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DEPARTMENT OF COMMERCE

[3510-16-P]

United States Patent and Trademark Office

[Docket No.: PTO-P-2016-0046]

**Request for Comments and Notice of Public Meeting on a Preliminary Draft
Convention on the Recognition and Enforcement of Foreign Judgments Currently
Being Negotiated at The Hague Conference on Private International Law**

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Notice of public meeting; request for comments.

SUMMARY: The Hague Conference on Private International Law (“The Hague Conference”), an international organization in the Netherlands, is sponsoring negotiations for a convention on the recognition and enforcement of foreign judgments in civil and commercial matters. In February 2016, the Council on General Affairs and Policy of The Hague Conference created a Special Commission on the Recognition and Enforcement of Foreign Judgments (“the Special Commission”) to prepare a preliminary draft text of the convention, which is subject to a formal diplomatic negotiation open to member States of The Hague Conference. At its first session in June 2016, the Special Commission produced a Preliminary Draft Convention that contains general and specific provisions that would apply to the recognition and enforcement of judgments arising from transnational intellectual property disputes. The United States Patent and Trademark

Office (USPTO) seeks public comments on the June 2016 Preliminary Draft Convention (the “Preliminary Draft”) as it relates to intellectual property matters.

To assist the USPTO in determining the best way to address this topic, the USPTO will host a public meeting to obtain public input. The meeting will be open to the public and will provide a forum for discussion of the questions identified in this notice. Written comments in response to the questions set forth in this notice also are requested.

DATES: The public meeting will be held on January 12, 2017, beginning at 1:00 p.m. Eastern Standard Time (EST) and ending at 4:00 p.m. EST.

Public Meeting Registration Deadline: Registration to attend the public meeting in person or via webcast is required by January 5, 2017. Additionally, requests to participate in the public meeting as a speaker must be submitted in writing no later than December 29, 2016. See the “Event Registration Information” section of this notice for additional details on how to register and how to request to present as a speaker.

Written Comments: Written comments must be received on or before January 9, 2017.

ADDRESSES:

Event Address: The public meeting will be held in the USPTO Headquarters, Global Intellectual Property Academy (GIPA), Madison Building (East), Second Floor, 600 Dulany Street, Alexandria, Virginia 22314.

Written Comments: Interested parties are encouraged to file written comments electronically by email to judgmentsproject@uspto.gov. Comments submitted by email

should be machine-searchable and should not be copy-protected. Written comments also may be submitted by mail to the Office of Policy and International Affairs, United States Patent and Trademark Office, Mail Stop International Affairs, P.O. Box 1450, Alexandria, Virginia 22313–1450. Responders should include the name of the person or organization filing the comment, as well as a page number, on each page of their submissions. Paper submissions should also include a CD or DVD containing the submission in MS Word®, WordPerfect®, or pdf format. CDs or DVDs should be labeled with the name and organizational affiliation of the filer, and the name of the word processing program used to create the document. All personally identifiable information (for example, name, address, etc.) voluntarily submitted by the commenter may be publicly accessible. Do not submit confidential business information or otherwise sensitive or protected information. The USPTO will accept anonymous written comments (enter “N/A” in the required fields if you wish to remain anonymous).

All comments received are part of the public record and will be available for public inspection without charge via the USPTO’s Website at www.uspto.gov/learning-and-resources/ip-policy/hague-conference-private-international-law and at the Office of the Director, Policy and International Affairs, located in Madison West, Tenth Floor, 600 Dulany Street, Alexandria, Virginia 22314, upon request. Because comments will be available for public inspection, information that is not desired to be made public, such as name, an address or phone number, etc., should not be included in the written comments.

FOR FURTHER INFORMATION CONTACT: Requests for additional information should be directed to the attention of Michael Shapiro, Senior Counsel, Office of Policy

and International Affairs, USPTO, by telephone at 571-272-9300, or by email to judgmentsproject@uspto.gov.

SUPPLEMENTARY INFORMATION:

Background

The Hague Conference is sponsoring negotiations for a convention on the recognition and enforcement of foreign judgments. Following preparatory work on the draft convention by a Working Group beginning in 2012, in February 2016, the Council on General Affairs and Policy of The Hague Conference established a Special Commission to prepare a preliminary draft convention on the recognition and enforcement of foreign judgments in civil and commercial matters. The first meeting of the Special Commission took place June 1-9, 2016, at The Hague, Netherlands. The second meeting of the Special Commission is scheduled to take place February 16-24, 2017, at The Hague. The text of the Preliminary Draft produced at the first session of the Special Commission, along with other documents relating to the convention is available at:

<https://www.hcch.net/en/projects/legislative-projects/judgments/special-commission1>.

Brief Summary of the Draft Convention

The Preliminary Draft currently contains 16 articles organized into two chapters. Chapter I (Articles 1-3) sets forth the scope and definitions for the draft treaty. Chapter II (Articles 4-16) sets forth the basic rules governing the recognition and enforcement of judgments under the treaty.

Scope, Exclusions from Scope, and Definitions

The Preliminary Draft applies to the recognition and enforcement of judgments in a Contracting State of judgments relating to civil or commercial matters in another Contracting State (Article 1). The term “judgment” means any decision on the merits, including determinations of costs or expenses related to such decisions (Article 3).

Judgments related to revenue, customs, and administrative matters are excluded from the scope of the Convention (Article 1) as well as more specific subject matter such as family law matters, wills and succession, and insolvency, but judgments related to intellectual property matters (Article 2) are not excluded.

Bases for Recognition and Enforcement

The Preliminary Draft requires that a judgment of a court in a Contracting State (the “State of origin”) be recognized and enforced in another Contracting State (the “requested State”) without reviewing its merits (Article 4). Recognition and enforcement, however, may be refused but only under the grounds set forth in the treaty.

The Preliminary Draft sets forth the bases for recognition and enforcement of judgments (Article 5).

Of particular importance to the intellectual property community are paragraphs 5(1)(k) and 5(1)(l), which set forth the bases for the recognition and enforcement of judgments for infringements of a patent, trademark, design, or other similar right, and judgments on the validity or infringement of a copyright or a related right, respectively. It should also be noted (subject to Article 6, discussed below), a judgment in such an infringement case might also be enforceable if one of the other bases for recognition and enforcement of the

judgment set forth in Article 5 exists (for example, the person against whom recognition or enforcement is sought brought the claim on which the judgment is based) applies.

Exclusive Bases for Recognition and Enforcement

Notwithstanding Article 5, a judgment on the registration or validity of patents, trademarks, designs, or other similar rights that are required to be deposited or registered is eligible for recognition and enforcement in a requested State “if and only if” the State of origin is the State where the deposit or registration took place, or is deemed to have taken place under an international or regional instrument (Article 6). Judgments on the validity of copyrights or related rights, however, are not subject to the exclusive jurisdiction rule in Article 6. The Preliminary Draft also lists several bases on which a court of a Contracting State may refuse to recognize and enforce foreign judgments (Article 7).

Preliminary Questions

The Preliminary Draft bars the recognition and enforcement of rulings on the registration or validity of patents, trademarks, and designs, or other similar rights that arose as a preliminary question in courts other than those with exclusive jurisdiction under Article 6 (Article 8(1)). The Explanatory Note Providing Background on the Proposed Draft Text and Identifying Outstanding Issues (Prel. Doc. No. 2) provides the following example of a preliminary question: a ruling on the validity of a patent raised as a defense to an infringement claim (Prel. Doc. No. 2, para. 111). In such instances, however, a court may refuse or postpone the recognition or enforcement of a ruling on validity only (1) where the ruling is inconsistent with a judgment or a decision of a competent authority on

the matter or (2) where the proceedings on validity took place in the State with exclusive jurisdiction under Article 6 (Article 8(3)). A court may refuse to recognize a judgment “if, and to the extent that, it was based on” a ruling on registration or validity as a preliminary question by in courts other than those with exclusive jurisdiction under Article 6.

Damages and Other Remedies

The Preliminary Draft allows the court of the requested State to refuse recognition and enforcement of judgment awarding damages if and to the extent that those damages (including exemplary or punitive damages) do not compensate a party for actual loss or harm suffered (Article 9). The Preliminary Draft does not expressly address enforcement of judgments for injunctive relief. However, the Explanatory on the Preliminary Draft notes, without expressly mentioning injunctive relief, that “non-money judgments have been included in the scope of the Proposed Draft Text” (Prel. Doc. No 2, para. 52).

Questions Posed

The USPTO is seeking comments on the Preliminary Draft as it relates to intellectual property. Interested members of the public are invited to present written comments on any issues they believe to be relevant to protection of intellectual property or any aspect of the proposed Convention as it relates to intellectual property. Comments also are invited on any or all of the questions listed below.

As used in the Preliminary Draft, the term “intellectual property rights” includes patents, trademarks, designs, and copyrights or related rights. If your response does not apply to

all of these intellectual property rights, please state the specific intellectual property right, or rights, to which your response applies. Other intellectual property rights that are outside the scope of the current text of the Preliminary Draft, such as trade secrets, are identified separately in this notice where appropriate.

With respect to these and any other issues raised by the Preliminary Draft, in your responses, please: (1) clearly identify the matter being addressed; (2) provide examples where appropriate; (3) identify any relevant legal authorities to support your comment; (4) indicate approaches and provisions that are unacceptable; and (5) express preferences for approaches, effective solutions to specific challenges, and drafting recommendations to address the matter being addressed.

1. What are your experiences in having U.S. judgments involving intellectual property matters recognized and enforced in foreign courts?
2. What are the benefits, if any, of increasing the recognition and enforcement of U.S. judgments involving intellectual property matters in foreign courts through joining a multilateral treaty?
3. What are your experiences in having foreign judgments recognized in U.S. courts, including on the basis of comity or under state statutes?
4. What are the risks, if any, of increasing the recognition and enforcement of foreign judgments involving intellectual property matters by U.S. courts through joining a multilateral treaty?

5. Are uniform rules for international enforcement of intellectual property judgments desirable?
6. What impact, if any, would the territorial nature of intellectual property rights have on enforcing rights across borders?
7. What impact, if any, would differences in procedural practices across borders have on enforcing intellectual property rights across borders?
8. What impact, if any, would differences in substantive law have on enforcing intellectual property rights across borders?
9. Would this convention have any disproportionate effects on a particular technology sector? If so, which ones and how?
10. Please identify problems that could occur from recognizing or enforcing judgments rendered on intellectual property matters in other Contracting States that have policies or laws that are inconsistent with U.S. intellectual property laws and policies.
11. Please identify any challenges with respect to enforcement in foreign courts of U.S. judgments, or in U.S. courts of foreign judgments, involving intellectual property matters.
12. How often are U.S. nationals also foreign intellectual property owners who would then be able to use this Convention to have judgments they obtain in foreign courts enforced by U.S. courts? Would that be useful for U.S. nationals?

13. What changes, if any, to U.S. law would be needed to implement the proposed convention? Please identify any drawbacks and/or advantages to such changes.

14. What effect, if any, would the Preliminary Draft have on the enforcement of intellectual property rights in the digital environment? In particular, should the language in the Preliminary Draft be revised to take into account issues that arise in connection with infringement and enforcement of intellectual property rights on the Internet?

Exclusions from Scope

15. Should judgments on the validity and/or the infringements of intellectual property rights, other than copyright and related rights, be excluded from the scope of the treaty under Article 2(2)? Please identify the specific intellectual property right at issue and the specific concerns, if any, raised by including it within the scope of this convention?

16. Should judgments on the validity, ownership, subsistence, and/or the infringement of copyright and related rights be excluded from the scope of the treaty under Article 2(2)? Please state the specific concerns, if any, raised by including copyrights or related rights within the scope of this convention.

17. Should judgments on the validity or misappropriation and/or theft of trade secrets be excluded from the scope of the treaty under Article 2(2)? Please state the specific concerns, if any, raised by including judgments on the validity or misappropriation and/or theft of trade secrets within the scope of this convention.

Bases for Recognition and Enforcement

18. Should judgments on the infringement of intellectual property rights, other than copyright and related rights, be included as bases for recognition and enforcement in Article 5(1)(k)?
19. Should judgments on the infringements of plant breeders' rights be included in Article 5(1)(k)?
20. Should judgments on the infringements of service marks, trade dress, and geographical indications rights be expressly included in Article 5(1)(k)?
21. Should judgments on the validity or infringement of unregistered designs and trademarks be included in Article 5(1)(l)?
22. Should judgments on the validity or the misappropriation and/or theft of trade secrets be included in Article 5(1)(l)?
23. Should the bracketed language in Article 5(1)(l) be included?
24. Should judgments on the validity, ownership, subsistence or infringement of copyright or related rights be included in Article 5(1)(l) in cases where the right arose under the law of the State of origin?
25. Should such judgments be included **in** Article 5(1)(l) where the right did not arise under the law of the State of origin but where another basis for jurisdiction set forth in Article 5 is satisfied?

Exclusive Jurisdiction

26. With respect to a judgment on the registration or validity of patents, trademarks, designs, or other similar rights that are required to be deposited, registered, or issued, the Preliminary Draft provides for exclusive jurisdiction of the court in the State of origin where the right issued or registration took place, or is deemed to have taken place under an international or regional instrument (Article 6). Please comment on the appropriateness of this rule.

27. Should a judgment on the registration or validity of mask works or vessel designs that are required to be deposited, registered, or issued be included in Article 6?

Preliminary Matters

28. What are your experiences in having U.S. rulings on preliminary questions, or judgments based on such rulings, involving the registration or validity of patents, trademarks, and designs, or other similar rights, by courts other than those with exclusive jurisdiction recognized and enforced by a foreign court?

29. Should a judgment on the registration or validity of mask works or vessel designs that are required to be deposited, registered, or issued be included in Article 8?

30. Does Article 8 provide an appropriate framework for resolving problems, if any, related to recognition and enforcement of rulings on preliminary questions and judgments based on such rulings?

31. How much discretion should a court in the requested State have to refuse or postpone the recognition or enforcement of a ruling on the validity of a patent, trademark, design, and other similar rights raised as preliminary matter in a court in the State of origin?

Remedies

32. Article 9 provides that recognition or enforcement of a judgment may be refused if, and to the extent that, the judgment awards damages, including exemplary or punitive damages, that do not compensate a party for actual loss or harm suffered. Should the court in a requested State be allowed to recognize and enforce non-compensatory damages in judgments involving intellectual property matters?

33. Does Article 9 include the types of damages that would provide effective relief for intellectual property right owners? If not, what other types of damages or other remedies ought to be included? Why?

34. How should statutory damages for copyright infringement be treated under this Article, and should Article 9 be amended to address statutory damages expressly?

35. When a judgment for infringement of an intellectual property covered by the convention includes injunctive relief, should a court in the requested State be required to recognize and enforce the award of injunctive relief?

36. If so, should there be any limitation on the circumstances under which such awards should be recognized and enforced (for example, by specifying the limitation in Article 5)? If not, should a judgment for infringement of an intellectual property right

covered by the convention that includes injunctive relief be excluded as a basis for recognition and enforcement, or whole or in part, under Article 5?

Event Registration Information: To register to attend or to request to present as a speaker, please send an email message to judgmentsproject@uspto.gov and provide the following information: (1) your name, title, company or organization (if applicable), address, phone number, and email address; (2) whether you wish to attend in person or via webcast; and (3) whether you wish to make an oral presentation at the meeting and, if so, which question(s) identified in the supplementary information section of this notice will be addressed and the approximate desired length of your presentation. Each attendee, even if from the same organization, must register separately. In order to give all speakers a meaningful opportunity to speak, the USPTO may not be able to accommodate all persons who wish to make a presentation. However, the USPTO will attempt to accommodate as many persons as possible who wish to make a presentation. After reviewing the speaker requests and the information regarding the presentations provided in the requests, the USPTO will contact each speaker prior to the event with the amount of time available and the approximate time that the speaker's presentation is scheduled to begin. The amount of time available for each speaker presentation and selected speakers without a formal presentation may be limited to ensure that all persons selected to speak will have a meaningful opportunity to do so. Speakers who opt to employ slides as part of their presentation must send final electronic copies of the slides in Microsoft PowerPoint® to judgmentsproject@uspto.gov by January 5, 2017, so that the slides can be displayed at the meeting. Additionally, and only if time allows, the USPTO will provide an opportunity for persons in the audience, who did not register as speakers or

were not selected as speakers, to speak at the meeting without a formal presentation. For more information on the meeting, including webcast access instructions, agenda, and a list of speakers, please visit USPTO's Website at www.uspto.gov/learning-and-resources/ip-policy/hague-conference-private-international-law. If special accommodations due to a disability are needed, please inform the contact person(s) identified under the heading FOR FURTHER INFORMATION CONTACT.

November 14, 2016.

Date

Michelle K. Lee,

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office.

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