

Introduction

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Intellectual property adjudication is at the heart of contemporary efforts for the development and modernisation of intellectual property regimes at the national, regional and international level. There are numerous signs of maturity of intellectual property enforcement, many of them involving the judiciary. Signs of progress include both judicial specialisation and the blooming of international intellectual property dispute settlement bodies. They include advances as well that go beyond institutional aspects.¹ Think for instance about the development of particularly crafted procedural rules to settle intellectual property disputes, or the cases of the specialisation developed over time with respect to evidence and measures for the preservation of evidence, the criteria specifically developed for the award of damages with respect to intellectual property disputes or, still, the adjustment of the conditions for the granting of injunctions when they impact intellectual property rights.

Naturally, there is no expansion without tension and no progress without challenges. This is precisely the reason why scholars, legal experts and practitioners feel excited about legal change and normative development. One tends to forget, however, that legal change also impacts those who have the last say over intellectual property disputes or, rephrasing Judge Robert H. Jackson, those who are not final because they are infallible, but are infallible only because they are final.²

¹ On the institutional environment for enforcement at international level, see 'Rethinking International Intellectual Property Law: What Institutional Environment for the Development and Enforcement of IP Law?', CEIPI-ICTSD Publication Series on Global Perspectives and Challenges for the Intellectual Property System, Issue 1, Geneva/Strasbourg, November 2015, available at <http://www.ceipi.edu/fileadmin/upload/DUN/CEIPI/Documents/Publications_CEIPI___ICTSD/CEIPI-ICTSD_no_1.pdf>.

² *Brown v. Allen*, 344 U.S. 443, 540 (1953).

In a dynamic and ever-evolving field such as intellectual property law, judges are frequently confronted with challenges arising from technical complexity and ethical dilemmas. Judges will be the first to decide with respect to unexplored areas and matters of dispute, frequently involving significant social, economic, scientific and ethical consequences.³ Moreover, challenges for judges do arise from systemic aspects. Take for instance the case of jurisdictional overlaps impacting intellectual property protection, or the phenomenon of transplantation of intellectual property enforcement norms. Diverging comparative jurisprudence may not be, thus, just a matter of different legal opinions, but may also respond to systemic determinants.⁴

Whether judges welcome these challenges is unknown to us. Certainly, it may be advisable to leave this inquiry unanswered, to preserve the discreteness and some sort of mystery that characterises the judicial profession. However, what is clear is that at the end of the day judges must decide. They must adjudicate the cases that fall on their desks and, in doing so, they must address the aforementioned difficulties and challenges. In this context, it is an opportune time to underline that intellectual property enforcement is a dynamic activity rather than a mechanical operation. Enforcement does not evoke a pre-established set of things or a final situation. By contrast, enforcement is a process of weighing and balancing rights and interests, and in this process judges play a prominent role.⁵

³ See Ch Geiger, 'The Social Function of Intellectual Property Rights, Or How Ethics Can Influence the Shape and Use of IP Law', in G. B. Dinwoodie (ed.), *Methods and Perspectives in Intellectual Property*, 153 (Cheltenham, UK / Northampton, MA, Edward Elgar Publishing, 2013), underlining that the judiciary is the implementer of the social function of intellectual property law and explaining how courts can make use of ethical principles when deciding IP disputes. Copyright law is an area particularly affected by constant technological, social and economic change and it is thus not surprising that its enforcement has been particularly sensitive and difficult in recent years, see Ch Geiger, 'Challenges for the Enforcement of Copyright in the Online World: Time for a New Approach', in P. Torremans (ed.), *Research Handbook on the Cross-Border Enforcement of Intellectual Property*, 704 (Cheltenham, UK / Northampton, MA, Edward Elgar Publishing, 2014).

⁴ On the challenges of comparative analysis within intellectual property (IP), including legal transplants, see I. Calboli, 'The Role of Comparative Legal Analysis in Intellectual Property Law: From Good to Great', in G. B. Dinwoodie (ed.), *Methods and Perspectives in Intellectual Property*, op. cit., at 3 *et seq.*

⁵ See Ch Geiger, J. Raynard and C. Rodà, 'What Developments for the European Framework on Enforcement of Intellectual Property Rights? A Comment on the Evaluation Report of the European Commission dated 22 December 2010', (2011) *European Intellectual Property Review* (EIPR) 543, emphasising

Intellectual property is a kaleidoscope of social, legal and economic interests and actors.⁶ Putting them together and delivering a socially relevant contribution depends on a fine balancing exercise.

The *eBay, Inc., v. MercExchange* litigation is a good case in point. In *eBay*, the Supreme Court of the United States differentiated ‘the creation of a right’ from ‘the provision of remedies for violations of that right’. This apparently trivial observation was, however, the basis to assess the relevance of the public interest when granting an injunction, and reverse the practice of granting injunctions automatically once a patent infringement had been found. The court emphasised that ‘flexibility rather than rigidity has distinguished [equity]. The qualities of mercy and practicality have made equity the instrument for nice adjustment and reconciliation between the public interest and private needs as well as between competing private claims.’⁷

In this dynamic context, when enforcing intellectual property rights, other norms and principles, including values and legal interests found in other branches of the law, come into play.⁸ Under this background, it seems fair to compare the work of a judge with that of a potter, who moulds the clay by measuring the ingredients and adjusting the velocity of the wheel, as the judge drafts her sentences by taking into consideration all relevant facts and laws, in light of secondary norms of interpretation and adjudication.

that an appropriate legal framework in terms of enforcement ‘necessarily involves a fair balance between the implementation of effective protection rules for intellectual property rights and the respect of the freedom of competition, of trade and industry, as well as fundamental rights. The procedures, measures and compensation introduced in order to combat counterfeiting effectively should thus take into account other competing rights such as the right to a fair trial, the right to the respect of privacy and freedom of expression.’

⁶ See in this sense for patent law C. A. Nard, ‘Patent Law’s Institutional Players’, in *Rethinking International Intellectual Property Law: What Institutional Environment for the Development and Enforcement of IP Law?*, op. cit., 71, stating that ‘courts are comparatively in the best position to make and develop patent law and policy’ ... and ‘suggesting that the nature of the judicial institution better positions the judge to engage patent law’s most important doctrines in a manner that is more consistent with the technologic communities that come before him’.

⁷ *eBay, Inc., v. MercExchange, LLC*, 126 S.Ct. 1837 (2006), at 1840.

⁸ X. Seuba, *The Global Regime for the Enforcement of Intellectual Property Rights*, 8 (Cambridge, Cambridge University Press 2017).

In addition to dynamism and flexibility, specialisation of the judiciary has become highly relevant in contemporary intellectual property litigation.⁹ How specialisation is realised offers various and heterogeneous responses.¹⁰ For instance, in some cases, already existing tribunals have become specialised by concentrating intellectual property cases under their sole jurisdiction. In other cases, new courts have been set up at the regional and national level to solely address intellectual property disputes.

Some courts may have jurisdiction over controversies related to all categories of intellectual property rights, while other courts address disputes concerning discrete intellectual property categories. Specialised dispute settlement bodies already exist, indeed, for patents, trademarks, copyrights and even plant varieties. In addition to specialisation that results from focusing only on certain intellectual property categories, intellectual property courts may have jurisdiction over either all types of disputes or just specific intellectual disputes. For example, some patent courts may rule only on the validity of patents, while other courts may decide both on infringement and validity.¹¹ Still, differences may derive from the hierarchy of the courts. In this respect, some judicial bodies with the primary mission to judge intellectual property disputes are first instance courts, others are second instance courts and still others are fully fledged tribunals, capable of deciding not only on first instance cases, but also appeals. Finally, while most specialised courts decide only on civil and border enforcement disputes, other courts may also rule on criminal matters related to intellectual property infringement.¹²

⁹ See on this issue in the context of the European Union, X. Seuba, Ch Geiger and L. Lu, 'The Evaluation and Modernisation of the Legal Framework for the Enforcement of Intellectual Property Rights. Comments of the CEIPI on the EU Commission's Public Consultation of December 2015, with a Focus on the Issue of Specialization of IP Courts', May 2016, Centre for International Intellectual Property Studies (CEIPI) Research Paper No. 2015-03, available at SSRN <<https://ssrn.com/abstract=2966839>>.

¹⁰ See in detail J. de Werra, in *Specialised Intellectual Property Courts – Issues and Challenges*, CEIPI-ICTSD Global Perspectives and Challenges for the Intellectual Property System, Issue 2, Geneva / Strasbourg, March 2016, p. 15 *et seq.*, available at <http://www.ceipi.edu/fileadmin/upload/DUN/CEIPI/Documents/Publications_CEIPI__ICTSD/CEIPI_ICTSD_N_2.pdf>.

¹¹ For a comparative analysis on the enforcement of patents, see C. A. Nard, *The Law of Patents*, 4th ed., 498–500 (New York, Wolters Kluwer Law Business, 2016), in particular the chapter 'Enforcing Patent Rights'.

¹² X. Seuba, 'Introduction', in J. de Werra et al., *Specialised Intellectual Property Courts – Issues and Challenges*, op. cit., 11. On the issue of criminal

Intellectual Property and the Judiciary provides a comprehensive picture of judicial specialisation in the area of intellectual property. Edited chapters capture not only regional and national experiences, but also global dynamics. In this regard, and with the objective of offering a comprehensive picture, this book pays attention to international dispute settlement bodies, human rights tribunals and arbitration panels, as well as specialised national courts and phenomena like technical specialisation. *Intellectual Property and the Judiciary* explores the role of the judiciary in the elaboration and implementation of intellectual property law, looking at the way intellectual property norms are applied in different court systems, be it in general or in specialised intellectual property courts and quasi-judicial bodies. The objective is to draw conclusions on the optimal design of the judiciary as well as on the training of members of intellectual property courts.

Intellectual Property and the Judiciary mostly compiles the chapters submitted by speakers of the conference of the European Intellectual Property Institutes Network (EIPIN) jointly hosted by the Center for International Intellectual Property Studies (CEIPI) of the University of Strasbourg and the Spangenberg Center for Law, Technology & the Arts, Case Western Reserve University School of Law, held 29 and 30 January 2016. On that occasion, CEIPI and the Spangenberg Center put together a roster of highly renowned speakers with very different backgrounds. Judges, international arbitrators, scholars and international public servants allowed us dig into the rich and complex relationship between dispute settlement and intellectual property. The reflection started in that conference has continued and informed the present volume.

The book is structured in three parts. In the first part, reflection on intellectual property and European courts is organised in three sections, touching upon intellectual property in front of the European Court of Human Rights (with chapters drafted by Christophe Geiger and Elena Izyumenko, and Aurora Plomer) and the relationship between copyright and human right to property before the European and international courts (with a chapter drafted by Thomas Cottier), intellectual property and the Court of Justice of the European Union (contributions by Jonathan Griffiths, Alain Strowel and Vincent Cassiers, and Stefan Lugienbuehl and Teodora Kandeve), the Unified Patent Court (with chapters drafted by Jens Schovsbo and Clement Salung Petersen, Sam Granata, and

enforcement in particular, see Ch Geiger (ed.), *Criminal Enforcement of Intellectual Property: A Handbook of Contemporary Research* (Cheltenham, UK/ Northampton, MA, Edward Elgar Publishing, 2012).

Xavier Seuba) and intellectual property and European quasi-judicial bodies (with contributions by Cees Mulder and Marcus O. Müller, Martin Ekvad, Gert Würtenberger, Stefan Martin and Alexander von Mühlendahl). The second part is devoted to American and Japanese courts and intellectual property adjudication. This part consists of chapters drafted by Kathleen O'Malley and Barbara Lynn, Toshiko Takenaka and Craig Nard. Finally, the last part is divided into chapters drafted by Susy Frankel, Peter Yu and Daniel Gervais who reflect on international intellectual property adjudication.

This work could not have been possible without the contribution of many people. First, naturally, the speakers in the conference and the contributors to this book. Second, all the EIPIN partners and in particular their representatives who chaired the panels and contributed to the success of the conference. And, last but not the least, Ms Tamar Khuchua, Researcher at CEIPI, who has carried out a tremendous job in the editing phase of the book.