench and the Copyright Tribunal in 2010, although he remains his successor's Deputy. He is now engaged in mediation and opinion work from his former Chambers as well as lecturing and Court work overseas in the field of intellectual property. Judge Fysh has authored a number of legal texts. He received an Honorary Doctorate in Laws from the University of Wolverhampton in 2007 and became a fellow of the Institute of Intellectual Property Law at the University of Oxford in 2010. Judge Fysh received a B.A. (1962) and M.A. (1969) in Natural Sciences (Chemistry) from Oxford University.

Hon. Louis Harms

The Honourable Justice Louis Harms retired as the Acting President and the Deputy President of the Supreme Court of Appeal of South Africa on November, 30 2011, and has been a judge of appeal since 1991. After a short spell in academia, he spent 20 years as a trial lawyer specializing in intellectual property law. Justice Harms served on the committee responsible for the current South African Patents Act, and served as chairman of the committee responsible for the Trade Marks Act, the Designs Act and the updating of the Copyright Act. He also served as vice-chairman of the Assembly of the Paris Convention (1995-1997) and acted as chairman of the Conference in Working Committee that adopted the Trademark Law Treaty.

Justice Arms has authored a number of legal textbooks and articles. He is a *cum laude* law graduate from the University of Pretoria and holds an honorary doctorate from the University of the Free State. He holds an extraordinary professorship at the Adams & Adams Chair in Intellectual Property at the University of Pretoria.

Prof. Dionysia Kallinikou

Professor Dionysia Kallinkiou is currently a Professor of Law at Athens University and the Vice President of the Athens University law faculty. He currently serves as Vice President of the Greek Copyright Organisation, and served as Director and President of that organization from 1995 through 2004 and again from 2010 through 2011. He has also been project leader for EU Twinning Projects on intellectual property in several nations in Eastern Europe and authored numerous textbooks and articles, primarily on copyright.

Professor Kallinikou received his law degree from the University of Athens in 1971 and also has a Diplôme d' Etudes Supérieures de Doctorat (1975) and a Docteur d'Etat en Droit (1981) from the University of Paris.

Hon. Ryoichi Mimura

The Honorable Ryoichi Mimura received a B.A. in Law at the University of Tokyo in 1977. After graduation and 2-years of legal training at the Legal Training and Research Institute of Japan, he was appointed Assistant Judge of the Tokyo District Court in 1979. In 1981, he was sent by the Supreme Court of Japan to the University of Cologne, Germany for 2 years of judicial research. He was promoted to Judge of the Tokyo District Court in 1989. Judge Mimura started his career as IP expert in 1989 as Judge at the IPR division of the Tokyo District Court. In 1993, he was appointed Judicial Research Official of the Supreme Court to handle IPR cases. From 1998 to 2005, he served as Presiding Judge of the Intellectual Property Division of the Tokyo District Court. He worked as Judge at the Intellectual Property High Court (IP High Court) in Tokyo from 2005 to 2008 and as Judge at the Tokyo High Court from 2008 to 2009. He is currently an Attorney at Law and has been a Partner at the Japanese law firm Nagashima Ohno & Tsunematsu since August 2009.

Hon. Nicholas Ombija

The Honorable Justice Nicholas R. O. Ombija has been Pusine Judge of the High Court of Kenya since 2001. Prior to his judgeship, he successfully practiced law in Kenya for 22 years, gaining vast experience in matters of criminal law, civil litigation, and alternative methods of dispute resolution. During his time as an attorney, he advocated for many major clients, including Maseno University College and several of Kenya's largest banks.

Justice Ombija received an LL.B. with honors from the University of Nairobi in 1979. He has since received a LL.M. in Public International Law and LL.B. from the University of Nairobi (2005) as well as a Post-graduate Diploma in Legal Studies from the Kenya School of Law (1980).

Shinjiro Ono

Shinjiro Ono joined YUASA and HARA as a partner and a patent attorney in October 2005. He has served as a Senior Partner and Head of Patent Division since 2007. Prior to taking up his position at YUASA and HARA, Mr. Ono served as Deputy Commissioner of the

Japanese Patent Office (JPO) from 2002 to 2005. During his time in office, he significantly strengthened the examination system in order to facilitate timely and high-quality patent examination. Mr. Ono was involved in revising the Patent Law in 2003 on invalidation trials and again in 2004 on the creation of Article 104-3, enabling an alleged infringer to challenge the validity of a patent in the infringement litigation. Mr. Ono proposed the JPO's "Patent Prosecution Highway" at the Trilateral Conference in 2005.

Mr. Ono is currently a member of International Advisory Board of International Institute of Intellectual Property (IPI) in Washington DC and is an Advisory Committee member of the Center for Advanced Study & Research on Intellectual Property (CASRIP) of the University of Washington School of Law.

Dr. Ana María Pacón

Dr. Ana María Pacón has served as a professor lecturing on intellectual property matters at numerous universities around the world, including Escuela de Gestores de Políticas de Ciencia, Tecnología e Innovación (Santiago, Chile), the University of Rio de Janeiro, Pompeu Fabra University (Barcelona, Spain), University Los Andes (Merida, Venezuela), the University of Montevideo, and the University of Buenos Aires. She held leadership positions at INDICOPI, Peru's intellectual property office, as President of the Intellectual Property Tribunal from 1996-2001 and as President of the Tribunal for the Defense of Free Competition and Protection of Intellectual Property from 1998-2001. She has served as a consultant to the World Intellectual Property Organization (WIPO) since 1995. She has published on intellectual property matters in Spanish, English, and German language journals.

Dr. Pacón received her B.A. in law with high honors from Pontificia Universidad Católica del Perú in 1988, and also holds an LL.M. with high honors (1991) and a Ph.D., *summa cum laude* (1996), from the University of Augsburg (Germany).

Kiat Poonsombudldert

Kiat Poonsombudldert has been an attorney at Domnern, Somgiat, and Boonma, one of Thailand's premier intellectual property firms, in Bangkok since 1992. He currently serves as a partner and a registered patent agent. He was admitted to the bar in 1982 and served as a judge in Thailand's trial courts from 1989 through 1992.

Mr. Poonsombudldert obtained his B.A. in Law with honors from Chulalongkorn University in 1982. He also has an M.C.L. from the University of Michigan (1985) and an LL.M. from New York University (1986).

Assoc. Prof. Rohazar Wati Zuallcoble

Rohazar Wati Zuallcoble is an Associate Professor of Law at University of Technology MARA (UiTM) and an active member of the intellectual property committee established by the Malaysian government. As the former Deputy Director General of the Intellectual Property Corporation of Malaysia, she was the Chairperson of the technical committee for the setting up of the Intellectual Property Court in Malaysia. She has more than 20 years of working experience and has been involved with the teaching of intellectual

property at UiTM since 1987 for both undergraduate and postgraduate students. She has supervised research by LL.M. students on IPR-related topics. She also lectures on Intellectual Property for the Masters in Intellectual Property program conducted by University Kebangsaan in Malaysia.

She obtained a Postgraduate Specialization Diploma in Intellectual Property from University of Turin and World Intellectual Property Organization (WIPO) Worldwide Academy in 2000. She also graduated with an LL.M. from University College London (1986), a Postgraduate Diploma in Shipping Law from University College London (1985), an LL.B. with honors from the University of London (1984), and a diploma in Public Administration from UiTM (1981).