

**Australian Attorney-General's Department**  
**Consultation on the Hague Convention on the Recognition and Enforcement of Judgments**

**Chapter 5 – Intellectual Property Matters**

**Question 7**

**Should intellectual property matters be included or excluded in the draft Convention (see Article 5(3) and Article 2, respectively)? To what extent should the circulation of intellectual property judgments be treated differently to that of other judgments under the draft Convention?**

The International Trademark Association (INTA) is a brand owner's association and as such, it is INTA's objective and mission to improve trademark and brand protection and support any initiatives that will benefit brand owners in the maintenance and enforcement of their rights and protect consumers. INTA has taken the position that the current draft Convention is an effective tool in the fight against increasing borderless IP infringements, counterfeiting and other violations.

Transactions these days are often conducted across borders where the source of an infringement may be geographically removed from the place where an action has an impact. In addition, infringers may attempt to avoid responsibility as determined in a court judgment by retreating to foreign jurisdictions, leaving the right owners with no available assets to enforce their claims against. Current options for enforcement of judgments in foreign jurisdictions vary widely from country to country and are often onerous, long lasting, costly and may even require a full blown procedure before the judgment is recognized. For IP infringements, this delay in being able to enforce a judgment in foreign jurisdictions may cause irreparable harm to the rights owner.

The inclusion of trademark judgments under the Hague Convention addresses these modern realities by providing the claimants with tools to counter the effects of online and cross-border infringements and follow the money, thus enabling them to enforce judgments at the source. To this effect, the Convention would create a unified, standardized procedure for recognition and enforcement of foreign judgments, which would provide brand owners with a cost effective and predictable mechanism to enforce Trademark rights. ..

While the main difference between judgments in IP matters and other judgments is rooted in the territoriality of IP rights, the current draft limits the circulation of IP judgments in the Convention – particularly in Art. 5.3 – to effectively balance the need to allow cross-border enforcement and the mandate to protect the principle of territoriality of IP rights. Along with

other safeguards embedded in the Draft, Art. 5.3 ensures that only those IP judgments which have been issued by a competent Court in the State of registration or protection of the IP right may circulate. In addition, the enforcement of IP judgments in the foreign jurisdiction is limited to the application of coercive measures to achieve the compliance of the debtor with the foreign court order - there is no determination of infringement or validity in the territory of the requested state, and hence the territoriality of the rights in question is preserved and protected. Finally, judgments which have been issued in violation of general principles of fair trial, due process or public order may also be refused recognition and enforcement in accordance with Art. 7.

**In summary, INTA has taken the position that the Draft Convention in its current design provides benefits to brand owners while at the same time containing the restrictions necessary to ensure the protection of the principles of territoriality of IP rights and judgments, and the sovereignty of States and their judiciary systems.**

**Question 8**

**If included in the draft Convention, what are your views on the scope of intellectual property rights as currently defined/categorised?**

In accordance with the last discussions during the Special Commission meetings, INTA expects that there will yet be a specific list of IP rights to be included in the Convention so as to ensure that there is a widely accepted definition of the IP rights the Convention should apply to.

**Question 9**

**Are the suggested discretionary safeguards in the draft convention adequate for intellectual property matters?**

INTA believes that the safeguards as contained in the current Draft Convention seem adequate (see above Answer 7) despite the fact that the discussions about details and open questions in this regard continue.

**Question 10**

**What are your views on the recognition and enforcement of monetary vs non-monetary judgments for infringement in intellectual property matters? Are there any other issues relating to intellectual property that should be addressed by the draft Convention?**

INTA has taken the position that the actionable injunctive parts of Trademark judgments should also be included under the Convention and be enforceable in foreign jurisdictions. For brand owners in infringement cases, the most important purpose of any action is obtaining cease and desist of the infringing conduct, compared to which the prospect of damage payments or other monetary awards rank secondary at best. Reducing the application of the Convention to monetary damages therefore eliminates a very important aspect of the Convention for brand owners. Without the enforcement of the actionable parts of the judgment (injunction), the cross-border advantage is all but eliminated as infringers could withdraw into foreign jurisdictions and continue the infringing conduct with impunity.