

# ADJUDICATING INTELLECTUAL PROPERTY DISPUTES

**An ICC report on specialised IP  
jurisdictions worldwide**

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## Preface

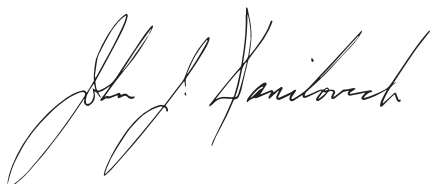
ICC has always been a strong believer in the importance of intellectual property for supporting innovation, cross-border trade, and economic development. The growing number of businesses and other entities around the world which are actively using the intellectual property system to develop their activities, increase their competitive edge, collaborate with partners and obtain financing, only confirms this belief.

With the resulting increase in the number of IP rights granted and IP-related transactions, the number of disputes related to intellectual property is set to grow. Both users and holders of IP rights need well-functioning and efficient mechanisms to resolve these disputes, which are growing both in number and technical complexity.

ICC welcomes initiatives to improve such IP-related dispute settlement mechanisms, which it sees as an essential part of efficient and effective systems to protect intellectual assets.

In view of the increasing number of countries that have created or are creating specialised jurisdictions to deal with intellectual property disputes, ICC's Commission on Intellectual Property has prepared the present report which describes how these specialised IP jurisdictions work from the perspective of businesses and practitioners.

We hope that this report will help both businesses and governments to better understand this development, and make a useful contribution to the pool of knowledge that countries can draw upon when considering how to establish or improve their systems for resolving IP disputes.



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## A Introduction

### Background

Along with the rapid progress of the global innovative economy, the importance of intellectual property rights to businesses has grown and the number of intellectual property (IP) applications and registrations has been increasing dramatically each year. In 2014, patent applications worldwide grew by 4.5% to around 2.7 million, and trademark applications rose to around 7.44 million, with a growth of 6% (compared to 2013)<sup>1</sup>. Concurrently, more filings of IP rights in recent years have also resulted in more disputes related to IP. In China alone, the number of new first instance IP-related lawsuits in 2014 came to 116,528, marking a 15.6% increase over the previous year<sup>2</sup>. More IP-related lawsuits have not only raised public awareness of the importance of IP enforcement, but have also led to increased reflection concerning the efficiency, impartiality and predictability of court trials for IP disputes.

These developments have led some countries to establish—or to consider establishing—specialised IP jurisdictions (SIPJs) for resolving IP-related disputes. Although created in the context of diverse legal, economic, cultural and historical frameworks, SIPJs have often been established in different countries for similar reasons—to increase judicial specialisation in IP-related issues, promote consistency and predictability in trials and case outcomes, and reduce the risk of judicial error—even if with local nuances.

However, the form that SIPJs take and the scope of their competence can vary widely from country to country. Some are empowered to try both administrative and civil IP disputes, such as China, Japan and Russia, while others may be purely civil or administrative. Some are established as separate judiciary institutions, totally independent of civil and administrative courts, and others are structured as a chamber or tribunal within a civil or commercial court. The modes of trial practiced by SIPJs also differ to some extent.

### Aims and object of the report

ICC has prepared the present study to assist countries in their consideration of whether, and how, to establish or improve SIPJs so as to enhance overall efficiency and expertise in IP-related trials. The report provides an overview of the structures and trial procedures of SIPJs in various jurisdictions around the world, with a view to contributing to a better understanding of the current landscape of SIPJs and the way they function. It is intended to build on and complement work already done by the International Bar Association, and by the US Patent and Trademark Office and

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1 WIPO Statistics Database, at [http://www.wipo.int/edocs/pubdocs/en/wipo\\_pub\\_941\\_2015.pdf](http://www.wipo.int/edocs/pubdocs/en/wipo_pub_941_2015.pdf)

2 [http://www.sipo.gov.cn/mtjj/2015/201504/t20150422\\_1105571.html](http://www.sipo.gov.cn/mtjj/2015/201504/t20150422_1105571.html) (Chinese).

the International Intellectual Property Institute in this area by exploring more specific issues related to the functioning of SIPJs.<sup>3</sup>

For the purposes of this report, a specialised IP jurisdiction may be broadly defined as a tribunal or court, or a permanent division or a chamber within a civil or commercial court or administrative body, having exclusive authority to hear IP disputes or a particular kind of IP dispute. The report focuses on contentious proceedings relating to IP infringements and the invalidation of registered IPRs; it does not deal with proceedings relating to the registration of IPRs or tribunals focused on the valuation of remunerative IPRs, such as copyright royalty tribunals.

## Methodology

The present report is based on a survey of ICC members which aimed to obtain first-hand information from parties and practitioners on the litigation mechanisms in their countries for trying IP disputes. The respondents are all attorneys or IP practitioners with hands-on litigation experience and expertise in IP. Altogether, information was obtained from a diverse group of 24 countries from Europe, Asia, and North, Central and South America.<sup>4</sup> The survey was designed to first determine if a country had an SIPJ and, if so, to collect information on various SIPJ-related issues, from the rationale behind the establishment of SIPJs to their structures and the specifics of the trial process. Among the issues surveyed, particular attention was paid to the standing and qualification of representatives of parties in the SIPJs and the selection of judges for SIPJs. The survey was designed to obtain information as comprehensive and detailed as possible to serve as a good foundation for a readable and useful report.

The report was prepared based on an analysis of the information from the survey, complemented by additional points from the contributors to the project. It was also reviewed by the ICC Commission on Intellectual Property and the wider ICC membership.

In order to assist countries in their reflection on whether or how to establish or improve SIPJs, the report does not limit itself to presenting a snapshot of the status of SIPJs in the countries surveyed, but also includes commentary and some conclusions.

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<sup>3</sup> See the IPI and USPTO “Study on Specialized Intellectual Property Courts” (2012) at <http://iipi.org/2012/05/study-on-specialized-intellectual-property-courts-published/> and the International Bar Association’s “International Survey Of Specialised Intellectual Property Courts And Tribunals” (2007) at [http://www.ibanet.org/LPD/IP\\_Comm\\_Tech\\_Section/IP\\_Entrtmnt\\_Law/Projects.aspx](http://www.ibanet.org/LPD/IP_Comm_Tech_Section/IP_Entrtmnt_Law/Projects.aspx)

<sup>4</sup> Albania, Belgium, Brazil, Chile, China, Costa Rica, France, Guatemala, Germany, Honduras, India, Ireland, Japan, Republic of Korea, Mexico, Peru, Portugal, Russia, Spain, Sweden, Switzerland, Thailand, United Kingdom, United States.



## B Different aspects of specialised IP jurisdictions

### 1 Existence and rationale for specialised IP jurisdictions

Among the 24 countries surveyed, 19 have SIPJs: Belgium, Brazil, Chile, China, France, Germany, India, Japan, the Republic of Korea, Mexico, Peru, Portugal, Russia, Spain, Sweden, Switzerland, Thailand, the United Kingdom and the United States. In these countries, SIPJs may bear different names even if they are established to fulfil essentially the same function and achieve the same goals.

To name a few examples, there are the IP High Court in Japan, the Federal Patent Court in Switzerland and in Germany, the Patent Court in the Republic of Korea, the Court for Intellectual Rights (IP Court) in Russia; the Intellectual Property Court(s) in China and Portugal, the Central Intellectual Property and International Trade Court in Thailand, the Specialised Chamber of IP Matters of the Federal Court for Tax and Administrative Affairs in Mexico, and the Specialised Court Chambers in France.

Among the primary motivations that respondents cited for the establishment of SIPJs, or for limiting the number of courts that may deal with IP disputes, were the desire to: develop IP expertise in specialised judges; unify court practice with respect to IP cases; improve the consistency of court judgments and the predictability of litigation outcomes, and; ultimately, enhance the effectiveness of the enforcement of IP rights. The creation of SIPJs is also believed by many to be a prerequisite for improvement of the overall climate of respect, protection and enforcement of IP rights in their respective countries.

#### *Box 1*

Prior to the inauguration of the Federal Patent Court in Switzerland, the courts in each of its 26 cantons/districts had jurisdiction for IP cases. By harmonizing the legal practice, the stability of legal decisions increased and the opportunities for “forum shopping” were minimised. The duration of proceedings was also shortened, resulting in more efficient proceedings. Similarly, with the recent creation of commercial courts and commercial divisions which can also hear IP cases in India, IP disputes are now given special treatment in the form of expert and efficient adjudication, and extremely speedy resolution of disputes. In Sweden, the key objective was to centralise and improve judicial expertise in IP matters to enable more predictable and high quality decisions. According to the legislation passed in 2014 by the National People’s Congress of China, which authorised the new IP courts, the purposes of setting up these specialised courts were “to promote and implement the national strategy of innovation-driven development, to further enhance the judicial protection of intellectual property, to safeguard, in practice and under the law, the lawful rights and interests of IP rights holders, and to defend social and public interests.”

The need for SIPJs is particularly evident in the area of patents, which require a high degree of expertise in science and engineering. This is reflected by the fact that SIPJs in several countries have exclusive jurisdiction only for patents, and not for other IP rights. This is true, for instance, of the US Court of Appeals for the Federal Circuit, the Patent Court of the Chancery Division of the High Court of England and Wales, and the Federal Patent Court in Switzerland.

The survey revealed that one or a small number of specialised courts or divisions usually satisfy the need for judges specialised in IP. SIPJs are usually established in the capital city and/or in the centres of highly industrialised regions, where the need for a specialised jurisdiction is naturally high. For instance, in Brazil, specialised IP chambers exist within the courts of São Paulo and Rio de Janeiro, whereas in the vast majority of Brazilian states there are no courts of this nature simply because there is no relevant demand. In many countries, SIPJs are in the same city as the national patent and trademark office.

Albania, Costa Rica, Guatemala, Honduras and Ireland do not have specialised IP jurisdictions. However, respondents from the first four countries expressed the view that there is a need for, and interest in, establishing SIPJs. In Albania, for example, it was reported that the current system provides different courts with jurisdiction over IP disputes with unclear and sometimes overlapping subject matter as the basis for determining jurisdiction. This creates confusion as to the correct forum, as well as inconsistencies in the practices of different courts in relation to the same or similar IP matter. Respondents from Costa Rica argued that an SIPJ would help reduce the organizational and administrative costs related to the resolution of IP-related cases and the length of proceedings. In contrast, there is no demand for SIPJs reported in Ireland, due to a low caseload of IP-related matters and general satisfaction with the way that the cases are dealt with by the Commercial Division of the High Court, where the most important IP cases are litigated.

## 2 Structure and competence of existing specialised courts/jurisdictions

### Judicial structures

The survey revealed various forms of structural organization of SIPJs—which sometimes coexist in the same country—in the jurisdictions studied.

- The majority of the surveyed countries opted for the **establishment of specialised chambers or divisions within existing civil or commercial courts** that hear IP cases exclusively or in addition to other disputes. Such is the case in Brazil, Belgium, China<sup>5</sup>, France, Germany, India, Japan, the Republic of Korea, Mexico, Peru, Spain, Sweden, Thailand<sup>6</sup>, and the UK.

This approach allows the use of the infrastructure of the existing judiciary and a reduction of organisational costs related to the creation of the SIPJs. In addition, as IP disputes are frequently related to entrepreneurial activities, strengthening IP expertise within commercial courts is often believed to provide business with better access to justice in IP matters as part of the whole process of commercial dispute resolution.

#### Box 2

##### Examples of specialised divisions

**Belgium:** Civil IP disputes are exclusively handled by one of the five court districts (Brussels, Ghent, Antwerp, Liège or Mons).

**China:** In addition to stand-alone IP courts, there is a system of IP divisions within the higher and intermediate courts of every major city; the constituent tribunals are organised based on the types of disputes.

**England and Wales** (which account for almost all IP cases in the UK): There is an SIPJ in the Chancery Division of the High Court of England and Wales.

**France:** IP matters are tried by the specialised chambers of nine regional courts, amongst which only the Paris Court is competent to hear patent cases. Misappropriation of know-how can also be tried before commercial courts.

**India:** Recent legislation has created commercial courts and commercial divisions dedicated to the adjudication of commercial disputes, including intellectual property disputes. These courts look into the issues of invalidity as well as infringement.

**Japan:** IP cases are heard by the IP High Court, established as a special branch of the Tokyo High Court in April 2005, and specialised civil IP divisions of the Tokyo and Osaka District Courts.

<sup>5</sup> China has two types of SIPJs: specialised IP courts and divisions specialised in IP matters.

<sup>6</sup> Thailand has two types of SIPJs: a stand-alone court of first instance (Central Intellectual Property and International Trade Court, which has exclusive jurisdiction over all IP-related disputes and also hears international trade cases) and in the second instance the Supreme Court, with a division specialised and responsible for IP-related matters.

**Republic of Korea:** Infringement disputes of certain IP rights are exclusively heard by one of the five court districts where the High Courts sit (Seoul Central District court, Daejeon, Daegu, Gwangju, and Busan). The Patent Court has centralised appellate jurisdiction over validity and infringement actions of certain IP matters.

**Sweden:** Questions regarding invalidation and infringement of patents are tried by the Stockholm District Court, which is also the proper court for cases regarding infringements of community designs, infringements of community trademarks and radio or television broadcasts in violation of the Act on Copyright in Literary and Artistic Works. Other cases regarding invalidation or infringements of IP rights are handled by the general courts.<sup>7</sup>

- Some countries have **separate stand-alone courts specialised in IP cases**, such as Chile, China<sup>8</sup>, Germany, Portugal, Russia, Switzerland, Thailand<sup>9</sup> and the US<sup>10</sup>.

This approach is usually adopted for the resolution of patent disputes (mostly related to patent validity), because such cases require specialised technical expertise (e.g. Germany, Switzerland), but some countries have referred all IP matters to the SIPJ (China, Portugal, Russia, and Thailand).

- Many countries also have **administrative agencies dealing with IP cases** through administrative procedures and have appellate boards reviewing invalidation actions.

India, for example, has administrative bodies within the executive authority which handle invalidation cases, whereas all civil and criminal IP cases are heard by the non-specialised courts. In Mexico, IP matters such as invalidation actions and infringement actions are resolved before administrative bodies (the Mexican Institute of Industrial Property and the Mexican National Institute of Copyright), while the appeals from the administrative decisions issued by these authorities are decided by the Specialised Chamber of IP Matters of the Federal Court for Tax and Administrative Affairs. In Sweden, most cases are tried by the Stockholm District Court or general courts, but questions regarding invalidation of trademarks may be tried within an administrative procedure.

7 A government bill proposing a change in court jurisdiction for IP cases was brought forward in 2015, saying that all cases regarding IP rights should be tried in a special court, the Patents and Market Court, and its verdicts should be appealed to the Svea Court of Appeal.

8 China has two types of SIPJs: specialised IP courts and divisions specialised in IP matters.

9 Thailand has two types of SIPJs: a stand-alone court of first instance (Central Intellectual Property and International Trade Court, which has exclusive jurisdiction over all IP-related disputes and also hears international trade cases) and in the second instance the Supreme Court, with a division specialised in and responsible for IP-related matters.

10 The US Court of Appeals for the Federal Circuit has exclusive jurisdiction over patent-related appeals and can also hear other IP disputes, in addition to certain categories of non IP-related disputes.

## Competence of SIPJs

SIPJs vary with regard to the kind of IP rights or the types of cases which fall within their exclusive competence.

For example, the Federal Patent Court in Switzerland only hears patent cases, while the IP Appellate Board in India is in charge of invalidation actions and appeals against decisions of the Patent Controller and Trademark Office, but does not hear IP infringement cases. In Sweden, proceedings concerning the validity of an already registered patent, trademark or design are brought before the General Courts, or the District Court of Stockholm with respect to patents.

In Mexico, the Mexican Institute of Industrial Property can hear most IP matters, though some other IP-related cases, such as a breach of a licence agreement or recovery of damages after a definitive finding of infringement by the Institute, can be heard by civil courts. In the UK, all IP actions in England and Wales involving registered designs and patents are heard by the Patents Court, which is a subdivision of the Chancery Division, or by the Intellectual Property Enterprise Court (IPEC), which is a specialised list within the Chancery division. Other types of IP disputes are mostly heard within the wider Chancery Division, where judges with experience of hearing such cases (including the judges of the Patents Court) sit.

In the United States, federal district courts have exclusive jurisdiction to conduct trials in copyright and patent infringement cases and the US Court of Appeals for the Federal Circuit has exclusive jurisdiction over appeals in patent matters, subject to Supreme Court review. Although neither federal nor state courts have specialised divisions that handle IP matters exclusively, both the federal district courts and state courts of general jurisdiction have authority to hear trademark infringement and trade secret misappropriation claims. Generally, state courts also have authority (along with the federal courts) to hear certain cases (frequently contractual in nature) involving copyrights and patents, for example, whether a copyright licensee has breached a licence agreement.

In the Republic of Korea, the five district courts have exclusive jurisdiction to hear infringement disputes as the first instance involving patent, trademark, utility model, design and plant variety protections. The Seoul Central District Court may hear any infringement dispute of first instance, even if one of the other district courts has relevant jurisdiction over the disputes. Disputes involving copyright infringement or the misappropriation of trade secrets are heard by the district courts having general jurisdiction over the matters. On the other hand, validation cases must be filed with the Korean Intellectual Property Tribunal (KIPT), an administrative tribunal within the Korean Intellectual Property Office. Appeals from the KIPT and the District Courts must be filed before the Patent Court.

In Japan, the IP High Court, a special branch of the Tokyo High Court, has exclusive jurisdiction, as the court of first instance, over suits against the Japan Patent Office, and as the court of second instance over civil cases relating to IP matters (patent

rights, utility model rights, rights to layout-designs of integrated circuits, and rights of the authors of a computer programme). The Tokyo and Osaka District Courts have specialised civil IP divisions hearing cases from the eastern and western parts of Japan respectively.

In some countries, the distinction is made between administrative (invalidation) and civil (infringement) IP matters. Germany traditionally adheres to this principle of “bifurcation” in some IP matters, particularly in patent cases, which means that infringement and invalidation in Germany are handled by different legal entities. Patent invalidation cases as well as appeal cases against decisions of the German Patent and Trademark Office (in patent, utility model, trademark and design cases) and against decisions of the Federal Plant Variety Office are tried by a specialised IP court, i.e. the Federal Patent Court. IP infringement cases at first instance are dealt with by designated intermediate civil courts (regional courts, *Landgerichte*), and at second instance by higher intermediate courts (higher regional courts, *Oberlandesgerichte*). China also has a bifurcated system, in which disputes relating to the validity of IP rights are initiated before administrative bodies. In Russia, the IP Court hears infringement cases as the court of third instance (second-level appeal), while acting as the court of first and second instance (first-level appeal) for administrative decisions of the patent and trademark office (*Rospatent*).

In many other countries, courts which hear infringement disputes also have competence to hear challenges to the validity of the right. For example, in the UK, a challenge to the validity of a patent may be brought in the Chancery Division of the High Court of England and Wales (in the Patents Court or in the IPEC) irrespective of whether infringement proceedings are in existence or contemplated. Where the dispute involves both the alleged infringement and the validity of a right, the issues are almost always heard by the court together. In Mexico, the Mexican Institute of Industrial Property can hear both invalidation and infringement actions in patent and trademark cases, as well as cases of commercial infringement of copyrights. In France, the same courts handle disputes regarding infringement and the validity of IP rights, in many cases raised as a defence by the defendant in an IP litigation procedure.

In some jurisdictions, there is a monetary value threshold for a dispute to be attributed to the competence of certain courts. In the UK, the IPEC deals with smaller and less complex cases than the Patents Court. The IPEC has a multi-track and a small claims track which have limits on damages of up to £500,000 and £50,000 respectively. Litigation in the IPEC is also subject to caps on recoverable costs. In Belgium, copyright infringement cases are heard by one of the five district courts with exclusive competence in IP matters provided that the claimed value is not below €1,860.

### Appellate structure

In different countries, SIPJs hear cases as either courts of first instance, appeal or last resort, with ultimate authority often vested in a higher court or even the Supreme Court (non-specialised). In Russia, first instance decisions of the IP Court are rendered by a panel of three judges, effective immediately, and may not be appealed (but may be reviewed by the Presidium of the IP Court). In Germany, appeal against the first instance decisions of the Federal Patent Court in patent invalidation cases and, under certain circumstances, against decisions of the Federal Patent Court in appeal cases (i.e. against second instance decisions of the Federal Patent Court) is available in the Federal Court of Justice (*Bundesgerichtshof*). In Switzerland, in patent cases from the Federal Patent Court, appeal is available to the Federal Supreme Court, while in other IP cases it is available to general appeal courts. Administrative proceedings related to the registration of trademarks may be appealed to the Swiss Administrative Court and subsequently to the Swiss Federal Court.

In some countries, as in France, administrative decisions of the national patent and trademark office on registration of applications can be directly challenged before the court of appeal. This is also the case in the US, where appeals from rulings from the administrative tribunals of the Patent and Trademark Offices (which determine questions of registrability) proceed in the Court of Appeals for the Federal Circuit for patents, or in the federal district courts with further appeals to the regional Court of Appeals for trademarks. In India, appeals against the first instance decisions of the Patents and Trademarks Office are heard by the Intellectual Property Appellate Board. An appeal from the decision of this body is then heard before the appropriate High Court of competent jurisdiction. In Mexico, appeals from first instance decisions by the Mexican Institute of Industrial Property are heard by the Specialised Chamber of IP Matters of the Federal Court for Tax and Administrative Affairs, and the third and final instance is before a non-specialised court.

### 3 Judges, juries and experts

Adjudication and enforcement of IP rights—especially when patents are concerned—often require specific technical expertise, and the creation of SIPJs gives judges the opportunity to deal exclusively or mainly with IP matters and, consequently, to develop expert knowledge.

#### Types of judges

For the purpose of this report, a distinction is made between the following three types of judges that may be members of the competent tribunal of an SIPJ:

- The term “**legally qualified judge**” encompasses members of the competent tribunal who have an appropriate legal qualification, e.g. a university degree in law or a comparable qualification. In some jurisdictions, a law graduate may progress to being a legally qualified judge at a fairly early stage in their career, as a career path. In other jurisdictions judges are appointed only from amongst the most senior and capable advocates in their field (i.e. intellectual property).
- The term “**technically qualified judge**” encompasses members of the competent tribunal who, in addition to an appropriate legal qualification, are also obliged to have a technical qualification, e.g. a university degree in a specific technical field or comparable qualification.
- The term “**lay judge**” encompasses members of the competent tribunal who do not have to have a legal qualification but are citizens appointed to the tribunal through a specific appointment process.

#### Composition of boards and juries

The composition of the boards of SIPJs with regard to the type of judges varies not only among the surveyed countries, but also among the different instances within the respective countries, as follows:

- All surveyed countries that have established SIPJs rely on legally qualified judges as at least a part of the members of the competent tribunal.
- Among the surveyed countries with SIPJs, only China, Germany, India, Sweden, Switzerland and the US rely on technically qualified judges as members of the competent tribunal in all or some of its SIPJs.
- Among the surveyed countries with SIPJs, only Belgium, China and Thailand can rely on lay judges as members of the competent tribunal in first instance cases before its SIPJs. In commercial cases, the Belgian commercial court relies on the expertise of consular lay judges with business expertise to assist the legally qualified judge, who acts as the court’s president. China has so-called “people’s assessors” appointed to the board by the local People’s Congress, and Thailand relies on the appointment of persons with specific expertise in IP or international trade.



None of the surveyed countries with SIPJs, other than the US, rely on juries in the decision-making process before their SIPJs. In the US, IP cases for monetary damages must be brought in a court of competent jurisdiction where the parties can elect to have any factual disputes determined by a jury. Legal questions and equitable relief, however, can only be decided by legally qualified judges who need not be technically qualified.

In some countries with highly developed SIPJs, cases are tried by panels of judges, often comprising technical judges. In Germany, the composition of the panels differs according to the type of case. For instance, patent invalidation cases are tried by three technical judges and two legal judges, appeals against the rejection of a patent application are handled by three technical judges and a legal judge, and appeals against the rejection of a trademark are tried by three legal judges. In Switzerland, the judges are assigned to the court cases to form chambers of three judges, at least one being a technical and one being a legal judge.

In countries with a common-law tradition, such as the UK and the US, IP cases are usually heard at first instance by a single legally qualified judge. In the UK, this judge is someone who has previously been a senior advocate in her or his field, and is assisted by evidence provided by experts in the relevant field (discussed further below). Those experts usually appear before the court as expert witnesses, not as members of the judicial bench. In appeal courts, appeals tend to be heard by a panel of judges.

### **Technical experts**

A technical expert has a different capacity to a technically qualified judge because a technical expert is not a member of the decision-making panel hearing the dispute.

In most surveyed countries with SIPJs, in particular the ones relying exclusively on legally qualified judges, the competent tribunal may rely on the support of technical experts, if needed.

In India, especially in patent disputes, the legislation itself mandates the appointment of scientific advisors in any proceeding for infringement or other related proceedings before the court. These advisors are mandated to inquire and report on questions of fact and to render their opinion to the court, but are prohibited from giving their opinion on their interpretation of the law.

In the US, the federal courts are authorised to appoint a “special master” to assist the court, but typically, the courts will be satisfied to rely on the opinions and evidence submitted by technical experts retained by the parties to the case.

In certain countries, it is usual that a technical expert is not appointed by the court but that, particularly in patent cases, parties may submit evidence from an appropriate technical expert of their choosing.

Such is the case in France, India, and the UK. In the UK, the duty of each party's expert(s) is to assist the court (i.e. the legally qualified judge) in understanding the background technology and the technical matters at issue; it is the legally qualified judge who then makes the necessary findings of fact and legal rulings in relation to such issues. In such countries there is often a tradition of cross-examination, which assists the court in scrutinising the expert evidence submitted and in deciding technical disputes. Occasionally, the court also appoints a technical expert to assist the judge with understanding more complex technology.

In Mexico, in patent invalidation or infringement cases, each party can appoint a technical expert, and if the opinions of experts are inconsistent, the administrative body or court appoints a third expert, whose opinion will be the one taken into account by the judge or authority when deciding the case. In the Republic of Korea, a technical expert must be appointed by the court in principle—but in practice the court usually appoints the expert designated in the parties' application for the expert opinion. The court may also seek expert opinions from a government or public office, an educational or other institution, or a foreign government or public office where deemed necessary. Experts may state their opinion either orally or in writing (the courts usually have experts submit written opinions). In Sweden, too, both the court and the parties are able to appoint experts in cases where expert knowledge is required. In most of the surveyed countries, an individual of proven technical background and expertise in the specific technical field can be appointed as a technical expert. In some of the surveyed countries, the same applies to legal entities. Few of the surveyed countries require official recognition for persons or entities that can be appointed by the competent board as an expert. One example is China, where the Beijing High People's Court publishes a list of judicial appraisal institutions admitted to assist courts of Beijing with technical expertise in IP disputes involving high technology<sup>11</sup>.

In most countries, irrespective of the appointment of technical experts by the competent board, parties in a dispute are allowed to submit expert evidence provided by technical experts appointed by the respective parties.

The involvement of technical experts and/or technically qualified judges is generally provided for in cases where technical aspects may play an important role in the decision; this is typically the case for patent-related disputes. As a logical consequence, the involvement of technical experts and technically qualified judges is mostly limited to instances dealing with facts, i.e., usually at first instance. When higher instances only deal with legal revision issues, technically qualified judges are normally no longer involved. Similarly, in countries with a common-law tradition, technical evidence is usually limited to the first instance.

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<sup>11</sup> See, e.g., 12 IP-related entities listed by the Beijing High People's Court as "Admitted Social Intermediary Institutions": <http://www.bjcourt.gov.cn/mcxx/detail.htm?channel=100012005> (Chinese).

The primary motivation for having technically qualified judges is to avoid the need for court-appointed technical experts during the procedure, in order to keep the duration and costs of the procedure within foreseeable limits. On the other hand, technical experts (and expert witnesses) usually need not have a legal qualification, which broadens the choice of individuals who may fulfil the role. This is the case, for example, in India and in Mexico. This can be of assistance for more complex areas of technology, where leading experts in the field in question may be able to support the court.

## 4 Procedures, doctrines and rules of evidence

### Types of procedures

The types of non-criminal procedures for IP cases among the countries surveyed can be roughly divided into three groups: procedures before general civil or commercial courts, before stand-alone IP courts (i.e. courts that only handle IP-related cases), and before administrative bodies (see also above: section B.2 *Structure and competence of existing specialised courts/jurisdictions*):

- In the majority of the surveyed countries, civil or commercial courts handle IP litigation cases according to general court procedure, with certain specifics codified in the relevant procedural and/or IP law. Many of these countries have established, within existing civil or commercial courts, specialised chambers or divisions that hear IP cases exclusively or in addition to other disputes.
- In some of the surveyed countries with stand-alone IP courts, such as Switzerland, these courts handle IP litigation, and sometimes also disputes relating to the validity of IP rights, in a similar manner with respect to procedure.
- In some of the surveyed countries, such as Chile, China, India, Mexico and Sweden, IP litigation cases are also handled, partly or exclusively, before administrative bodies according to specific administrative rules codified in the relevant administrative and IP laws.

### Preliminary measures

All of the surveyed countries with SIPJs allow for preliminary injunctions as expedited proceedings in IP-related cases. The vast majority of the surveyed countries provide for ex-parte preliminary injunctions, the rationale being that any notice to the defendant of such an impending injunction involves the risk of destruction of evidence by the defendant. Japan and the Republic of Korea exclusively provide for inter-partes preliminary injunctions, on the basis that an ex-parte preliminary injunction also carries the risk of irreparable harm to the defendant.

By and large, the survey showed that these expedited proceedings are governed by the following basic principles:

- Preliminary injunctions are granted in cases where delayed action would be likely to cause irreparable harm to the claimant.
- The issuance of ex-parte preliminary injunctions follows strict rules and is an exception rather than the rule in most surveyed countries, in view of the risks on both sides.
- Where preliminary injunctions are granted, their enforcement is typically subject to the deposit of a security, usually set by the issuing court. The security is intended to cover potential damage to the defendant in case the injunction is later found to be unjustified.

- Defendants can oppose preliminary injunctions. In the event of such an opposition, the preliminary injunction is typically conditioned on the initiation of inter-partes court proceedings within certain short time limits.

In some countries, such as Belgium and Germany, so-called protective letters may be submitted to one or more potentially competent courts to prevent the grant of an ex-parte preliminary injunction. Under this procedure, a potential defendant fearing the request for an ex-parte preliminary injunction by a potential claimant, files arguments with the respective court as to why such an ex-parte preliminary injunction should not be granted. In such a case, the court will typically not issue an injunction without hearing both parties. In Mexico, the defendant can file a counter-bond which will stop the effects of the preliminary injunction.

In certain countries, such as India and the UK, the usual preliminary injunction procedure is a mini-procedure which takes place within the context of the main litigation.

Courts in the US provide for temporary restraining orders, which may be granted ex-parte only on a showing of exceptional need pending an expedited hearing with notice to all parties, and preliminary injunctions, which require prior notice to all parties.

### Doctrines and principles applied

Most of the studied countries apply similar doctrines in IP-related court proceedings.

- In patent infringement cases, most countries apply the so-called **doctrine of equivalents**, generally meaning that a party can be held liable for patent infringement even if the potentially infringing product or process does not literally realise all the elements of a claim of the patent but contains one or more replacing elements considered equivalent to the respective replaced element of the claim. In some countries (including the UK) the “purposive” approach to construction achieves a broadly similar result. In trademark cases, most surveyed countries apply the so-called doctrine of **likelihood of confusion** of the colliding marks, which is based on generally similar considerations expanding the scope of protection beyond mere identity. The scope of protection is expanded even further in most of the surveyed countries applying the doctrines of **well-known or famous marks**.
- In most of the studied countries, the doctrine of **exhaustion** of rights is applied. This means that once the rights owner has received proper remuneration for an act of use of his right, he cannot require further remuneration for legitimate acts deriving from this specific act of use (such as re-selling a legitimately acquired product). The doctrine of **forfeiture** of rights is also applied in most of the surveyed countries, and is based on specific improper behaviour of the rights owner.
- In all of the surveyed countries, the doctrine of **prior use rights** is applied, meaning that a registered right cannot be enforced against someone who has legitimately and in good faith used the object of the registered right prior to the right’s owner’s application for the registered right. The doctrine of **intermediate rights**—where the

registered right cannot be enforced against someone who has legitimately and in good faith used the object of the registered right during a period when the right had temporarily expired—is similarly applied.

- Some countries, such as Brazil, China, India, Japan, Mexico, Peru, and in rare cases France, apply the doctrine of **file wrapper estoppel**, meaning that statements made by the rights owner during the procedure for grant of the right may limit the scope of protection of the registered right.
- All of the studied countries apply the **first-to-file** doctrine in disputes relating to the ownership of rights or relating to conflicting rights, meaning that the one who has filed the earliest application in good faith is the legitimate owner of the right. The US switched from a “first-to-invent” system to a “first-to-file” system for patent applications filed on or after 16 March 2014. While in the US trademark rights are created by use, not registration, registration—especially at the federal level—confers significant benefits, including establishing a priority date from the date of filing. In Chile, although trademark rights are created by registration, any previous user of the same trademark will prevail in a dispute.

### Evidence

The survey also revealed that, in the countries surveyed, similar principles are applied to the provision of evidence in IP-related court proceedings:

- All countries surveyed appear to apply—both in civil courts as well as in SIPJs—principles regarding the provision of evidence similar to those in civil cases.
- All countries surveyed apply the principle that each party has the **burden of proof**—i.e. has to produce the evidence—for the facts that are in its favour. However, many of the surveyed countries also apply a reversal of the burden of proof in specific cases. This reversal of the burden of proof typically applies in cases where only the other party is in a position to provide positive evidence to disprove the first party’s contention.
- In most of the countries surveyed, similar **types of evidence** may be submitted, such as documentary evidence, statements of the parties, statements of witnesses, expert statements, court inspection, etc.
- In countries with a common-law tradition, including India and the UK, **oral testimony** is the standard manner of adducing evidence, although written evidence-in-chief is employed to streamline the procedure. Cross-examination is used to test the evidence given, for both witnesses of fact and expert witnesses. This commonly impacts the weight attached to evidence given by each individual in any particular case: evidence given by an individual related to a party may prove persuasive after standing up to scrutiny; on the other hand, evidence may be given little weight by the court if it fails to stand up to scrutiny.

- In many of the countries surveyed, the plaintiff in an IP-related case has a claim to **information, discovery, inspection or seizure of evidence**, which may be dependent upon the claim meeting a minimum threshold of strength or the probability of infringement being sufficiently high. This follows the rationale that, in some cases, positive evidence can only be obtained from the defendant. In many cases, the legitimate interest of the defendant to secrecy is protected by having, inter alia, a neutral person or bailiff collecting the evidence, as is the case in France. In some countries, such as India, Mexico and the UK, the court may limit access to disclosed confidential information in appropriate cases, for example to key individuals and/or key members of a legal team, by making orders maintaining confidence in documents referred to in court hearings and by restricting confidential information to judgment annexes over which confidentiality is maintained. India follows a unique practice for recording evidence, in the form of appointing a local commissioner, who is usually a retired judge. The appointment of a neutral, former member of the judiciary ensures that the trial in such matters is concluded in a very speedy and efficient manner.
- Most of the surveyed countries seem to acknowledge that absolute certainty may rarely be obtained. Hence, the competent bodies typically apply two basic principles to determine the **standard of proof**. The balance of probabilities principle is the least strict, and holds that something is considered proven if it is more likely to be true than not. This is the usual test in civil cases. The stricter standard is the beyond reasonable doubt principle, meaning that something is considered proven if the judge is sure, without being certain, of its veracity. This is the more usual test in criminal cases. Most IP disputes are civil in nature—for example, patent infringement, which is rarely brought before criminal courts, and most trademark infringement cases—though monetary compensation awarded may be punitive in some jurisdictions (e.g. in the US, and in cases under the EU IP Enforcement Directive). However, some types of infringements of IP rights are more commonly criminal in nature, such as counterfeiting and some breaches of copyright.

The survey has revealed that, despite considerable differences in the actual process and course of IP-related non-criminal court procedures, there seems to be a wide consensus among the surveyed countries on the basic principles applied in such procedures.

## 5 Representation

The term “representation” in this report falls within the general concept of a person or entity acting on behalf of another before an authority (e.g. judicial institutions including judicial courts and administrative tribunals, etc.). In the context of this report, it refers particularly to representatives of parties in IP-related lawsuits, whether relating to the infringement or invalidation of IP rights.

The discussion in this section refers only to representation before SIPJs.

### Representation before SIPJs

The individuals or entities authorised to represent parties before SIPJs in the countries surveyed can be classified into three categories:

- i. Attorneys-at-law (in some countries ‘attorneys’ may include independent counsel who are specialists in oral advocacy, for example in the UK);
- ii. Qualified IP practitioners (e.g. patent attorneys/agents, trademark attorneys/agents, etc.) who are not qualified attorneys;
- iii. Any individual or entity who is neither an attorney-at-law nor an IP practitioner (e.g. corporate in-house counsel or staff members, social organizations and individual citizens).<sup>12</sup>

While some countries allow only one category of representatives (usually attorneys-at-law) to represent parties, other countries allow simultaneous representation by individuals or entities in more than one category in the same case.

Some countries, including Chile, France, Portugal and Spain, have more traditional representation rules which provide that only attorneys-at-law are entitled to represent clients before SIPJs.

In Germany, Japan, the Republic of Korea, and Switzerland, parties in all IP-related lawsuits may be represented by attorneys-at-law, and parties in administrative proceedings (such as for the invalidation/revocation of IP rights) may be represented by attorneys-at-law and/or IP practitioners. In the UK, representation by IP practitioners may occur in the IPEC but not in the Patents Court or in the wider Chancery Division without additional qualification.

Among the countries studied, China, Russia, Mexico, Peru and Sweden are similar in authorising all types of representatives to act for clients before SIPJs.<sup>13</sup> China, however, further stands out by limiting representation by individuals or organisations

<sup>12</sup> Excluding the litigating party him/herself.

<sup>13</sup> As for Sweden, in non-criminal proceedings the Code of Judicial Procedure states that any natural person who, due to probity, knowledge and previous work, is found fit for the assignment by the court, may represent a party in court proceedings.



which are neither attorneys-at-law nor IP practitioners admitted by the Chinese courts, to those with an interest in the case being tried. In contrast, Russia and Peru permit representation in administrative courts by anyone, without any qualification requirement.

### Further findings

Although individual countries differ in their legal history, theory, culture and practice of law—which partly explains how the forms of representation before tribunals vary—some general features of representation before SIPJs can be extracted from an analysis of the information obtained:

i. **Attorneys-at-law play an essential role in representation before SIPJs**

Traditionally, attorneys-at-law have played a significant role in representing clients in legal actions in courts, as witnessed in nearly all the jurisdictions in the world. As SIPJs are, in essence, no different than any other jurisdictions, representation by attorneys-at-law has been understandably considered to be natural and appropriate. The fact that attorneys-at-law are still the main body of representatives before SIPJs indicates that the professional knowledge and hands-on experience of lawyers in legal proceedings still play a significant role in IP-related lawsuits and are likely to continue to do so.

ii. **IP practitioners and technical experts provide valuable assistance in representation before SIPJs**

Intellectual property litigation, particularly with respect to patents, presents sophisticated technical issues, which would tend towards the involvement of technical experts and/or IP practitioners before SIPJs. The results of the survey, as summarised above, show that most surveyed countries, including China, Germany, Japan and Switzerland, either authorise IP practitioners such as patent attorneys to represent parties before SIPJs, or allow them to appear in SIPJs as technical assistants to lawyers in lawsuits. Countries with a common-law tradition, such as India and the UK, commonly make extensive use of technical experts as expert witnesses in IP litigation, and IP practitioners have traditionally had less involvement in court litigation in those countries than in some other countries.

Legal representation with scientific and technological expert support before SIPJs stands out as the most prevalent type of representation in IP-related lawsuits.

iii. **Representation by any individual or entity, to supplement practical needs**

The summary above shows that only a few countries allow representation by individuals or entities who are neither attorneys nor IP practitioners in IP-related lawsuits. Viewed from the perspective of legal history, tradition, social system and ideology, there appear to be several rationales for this kind of representation. Firstly, it originates from the tradition and ideology of the civil law systems. Secondly, a concentration of IP specialists in only a few cities may give rise to a need for representation by a broader range of representatives who are neither attorneys nor IP practitioners in other parts of the country. Lastly, the countries allowing this

type of representation appear to have shorter histories of IP law which have not allowed them sufficient time to train enough lawyers and professional practitioners to represent clients in IP cases, hence the need to open up the category of authorised representatives.

The features highlighted and analysed above indicate that the type of representation authorised before SIPJs is influenced by a country's judicial system, legal tradition and ideology, and socio-economic context. Due to the differences among regions, countries and social systems, it is not possible to draw conclusions on the advantages and disadvantages of the different types of representation as each of these is developed and implemented in response to the need of a particular region, country, legal culture, history and social ideology. The type of representation that best meets the needs of the development of the local economy and social legal system, and enhances the efficiency and effectiveness of the IP law system, would be the most appropriate for any given country.

### **Challenges and prospects**

Although in some jurisdictions, such as India, the UK and the US, attorneys specialised in technology-related IP commonly have scientific training, many of the jurisdictions surveyed lack sufficient representatives for technical IP disputes who have both technical and legal expertise (i.e., professionals with both legal qualifications and the aptitude to understand the technology that is the subject of the dispute). The issue is prevalent in the countries studied and has led a few countries to provide that patent attorneys be entitled to represent clients in trials of administrative cases; some countries even allow patent attorneys to appear in civil infringement cases. In other countries, the involvement of technical experts enables the court (and the legal teams) to obtain the necessary technical understanding. Since, in many jurisdictions, general lawyers ordinarily have no background of science and technology, they require assistance from a technical expert or an IP practitioner in cases involving complex technologies; this raises the cost of litigation and increases the burden for both parties to an IP-related lawsuit.

With the increasing technical complexity of many IP cases, it is important to ensure that courts and representatives can attain the technical knowledge necessary for determining each dispute. This is achieved in different SIPJs in different ways, by involving technical experts, IP practitioners and/or technically qualified judges, according to the legal tradition of the country of the SIPJ.

## 6 Execution of judgments

This section on the execution of judgments refers to judgments rendered by SIPJs in administrative, commercial and civil jurisdictions.

According to the results of the survey, none of the surveyed countries with SIPJs has developed a particular execution mechanism or special measures or procedures for execution of judgments rendered by SIPJs, so that civil or administrative procedural laws are applied to the execution of judgments. Chile, China, France, Germany, India, Portugal, Spain and Switzerland specifically apply civil procedural laws to the execution of judgments of SIPJs, while Peru applies the administrative procedural code to the execution of judgments.

As for the execution of foreign judgments (i.e. judgments rendered by foreign courts, especially foreign SIPJ judgments), the countries with SIPJs ordinarily follow the normal routes of execution, i.e. execution under rules in bilateral or international treaties, or in accordance with reciprocity principles for the recognition of judicial acts. Some countries, like Germany, may enforce foreign judgments by generally requiring the prior acknowledgement of the foreign judgment or other type of decision by a German national court. China and India also allow execution of foreign judgments on a reciprocity basis in the event of the absence of bilateral or international treaties or conventions.

In summary, none of the countries surveyed have a special mechanism or measure for the execution of SIPJ judgments, which are enforced via ordinary civil procedures with no exception made for the execution of foreign judgments. The absence of specific mechanisms for the execution of SIPJ judgments is probably due to the fact that SIPJs are just one form of jurisdiction among others and it is simpler, more cost-effective and efficient to follow the usual execution procedures and route. In addition, SIPJ judgments and their execution have not presented particular issues that require independent and specific mechanisms and procedures.

## C Conclusions

The present study provides a snapshot of SIPJs and their structures and practices in a group of geographically and economically diverse countries. It shows that a significant number of countries around the world have established SIPJs that are very diverse. This diversity can especially be seen in their different structures and in their mechanisms in relation to the appointment of judges and experts and the representation of parties. The same basic principles are however applied across the different countries surveyed, e.g. in relation to expedited proceedings and legal doctrines.

Based on the information obtained, this study draws the following conclusions, which could assist countries in their consideration of whether, and how, to establish or improve SIPJs.

### ➤ **SIPJs can improve the efficiency and quality of IP-related litigation processes and outcomes**

A large majority of the countries surveyed for this study has established SIPJs in various forms, and the respondents from most of the countries that have not established them believe it would be desirable to do so.

Some of the specific reasons expressed by respondents in different countries as to why SIPJs are established include: “...to develop IP expertise in specialised judges, and unify standards of trials”<sup>14</sup>, “to develop IP expertise in specialised judges; and to streamline the jurisdiction of national courts over intellectual property matters with a view to simplifying proceedings”<sup>15</sup>, “to develop IP expertise in courts, and for parties’ convenience”<sup>16</sup> and “creation of subject matter experts/expertise; effectiveness of the decision; enhance efficiency and accuracy; consistency and predictability of case outcomes”<sup>17</sup>. All of these clearly indicate that SIPJs are seen to increase the effectiveness of enforcement of IPRs and are welcomed by practitioners and litigants in the surveyed countries.

The contribution of SIPJs to developing IP expertise in courts, unifying standards of trials, enhancing the efficiency and accuracy of trials and ensuring the predictability of case outcomes thus argues in favour of their establishment and maintenance.

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<sup>14</sup> Questionnaire response from China.

<sup>15</sup> Questionnaire response from France.

<sup>16</sup> Questionnaire response from Japan.

<sup>17</sup> Questionnaire response from Peru.

➤ **The need for and the most appropriate form of SIPJs depend on individual country needs and circumstances**

Despite the largely coincident reasons motivating different countries to establish SIPJs — as described above—the choice of form for SIPJs often varies according to the different national legal cultures, economic contexts and priorities. Where IP disputes are numerous and technically complicated, SIPJs may have a more elaborate structure and larger dedicated staff (e.g. a separate court with experienced judges). Where a country’s economic and legal environment suggests little demand for an SIPJ, it can be concluded that such a solution is not beneficial. Likewise, if civil or commercial courts are able to handle IP disputes effectively on their own, SIPJs may not be an urgent priority. The need for and design of SIPJs should emerge from actual social, economic and legal needs—as is the case in most countries.

China, for example, is a vast country with a huge number of IP-related disputes, requiring a large number of judges versed in IP. Nevertheless, the training of judges to meet this demand is a tremendous task; even if the judges are qualified for the job, different judges with distinct educational backgrounds and experience may have different views on similar legal or factual issues. Consequently, unifying IP trials, especially in respect of cases involving complex technological issues, was a fundamental consideration for establishing SIPJs in China. SIPJs could therefore be helpful for those countries with a large territory or population—and, therefore, usually with more courts—if they have sufficient IP disputes.

In short, if the aim of an SIPJ is to increase the efficiency and quality of IP-related dispute resolution, and thus to meet the needs of the national economy, it should only be established if it adequately serves these goals and should be designed in the most appropriate way to fulfil them.

➤ **Proper trial mechanisms and judicial expertise are essential**

Where there is a need for SIPJs, the overall mechanism of the SIPJ (i.e. the procedures and personnel arrangements) is very important for the way IP cases are decided. It is advisable that SIPJs be staffed with knowledgeable judges and, especially for patent cases, be structured so as to enable the court to understand the technical issues in dispute—which are often complex—whether by involving judges with a certain technical background, technical experts (as court or party appointed experts) and/or IP practitioners or other specialists. This was particularly highlighted by respondents to the survey.

The appropriate mechanism for any particular SIPJ will again be influenced by the judicial system, legal tradition and ideology, and socio-economic context.

Based upon the analysis of the survey results, ICC concludes on balance that SIPJs present an advantage in the current economic and legal environment worldwide in jurisdictions where there is a sufficient body of IP litigation and can, in many circumstances, enhance the efficiency of IP enforcement.

The structure and mechanisms of SIPJs should be designed in response to the specific context of the country, and with the aim of developing IP expertise in the judiciary, unifying trial standards and practices, enhancing efficiency in trials and ensuring the predictability and accuracy of case outcomes.

ICC recommends that countries should consider establishing and adopting some form of SIPJs, or improving existing SIPJs, according to their respective economic and legal situations, and hopes that the present study will assist in this reflection.

## Tables

### Competent jurisdictions for non-criminal IP cases

COUNTRY	Administrative body (e.g. patent and trademark office)		Stand-alone court specialised in IP cases		Specialised IP chamber/tribunal within a general court		General court (not specialised in IP)		Types of IPRs tried by SIPJs
	Invalidity	Infringement	Inv.	Inf.	Inv.	Inf.	Inv.	Inf.	
Belgium									
1st instance	x <sup>18</sup>				x	x			P - D - T - C - UC - PV - IO
2nd					x	x			
3rd					x	x			
Brazil									
1st	x <sup>19</sup>				x	x	x	x	P - D - T - UC - PV - TD - IO
2nd					x	x <sup>20</sup>	x	x	
3rd							x	x	
Chile									
1st	x							x	P - D - T - PV - IC - IO
2nd			x					x	
3rd							x	x	
China									
1st			x	x		x			P - D - T - C - UC - PV - IC
2nd				x	x	x			
3rd					x	x			
England and Wales									
1st					x	x			P - D - T - C - PV - IC - TD - IO <sup>21</sup>
2nd					x <sup>22</sup>	x <sup>23</sup>			
3rd					x <sup>24</sup>	x <sup>25</sup>			

18 D, T.

19 The Brazilian Patent and Trademark Office has an administrative nullity procedure for patents, trademarks and industrial design.

20 In the State Court of São Paulo.

21 There is no law of unfair competition in the UK, but the tort of passing off (which probably encompasses TD) and the IP threats provisions can provide legal basis for remedy in comparable situations. In this table the Patents Court, IPEC and the wider Chancery Division are all classified in the same way because they all act as specialised IP chambers, just in slightly different ways.

22 Specialist judges within appeal court panels.

23 *Idem.*

24 *Idem.*

25 *Idem.*

COUNTRY	Administrative body (e.g. patent and trademark office)		Stand-alone court specialised in IP cases		Specialised IP chamber/tribunal within a general court		General court (not specialised in IP)		Types of IPRs tried by SIPJs
	Invalidity	Infringement	Inv.	Inf.	Inv.	Inf.	Inv.	Inf.	
France									
1st					x	x			P - D - T - C - UC - PV - IC - TD - IO
2nd					x	x			
3rd					x	x			
Germany									
1st	x		x			x			P - D - T - C - UC - PV - IC - IO
2nd			x		x	x			
3rd					x	x			
India									
1st	x				x		x	x	P - D - T - C - PV - IC - TD - IO
2nd							x	x	
3rd							x	x	
Japan									
1st	x					x			P - D - T - C - UC - PV - IC - TD - IO
2nd			x	x					
3rd							x	x	
Republic of Korea									
1st	x					x <sup>26</sup>		x <sup>27</sup>	P - D - T - PV - utility model
2nd			x <sup>28</sup>	x <sup>29</sup>				x <sup>30</sup>	
3rd							x	x	

26 D, P, PV, T, utility model.

27 C, IC, IO, TD, UC.

28 D, P, PV, T, utility model.

29 D, P, PV, T, utility model.

30 C, IC, IO, TD, UC.



COUNTRY	Administrative body (e.g. patent and trademark office)		Stand-alone court specialised in IP cases		Specialised IP chamber/tribunal within a general court		General court (not specialised in IP)		Types of IPRs tried by SIPJs
	Invalidity	Infringement	Inv.	Inf.	Inv.	Inf.	Inv.	Inf.	
Mexico									
1st	x	x							P - D - T - C - UC - PV - IC - TD - IO
2nd					x	x			
3rd							x	x	
Peru									
1st	x	x							P - D - T - C - UC - PV - IC - TD - IO
2nd					x	x			
3rd							x	x	
Portugal									
1st	x <sup>31</sup>	x <sup>32</sup>	x	x					P - D - T - C - UC - PV - IC - TD - IO
2nd							x	x	
3rd							x	x	
Russia									
1st	x		33					x	P - D - T - C - UC - PV - IC - TD - IO
2nd			x					x	
3rd			x	x					
Spain									
1st	x				x	x			P - D - T - C - UC
2nd					x	x			
3rd							x	x	

31 The National Institute of Industrial Property (INPI) is an Autonomous Government Institution (administrative body), with legal personality as well as administrative and financial autonomy, and independent assets. During the registration process, there is a right to oppose the pursued application.

32 *Idem*.

33 Trademark non-use cases differ from the other invalidity cases in that the rights are recognized invalid not ab initio but from the date of the court decision. While the other invalidity cases are heard first by the trial arm of the patent and trademark office, i.e. are of administrative nature, trademark non-use cases are tried by the IP Court already in the first instance.

COUNTRY	Administrative body (e.g. patent and trademark office)		Stand-alone court specialised in IP cases		Specialised IP chamber/tribunal within a general court		General court (not specialised in IP)		Types of IPRs tried by SIPJs
	Invalidity	Infringement	Inv.	Inf.	Inv.	Inf.	Inv.	Inf.	
Sweden									
1st	✗ <sup>34</sup>				✗	✗	✗	✗	P - T - C
2nd							✗	✗	
3rd							✗	✗	
Switzerland									
1st	✗ <sup>35</sup>		✗ <sup>36</sup>	✗ <sup>37</sup>			✗ <sup>38</sup>	✗ <sup>39</sup>	Only P - T - C - UC considered
2nd							✗ <sup>40</sup>	✗ <sup>41</sup>	
3rd							✗ <sup>42</sup>	✗ <sup>43</sup>	
Thailand <sup>44</sup>									
1st			✗	✗					P - D - T - C - PV - IC - TD - IO
2nd					✗	✗			
3rd									
US <sup>45</sup>									
1st							✗	✗	P - D - T - C - UC - PV - IC - TD - IO
2nd			✗	✗			✗	✗	
3rd							✗	✗	

Key: P Patent; D Industrial Design; T Trademark; C Copyright; UC Unfair competition; PV New Varieties of Plant; IC Design of Integrated Circuits layout; TD Trade dress; IO Indication of origin

34 The invalidation of trademarks may be tried within an administrative procedure.

35 P, T.

36 P.

37 *Idem.*

38 C.

39 C, T, UC.

40 C, P, T.

41 C, P, T, UC.

42 C, T.

43 C, T, UC.

44 Thailand has two types of SIPJs: a stand-alone court of first instance (Central Intellectual Property and International Trade Court, which has exclusive jurisdiction over IP-related disputes and also hears international trade cases) and in the second instance the Supreme Court, with a division specialised and responsible for IP-related matters.

45 The US Court of Appeals for the Federal Circuit has exclusive jurisdiction over patent-related appeals and can also hear other IP disputes, in addition to certain categories of non IP-related disputes.

## Judges and experts in SIPJs

Country	Legally qualified judge	Technically qualified judge	Lay judge	Technical experts
Belgium	x		x	
Brazil	x			x
Chile	x			
China	x	x	x	x
England and Wales	x			x <sup>46</sup>
France	x			x
Germany	x	x		x
India	x	x		x
Japan	x			x
Republic of Korea	x			x
Mexico	x			x
Peru		x		
Portugal	x			x
Russia	x	x <sup>47</sup>		x
Spain	x			x
Sweden	x <sup>48</sup>	x <sup>49</sup>		x
Switzerland	x	x		
Thailand	x		x	x
US	x	x		x

46 Usually expert witnesses, occasionally court-appointed experts.

47 Not all.

48 In procedures regarding invalidation of patents and patent infringements the District Court shall consist of four members, among whom two shall be proficient in law and two shall have technological qualifications.

49 *Idem*.

**Preliminary measures applicable in SIPJs**

Country	Ex-parte preliminary injunctions	Inter-partes preliminary injunctions
Belgium	×	×
Brazil	×	×
Chile	×	×
China	×	
England and Wales	×	×
France	×	×
Germany	×	×
India	×	×
Japan		×
Republic of Korea		×
Mexico	×	
Peru	×	
Portugal	×	×
Russia	×	×
Spain	×	
Sweden	×	×
Switzerland	×	×
Thailand	×	
US	50	51

50 Injunctions are not granted by SIPJs in the US, but by courts of general jurisdiction, which only grant ex-parte injunctions rarely, and on the condition that an inter-partes hearing takes place shortly after.

51 *Idem.*

## Doctrines and principles in IP-related court proceedings

Country	Doctrine of equivalents	Likelihood of confusion	Well-known / famous marks	Exhaustion	Forfeiture	Prior use rights	Intermediate rights	File wrapper estoppel	First-to-file
Belgium	x	x	x	x	x	x		x	x
Brazil	x	x	x	x	x	x	x	x	x
Chile		x	x	x	x	x			x
China	x	x	x	x	x	x		x	x
England and Wales	52	x	x	x	x	x			x
France	x	x	x	x	x	x	x	x	x
Germany	x	x	x	x	x	x	x		x
India	x	x	x	x	x	x		x	x
Japan	x	x	x	x	x	x	x	x	x
Republic of Korea	x	x	x	x	x	x		x	x
Mexico		x	x	x	x	x		x	x
Peru	x	x	x	x	x	x		x	x
Portugal	x	x	x	x	x	x	x	x	x
Russia	x	x	x	x	x	x		x	x
Spain	x	x	x	x	x	x	x	x	x
Sweden	x	x	x	x	x <sup>53</sup>	x	x		x
Switzerland	x	x	x	x	x	x	x	x	x
Thailand	x	x	x	x	x	x	x		x
US	x	x	x	x	x	x	x	x	x

52 Purposive construction—a different doctrine with substantially similar overall effects .

53 The doctrine of forfeiture of rights is applied regarding patents, as the patent will terminate if the annual fee is not paid, and regarding trademarks (see Trademark Act, SFS 2010:1877, Chapter 3, section 1 and 2 regarding passivity and non-use).

### Authorised representation before SIPJs

Country	Attorneys-at-law	IP practitioners	Any individual/entity <sup>54</sup> , neither attorneys-at-law nor IP practitioners
Belgium	x	x	x
Brazil	x		
Chile	x		
China	x	x	x
England and Wales	x	x <sup>55</sup>	
France	x		
Germany	x	x	x <sup>56</sup>
India	x	x	
Japan	x	x	
Republic of Korea	x	x	x
Mexico	x	x	x
Peru			x
Portugal	x		
Russia	x	x	x
Spain	x		
Sweden	x	x	x
Switzerland	x	x	x
Thailand	x		
US	x		x <sup>57</sup>

54 Excluding the litigating party him/herself.

55 Patent attorneys have rights of audience in IPEC; with additional litigation qualifications patent attorneys can appear in the High Court, but this is the exception rather than the norm.

56 Depending on the instance, there may be no requirement for representation by an attorney-at-law or IP practitioner (e.g. before the Federal Patent Court, BPatG), whereas e.g. the Federal Court of Justice, BGH, requires such qualified representation.

57 Individuals only.

Notes

