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## WORKSHOP

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WIPO-KIPO-DIP/IPR/JU/BKK/15/INF/1  
ORIGINAL: ENGLISH  
DATE: OCTOBER 28, 2015

## **WIPO-KIPO-DIP Regional Colloquium on Intellectual Property Enforcement for Judges**

organized by  
the World Intellectual Property Organization (WIPO)

the Intellectual Property Office of the Republic of Korea (KIPO)

and  
the Department of Intellectual Property of Ministry of Commerce of Thailand (DIP)

**Bangkok, October 28 and 29, 2015**

## PROGRAM

*prepared by the International Bureau of WIPO*

Practical Information:

1. The two participants of each country are requested to jointly prepare a written country report based on a questionnaire on the legislative framework for intellectual property (IP) enforcement available in their country. The reports (one per country) will be shared with all participants prior to the Colloquium, unless requested otherwise by the submitting participants.
2. The two participants of each country are requested to jointly prepare a written summary of an IP court judgment from their jurisdiction. The summaries will be shared with all participants prior to the Colloquium. In addition, one participant per country will be requested to provide an oral presentation of the case of no more than ten minutes during the Colloquium.
3. To allow for utmost interaction, a number of topics of the program will be dealt with through discussion in small groups of participants, based on a mock case scenario addressing the relevant topic. Each group will be moderated by one of the four invited speaker judges and is expected to report to the plenary on the commonalities and differences that emerged from their discussion. At the end of the session, the most important aspects of the topic will be summarized by one of the invited speaker judges.

Wednesday, October 28, 2015

8.00 – 9.00	Breakfast / Registration and Administrative Matters
9.00 – 9.15	Opening Ceremony  Ms. Nuntawan Sakuntanaga, Director General, Department of Intellectual Property, Ministry of Commerce of Thailand (DIP)  Mr. Kyuhong Lee, Presiding Judge, Seoul Central District Court, on behalf of the Intellectual Property Office of the Republic of Korea (KIPO)  Ms. Eun-Joo Min, Senior Legal Counsellor, Building Respect for IP Division, World Intellectual Property Organization (WIPO), Geneva
9.15 – 9.35	Introduction of Participants
9.35 – 9.55	<b>Topic 1      International Cooperation on Building Respect for IP</b>  Speaker:      Ms. Eun-Joo Min
9.55 – 10.15	<b>Topic 2      International IP Enforcement Framework – Part III of the Agreement on Trade-Related Aspects of IP Rights (TRIPS Agreement)</b>  Speaker:      Mr. Tobias Bednarz, Legal Officer, Building Respect for IP Division, WIPO
10.15 – 11.00	<b>Topic 3      Available Routes for IP Infringement – Civil, Criminal and Administrative Courts</b>  Which courts have jurisdiction over infringement of Intellectual Property rights (IPRs)? Describe the interplay between available actions. Is there a defined order? What is the impact, if any, of the criminal action on the civil action, and <i>vice versa</i> ?

Are there specialized IP courts or a specialized IP judiciary?

What is the hierarchy of courts, for purposes of appeals, with regard to cases of infringement of IPRs?

*Break-out Discussion in Groups and Reporting*

11.00 – 11.30    **Topic 4**    **Case Law Developments from the Region (1)**

Speakers:    Participant from China

Participant from the Philippines

Participant from Thailand

11.30 – 12.15    **Topic 5**    **Civil Procedures and Remedies**

What is the average period that lapses between the commencement of proceedings and the delivery of the judgement of the court? Under what circumstances can proceedings be expedited?

Do the procedures include means to identify and protect confidential information?

What are the frequently encountered evidentiary hurdles?

What are the available civil remedies defined in the law? How are they applied in practice? Can the court award exemplary or punitive damages? Under what circumstances? How are damages calculated? Provide examples. Discuss the circumstances under which secondary liability may be found in IP infringement cases.

Can the court order the disposal and destruction of IP infringing goods? Does any other entity have the authority to make such an order? Who determines the means of the disposal/destruction? Who are the stakeholders involved? Who pays for the disposal/destruction?

Discuss cross-border considerations in IP infringement cases. Under which circumstances is jurisdiction declined? Are there cases in which foreign substantive law is applied in IP infringement cases? Have there been cases in which a foreign judgement in an IP infringement case has been recognized and enforced in your country?

*Break-out Discussion in Groups*

12.15 – 13.30    Lunch Break

13.30 – 14.45    **Topic 5**    **Civil Procedures and Remedies**  
(cont'd.)

*Reporting*

*Summarizing Analysis*

Speaker: Judge Maria Rowena Modesto-San Pedro,  
Regional Trial Court, Pasig City, The Philippines

15.15 – 16.30 **Topic 6** **The WIPO Report “Private International Law Issues in Online Intellectual Property Infringement Disputes with Cross-Border Elements - An Analysis of National Approaches**

Speaker: Ms. Eun-Joo Min

15.00 – 15.15 Coffee Break

15.15 – 16.30 **Topic 7** **Provisional Measures**

Which procedural requirements must be fulfilled for a court to order a provisional measure in relation to an alleged IP infringement? What substantive considerations must the judge balance when deciding on a provisional measure? What type of provisional measures can be ordered by the court?

Does the requesting party have to take any action to maintain the provisional measure? Under what circumstances can a provisional measure be reviewed?

Can the court order the customs authorities to suspend at the border the release of goods that are to be imported but that allegedly infringe IPRs? Can such a suspension of release be ordered for any or just particular types of allegedly infringing goods? Where customs authorities are competent to receive and decide on applications for suspension of release, is there a point at which a court reviews the legality of this border measure?

Can the court issue a provisional measure without hearing the affected party (*ex parte* or *inaudita altera parte*)? Under what conditions?

*Break-out Discussion in Groups and Reporting*

*Summarizing Analysis*

Speaker: Justice Annabelle Bennett, Federal Court of Australia

16.30 – 17.00 **Topic 8** **Case Law Developments from the Region (2)**

Speakers: Participant from Indonesia

Participant from Malaysia

Participant from the Republic of Korea

18.00 – 20.00 Cocktail Reception

Thursday, October 29, 2015

8.00 – 9.00 Breakfast / Group Discussion

9.00 – 09.20 **Topic 9 Understanding the Phenomenon of Counterfeiting and Piracy**

Identifying the different types of infractions and motivations for IPR infringements and understanding the social, economic and commercial impact of counterfeiting and piracy.

Speaker: Mr. Tobias Bednarz

09.20 – 9.40 **Topic 10 Association of Southeast Asian Nations (ASEAN) Regional Action Plan on IP Enforcement**

Speaker: Judge Maria Rowena Modesto-San Pedro,  
Regional Trial Court, Pasig City, The Philippines

9.40 – 10.10 **Topic 11 Case Law Developments from the Region (3)**

Speakers: Participant from Singapore

Participant from Viet Nam

Participant from Cambodia

10.10 – 12.00 **Topic 12 Criminal Procedure**

Which IP infringements are subject to criminal action? What are the main penalties defined in the law? How are they applied in practice? Which public interest considerations must be taken into account when determining a sentence? How does the judge ensure that a sentence is proportionate?

Who is responsible for initiating criminal proceedings? Are complaints from right holders required?

Can damages be claimed before a criminal court? If so, can such a claim be made during the same criminal procedure?

May non IP-specific legislation be applied in IP infringement cases (e.g., laws against money laundering or product specific regulatory provisions)?

Are IP crimes specifically mentioned in proceeds of crime legislation as one of the areas to which such legislation applies? Is there a hierarchy in the payments between damages and confiscations of proceeds of crime? What happens with confiscated proceeds of IP crimes?

*Break-out Discussion in Groups and Reporting*

*Summarizing Analysis*

Speakers: Judge Watchara Neitivanich, Central Intellectual Property and International Trade Court, Thailand  
  
Judge Chachavech Sukitjavanich, Central Intellectual Property and International Trade Court, Thailand

12.00 – 13.00 Lunch Break

13.00 – 13.40 **Topic 13 Addressing Technical Issues in IP Litigation**

Speaker: Justice Annabelle Bennett, Federal Court of Australia

13.40 – 15.00 **Topic 14 IP Enforcement in the Digital Environment**

Are there procedures available specific to the digital environment (e.g., site blocking, graduated response, etc.)? Who initiates, who implements, who pays? Can intermediary service providers be held liable? Are there initiatives to cooperate voluntarily with intermediary service providers?

Moderators: Judge Pablo III Cabillan Formaran, Presiding Judge, Branch 21, Regional Trial Court, Naga City, the Philippines

Judge Romeo Dizon Tagra, Presiding Judge, Branch 273, Regional Trial Court, Marikina City, the Philippines

Speaker: Mr. Kwee Tiang Ang, Regional Director, Asia, International Federation of the Phonographic Industry (IFPI)

Panelists: Judge Bo Xu, Judge, Assistant of the President of the Beijing IP Court, China

Judge Hyun Nam, Judge, Seoul Central District Court, Republic of Korea

Judge Watchara Neitivanich, Central Intellectual Property and International Trade Court, Thailand

Judge Chachavech Sukitjavanich, Central Intellectual Property and International Trade Court, Thailand

15.00 – 15.20 **Topic 15 Case Law Developments from the Region (4)**

Speaker: Participant from Myanmar

Participant from Brunei Darussalam

15.20 – 16.00    **Topic 16**    **Roundtable Discussion on Challenges and Opportunities  
for the Effective Enforcement of IPRs**

What are the challenges? What can be improved in IP enforcement? Is there a need or room for judicial cooperation? What are useful follow-up actions? What strategies exist for efficient case management?

Moderator:    Justice Annabelle Bennett, Federal Court of  
Australia

Panelists:    Justice Azizah Binti Nawawi, High Court,  
Malaysia

Rong Wei Justin Yeo, Assistant Registrar,  
Supreme Court, Singapore

16.00 – 16.15    Evaluation and Closing Ceremony

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