
REQUESTS OR OPINIONS

To be Submitted to “Working Group on Various Problems concerning Intellectual Property Right in Private International Law”, Institute of Intellectual Property

December 21, 2003

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Re: Opinion Concerning “Preliminary Draft Convention on Exclusive Choice of Court Agreements” of Hague Conference on Private International Law*

Japan Intellectual Property Association (JIPA) is a private organization related to intellectual property, consisting of approximately 830 of member enterprises from various industrial fields such as the electric, machinery, metal, chemical and construction industry as well as trading companies. JIPA has been engaged in research and study in intellectual property issues in general including the industrial property right and copyright, and has made proposals to each relevant authorities from the viewpoint of the industry.

Prior to the December 2003 when Special Commission of the Hague Conference on Private International Law is to be held, we propose the following opinion concerning “Preliminary draft Convention on exclusive choice of court agreements”. Please take our opinion into consideration.

1. General

We understand that we need to establish an international framework to resolve international disputes in the field of intellectual property right. However, considering the uniqueness of intellectual property legislation of each country closely connected to the national industrial policy under the territoriality principle, we cannot say that we have had thorough and exhaustive discussions concerning this issue, thus we need, in our opinion, to continue our discussion in the future. Therefore, for the present, it would be reasonable to exclude intellectual property from the subject of application of the Convention in this draft.

2. Specific Issues

(1) Article 1.3(k)

As the exceptions for the application of the Convention set forth in Article 1.3(k), the description should state, for example, “patents, trademarks and other intellectual property rights”, and further discussion should be made as to whether the design right, copyright and related rights, unregistered well-known trademark, as well as the trade secret (as protected under the Unfair Competition Prevention Law in Japan) or the defamation of business reputation (as prohibited as one of the examples of

* “CHIZAI KANRI” (Intellectual Property Management), Vol. 54, No. 2, pp. 325-326 (2004)

prohibited acts under the Unfair Competition Prevention Law), and as to the definition of the intellectual properties to be stated as the exception for the application of the Convention.

(2) Article 1.4

In our opinion, intellectual property rights should be in any way excluded from the subject of application of the Convention, even if the issue of intellectual property right set forth in Article 1.3(k) arises as an underlying problem in the proceedings.

(3) Article 7

The 2001 draft version set forth in Article 12.8 that the term “court” may include the Patent Office and other similar institutions for the purposes of the application of Article 12. However, there is no definition of “court” in the present draft, and some doubts may arise in respect of the definition. Therefore, it would be necessary to note that the Convention would not apply to the “decision” rendered by the “court” in relation to intellectual property rights, from the viewpoint of both grant and execution of the right.

