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Chapter 28

COMMENTARY: THE HAGUE DRAFT CONVENTION ON JURISDICTION: AN INTRODUCTION TO THE INTELLECTUAL PROPERTY ISSUES

*Martin Adelman**

I want to acknowledge the many people who are so knowledgeable on this subject. I specifically want to thank Judge Newman, who actively got at least me and some other patent people alerted to the important issues raised by the Hague Conference, and indeed insisted that we discuss it at the International Judges Conference of Patent Judges, which was held in October, sponsored by the Federal Circuit in Washington. At that time, Hugh Hansen said we ought to discuss it at Fordham and get the people who are really involved in working on the subject to Fordham. With all the efforts that Hugh has put into this conference, he put it together.

Now, other people will tell you the exact status of the negotiations. I just want to set the stage and tell you basically what is in the treaty.

We all know about the European treaties on jurisdiction and judgments, the Brussels Convention¹ and the Lugano Convention,² and of course they form an important backdrop of this treaty.

I had thought that those would be widely known. I do have to say that I had a graduate student in my class who just graduated from Leyden, one of the great law schools of Europe. When we started to discuss IP litigation, and of course the Brussels Convention, she developed a very blank look on her face, and then it was a stricken look on her face. She came up to me afterwards and said, "I am so embarrassed. I never heard of it. I was never taught about the Brussels Convention." So maybe it isn't as widely known as I had thought.

In any event, if we start just from the basics, if you want to bring a case, we all know you have to look at local law to see whether you can sue somebody and for what. On the other hand, people get judgments abroad and they may want to enforce them in courts other than the court that actually granted the judgment.

And you may want to, in this international age, develop a treaty that would say, "Okay, let's all agree essentially on what those jurisdictional laws are in the signatory countries, or should be, and we will make them that way." And then, we

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¹ Brussels Convention on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters, Sept. 27, 1968, 1968 O.J. (L 299) 15, revised in 1978 O.J. (L 304) 77, revised in 1982 O.J. (L 388) 30, in English at 1989 O.J. (L 285) 1 [hereinafter Brussels Convention].

² Lugano Convention on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters, 1988 O.J. (L 319) 9 [hereinafter Lugano Convention].

will say, "If you follow those laws and get a judgment, then that judgment can be enforced in all of the signatory countries." So that is the broad idea.

There are many debates about whether the United States really ought to be concerned about this and all the rest of it, but the United States did initiate negotiations at The Hague Conference to develop such a treaty.

We can take a quick look now at some of the provisions that would affect copyright litigation, where you would sue for copyright infringement in one country and look to get relief for infringements in other countries; and the same for patents.

The treaty has to have an ordinary place where you can sue somebody. This one does. Article 3 tells you where you can sue somebody, just generally, just as a general rule. They use the notion that you can be sued where you are "habitually resident." And then, for corporations who have a lot of intellectual property, there is a definition of what that means. Then, there is a special rule also for torts in Article 10.

Now, the next question that comes up: as you know, there are ideas in various laws of many countries that certain kinds of actions should not be dealt with in those courts, even though the defendant is properly before the court. This is sometimes known as local action. What that suggests is maybe for certain kinds of actions you will just pick one court and you will say that is the only place amongst all the courts that could be used that can deal with this particular cause of action. That is dealt with in Article 12 of the latest draft.

The particular section that is of greatest interest to us in the intellectual property community is Article 12(4). Here, if we look at the language, it partially tracks the Brussels Convention, but then there is language that suggests an answer to the question that Sir Hugh Laddie was talking about this morning when he asked, "What happens if nobody takes an issue to the European Court of Justice where the Dutch courts have gone one way and the British courts have gone another?"³ What he was referring to was the fact that in England the language of Article 16(4), even without the bracketed language, was interpreted to mean that you cannot try an infringement issue in any place but the courts of the state that granted the patent, because you cannot separate out validity and infringement.

There is what I find a very persuasive opinion by Judge Laddie, called *Coin Controls*.⁴ I will not read you the passage where he explains all of this. You would probably say it is the rantings of some local British judge or somebody who didn't know what they were talking about. But at least you can go back and read it, and whether you find it persuasive or not in a sense does not matter, because the issue is on the table for resolution.

The point is, at least with respect to patents, are patent infringement cases going to be tried under the regular rules—not validity, but infringement issues—and validity issues tried only in the courts of the state that granted the patent? Or alternatively, are you going to simply say, "No, the answer is that those patent infringement cases can only be decided in what I would call the local courts"? That is a major policy issue that is not really resolved by this language, because the European Court of Justice someday will decide it under the Brussels Convention, but that can be resolved legislatively.

³ See Chapter 5, this volume.

⁴ *Coin Controls Ltd. v. Suzo Int'l (UK) Ltd. et al.*, decision of the High Court of Justice, Chancery Division, Patents Court of 26 March 1997 [1997] F.S.R. 660.

But here the language can be changed, and the language that would change it is in brackets, to make it clear that if the bracketed language is used, what Sir Hugh said about the language of the Brussels Convention is definitely the case now with respect to this treaty.

Now, let me go on and just make a couple of other points.

There is nothing in the treaty about conflicts of law. So one of the big issues, and some of the people sitting on this panel have written about it, is what is the appropriate conflict of law rule, particularly in copyright, because the Internet, and other things that we all know about, raise interesting conflict-of-law rules. There is nothing in here about conflict of law. That is simply not dealt with.

In the patent area, I have not heard any serious argument—maybe there is one—that the conflict-of-law rule would be anything other than where the patent was infringed—if it is a British patent, the British patent law would be applicable; even if an Italian judge was making the decision, the Italian judge would use British patent law.

Finally, there is a provision that is different from the Brussels Convention and one ought to look at it, the *lis pendens* provision, because it does not permit game playing with respect to forum shopping through the use of declaratory judgments. That seems to be a general problem that is dealt with in the treaty, although if you know European litigation in the IP area, that is an important issue under the Brussels Convention.

I hope I have laid out this in general, and we are going to learn a lot more from the speakers who have been in the trenches, as it were. Thank you.