

2020 WIPO Intellectual Property Judges Forum

Promoting transnational dialogue among judiciaries

November 18–20, 2020

Report

About the WIPO Judicial Institute

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Information on WIPO's work relating to judiciaries is available on the WIPO website at www.wipo.int/about-ip/en/judiciaries.

Acknowledgments

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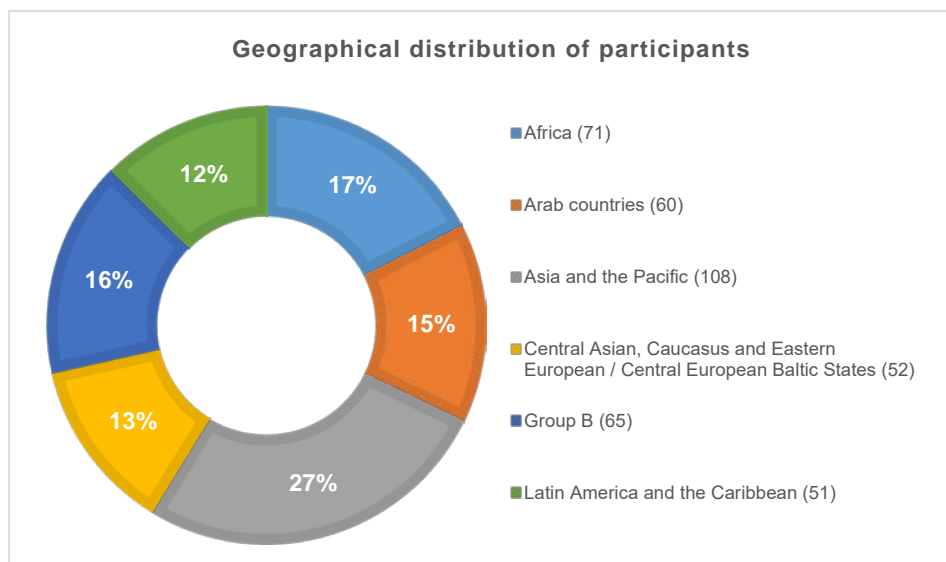
2020 WIPO Intellectual Property Judges Forum Promoting transnational dialogue among judiciaries

The annual *WIPO Intellectual Property Judges Forum* aims to provide a platform for judges from across the globe to exchange their expertise on the most pressing IP challenges raised by accelerating innovation and the increasingly transnational use of IP.

The 2020 edition of the Forum was conducted in a virtual format from November 18 to 20, 2020.

This year, 407 participants from 89 national and regional courts registered their participation, with an average of 230 to 260 participants attending each of the three days of the program.

Twenty-seven judges from 22 countries and one regional jurisdiction participated as moderators, panelists or lead discussants.



The format of the program was designed to maximize the exchange of perspectives among the jurisdictions represented on each panel, and to foster dialogue among all participants. In light of the virtual format necessitated by the global circumstances of the Covid-19 pandemic, the Forum sought to provide alternative avenues of informal discussion, including through the organization of “Reflections” sessions at the beginning of the second and third days. In these sessions, the moderators of each of the panels of the previous day engaged in informal conversation with a lead discussant, to reflect on and synthesize those discussions. Throughout the Forum program, the virtual platform’s “chat” function was used extensively by participants to engage through questions, comments, and exchange of their own perspectives.

In order to encourage free discussion, the Chatham House Rule was applied. Accordingly, the identity and affiliation of the speakers and participants shall not be revealed in reporting on the discussions. The speakers spoke in their personal capacity, expressing their own opinions and views and not necessarily those of the Secretariat or of the Member States of WIPO.

The participating judges expressed appreciation for the broad exposure provided to other jurisdictions, the rich exchanges with judicial peers from across the globe, and the collegial community of IP judges fostered by the Forum.

The Forum was conducted in six languages (English, Arabic, Chinese, French, Russian and Spanish) with simultaneous interpretation.

The program and other materials may be accessed on the Forum webpage at www.wipo.int/judgesforum2020.

Summary Report

The following summary reports on the discussions which took place during the Forum, and does not reflect the views of any individual participant or WIPO. As the discussions were limited to certain aspects of a small number of sample cases, this summary does not represent the state of the law of any jurisdiction.

Opening by WIPO Director General

The 2020 WIPO Intellectual Property Judges Forum was opened by Mr. Daren Tang, Director General of WIPO, who expressed WIPO's honor in welcoming the large number of judges participating from across the world during the difficult times of the pandemic.

The Director General shared some remarks on his vision for WIPO and its work, and of the Forum as a part of this vision. At a general level, the Director General highlighted the existing gap in understanding of the relationship between intangibles and the economy, which had significant implications for the use of IP, including its commercialization, financing, and translation into productive services, and ultimately to the way in which economies create jobs and value for citizens. The Director General also noted a lack of awareness about IP and the value it can bring to countries. He saw engagement with WIPO's stakeholders, including the judiciary, as an important element in addressing these challenges.

Turning to the importance of the Forum in this context, the Director General recalled that the Forum is the premier conversation in WIPO for and with the judiciary, and that it was born in response to demand from national and regional judges. He noted that the meeting intended to respond to the fast-evolving innovation landscape and the increasingly transnational use of IP, drawing on WIPO's strength as an impartial convener to enable discussions across jurisdictions on shared legal issues of importance. Over its three editions, the Forum offered an unparalleled space for judges from across the world to engage with and build a global community of peers. While stressing that the ultimate judicial approach to any IP question would depend on each country's distinct legal, social and economic context, the Director General hoped that the open judicial dialogue enabled by the Forum would contribute to supporting judges in addressing the complex issues arising in IP adjudication.

The Director General shared some other major developments in the Organization's work with the judiciary that also aimed to support the cross-pollination of ideas and judicial approaches. In particular, he highlighted the recent launch of WIPO Lex-Judgments, a new database providing free-of-charge access to leading judicial decisions in IP from around the world. He also noted the Organization's ongoing collaboration with courts in a number of countries on longer-term projects, including to develop regional IP benchbooks and judicial case management guides, and to introduce IP in the regular curricula offered by national judicial academies. He explained that these projects aimed at building sustainable resource tools to assist courts in the judicial administration of IP, and in making IP adjudication more coherent, effective and accessible.

In conclusion, the Director General emphasized WIPO's gratitude to the members of the WIPO Advisory Board of Judges for their guidance of the Organization's work with judiciaries and thanked all Forum speakers and participants for cultivating, through the Forum, a unique platform of transnational judicial dialogue.

Session 1: Patentability Assessment in the Pharmaceutical Sector

In introducing this topic, it was observed that the significance of patent questions for the pharmaceutical sector is ever-increasing, with the current Covid-19 pandemic particularly highlighting the important role of patents in matters of global health. The fundamental threshold question of patentability – what kind of innovation is entitled to be patented? – was therefore the subject of growing debate. This session and its accompanying “Reflections” segment covered a spectrum of issues under the rubric of patentability, including characterization of patentable subject matter in the case of new forms or dosages of known substances, the patentability of methods of medical treatment, and the ways in which different jurisdictions account for public interest considerations.

One patentability question that arose in the pharmaceutical area was the circumstances in which follow-on innovation could constitute patentable subject matter. Examples were shared from a jurisdiction in which claims covering new forms of known substances are excluded from patentable subject matter unless certain statutorily-defined criteria are met. The discussion shed light on how this statutory test – and particularly the meaning of “efficacy” in the context of new forms of known substances – has been interpreted and applied, and was capable of achieving different outcomes for patent validity depending on the specific fact scenario. As an example, the court’s reasoning in assessing whether the additional beneficial properties of the new form met the efficacy requirement was described. The discussions on this topic revealed that, in other jurisdictions, similar analyses may be conducted in assessing the different criteria of patentability, which may involve looking not only at a threshold question, but also when considering the inventive step requirement.

The panel also discussed new methods of medical treatment. Cases from some jurisdictions in which such methods are excluded from patentable subject matter provided insight on how courts have delineated which claims fall within the exclusion. Factors taken into account when determining whether a claim constituted a method of medical treatment included elements which could be seen to impinge on the skill of a medical professional administering treatment. In one case, a distinction was drawn with regard to whether the patent involved a claim for a substance administered at a precise dosage, or in a range of dosages. Another case considered a claim for a combination of known elements (so-called combination therapy), and considered the circumstances in which such a claim would be considered as a pharmaceutical composition eligible for patent protection, rather than as a method of medical treatment. The discussion of these cases was broadened by perspectives from jurisdictions that have designed different frameworks to address the patentability of such claims. For

Reference judgments

- Federal Court of Appeal, Canada [2020]: *Hospira Healthcare Corporation v. Kennedy Trust for Rheumatology Research*, 2020 FCA 30
- Supreme Court of India [2013]: *Novartis AG v. Union of India and Ors*, (2013) 6 SCC 1
- Delhi High Court, India [2015]: *Merck Sharp and Dohme Corporation and Anr v. Glenmark Pharmaceuticals Ltd*, CS (OS) No. 586/2013
- Delhi High Court, India [2020]: *AstraZeneca AB & Anr v. Intas Pharmaceuticals Ltd*, CS(COMM) 410/2020
- Court of Milan, Italy [2019]: *Actavis Group PTC EHF v. AstraZeneca*, Judgment No. 7427/2019
- Court of Milan, Italy [2020]: *Innovet Italia and Epitech v. Pharmasuisse Laboratories*
- Chamber of Constitutional and Social Law of the Supreme Court, Peru [2014]: *F. Hoffmann La Roche AG v. National Institute for the Defense of Competition and Protection of Intellectual Property (INDECOP)*, Cassation Number 1112-2011
- Court of Justice of the Andean Community [2013]: *Proceso 33-IP-2013*, Gaceta Oficial del Acuerdo de Cartagena No. 2209, 14.68
- Enlarged Board of Appeal, European Patent Office [2010]: *Dosage regime/ABBOTT RESPIRATORY*, G0002/08

example, it was observed that, in Europe, a claim format such as “compound X or composition Y for treating disease Z” was typically used to claim a purpose-limited product.

In other cases, patentability was reviewed against the requirements of novelty and inventive step. For example, in a nullity proceeding brought by a generic manufacturer concerning a second medical use patent, the court considered whether use of the product covered by the patent, by the originating manufacturer in clinical trials, constituted novelty-destroying disclosure, taking into account factors such as the existence of confidentiality agreements. In the same case, the steps followed by the court in assessing the obviousness of the patent were described. In a separate proceeding concerning novelty, the court’s approach in evaluating whether the form of the substance covered by the patent (micronized form of active ingredient) was disclosed by prior patents (same component in crystallized form), was explained. In this context, the risk of infringing the prior patents by equivalent was also examined. Finally, the panel also touched upon the scope of claims and disclosure issues in pharmaceutical patents, for example where multiple patents cover the same basic molecule.

The discussion further acknowledged differences between national systems in whether, and to what extent, courts are mandated or empowered to take account of public interest considerations. Comments contributed by participants highlighted the inadmissibility of public policy as a consideration for judges in some jurisdictions. Thus, while a concept of discretion exists in some systems, a variety of legislative formulations exists in other jurisdictions, for example providing multiple factors to be taken into account. Issues of public policy may also be raised in some jurisdictions to exclude inventions that are contrary to public order or morality from patentability. Further, in discussing the relevance of public interest considerations, some commentators noted that, in some cases, courts may consider public interest matters at the stage of enforcement of a patent, in particular in deciding whether an injunction should issue.

Consideration of compulsory licenses as an available tool for addressing exceptional circumstances was also raised. However, it was noted that while there may be statutory provision for such licenses, as a general matter, the grounds on which compulsory licenses may be granted are limited. There were comments that there have not been many compulsory license applications made, perhaps for this reason. It was also acknowledged that issuing a compulsory license may not be an easy decision for courts, due to the conflicting factors that would need to be considered, including global and local medical need and the impact on innovation. Finally, some judges considered that, where existing law did not provide sufficient basis for arriving at a judicial determination of, for example, the above matters, the question would be more appropriately flagged for possible legislative deliberation.

Session 2: Copyright Exceptions and Limitations in the Context of Information Technology and Digital Products

This session and its accompanying “Reflections” segment explored recent cases relating to copyright in the digital environment, with a particular focus on the application of copyright exceptions and limitations to the new technological landscapes in which copyright operates. Recognizing the crucial importance of protecting the interests of both copyright creators and users, the session asked how courts dealt with the issues arising from online copyright creation and exploitation. The subsequent discussions also reflected more broadly on how the current tools available to judges can be applied to adequately meet emerging challenges.

The factual scenarios raised in the cases shared during the session recalled fundamental copyright issues such as the criteria for copyright protection, highlighting the sometimes challenging distinction between copyrightable and uncopyrightable works in the online environment. In one case, the extent to which news texts, news summaries and related information (such as interviews and analyses of news) enjoy copyright protection was examined, in the particular context of digital dissemination of news in a marketplace marked by strong competition among providers. The factors taken into account by the courts of that jurisdiction in assessing each element of the news products were shared, including distinctions between the content of the news and its form, and evaluation of the originality, labor and skill in the news products.

Another area of discussion was the application of the doctrine of exhaustion in the digital environment. The panelists acknowledged the ease of digital dissemination of copyrighted works, including in high volume, at low cost and without deterioration of the works. Recent judicial guidance in a case involving a market for second-hand e-books was shared. The decision explored that jurisdiction’s approach to interpreting the applicable legislation governing the exhaustion of a copyright owner’s exclusive right of distribution in light of the WIPO Copyright Treaty. The questions asked included whether the right of distribution extends to intangible works, and whether the sale of an e-book would fall within the scope of the right of distribution. Questions raised during the session made the link between this case and the question of exhaustion in relation to other types of works, such as computer software. It was noted that, in another jurisdiction, the first-sale doctrine had been extended to cover both tangible and intangible works. Looking forward, the discussion acknowledged that the question of digital exhaustion, and the circumstances in which it may be available, may attract further consideration by policymakers in future. It was suggested by some judges that evolving technical measures could be tailored to address some of the challenges in regulating the dissemination of intangible copies of works, in order to enable both the protection of the interest of copyright holders and the fruitful use of works.

The cases also touched upon approaches to determining the ownership of copyright between employers and employees, and factors relevant to determining whether infringement has taken place. In a case involving online dissemination of a music composition, where a license had been granted by the songwriter, the court considered the scope of the licensing agreement to assess the extent to which the dissemination constituted an infringing act. In the case relating to news and information, the licensing practices of the parties were similarly taken into account, as well as the commercial nature of the infringing activities.

Reference judgments

- Court of Justice of the European Union [2019]: *Nederlands Uitgeversverbond and Groep Algemene Uitgevers v. Tom Kabinet Internet BV and Others*, Case No. C-263/18
- Court of Cassation, Morocco [2019]: Case No. 1649-3-1-2019
- Supreme Court of Appeal, South Africa [2019]: *Tellytrack v. Marshalls World Sport (Pty) Ltd and Others* [2019] ZASCA 153
- Supreme Court of Thailand [2019]: *InfoQuest v. Bisnews AFE (Thailand) Co Ltd*, Case No. 8313/2561

Finally, a recent case involving unlicensed screening of footage of a sporting event illustrated the distinction drawn in one jurisdiction between broadcasting and cinematographic works, and the different mechanisms for copyright protection that apply to each. In that case, a contested issue was fixation, which was a necessary element for the work to constitute a cinematographic work. The decision examined the applicability of the concept of fixation and the technical facts to determine whether the near-simultaneous screening of footage, to which sound recordings and graphic enhancement were added with only a few seconds of delay, was to be considered as having been reduced to material form or “fixed”. It was noted that, under this judicial approach, the general terms employed in the legislature permitted adequate space to encompass future technological developments.

Throughout the discussions, the speakers and participants acknowledged the significant changes to the copyright landscape, including the blurring of the distinction between tangible and intangible works, and the role of new and powerful internet actors. However, the conversation also highlighted the ways in which judicial approaches have already adapted copyright concepts, within existing legal frameworks, to address the nature of online copyright exploitation. Examples included the evolution of injunctions to better deal with online infringement that transcends territorial borders and that can easily circumvent access blocks, as well as current developments in the area of hyperlinks. It was suggested that judges can continue to renew and tailor the existing wealth of legal tools, while keeping their “feet on the ground”, to meet the needs of future IP adjudication.

Session 3: Influence of Technology in Judicial Case Management

This session and its accompanying “Reflections” segment focused on the ways in which technology has influenced the management of IP cases by courts, especially in the context of the global pandemic. The speakers provided an overview of recent developments in their respective courts and shared their own experiences to pin down the advantages and disadvantages of these changes. A recent study of the experiences of attorneys with online hearings was shared, to expand the discussion on the implications of these developments.

The panel focused on three main technological developments: the use of virtual hearings to replace in-person hearings during the pandemic, including in proceedings such as cross-examination of experts; moving towards, or strengthening existing, electronic filings and databases; and the use of new technologies such as blockchain and one-stop mobile litigation platforms to support judicial case management in the online environment.

On the topic of online hearings, the panelists exchanged their views on the practical and legal challenges arising from the displacement of in-person proceedings to the virtual space. The panelists observed several difficulties, such as regulating access by the public or interested parties (where permitted) and safeguarding their anonymity; protecting the confidentiality that is required in some cases, such as in fair, reasonable and non-discriminatory (FRAND) licensing disputes or cases involving trade secrets; allowing client-attorney privileged communication during the hearing; and the technical problems that can arise with the use of online platforms. One panelist noted that the loss of the court’s ability to perceive the interactions and non-verbal communication by and between witnesses, attorneys and experts was a major drawback of virtual formats. Differences in the approaches taken by courts to address these disadvantages were also shared.

The panel highlighted, however, that online hearings have also clear benefits, including the reduction in litigation costs achieved by eliminating the travel expenses of experts and attorneys, a reduction in length of trials, and the practical advantages for parties from around the globe to be able to connect remotely and follow the hearings. Some solutions to

traditionally physical tasks, such as virtual inspection of evidence of products or designs, were also shared, including the use of photographs in court documents and using cameras during the hearings that focus on all angles of the products.

Various developments to the provision of online case management systems were shared, including one-stop litigation platforms for mobile phones, electronic filing of documents by the parties (and, in some countries, electronic delivery of documents by the court to the parties), and open databases of court files. The panelists shared the approaches taken to safeguard the security and confidentiality of documents that are filed electronically, and also observed some of the broad benefits of these initiatives for the improvement of the administration of justice in general, such as quick and easy access to court files.

In terms of the perception by the relevant stakeholders of online hearings, a recent survey of the experiences of attorneys conducted in one jurisdiction was shared. The study highlighted not only some of the advantages noted by the attorneys, such as lower costs and quicker hearings, but also practical challenges and, more importantly, negative perceptions of the impacts on the level of trust in the judicial system, public access, the right to a fair trial and the perceived legitimacy of the judicial process. The study also reported the importance of physical and human interaction between the court and the parties and attorneys, and that the virtual formats lacked the ability to allow direct discussions and informal negotiations. It was agreed by the session discussants that the efficiency and convenience of virtual hearings must be balanced with other values, such as transparency, confidentiality and trust in the judicial system. The discussants suggested that future studies and evaluations are necessary to shed further light on the advantages, disadvantages and impacts of each format, and to inform decisions regarding which technological developments can be used to enhance judicial case management of IP disputes.

Looking forward, the panel considered whether some of the uses of technology on case management that had been triggered or enhanced during the pandemic could continue to serve courts in the future. Possibilities for harnessing the demonstrated advantages of greater use of technology by courts, while preserving the irreplaceable value of in-person attendance, were raised. For example, it was suggested that a hybrid system for hearings could balance the benefit of using online formats in the instances when they are most effective, such as in case management hearings and interlocutory procedures, while maintaining in-person hearings for bigger and more complex disputes.

Session 4: Non-Traditional Trademarks

This session explored how IP offices and courts have dealt with the interesting questions that arise when deciding to grant or deny the registration of non-traditional trademarks. With illustrative judicial and administrative cases, the panelists shared approaches from their jurisdiction to the consideration of non-traditional marks, such as three-dimensional marks and tactile marks, with regard to the legal requirements of distinctiveness and the technical result prohibition. The panelists also discussed the evaluation of evidence in such cases, and the particular consideration of competition principles that may arise in the context of three-dimensional marks. The discussion of these issues was expanded during the “Reflections” segment, which also highlighted the convergences in the issues and questions faced by the jurisdictions represented.

The discussion referred to the challenges of establishing acquired distinctiveness for non-traditional marks by reference to cases on marks consisting of the shape of the product itself, such as chocolate bars, clog shoes and medical pills in different jurisdictions. It was observed that non-traditional trademarks, and three-dimensional marks in particular, are often not considered as being capable of inherent distinctiveness. Therefore, the key question arising with regard to non-traditional trademarks was that of the acquired distinctiveness of the mark. For example, in some jurisdictions, the shape mark was evaluated by reference to the shape’s significant deviation from the norms and customs of the applicable sector, and by applying the reliance test, which requires that a significant proportion of the relevant consumers rely on the sign on its own as a source indicator. In one jurisdiction, the court emphasized that the question of acquired distinctiveness was a factual matter and should be approached without any *a priori* disqualification or classification. In another jurisdiction, in evaluating the distinctiveness of a tactile mark in the surface texture of a bottle, the regional court considered the extent to which such a texture was common and necessary for that class of goods.

The discussion made clear that evidence plays a crucial role in determining whether a non-traditional trademark is eligible for registration, and that proving acquired distinctiveness of non-traditional trademarks can be a heavy burden. The panelists also explored the use of different kinds of evidence to establish the acquired distinctiveness of a shape as a clear identifier of a brand. Direct evidence of consumer perception, such as market surveys to demonstrate distinctiveness, was considered as potentially persuasive evidence. However, it was argued that courts might still disregard such evidence when they consider that the survey did not pose the right questions to the consumers. The importance of the quality of the evidence and, in the context of market surveys, their objective value and precision, were emphasized, noting that surveys can be expensive for the party trying to establish the acquired distinctiveness. Other types of evidence to demonstrate acquired distinctiveness were mentioned, such as advertising materials, sales figures and website traffic data, but it was acknowledged that such evidence would not be regarded as conclusive evidence to prove the acquired distinctiveness of a non-traditional mark.

Reference judgments

- Civil and Commercial Court of Asunción, 12° Turno, Paraguay [pending]: *Minerías Orienpar S.A. v. Crocs, Inc.*, Interlocutory order No. 1836 of December 23, 2015
- Court of Appeal, Singapore [2017]: *Société des Produits Nestlé SA and another v. Petra Foods Ltd and another* [2017] 1 SLR 35
- Supreme Court of Appeal, South Africa [2002]: *Beecham Group PLC and another v. Triomed (Pty) Ltd* [2002] 4 All SA 193 (SCA)
- Supreme Court of Appeal, South Africa [2014]: *Société des Produits Nestlé SA v. International Foodstuffs* [2014] ZASCA 187
- African Intellectual Property Organization [2020]: *Société APPLE Inc. v. Société COVIFED Sarl*, Decision No. 0876/OAPI/DG/DGA/DAJ/SCG

Consideration of the technical result prohibition in trademark law was also an important aspect in some of the cases discussed by the panel. The panelists discussed the approach taken by the courts of their jurisdiction in analyzing whether the shape or texture at issue was necessary to achieve a technical result, and thus ineligible for trademark protection. For instance, in one jurisdiction, the court had considered evidence regarding whether the oval shape of a medical pill represented by the shape mark was important to assure the ease and safety of swallowing the medication, particularly with regard to larger tablets. In another case, a two-step approach was adopted by first identifying the essential features of the shape, and by subsequently determining whether these essential features are necessary to obtain a technical result, such as whether the shape was necessary to prevent the crumbling of the chocolate bar and to make consumption easier. Other considerations, such as whether the technical result prohibition relates to the product function or to the manufacturing process of the product, were also mentioned.

It was noted that non-traditional trademarks have not yet been litigated in some jurisdictions, though the legal framework for their registration has already been developed. Meanwhile, this legal framework had undergone recent changes in some jurisdictions, including the removal of the condition of registration that signs be visually perceptible. The discussion also extended to the more common issue of likelihood of confusion of trademarks in general.

Finally, the discussion revealed the interface between competition principles and trademark protection, especially in the context of three-dimensional marks. Since the grant of protection to a three-dimensional mark necessarily inhibits the use of shapes, a relatively limited resource, particular vigilance and precision in the judicial analysis were necessary to ensure that a monopoly on the use of a shape is not granted lightly. Three-dimensional marks presented a particular challenge, due to the difficulty of establishing acquired distinctiveness where shapes are used in conjunction with other elements. The risk existed that, in some cases, consumers might actually be identifying the product with elements other than the shape itself, such as the packaging or the word mark.

WIPO's Work in the area of the Judicial Administration of IP

The session provided an overview of WIPO's work in the field of the judicial administration of IP, particularly through the Organization's strengthened approach that was launched in 2018 to meet a growing demand for support to the judiciary in facing novel, and increasingly technical, IP questions.

It was noted that this work is organized under three pillars: exchange of information, strengthened judicial capacity building, and facilitating access to information on judicial systems and decisions on IP. The overarching principles that guide this work were highlighted. In particular, WIPO's work honors and caters to the diversity among the 193 WIPO Member States, in terms of diversity of substantive law, procedures, judicial structures or national socio-economic priorities and traditions. As such, WIPO emphasizes national ownership in its engagement with national judiciaries, and receives direction of its work from the judges, in particular the WIPO Advisory Board of Judges, whose 15 members represent broad geographical and technical coverage and serve in their personal capacity.

Under the first pillar of exchange of information, the annual WIPO IP Judges Forum was the preeminent event that each year fostered an expanding global community of IP judges. It was reiterated that the Forum is, first and foremost, a platform for judges to freely engage and deliberate on common matters, to understand what is occurring in other countries and the reasoning for certain decisions, and to discuss differences in procedures and judicial approaches. The judicial dialogue was not intended to provide any answers or directions, which would depend on the distinct circumstances of each country, but rather to enable judicial peers to inform and be informed.

In addition to the Forum, in 2020 WIPO launched a new series of WIPO Webinars for Judges, to enable transnational judicial dialogue to continue despite the restrictions resulting from the global pandemic.

The second pillar of WIPO's work with judiciaries focused on sustainable development objectives in judicial training. Four elements were presented under this pillar: WIPO's continuing judicial education program on IP, which served as a vehicle for collaboration with national judicial academies to shape long-term capacity building outcomes on the basis of national needs and ownership; the WIPO Master Class on IP Adjudication, which brought together a limited number of experienced IP judges; training on specialized topics; and the distance learning course dedicated for judges offered by the WIPO Academy.

The third and last pillar concerned efforts to build global reference sources in the area of the judicial administration of IP. Most recently in September 2020, these efforts resulted in the launch of WIPO Lex-Judgments, a database that provides open and free online access to judicial decisions on IP from around the world. In addition, following the publication of the first volume of the WIPO Collection of Leading Judgments on Intellectual Property with the Supreme People's Court of China in 2019, it was reported that projects are pending to expand this series and also to develop regional IP benchbooks and judicial case management guides.

Session 5: Forum Shopping in Multi-Jurisdictional IP Disputes: Example of FRAND Disputes

The session began with an introduction to the patent litigation landscape surrounding industry standards in telecommunications and standard essential patents (SEPs). In these cases, disputes frequently arise in the determination of fair, reasonable and non-discriminatory (FRAND) license terms. The global nature of the telecommunications market is also often reflected in the global nature of this patent litigation. Accordingly, one of the important issues faced by courts is the tension between the national nature of IP rights on one hand, and global businesses and global license rates on the other.

Four topics were addressed in the session:

- (i) the availability of global relief in FRAND disputes;
- (ii) the role of the court in promoting settlement;
- (iii) the relationship between parallel proceedings in different countries and anti-suit injunctions; and
- (iv) the factors informing parties' choice of jurisdictions, including the specific mechanisms developed by different national courts to address dispute resolution needs in global patent disputes.

The issue of global relief was addressed by asking what authority could one court have to act in a way that might impact the ability of another court to analyze similar issues within its jurisdiction. The panelists considered the implications of a new form of court order. This is an injunction granted by a court in one country to restrain infringement of a domestic patent unless the defendant accepts a particular form of FRAND license. The FRAND license terms, in light of the practical reality of the telecommunications business, would be worldwide in effect. The terms may include royalty rates for sales in different territories. The panelists stressed that, as a matter of law, such an order would not be granting injunctive relief outside the country or stepping outside the exercise of jurisdiction. However if made in a lucrative market the order could have practical effects extending beyond borders, due to the reality of business practice. In terms of damages, it was noted that generally courts could not impose damages for sales that occurred outside the court's jurisdiction. However, reference was made to a recent judgment which raised the prospect of obtaining damages when component parts were supplied outside the jurisdiction with the knowledge that the component had no practical non-infringing use other than in an infringing device within the jurisdiction. The contrast between the territorial limit of the effect of court orders and their potentially cross-border practical business effect underscored the importance of judges being aware of and looking at each other's judgments, as well as recognizing the potential for different approaches in different countries.

Reference judgments

- Federal Court of Justice of Germany [2020]: *Sisvel v. Haier*, Case No. KZR 36/17
- Higher Regional Court of Munich, Germany [2019]: *Nokia v. Continental*, Case No. 6 U 5042/19
- Intellectual Property High Court of Japan [2014]: *Samsung Elecs. Co. v. Apple Japan LLC*, Case No. 2013 (Ra) 10007
- Supreme Court of the United Kingdom [2020]: *Unwired Planet International Ltd & Anor v. Huawei Technologies (UK) Co Ltd & Anor* [2020] UKSC 37
- U.S. Court of Appeals for the Federal Circuit [2014]: *Ericsson, Inc. v. D-Link Sys.*, 773 F.3d 1201
- U.S. Court of Appeals for the Federal Circuit [2019]: *TCL Commc'n Tech. Holdings Ltd. v. Telefonaktiebolaget LM Ericsson*, 943 F.3d 1360
- U.S. District Court for the Northern District of Illinois [2013]: *In re Innovatio IP Ventures, LLC Pat. Litig.*, No. 11 C 9308, 2013 WL 5593609
- U.S. District Court for the Western District of Washington [2012]: *Microsoft Corp. v. Motorola, Inc.*, 871 F. Supp. 2d 1089

Turning to the court's role in promoting party settlement in global patent disputes, the panelists explained the practices in their courts, illustrating a variety of approaches. In one jurisdiction, the court has traditionally served as a mediator and thereby actively promoted party settlement in IP infringement cases. For example, in a SEP dispute, courts in that jurisdiction might propose the appropriate FRAND rates for the global license agreement. Court-facilitated settlements were viewed as providing a final and flexible solution that was based on the parties' trust in courts. Other jurisdictions had different national approaches. Generally the practice of court settlement was recognized in certain types of disputes, potentially including patent infringement cases, but in some courts it was not deemed appropriate for complex FRAND disputes. The panelists noted the possibility of arbitration, while acknowledging that parties may have reservations to binding themselves to arbitration outcomes.

In relation to parallel proceedings, the session focused on the rise of anti-suit injunctions in SEP disputes. These are orders by one court which prevent a party from commencing or continuing a parallel proceeding in another jurisdiction. They have led to "anti-anti-suit injunctions", whereby one court prevents a party from seeking an anti-suit injunction in another jurisdiction. One panelist viewed anti-suit injunctions as interference and anti-anti-suit injunctions as a defense to such interference. It was noted that, within the European Union, the Court of Justice of the European Union has held that issuing an anti-suit injunction within the EU runs counter to the principle of mutual trust between the courts of EU Member States. While there was no similar framework at a global level, the panelist expressed the hope for courts in one country to have trust in the courts of other countries in deciding SEP disputes, unless there were reasons to believe that the other courts would not deal with the disputed issues in an appropriate manner. While noting that anti-suit injunctions might be justified in certain types of cases through a careful review of multifactorial tests, it was generally thought that anti-suit injunctions should be the exception and that the courts should exercise their authority to grant them very cautiously.

Finally, the session considered the factors that drive parties' selection of forum. These included the size of the market covered by the court's jurisdiction; the typical cost and duration of litigation; access to justice for small businesses; the existence of a specialized judiciary; the availability of court-facilitated settlement; the nature of the litigated issue; and the availability of preliminary injunctions.

