

International Law Association's Guidelines on Intellectual Property and Private International Law ("Kyoto Guidelines"): General Provisions

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Abstract: The chapter "General Provisions" of the International Law Association's Guidelines on Intellectual Property and Private International Law ("Kyoto Guidelines") focuses on their scope of application. It provides the conditions under which the Guidelines are intended to be applied. The Guidelines cover only cross border disputes and transactions between private parties involving intellectual property rights. Hence, they only refer to situa-

tions connected to more than one State. The definition of "intellectual property rights" is of particular relevance to determine the scope. Given the similarities to certain claims based on unfair competition the possibility to apply the Guidelines *mutatis mutandis* to such claims is also contemplated.

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A. General Provisions

1. Scope of the Guidelines

(1) These Guidelines apply to civil and commercial matters involving intellectual property rights that are connected to more than one State.

(2) These Guidelines may be applied *mutatis mutandis* to claims based on unfair competition, if the matter arises from the same set of facts as relating allegations involving intellectual property rights, and on the protection of undisclosed information.

See as reference provisions

§ 102 ALI Principles

Art 1:101 CLIP Principles

Art 001 Transparency Proposal

Art 101 Joint Korean-Japanese Principles

Short comments

- 1 These are Guidelines on "Intellectual Property in Private International Law". Guideline 1(1) specifies this general explication of the Guideline's subject matter by setting out that the Guidelines apply to civil and commercial matters involving intellectual property rights that are connected to more than one State. The Guidelines have been drafted specifically for such matters. Therefore, every application of the Guidelines requires an assessment whether the requirements set out in Guideline 1(1) are met. Guideline 1(2) adds two further constellations in which the Guidelines may be applied *mutatis mutandis*.
- 2 According to Guideline 1(1), the Guidelines are applicable under three cumulative conditions. The cause of action has to be (1) a civil and commercial (and not a public law) matter, (2) it has to "involve" intellectual property rights as defined in Guideline 2(1), and (3) it has to be connected to more than one State, i.e. it has to entail an international element. If

one of these three requirements is lacking, questions of international jurisdiction, applicable law and recognition and enforcement are either not at stake (no international element) or ought to be decided on different grounds, namely the (private) international law rules governing the respective non-intellectual property right matter.

- 3 Only in two cases may the Guidelines be relied upon beyond their direct scope of application. According to Guideline 1(2), this concerns firstly claims based on unfair competition, if the matter arises from the same set of facts as relating allegations involving intellectual property rights, and secondly, claims based on the protection of undisclosed information. On the one hand, these causes of action differ doctrinally from claims based on intellectual property rights so that a separate qualification is called for. On the other hand, the two claims referred to in Guideline 1(2) share the purpose of intellectual property rights in that they aim at protecting a particular asset to the exclusive benefit of one party. In light of these similarities in structure and purpose, Guideline 1(2) provides the option to apply the Guidelines “*mutatis mutandis*”.

Extended comments

Hypothetical 1

A and B are both habitually resident in State X. A alleges that B infringes copyrights held by A in States X and Y. If A only seeks protection in State X, the Guidelines do not apply for lack of a connection of the matter to more than State X. If A, instead, sues B for copyright infringement in both States X and Y, the matter has an international element so that the Guidelines are applicable. In no case do the Guidelines cover, however, criminal procedures and penalties against B and administrative border measures of customs authorities preventing the release into the free circulation of copyright infringing goods into States X or Y.

Hypothetical 2

D imitates a product of C and sells its imitations in several States. C sues D, asking for an injunction and damages. He or she bases his/her claim on design rights and the allegation that the unauthorized product imitation is contrary to honest practices in industrial or commercial matters. The Guidelines apply directly to the design rights cause of action, and they may be applied *mutatis mutandis* to the unfair competition claim. The Guidelines are inapplicable, however, if C furthermore and unrelated to the imitation claims that D misleads consumers through false product specifications.

Hypothetical 3

E holds several patents and trade secrets concerning a machine. He or she enters into a license contract with F, which covers the relevant patents and trade secrets for several States. The Guidelines are applicable to this contract according to Guideline 1(1) (patent license) and Guideline 1(2) (trade secrets license). Consequently, the parties may choose the law governing this contract (Guideline 21). Absent a choice, the law applicable to the contract is to be determined according to Guideline 22(1)(b).

Guidelines

- 4 These Guidelines present the results of the ILA Committee on Intellectual Property and Private International Law.¹ Just like the “Principles” or “Proposals” published by European, American, and Asian predecessor projects in the field,² the Guidelines do not constitute a formally binding instrument such as a Convention that States are obliged to directly apply or incorporate into their domestic law. Instead, the term “Guidelines” suggests that the document contains an advisory, non-binding set of provisions, which can guide the application or reform of private international laws. The instrument may be considered as a code of current best practice with certain innovative provisions where appropriate.³
- 5 Guidelines can be both general as well as concrete. These Guidelines accomplish both. On the one hand, they restate well-established foundational principles such as the *lex loci protectionis* rule for all matters concerning the intellectual property right as such (Guideline 19). On the other hand, the Guidelines provide concrete solutions for pressing contemporary problems, for example regarding the law applicable to ubiquitous and multi-state infringements (Guideline 26) and to cross-border collective copyright management (Guideline 27).

1 Cf. ILA Committee Rules & Guidelines nos. 3.2, 6.1, adopted by the Executive Council on 25 April 2015, <http://www.ila-hq.org/index.php/committee-rules-and-guidelines>.

2 ALI Principles; CLIP Principles; Article 101(1) Joint Korean-Japanese Principles.

3 Similar Hague Principles on Choice of Law in International Commercial Contracts, Introduction, paragraph I.5.

Civil and commercial matters

- 6 The Guidelines only apply to “civil and commercial matters”.⁴ The reason for using the word “commercial” as well as “civil” is that in some legal systems, “civil” and “commercial” are regarded as separate categories. Since Guideline 1(1) covers both categories, it does not matter whether a legal system considers intellectual property as part of the “civil” or the “commercial” branch or even both branches of the law.⁵
- 7 Whereas intellectual property rights have significant repercussions on the public interest and also for that reason are generally considered territorial in nature, they are still “private rights” enforced or challenged in “civil” or “commercial” disputes before civil courts or arbitral tribunals.⁶ Because of this private nature of the matter, the Guidelines deviate from strict territoriality where appropriate. For example, the defendant’s forum has, in principle, territorially unlimited jurisdiction (Guideline 3), validity claims may under certain conditions and restrictions be decided by courts outside of the State of registration (Guideline 11), and certain multi-state infringements may be adjudicated by applying only the law or laws of the State(s) having an especially close connection with the global infringement (Guideline 26).
- 8 All these deviations from territoriality only seem appropriate, however, in cases of international civil and commercial disputes involving intellectual property rights. This requirement of Guideline 1(1) is intended to exclude matters of public law such as revenue, customs or administrative matters⁷ and criminal law from the scope of application of the Guidelines. A public law matter is characterized by the fact that one of the parties exercises governmental or sovereign powers that are not enjoyed by ordinary private persons. It is therefore necessary to examine the legal basis of the action. If the action is based on laws establishing intellectual property rights as defined in Guideline 2(1) or other private laws such as contract law, the Guidelines may be relied upon. If, instead, a public authority seeks to

punish a person for conduct proscribed by criminal law,⁸ implements administrative border measures⁹ or other public law sources to enforce intellectual property laws, the Guidelines are inapplicable. Nor do they apply to judgments on judicial actions brought either to enforce or appeal such public law orders.¹⁰

“Involving intellectual property rights”

- 9 The second requirement for the applicability of the Guidelines is that the civil and commercial matter has to involve intellectual property rights. The term “intellectual property right” is defined in Guideline 2(1) as meaning copyright and related rights, patent, utility model, plant breeder’s right, industrial design, layout-design (topography) of integrated circuits, trademark, geographical indication and similar rights. It follows *e contrario* from Guideline 1(2) that claims based on unfair competition and on the protection of undisclosed information are not covered by the term “intellectual property right” and thus the Guidelines. At a maximum, the Guidelines may be applied *mutatis mutandis* to such causes of action.
- 10 The international case at stake has to “involve” intellectual property rights.¹¹ According to the general meaning of “to involve”, the matter has to include intellectual property rights as a necessary or integral part or result.¹² The Guidelines on jurisdiction, applicable law and recognition and enforcement provide guidance on which disputes satisfy this requirement. Regarding the substantive law basis of a claim, the Guidelines distinguish between matters concerning an intellectual property right “as such” (Guidelines 8, 19-20), intellectual property right infringements (Guidelines 5-6, 25-27), and contractual matters (Guidelines 4, 21-24). An international case accordingly “involves” an intellectual property right if its adjudication requires a determination of the title to, ownership of, existence, validity, registration, duration, transferability, and scope (including the remuneration for the legal use of copyrighted

4 Similar § 102(1) ALI Principles (civil dispute, civil action); Article 1:101(2) CLIP Principles (“civil matters”); Article 001(1) s. 1 Transparency Proposal (“civil disputes”); Article 101(2) Joint Korean-Japanese Principles (“civil disputes”).

5 Cf. Explanatory Report on the 2005 Hague Choice of Court Agreements Convention (Hartley/Dogauchi Report), paragraph 49.

6 TRIPS Preamble; Guideline 31.

7 Article 1(1) Hague Draft Convention on the recognition and enforcement of foreign judgments in civil or commercial matters.

8 Cf. Article 61 TRIPS.

9 Cf. Articles 51-60 TRIPS.

10 Draft Convention on the recognition and enforcement of foreign judgments in civil or commercial matters, Revised Draft Explanatory Report, December 2018, paragraphs 28-31.

11 Likewise § 102(1) ALI Principles; Article 1:101 CLIP Principles; Article 101(2) Joint Korean-Japanese Principles; Article 001(1) s. 1 Transparency Proposal.

12 Involve, Oxford English Dictionary.

works or the subject-matter of related rights) of an intellectual property right; and/or one party seeks protection against an intellectual property right infringement. Contracts involve intellectual property rights and thus fall under the Guidelines if they “deal with” one or several intellectual property rights (cf. Guideline 22(1)) or where the efforts of an employee give rise to an intellectual property right (Guideline 23(1)). Whether these thresholds are met has to be decided in each individual case, considering all circumstances.

- 11 From a procedural point of view, the Guidelines cover proceedings concerning matters of title to and ownership of a right (Guideline 8), the grant, registration, validity, abandonment, or revocation of a registered intellectual property right (Guideline 11(1)), and actions seeking substantive relief on the basis of intellectual property license or transfer contracts (Guideline 4) or for an intellectual property right infringement (Guideline 5). The Guidelines furthermore apply to other proceedings, in particular declaratory actions, including declarations of non-infringement (Guideline 12), and provisional and protective measures (Guideline 13) if they entail a determination of the substantive issues mentioned before. Counterclaims, finally, are subject to the Guidelines if the original claim involves intellectual property rights and thus falls under the Guidelines, and the counterclaim arises out of the same set of facts on which the original claim is based (Guideline 15).

“Connected to more than one State”

- 12 For the Guidelines to be applicable, the civil or commercial matter involving intellectual property rights furthermore has to be “connected to more than one State”.¹³ The purpose of this requirement is to exclude purely domestic situations from the scope of application of the Guidelines. If an intellectual property case lacks any international element, questions of private international law and thus a need to apply the Guidelines do not arise from the outset.¹⁴ The ascertainment of internationality requires a careful case-by-case analysis. As a first step, one has to distinguish between internationality for the purposes of jurisdiction and applicable law and the determination of internationality for the purposes of recognition and enforcement.

- 13 Regarding jurisdiction and applicable law, the connection of an intellectual property right matter to more than one State can follow either from the divergent residence of the parties or any other element relevant to the dispute.¹⁵ If not all of the parties are habitually resident in the same State, an international element is present, even if, for example, an intellectual property license contract deals with an intellectual property right granted for one State only (Guideline 22(1)(a)). Conversely, the fact that all parties to a dispute are resident in one State does not exclude the applicability of the Guidelines because the necessary connection to another State can be derived from other relevant elements of the case, for example the grant of a license for more than one State (Guideline 22(1)(b)) or an alleged infringement by one of the parties in another State. The criteria listed in Guideline 16, for example the nationality of one party, are also sufficient to establish internationality of the case but insufficient for exercising jurisdiction. The sole fact that the parties have chosen a foreign court to govern their otherwise purely domestic relations should, however, not suffice to establish internationality.¹⁶

- 14 Regarding recognition and enforcement, a case is international where recognition or enforcement of a foreign judgment is sought.¹⁷ As a result, an originally purely domestic case can become international and thus subject to the Guidelines if it is to be recognized or enforced in another State.¹⁸

Application to claims based on unfair competition

- 15 The Guidelines apply to international matters involving intellectual property rights as defined in Guideline 2(1). According to Guideline 1(2), the Guidelines may furthermore be applied *mutatis mutandis* to claims based on unfair competition,

13 Cf. § 102(1) ALI Principles.

14 Cf. Article 1(1) Hague Convention on Choice of Court Agreements; § 102(1), (6) ALI Principles; Article 1:101(1) CLIP Principles; Article 101(2) Joint Korean-Japanese Principles; Article 001(1) s. 1 Transparency Proposal.

15 Cf. Article 1(2) Hague Convention on Choice of Court Agreements; Hague Principles on Choice of Law in International Commercial Contracts, Introduction, paragraphs 1.14 *et seq.*

16 Cf. Article 1(2) Hague Convention on Choice of Court Agreements; Explanatory Report on the 2005 Hague Choice of Court Agreements Convention (Hartley/Dogauchi Report), paragraphs 41-43; Hague Principles on Choice of Law in International Commercial Contracts, Introduction, paragraph 1.21.

17 Cf. Article 1(3) Hague Convention on Choice of Court Agreements.

18 Explanatory Report on the 2005 Hague Choice of Court Agreements Convention (Hartley/Dogauchi Report), paragraphs 44-45.

if the matter arises from the same set of facts as relating allegations involving intellectual property rights.

- 16 Claims based on unfair competition law can concern a broad range of diverse situations. Article 10^{bis} of the Paris Convention requires effective protection against acts “contrary to honest practices in industrial or commercial matters” but effectively leaves it to the contracting parties to define this threshold of unfairness. Many situations dealt with under the heading of “unfair competition” are completely unrelated to intellectual property. This is the case, for example, with regard to most misleading and aggressive commercial acts vis-à-vis consumers or the violation of statutory provisions that also intend to regulate market behavior. Cases like these are beyond the scope of application of the Guidelines.
- 17 Unfair competition laws and functionally equivalent torts can, however, also provide a basis for protection where intellectual property law fails to do so. Plaintiffs often claim that the defendant infringed certain intellectual property rights, and that he or she in any event practiced unfair competition/passing off.¹⁹ One scenario concerns allegations of unfair (“slavish”) product imitation, which complement allegations of infringements of e.g. design rights or copyrights. The other scenario pertains to misleading commercial practices that create a risk of confusion with the trademark, trade name or other protected sign of a competitor. These are situations where “the matter arises from the same set of facts as relating allegations involving intellectual property rights” (Guideline 1(2)).
- 18 But even in such constellations of closely related intellectual property and unfair competition claims, the doctrinal and teleological differences between the two areas of law have to be taken into account. In particular, the Guidelines concerning ownership and transferability suppose a predefined right that is owned by someone and that is, at least in principle, fungible. Unfair competition law, instead, defines the general boundaries of lawful market behavior, and sanctions these limits with private tort claims and/or public law remedies.²⁰ Therefore, questions of ownership and transferability of rights can only become relevant with regard to intellectual property rights. In light of these differences, private international laws and instruments distinguish between both areas.²¹

19 For an example see German Supreme Court, 13 October 2004, Case I ZR 163/02, GRUR 2005, 431 – *Hotel Maritime*.

20 Comment C06 Article 1:101 CLIP Principles (Torremans).

21 Cf. § 301(2) ALI Principles; Article 303 Transparency

- 19 Guideline 1(2) caters for these similarities and differences between intellectual property and unfair competition law by stating that the Guidelines “may be applied *mutatis mutandis*”. Guideline 1(2) thus provides a basis to subject, where and in so far as appropriate, unfair competition claims to the same private international law rules as related intellectual property claims. Guidelines that lend themselves to application to intellectual property-related unfair competition claims include the universal competence of the defendant’s forum (Guideline 3), the double-headed infringement jurisdiction under Guideline 5, Guidelines 25-26 on the law applicable to infringements,²² and the Guidelines on recognition and enforcement with the exception of Guideline 35(4) concerning the validity of registered rights. In contrast, the Guidelines dealing with the title to, ownership of, existence, validity, registration, duration, transferability, and scope of an intellectual property right (Guidelines 8, 11, 19, 20), and with collective copyright management (Guideline 27) are too much based on an intellectual property right “as such” as to be informative for deciding international unfair competition cases.

Application to the protection of undisclosed information

- 20 The second category of cases to which the Guidelines may be applied *mutatis mutandis* according to Guideline 1(2) concerns claims based on the protection of undisclosed information. As with unfair competition claims, this optional extension of the core scope of application of the Guidelines reflects the closely related yet still different legal nature and purpose of the protection of undisclosed information compared to the protection of intellectual property.
- 21 On the one hand, both types of protection reflect a balance between the private interest in certain kinds of information, and the public interest. The mix of private and public interests at stake in trade secrets is much the same as it is in conventional intellectual property.

Proposal; Article 304(3) Joint Korean-Japanese Principles; Articles 110, 136 Swiss IPRG; Articles 17, 20 Japanese PIL Act; Article 44 (torts) and Articles 48-59 Chinese Law on the Laws Applicable to Foreign-Related Civil Relations, 28 October 2010, transl. Lu; Article 6 and 8 Regulation (EC) No 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations (Rome II), [2007] OJ L199/40.

22 The law for which intellectual property right protection is sought (*lex loci protectionis*) regularly coincides with the law of the State on whose territory competitive interests on a given market collide (*lex loci damni*).

And indeed, the TRIPS Agreements regulates the protection of undisclosed information as one form of “intellectual property”.²³

- 22 On the other hand, the protection of undisclosed information takes various forms in national laws, ranging from the application of general civil remedies to specific provisions and forms of sui generis protection that are akin to but not quite a fungible property right.²⁴ Equally heterogeneous are the types of information as regards which protection against unauthorized acquisition, use and disclosure is claimed. Whereas trade secrets protection is akin to intellectual property protection, the protection of government and personal secrets differs fundamentally from intellectual property rights.
- 23 In light of these similarities and differences, Guideline 1(2) provides that the Guidelines “may be applied *mutatis mutandis*”.²⁵ As with regard to certain, intellectual property-related unfair competition claims, users thus have the option to apply the Guidelines to the protection of undisclosed information where and in so far as appropriate, considering all circumstances of the case. International trade secrecy cases may thus be adjudicated on the – if necessary modified – basis of Guideline 3 on the universal competence of the defendant’s forum, the double-headed infringement jurisdiction under Guideline 5, Guideline 8 on the law applicable to determine who the “trade secret holder” is,²⁶ Guidelines 21-24 on the law governing contracts that deal with trade secrets, Guidelines 25-26 on the law applicable to infringements, and the Guidelines on recognition and enforcement with the exception of Guideline 35(4) concerning the validity of registered rights.

23 Articles 1(2), 39 TRIPS. Consequently, § 102(1) ALI Principles stipulates that these “Principles apply to transnational civil disputes that involve copyrights, neighboring rights, patents, trade secrets, trademarks, related intellectual property rights, and agreements related to any of these rights”.

24 See, e.g. Directive (EU) 2016/943 of the European Parliament and of the Council of 8 June 2016 on the protection of undisclosed know-how and business information (trade secrets) against their unlawful acquisition, use and disclosure, [2016] OJ L157/1.

25 Article 1:101(3) CLIP Principles.

26 Cf. Article 2(2) Directive (EU) 2016/943 of the European Parliament and of the Council of 8 June 2016 on the protection of undisclosed know-how and business information (trade secrets) against their unlawful acquisition, use and disclosure, [2016] OJ L157/1.

2. Definitions

1. **“Intellectual property right” means copyright and related rights, patent, utility model, plant breeder’s right, industrial design, layout-design (topography) of integrated circuits, trademark and similar rights.**
2. **“Judgment” means any judgment rendered by a court or tribunal of any State, irrespective of the name given by that State to the proceedings that gave rise to the judgment or the name given to the judgment itself, such as decree, order, decision, or writ of execution. “Judgment” also includes court-approved settlements, provisional and protective measures, and the determination of costs or expenses by an officer of the court.**

See as reference provisions

§ 102(1) ALI Principles

Arts 1:101(2) s. 2, 4:101 CLIP Principles

Art 001(1) s. 2 Transparency Proposal

Art 102(1)-(3) Joint Korean-Japanese Principles

Short comments

- 24 By defining the term “intellectual property right” for the purposes of the Guidelines, Guideline 2(1) helps to delineate their scope of application. There is no universally agreed understanding of the term “intellectual property right”. Article 2(viii) of the WIPO Convention and Article 1(2) of TRIPS provide definitions only “for the purposes” of the respective treaties. The term “intellectual property right” and the open clause “similar rights” in Guideline 2(1) should be interpreted as taking into consideration the overall purpose and content of the Guidelines.
- 25 Taken together, Guidelines 1 and 2 distinguish three categories of international civil and commercial matters to which the Guidelines apply directly, apply *mutatis mutandis* or do not apply at all. The first category concerns intellectual property rights as defined in Guideline 2(1), i.e. the explicitly mentioned rights and “similar rights”. Whereas the Guidelines should be applied in cases “involving” such intellectual property rights without modification (Guideline 1(1)), the Guidelines “may be applied *mutatis mutandis*” to certain claims based on unfair competition and to claims based on the protection of undisclosed information (Guideline 1(2)). All other international civil and commercial matters are beyond the scope of application of the Guidelines.
- 26 The term judgment is defined broadly, to cover any decision on the merits by any authority having jurisdiction in civil matters involving intellectual property, regardless of the name given to the decision

or the proceedings. The definition of judgment is particularly relevant with regard to the application of the provisions of the Guidelines on recognition and enforcement. However, it is also significant with regard to other parts of the Guidelines, such as the provisions on consolidation and *lis pendens*.

Extended comments

Intellectual property rights

27 Like all predecessor principles/proposals concerning intellectual property in private international law,²⁷ the Guidelines define their scope of application by referring to a number of concrete examples of intellectual property rights that are complemented by an open clause, which allows to apply the Guidelines to “similar rights”. This way, Guideline 2(1) aims at combining legal certainty with flexibility in light of the fact that legislatures constantly create new types of intellectual property rights.

Rights expressly mentioned

28 Guideline 2(1) lists eight types of rights, which are to be considered intellectual property rights for the purposes of the Guidelines. If a civil and commercial matter, which is connected to more than one State, involves one or several of these rights, the Guidelines apply directly.

29 The first example of an intellectual property right is copyright, i.e. an economic and/or moral right in any type of literary, artistic or scientific work.²⁸ The second category of rights covered by the Guidelines concerns rights “related” to copyright. This terminology is borrowed from the TRIPS Agreement, which in the title of part II section 1 also speaks of “copyright and related rights”.²⁹ The international *acquis* of “related rights” in the TRIPS Agreement and several WIPO treaties comprises rights of performers, of producers of phonograms (sound recordings), and of broadcasting organizations.³⁰

National and regional intellectual property laws have gone beyond this level by codifying several other “related rights”. EU directives and respective EU Member States’ laws, for example, also protect first fixations of films, critical and scientific publications, non-creative photographs, the investment in a database, and press publications.³¹ By covering these rights, the term “related rights” functions as a small general clause for all new exclusive rights in the cultural sector.

30 In addition to copyright and related rights, Guideline 2(1) mentions six industrial property rights most of which are covered by the TRIPS Agreement, the Paris Convention for the Protection of Industrial Property, and/or the treaties establishing WIPO’s “Global Protection System”.³² First among those rank patents for inventions,³³ second utility models, which enjoy less international recognition and harmonization, but are also regulated by the Paris Convention.³⁴ The plant breeder’s right as currently specified on the international level in the Convention for the Protection of New Varieties of Plants (UPOV) is the third industrial/intellectual property right. The fourth industrial property right listed in Guideline 2(1) concerns industrial designs, which are covered by the Guidelines irrespective of whether the right requires registration or not.³⁵

Duplication of Their Phonograms (1971); Brussels Convention Relating to the Distribution of Programme-Carrying Signals Transmitted by Satellite (1974); WIPO Performances and Phonograms Treaty (WPPT) (1996); Beijing Treaty on Audiovisual Performances (2012).

31 Directive 2006/116/EC of the European Parliament and of the Council of 12 December 2006 on the term of protection of copyright and certain related rights (codified version), [2006] OJ L372/12; Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases, [1996] OJ L77/20; Directive (EU) 2019/790 of the European Parliament and of the Council of 17 April 2019 on copyright and related rights in the Digital Single Market, [2019] OJ L130/92, and amending Directives 96/9/EC, [1996] OJ L77/20, and 2001/29/EC, [2001] OJ L167/10, Article 2(4), 15.

32 <https://www.wipo.int/treaties/en/>.

33 Article 2(viii) WIPO Convention; Article 27(1) TRIPS; Article 102(1) Joint Korean-Japanese Principles.

34 Cf. Articles 5A(5), 4E Paris Convention.

35 Article 4 Paris Convention; Articles 25-25 TRIPS; Article 1 Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, [2002] OJ L3/1.

27 § 102(1) ALI Principles; Article 1:101(2) s. 2 CLIP Principles; Article 001(1) s. 2 Transparency; Article 102(1)-(3) Joint Korean-Japanese Principles.

28 Article 2(viii) WIPO Convention; Article 2 Berne Convention; Comment 1:101.C02 CLIP (Torremans).

29 Article 1:101(2) s. 2 CLIP Principles and §102(1) ALI Principles refer synonymously to “neighboring rights”.

30 Articles 1(2), 14 TRIPS; Article 2(viii) WIPO Convention (performances of performing artists, phonograms, and broadcasts); see further International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations (1961); Convention for the Protection of Producers of Phonograms Against Unauthorized

The same holds true for the protection of the layout-design (topography) of integrated circuits, the fifth example for an industrial/intellectual property right.³⁶

- 31 Finally, Guideline 2(1) mentions trademarks, for which there is a broad international consensus that they fall under the rubric of intellectual property rights,³⁷ and are furthermore subject to the same private international law rules governing copyright, patent and other industrial property rights matters.³⁸

“Similar rights”

- 32 The broad concept of “intellectual property right” is not limited to the eight categories of rights listed in Guideline 2(1). Lawmakers have the power to establish other rights that share core characteristics of copyright, copyright-related and industrial property rights. As the history of intellectual property law proves, lawmakers indeed make use of this legislative power. In order to allow the application of the Guidelines to cross-border matters involving such other rights, Guideline 2(1) adds that rights “similar” to those explicitly mentioned also fall into the category of “intellectual property rights”.³⁹ Whether the Guidelines are directly applicable on this basis depends upon a comparison between the right in question and the rights explicitly listed in Guideline 2(1). The requisite similarity concerns two aspects.

- 33 Firstly, the structure of the legal position at stake has to be similar to that of the intellectual property rights specified in Guideline 2(1). Their most important feature is exclusivity.⁴⁰ Exclusivity is

given if a right holder (single or joint ownership) is entitled to authorize or prohibit the use of a certain good or resource vis-à-vis any third party. The exclusive legal position at issue has to have a predefined scope within a specific territory so that it makes sense to speak of a title to or ownership of a right in a particular object (cf. Guidelines 8, 20) and that furthermore the existence and scope of the right can be distinguished from an infringement (cf. Guideline 19, 25). Since this property rights structure is lacking in matters involving claims based on unfair competition and on the protection of undisclosed information, Guideline 1(2) provides that the Guidelines may in these cases only be applied *mutatis mutandis*. Finally, the exclusive right at issue ought to be private in the sense that the right holder is free to decide whether to authorize or prohibit a use that encroaches on the exclusive scope of the right.⁴¹ Whether and under which conditions an intellectual property right is transferable is, however, to be determined according to the law of the State for which protection is sought (Guideline 19). Accordingly, laws prohibiting the commercial use of any sign consisting of or containing the Olympic symbol except with the authorization of the International Olympic Committee establish a “similar right” in the sense of Guideline 2(1).⁴² The same is true for the protection of geographical indications because the TRIPS Agreement and several WIPO treaties oblige members/contracting parties to provide “interested parties” with the legal means to prevent the unauthorized use of protected geographical indications and appellations of origin.⁴³ Another inconclusive factor regarding legal similarity is whether the right in question requires registration.⁴⁴

36 Cf. Washington Treaty on Intellectual Property in Respect of Integrated Circuits (1989).

37 Article 2(viii) WIPO Convention; Articles 15-21 TRIPS.

38 Cf. § 102(1) ALI Principles; Article 1:101(2) s. 2 CLIP Principles; Article 001(1) s. 2 Transparency Proposal; Article 102(1)-(3) Joint Korean-Japanese.

39 Functionally equivalent formulations can be found in all predecessor principles/proposals; cf. Article 1:101(2) s. 2 CLIP Principles and Article 001(1) Transparency Proposal (“similar exclusive rights”); § 102 ALI Principles (“related Intellectual Property rights”); Article 102(1) Joint Korean-Japanese Principles (intangible property “including” invention etc.).

40 Article 1:101(2) s. 2 CLIP Principles and Article 001(1) Transparency Proposal (“similar exclusive rights”); Statement by the European Commission concerning Article 2 of Directive 2004/48/EC of the European Parliament and of the Council on the enforcement of intellectual property rights, [2005] OJ L94/37 (“in so far as these are protected as

34 The second aspect with regard to which the right at issue has to be similar to the rights explicitly mentioned in Guideline 2(1) concerns its subject matter. The examples listed confirm that the

exclusive property rights in the national law concerned”).

41 Cf. TRIPS, Preamble (private rights).

42 Nairobi Treaty on the Protection of the Olympic Symbol adopted at Nairobi on September 26, 1981.

43 Article 10 Paris Convention; Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods; Articles 22-24 TRIPS; Lisbon Agreement on Appellations of Origin and Geographical Indications. But see Article 1:101(3)(a) CLIP Principles (*mutatis mutandis* application of the CLIP Principles to the protection of geographical indications).

44 This is only relevant for the applicability of those Guidelines which specifically address registered intellectual property rights, in particular Guideline 11.

Guidelines are Guidelines on “intellectual” property, not on any type of property right in private international law. In particular, the Guidelines do not apply to ownership in movables and immovables (real property). Consequently, an exclusive right is only a “similar right” under Guideline 2(1) if the subject matter results from an intellectual, creative or otherwise entrepreneurial human activity that can be easily duplicated.⁴⁵ Personal data do not fall into this category and are thus beyond the scope of the Guidelines.⁴⁶

- 35 Examples of rights that may satisfy the double similarity standard comprise rights in trade names,⁴⁷ rights in sports events, in traditional knowledge, genetic resources and traditional cultural expressions, and rights derived from supplementary protection certificates. In cross-border matters involving these intellectual property rights, the Guidelines are applicable.

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Judgment

- 36 The definition of the term “judgment” is mainly intended to clarify the decisions that can eventually be recognized and enforced under the Guidelines, provided that the particular judgment concerned meets the requirements laid down in the section on recognition and enforcement. The broad concept of judgment encompasses decisions of many different types, including monetary and non-monetary judgments and, hence, the features of the particular judgment concerned influence the application of the provisions on recognition and enforcement, particularly with regard to the grounds for non-recognition. The determination of costs or expenses of the proceedings by the court is also covered to the extent that it relates to a decision on the merits. Provisional and protective measures are also covered, but recognition and enforcement of such measures remain subject to specific restrictions, as it is also the case with regard to judgments which have not become final yet. Interlocutory decisions of a procedural nature are in principle not covered by the definition and hence not subject to recognition and enforcement under the Guidelines.

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45 Cf. Article 2(viii) WIPO Convention; Article 102(1) Joint Korean-Japanese Principles.

46 Cf. Comment 1:101.C03 CLIP Principles.

47 Article 2(viii) WIPO Convention; Articles 1(2), 8 Paris Convention.