

Global Perspectives and Challenges for the Intellectual Property System

A CEIPI-ICTSD publication series



Specialised Intellectual Property Courts– Issues and Challenges

Jacques de Werra

With contributions by

Denis Borges Barbosa and Pedro Marcos Nunes Barbosa, Hong Xue, Shamnad Basheer
and Susan Isiko Štrba



International Centre for Trade
and Sustainable Development



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Abbreviations and Acronyms

ADR	alternative dispute resolution
ARIPO	African Regional Intellectual Property Organization
CAFC	Court of Appeal for the Federal Circuit
ccTLD	country code top level domain
CCJE	Consultative Council of European Judges
CPC	Communist Party of China
EAC	East African Community
EPC	European Patent Convention
EPO	European Patent Office
EU	European Union
gTLD's	global top level domain name extensions such as .com and .org
IBA	International Bar Association
IPI	International Intellectual Property Institute
INDRP	Indian Domain Name Dispute Resolution Policy
INPI	Brazilian Patent and Trademark Office
INTA	International Trademark Association
IP	intellectual property
IPAB	Intellectual Property Appellate Board
IPEC	Intellectual Property Enterprise Court
JEC	Judicial Education Committee
LDC	least developed countries
NPC	National People's Congress
OHIM	Office for Harmonization in the Internal Market
PCC	Patents County Court
PPP	Patent Pilot Program
RTI	Right to Information
SIC	specialised intellectual property courts
SIMCA	South Indian Music Companies' Association
SPC	Supreme People's Court
STJ	Superior Tribunal de Justiça
TIPO	Taiwan Intellectual Property Office
TRIPS Agreement	Agreement on Trade-Related Aspects of Intellectual Property Rights
UDRP	Uniform Domain Name Dispute Resolution Policy
UPC	Unified Patent Court
USPTO	United States Patent and Trademark Office
WIPO	World Intellectual Property Organization
WPPT	WIPO Performances and Phonograms Treaty
WTO	World Trade Organization

Foreword

The Centre for International Intellectual Property Studies (CEIPI) and the International Centre for Trade and Sustainable Development (ICTSD) are pleased to present the second issue of the publication series on Global Perspectives and Challenges for the Intellectual Property System. This second issue continues to develop what the publication series intends to provide: high quality academic and policy-oriented papers dealing with topics that are of global relevance because of their normative pre-eminence, economic relevance and socioeconomic impact.

CEIPI and ICTSD decided to launch this common project convinced by the synergies existing between both organisations. We share a common interest in intellectual property (IP) as a tool for innovation, development and the pursuit of broader societal interests, being profoundly engaged in knowledgeable and informed reflection and international debates touching upon how intellectual property can fulfil these important goals. This series of papers aims, therefore, at provoking consideration of contemporary issues thanks to the collaboration of recognised professors and experts, giving voice to them, enriching the academic debate and feeding policymakers with high quality materials.

The present volume deals with issues and challenges around specialised IP courts. As noted in the introduction, the diversity of special IP tribunals is remarkable. The courts may have jurisdiction over controversies related to all categories of intellectual property rights or simply with respect to certain intellectual property categories.

The series editors invited Professor Jacques de Werra from the University of Geneva to write the lead article of this second issue. As highlighted by de Werra, under the TRIPS Agreement countries have the option to create specialised IP courts and on this basis, countries are free to decide what types of judicial body or bodies have the jurisdiction to hear disputes. In this respect, the experience in both developed and developing countries varies. Jacques de Werra concludes that how advantageous or necessary it is to establish specialised IP courts in a given jurisdiction depends on a number of factors that go beyond IP. Rather, this determination should take into account more general factors, including economics, the legal system and societal characteristics. Thus, the creation of specialised IP courts cannot be recommended in all circumstances. A decision relating to the establishment of specialised IP courts must consequently be made on the basis of a fully informed, transparent and unbiased analysis of the situation prevailing in the relevant territory.

The lead article is complemented by important contributions made by distinguished scholars on the current situation on specialised IP courts in the jurisdictions of Brazil, China, India and Uganda.

The series wishes to reach a broader audience, ranging from academics to public officials, including civil society, experts, business advisers and the broad membership of the intellectual property community. We also have in mind the actual implementation of intellectual property – how IP works in practice – without losing sight of public policy objectives, including its intersection with innovation, creativity and sustainable development goals.

We sincerely hope you will find this second issue of the series a useful contribution to a better understanding of the complexities of the interface between intellectual property and sustainable development goals.



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Introduction

Xavier Seuba

Introduction

Lack of enforcement of a particular legal system puts into question its actual relevance. In the case of intellectual property, the significance of enforcement has been expressed in many different ways. Sometimes delicate metaphors — “without effective enforcement, IPRs are nothing but empty shells”¹ — have been made, and on other occasions the relevance of enforcement has been conveyed in a more descriptive fashion. For instance, “the value of intellectual property rights depends in practice on whether the holder can take effective measures to prevent others from infringing them,”² or “without effective remedies for the enforcement of these rights, the rights are worthless.”³ It is in this context that the relevance of intellectual property litigation must be assessed. Judicial adjudication and enforcement transforms substantive protection into reality and, equally important, places intellectual property norms in connection with the norms integrating the broader legal framework to which they belong.

The International Centre for Trade and Sustainable Development (ICTSD) and the Centre for International Intellectual Property Studies (CEIPI) share a strong interest in the relationship between the judiciary and intellectual property. ICTSD has organised a number of forums and seminars addressed to judges sitting in high courts and national specialised bodies ruling on intellectual property cases. CEIPI has recently set up the first training programme for the judges of the Unified Patent Court, and judicial bodies were the focus of analysis for the conference on *Intellectual Property and the Judiciary* convened at the CEIPI in January 2016. The shared interests of ICTSD and CEIPI and the rising policy and academic attention that the phenomenon of judicial specialisation in intellectual property attracts form the background of the second issue paper of the *CEIPI/ICTSD Publication Series Global Perspectives and Challenges for the Intellectual Property System*.

The diversity of specialised intellectual property tribunals is notable. These courts may have jurisdiction over controversies related to all categories of intellectual property rights or simply with respect to certain intellectual property categories. Specialist dispute settlement bodies already exist, in fact, for patents, trademarks, copyrights, and even plant varieties. Whether with respect to all intellectual property categories or merely regarding a specific category, intellectual property courts may have jurisdiction over either all types of disputes or just specific intellectual disputes. For instance, some patent specialist courts may rule only on the validity of patents, while other courts may decide both on infringement and validity disputes. Further, some judicial bodies with the primary mission to judge intellectual property disputes are first instance courts; others are second instance courts; still others are fully fledged tribunals, capable of deciding not only on first instance cases, but also on appeals. Finally, but without being exhaustive, 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.

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- 1 Hilty, RM. “Economic, legal and social impacts of counterfeiting,” in Ed. C Geiger. *Criminal Enforcement of Intellectual Property: A Handbook of Contemporary Research*, Edward Elgar, Cheltenham, UK and Northampton, MA, 2012, p. 11.
 - 2 Stauder, D. “Enforcing industrial property rights: Patent protection from a comparative viewpoint,” in: Eds. C. Heath and K. Sanders. *New Frontiers of Intellectual Property Law: IP and Cultural Heritage, Geographical Indications, Enforcement and Overprotection*, Hart Publishing, Oxford and Portland, Oregon, 2005, p. 291.
 - 3 Blair, RD and TF Cotter (2005) *Intellectual Property: Economic and Legal Dimensions of Rights and Remedies*. Cambridge University Press, Cambridge, p. 2.

As Jacques de Werra states in the leading paper of the second volume of the CEIPI-ICTSD edited series, it is difficult to give a simple and unique answer to the question of whether it is beneficial to establish specialised intellectual property courts. This clearly results from the comparison of the analysis of the situations in Brazil, India, China, and Uganda made by Denis Borges Barbosa, Pedro Marcos Nunes Barbosa, Shamnad Basheer, Hong Xue, and Susan Isiko Štrb. On the one hand, the diversity of intellectual property disputes suggests following different approaches with respect to different categories of intellectual property rights. In this sense, specialisation may be particularly relevant in the area of patents, given the technical and scientific complexities of the field. On the other hand, in each and every national situation presented in this issue of the CEIPI/ICTSD publication series, specialisation has adopted different forms and has produced different outcomes. This is due to a wide array of factors, which include national legal traditions, legal systems, human resources constraints, local industrial development status, and the more diffuse but equally important stance of the country with respect to the function of intellectual property rights.

Even if specialisation may contribute to improving the management and enforcement of intellectual property, it should not be confused with setting up bodies exclusively devoted to the adjudication of intellectual property disputes. Specialist courts are probably the paramount example of specialisation, but by no means the sole example, and not even the most important one. In practice, other mechanisms enhancing specialisation are easier to implement and represent the first step toward deeper specialisation. Authors in this volume agree that specialisation by concentration of cases in some courts or by certain judges is an optimal way to initially respond to the complexities of intellectual property litigation. This may entail creating specialist intellectual property benches within regular courts or just informally assigning intellectual property cases to selected judges. Other measures along this line would be providing adequate and continuous training to judges, ensuring that magistrates remain in office for a certain period, and setting up appropriate eligibility criteria so that judges familiar with intellectual property law and with expertise in technical areas are appointed.

Advantages and disadvantages of specialisation are introduced in de Werra's paper and tested by the authors integrating this volume. Advantages can be summarised in the improvement of the quality of justice and the capacity to respond to the dynamic development of intellectual property law, the enhanced efficiency of the proceedings in terms of time and cost, the increased consistency and uniformity of jurisprudence, and the reduction of forum shopping. Certainly, these advantages cannot always be observed, and their intensity may change from institution to institution and in each specific area of intellectual property litigation.

Among the disadvantages of specialisation, there is coincidence in the costs of establishing and operating an intellectual property court, the possible political or economic influences being placed on the court, and the possibility of developing what De Werra calls "tunnel vision." In this same context, the focus of specialised courts may be too narrow, and courts may not fully take into account the broader legal and policy framework that surrounds intellectual property disputes. In this sense, for instance, it will be interesting to see how the Unified Patent Court will integrate into its jurisprudence fundamental pillars of European Union law, such as competition law and human rights law. Likewise, the possibility — or not — to appeal to a higher, not specialised, court may also be a key to addressing such "tunnel vision." Finally, concerns have also been expressed on possible

problems for access to justice, since specialised courts may sit far from the domicile of parties to intellectual property disputes.

Contrary to a relatively widespread belief holding that specialist intellectual property courts tend to benefit right holders, two papers in this volume hold that there is no direct relation between creating specialised courts and increased levels of protection. Some of the national cases presented depict that newly created specialised bodies have adopted stricter standards when adjudicating both infringement and validity cases. Two other papers underline that specialisation is part of a tendency to strengthen intellectual property protection and enforcement, a progression that is unlikely to ensure a more balanced intellectual property system, since judges of these courts could overemphasise the exclusiveness of intellectual property rights, as Hong Xue explains.

An international perspective could be added to the experiences presented in this volume. A range of international bodies oversee implementation of intellectual property obligations undertaken by states. To the extent that these bodies compel or ensure compliance with those obligations, they can be considered international enforcement institutions. Their objective is achieved by the activation of dispute settlement mechanisms or the application of political pressure. In this respect, international bodies may also enhance enforcement through systems based on state monitoring and reporting.

Many international intellectual property treaties set up or permit setting up dispute settlement bodies, and describe their institutional shaping and the dispute settlement methods administered. Some implement diplomatic or political means for dispute settlement, while others administer truly judicial or quasi-judicial dispute settlement methods. Certainly, other treaties belonging to areas, such as foreign investment, environment, or human rights also set up dispute settlement bodies that may eventually decide intellectual property-related disputes. Indeed, the most successful bodies for the settlement of international intellectual property disputes are those related to the settlement of trade disputes, notably — but not only — the World Trade Organization panels and Appellate Body. More recently, the settlement of intellectual property disputes in the context of foreign investment treaties has also become a controversial option. Hence, specialisation and jurisdictional overlaps are also relevant from a strictly international point of view and, therefore, constitute an area of further research.

Part One

Specialised IP Courts: Issues and Challenges

Jacques de Werra

Executive Summary

Under the TRIPS Agreement (Art. 41 para. 5) countries are given the option to create specialised intellectual property (IP) courts. On this basis, countries are free to decide what types of judicial body or bodies have the jurisdiction to hear IP disputes. Although IP disputes are sometimes primarily viewed as relating to the enforcement of intellectual property rights against counterfeiters (specifically in the copyright and trademark areas), the reality and the landscape of IP disputes are much more complex. The diversity of IP disputes makes it difficult to give a simple and unique answer to the question of whether it is advantageous or necessary to establish specialised IP courts. This diversity is also reflected in the way in which national or regional lawmakers and regulators have structured their IP dispute resolution systems. While recent studies demonstrate that there is no unique global system or even a prevailing system, a trend towards specialisation or centralisation of certain types of IP disputes seems perceivable at the global level. However, this trend does not eliminate the differences which remain, particularly regarding the scope of the jurisdictional power of specialised IP courts.

There are various advantages and disadvantages in establishing a specialised IP court. Improvements in the quality of justice, time and cost efficiencies of the proceedings, as well as consistency and uniformity, are among the advantages that are generally identified. In terms of disadvantages, reference is generally made to the costs of establishing and of operating a specialised IP court. In addition, some have expressed concerns that such a court may become subject to political or economic influences and may develop 'tunnel vision' deriving from mainstream legal and societal movements.

Given the diversity of legal systems and regimes, there is no single method for establishing an efficient IP court system that promotes innovation and social welfare. Similarly, there is no clear evidence that specialised IP courts more effectively promote innovation vis-à-vis non-specialised courts in all circumstances. However, it is clear that a sufficient level of experience and expertise among the courts and judges can significantly improve the quality of justice in IP disputes.

How advantageous or necessary it is to establish specialised IP courts in a given jurisdiction depends on a number of factors which are not limited to IP issues. Rather, this determination will take into account more general factors, including economics, the legal system and societal characteristics. Thus, the creation of specialised IP courts cannot be recommended in all circumstances. A decision relating to the establishment of specialised IP courts must consequently be made on the basis of a fully informed, transparent and unbiased analysis of the situation which prevails in the relevant territory.

1.1 Introduction

Given that '[s]pecialization is a hallmark of modern society',¹ it is no surprise that specialisation has also affected the legal world: the practice of law tends to foster (or even to require) legal specialisation in view of the growing complexity of legal issues. Specialisation can similarly affect the court system and thus raises the question of whether specialised courts are needed and whether they can bring value. However, whether it is advantageous or necessary to set up specialised courts is a broad and complex issue which is not limited to intellectual property disputes.²

The policy choice of a country to create specialised courts for (certain types of) intellectual property disputes is expressly left open by the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement). Art. 41 para. 5 TRIPS provides that there is no obligation imposed on World Trade Organization (WTO) Member States to establish a judicial system that is distinct from general law enforcement and that nothing in the TRIPS chapter on enforcement 'creates any obligation with respect to the distribution of resources as between enforcement of intellectual property rights and the enforcement of law in general'.³

On this basis, countries remain free to decide what types of judicial bodies have the jurisdiction to hear intellectual property disputes. The freedom of choice and the flexibilities which are granted to Member States under the TRIPS Agreement can sometimes be reduced or even eliminated by bilateral or regional treaties for the purpose of increasing the protection of intellectual property rights ('TRIPS-plus'). However, this trend is not clearly perceivable with respect to the creation of specialised intellectual property courts. Bilateral or regional treaties generally do not require the creation of specialised intellectual property courts,⁴ subject to specific types of disputes for which submission to specialised alternative dispute resolution mechanisms may be required.⁵

1 See Lawrence Baum, *Specializing the Courts* (University of Chicago Press, 2011), p. 1.

2 See Baum, *Specializing the Courts*; Stephen H. Legomsky, *Specialised Justice* (Oxford University Press, 1990); see also Markus B. Zimmer, 'Overview of Specialized Courts', *International Journal for Court Administration* (Aug. 2009): 1 (<http://www.iaca.ws/files/LWB-SpecializedCourts.pdf>); Edward Cazalet, 'Specialised Courts: Are They a "Quick Fix" or a Long-Term Improvement in the Quality of Justice? A Case Study', Mar. 2001 (<http://siteresources.worldbank.org/INTLAWJUSTINST/Resources/SpecializedCourtsCazadet.pdf>).

3 'It is understood that this Part does not create any obligation to put in place a judicial system for the enforcement of intellectual property rights distinct from that for the enforcement of law in general, nor does it affect the capacity of Members to enforce their law in general. Nothing in this Part creates any obligation with respect to the distribution of resources as between enforcement of intellectual property rights and the enforcement of law in general.'

4 Quite to the contrary, certain bilateral free trade agreements reflect the freedom enshrined in Art. 41 para. 1 TRIPS. This is, for instance, the case with the bilateral free trade agreement between the United States and Panama which entered into force on 31 Oct. 2012, which provides (Art. 15.11 para. 2) that: 'This Article does not create any obligation: (a) to put in place a judicial system for the enforcement of intellectual property rights distinct from that for the enforcement of law in general; or (b) with respect to the distribution of resources for the enforcement of intellectual property rights and the enforcement of law in general' (see http://www.ustr.gov/sites/default/files/uploads/agreements/fta/panama/asset_upload_file131_10350.pdf).

5 This is what has been done for certain internet domain name disputes: see e.g. Art. 15.4 of the USA-Panama free trade agreement (see note 4) which provides that: '1. In order to address trademark cyber-piracy, each Party shall require that the management of its country-code top-level domain (ccTLD) provides an appropriate procedure for the settlement of disputes based on the principles established in the *Uniform Domain-Name Dispute Resolution Policy*.'

1.2 Specialised Courts for Intellectual Property Disputes

Concept of specialised IP courts

The concept of specialised IP courts must be clarified from the outset: a specialised IP court can be defined as an independent⁶ public judicial body⁷ which has the primary mission to adjudicate certain types of disputes relating to intellectual property rights at the national or regional level,⁸ whereby such court can also be charged with the adjudication of other types of disputes beyond IP disputes.⁹

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- 6 See, by way of example, Art. 2 of the Swiss Federal Act on the Federal Patent Court of 20 Mar. 2009 (the text in English – unofficial version – is at <http://www.admin.ch/opc/en/classified-compilation/20071763/index.html>): 'The Federal Patent Court is *independent* in its adjudication and is bound only by the law' (emphasis added).
- 7 The terms "Public judicial body" make it clear that an IP specialised court is an official and public institution. This means that it is a judicial body which meets all the relevant requirements which are generally expected from judicial bodies (in terms of independence and impartiality etc.) and that it has the jurisdictional power to render enforceable judgments. An IP specialised court must consequently be distinguished from (private or public) providers of alternative dispute resolution services (such as mediation or arbitration) which do not lead to court judgments (but potentially to arbitral awards or settlements) and which do not as such have any power to render decisions or judgments. By way of example, the World Intellectual Property Organization (WIPO) Arbitration and Mediation Center is a provider of services for the alternative resolution of (intellectual property) disputes which does not render decisions on disputes. It must be noted that the TRIPS Agreement requires (in its Chapter III on enforcement) that certain disputes shall be submitted to judicial authorities: see Art. 41 para. 4: 'Parties to a proceeding shall have an opportunity for review by a judicial authority of final administrative decisions [...]'; see also Art. 31 ('An opportunity for judicial review of any decision to revoke or forfeit a patent shall be available'); Art. 62 para. 5 further provides that 'Final administrative decisions in any of the procedures referred to under paragraph 4 [e.g. procedures concerning the acquisition or maintenance of intellectual property rights] shall be subject to review by a judicial or quasi-judicial authority'. As this results from this last provision, a judicial authority can be assimilated to a quasi-judicial authority, which indicates that the distinction between these institutions and concepts may be difficult to make in certain cases; the identification of the legal nature (i.e. judicial or quasi-judicial) of adjudicatory authorities can particularly be debated about bodies which have been instituted under regional IP agreements, such as the boards of appeal of the European Patent Office (EPO) and of the Office for Harmonization in the Internal Market (OHIM); for the boards of appeal of the EPO, see Art. 23 para. 3 of the European Patent Convention (EPC: Convention on the Grant of European Patents of 5 Oct. 1973 as revised by the Act revising Art. 63 EPC of 17 Dec. 1991 and the Act revising the EPC of 29 Nov. 2000, at <http://www.epo.org/law-practice/legal-texts/html/epc/2013/e/ma1.html>) which provides that 'In their decisions the members of the Boards shall not be bound by any instructions and shall comply only with the provisions of this Convention': see also the Case Law of the Boards of Appeal, VII. Institutional matters, 1.1. A specialised court exercising judicial authority (indicating that the EPO boards of appeal (as resulting from its case law) 'may be seen as having the status of judicial authorities' or 'at least a quasi-judicial authority as referred to in Art. 62(5) TRIPS'), at http://www.epo.org/law-practice/legal-texts/html/caselaw/2013/e/clar_vii_1_1.htm; a consultation was launched on 30 Apr. 2015 on the reform to the EPO boards of appeal (<http://www.epo.org/news-issues/news/2015/20150430.html>) the goals of which are to increase the organisational and managerial autonomy of the boards of appeal, the perception of their independence (enshrined in Art. 23 EPC) and also their efficiency, in order to respect the principle of effective legal protection within the legal framework of the current EPC; these IP institutions which have been established in order to decide on the validity of certain industrial property rights will not be analysed separately in this paper, since they raise issues which are essentially similar to the ones that shall be discussed in this paper.
- 8 This paper will not address the issue of international intellectual property disputes which arise between countries (and that can potentially be submitted to the WTO Dispute Resolution mechanism) and of international investment disputes which oppose countries to private parties/foreign investors that can potentially be submitted to international dispute settlement mechanisms under the relevant agreements (potentially International Centre for Settlement of Investment Disputes arbitration), even if these types of disputes seem to play a growing role in the international intellectual property dispute resolution landscape, as evidenced by the Australian cigarette 'plain packaging' dispute under the WTO (cases DS434, DS435, DS441, DS458 and DS467) and under a bilateral investment treaty (Hong Kong – Australia): see <http://www.ag.gov.au/Internationalrelations/InternationalLaw/Pages/Tobaccoplainpackaging.aspx>; given that these disputes are submitted to dispute settlement bodies which do not focus only on IP disputes, these dispute settlement bodies cannot be assimilated to specialised IP courts and will consequently not be analysed in this paper.
- 9 This means that a court can be viewed as a (de facto) specialised IP court if IP disputes constitute the major part of the court's caseload/docket; this is the case of the US Court of Appeals for the Federal Circuit which has the exclusive jurisdictional power to decide on appeals relating to patent disputes, even if the Court also has jurisdiction to decide on matters which are not related to patents; see Circuit Judge Alan Lourie, State of the Court Address at the Federal Circuit Bar Association Bench and Bar Conference on 19 June 2014 (<http://www.fedcirbar.org/olc/filelib/LVFC/cpages/9008/Library/Circuit%20Judge%20Lourie%20State%20of%20the%20Court%20Address%20June%202014.pdf>), p. 2 ('The

The nature of intellectual property disputes and the delimitation of the jurisdictional powers of specialised IP courts further call for a definition of the concepts of intellectual property rights and of intellectual property disputes that fall within the ambit of the jurisdictional power of the relevant courts.¹⁰

Broad diversity of IP disputes and of national and regional IP dispute resolution systems

Intellectual property disputes are sometimes associated primarily with disputes relating to the enforcement of intellectual property rights against counterfeiters (specifically in the copyright and trademark areas).¹¹ However, the reality and the landscape of IP disputes are much more complex: disputes relating to intellectual property rights can be very diverse. This diversity results from the differences between the types of IP rights and between the legal regimes on which they are based, as well as from the specific legal issues that can arise for certain types of intellectual property rights.

For example, in the field of copyright law (and of related rights), disputes can arise about the determination of tariffs which set out the terms and conditions of use and regarding the remuneration of copyright protected works (or of the objects protected by related rights). These disputes are frequently submitted to specific adjudicatory bodies and to specific procedural rules which are generally different from those applicable to other IP disputes.¹² Reference can also be made to the grant of compulsory licences under patent law for which specific substantive and procedural rules have been adopted.¹³ Certain legal systems have also adopted special rules relating to the remuneration owed to employees as a result of the inventions that they have made for the benefit of their employer, which can generate another type of IP dispute.¹⁴

patent cases have certainly been increasing. In the last 12-month period for which we have data, total patent cases from the district courts, the Patent Office, and the ITC [International Trade Commission] have crept up to 55% of our case load. I think that is a historic high'); see also the definition made in *International Survey of Specialised Intellectual Property Courts and Tribunals* by the International Bar Association Intellectual Property and Entertainment Law Committee (London, Sept. 2007) (hereinafter 'the IBA Survey'), at <http://www.ibanet.org/Document/Default.aspx?DocumentUid=7F5A1221-6C07-4CE7-A628-1F457A2433A5>, pp. 4–5: 'a permanently organised body with independent judicial powers defined by law, consisting of one or more judges who sit to adjudicate disputes and administer justice in the IP field'; see also Jumpul Pinyosinwat, 'A Model for Specialized Intellectual Property Court in Developing Countries' (thesis submitted in partial fulfilment of the requirements for the degree of Doctor of Laws, Faculty of Law, Waseda University, 2010), at <http://dspace.wul.waseda.ac.jp/dspace/bitstream/2065/36551/3/Honbun-5664.pdf>; the Court of Justice of the Andean Community can be considered as a specialised IP court given that its caseload essentially consists of IP cases, see Giovanni Molano Cruz and Stephen Kingah, 'Addressing Human Rights in the Court of Justice of the Andean Community and Tribunal of the Southern African Development Community (SADC)', UNU-CRIS Working Papers, W-2014/1, p. 14 (<http://www.cris.unu.edu/fileadmin/workingpapers/W-2014-1.pdf>) (noting that more than 90 per cent of the rulings rendered by the court involve intellectual property rights disputes).

- 10 See, by way of example, the UK case *Ningbo Wentai Sports Equipment Co Ltd v. Wang* [2012] EWPC 51 in which the Patents County Court (PCC) (now replaced by the Intellectual Property Enterprise Court) held that it has jurisdiction over an action for breach of confidence; as will be discussed below, one difficulty of specialised IP courts is to clearly delineate the specific jurisdictional power of these courts and the general power of generalised courts, see text at notes 92–5.
- 11 Reference can be made here to 'counterfeit trademark or pirated copyright goods' as used in Art. 51 TRIPS (as defined in note 14 of the TRIPS Agreement, see https://www.wto.org/english/docs_e/legal_e/27-trips_05_e.htm#Footnote14).
- 12 By way of example, in the United Kingdom, the Copyright Tribunal has the power to set the tariffs (see <http://www.ipo.gov.uk/ctribunal.htm>).
- 13 See Art. 31 TRIPS, whereby Art. 31 (i) expressly requires that 'the legal validity of any decision relating to the authorization of such use shall be subject to judicial review or other independent review by a distinct higher authority in that Member'.
- 14 See Beate Schmidt, 'Das Bundespatentgericht in der Krise – Auslaufmodell oder zukunftsicherer Klassiker?', *Zeitschrift zum Innovations- und Technikrecht (InTeR)* 2 (2013): 71–6, at 76 (noting that inventions of employees constitute one of the justifications for the future use of the German Bundespatentgericht in spite of the creation of a European patent court system); see also McDermott Will & Emery, 'Patent Ownership in Germany: Employers v Employees' (July 2013), at

The diversity of IP disputes further results from the various types of legal proceedings which are available: IP disputes can be submitted to civil proceedings,¹⁵ criminal proceedings,¹⁶ and/or administrative proceedings, particularly with respect to the grant of industrial property rights (such as patents, trademarks or designs)¹⁷ or to border measures.¹⁸ In addition, IP disputes frequently arise in a transactional context,¹⁹ which can generate complex legal questions at the intersection of different legal areas, including competition law,²⁰ contract law and private international law. The protection of IP rights in the digital environment can also call for specific regulations and/or enforcement mechanisms.²¹

These few (non-exhaustive) examples confirm the diversity of IP disputes. As a result, it would be too restrictive to suggest that IP disputes – for which the question of specialised IP courts may arise – would be limited to disputes about the grant or registration of intellectual property rights. Nor are cases likely to be restricted to traditional IP infringement disputes between right holders and (trademark or copyright) counterfeiters.²²

Thus, the diversity of IP disputes makes it difficult to give a unique answer to the question of whether it is potentially advantageous or necessary to establish specialised IP courts. This diversity is also

http://www.mwe.com/files/Uploads/Documents/Pubs/White_Paper_Patent_Ownership_Germany.pdf; TaylorWessing, 'Compensating Employee Inventors' (Jan. 2014), at http://www.taylorwessing.com/synapse/ti_compensation_employee_inventors.html.

- 15 See in particular Art. 42 para. 1 TRIPS ('Members shall make available to right holders civil judicial procedures concerning the enforcement of any intellectual property right covered by this Agreement').
- 16 See Art. 61 TRIPS; the choice of IP owners to enforce their rights in civil and/or criminal proceedings may depend on various factors, and particularly on whether there are 'specialist commercial criminal courts qualified to deal with IP cases'; see Louis Harms, 'The Role of the Judiciary in Enforcement of Intellectual Property Rights; Intellectual Property Litigation under the Common Law System with Special Emphasis on the Experience in South Africa', WIPO doc. WIPO/ACE/2/4 Rev. (19 May 2004) (http://www.wipo.int/edocs/mdocs/enforcement/en/wipo_ace_2/wipo_ace_2_4_rev.pdf).
- 17 See Art. 62 para. 5 TRIPS ('Final administrative decisions in any of the procedures referred to under paragraph 4 shall be subject to review by a judicial or quasi-judicial authority. However, there shall be no obligation to provide an opportunity for such review of decisions in cases of unsuccessful opposition or administrative revocation, provided that the grounds for such procedures can be the subject of invalidation procedures').
- 18 See Arts 49, 50 para. 8 and 51 TRIPS; the establishment and composition of IP dispute resolution bodies should ensure the independence of such bodies from the government (and from other stakeholders): it must be noted in this respect that the independence of the Indian Intellectual Property Appellate Board (IPAB) has been challenged on constitutional grounds before the Indian courts: the Madras High Court held on 10 Mar. 2015 that certain rules relating to the composition of the IPAB violate certain fundamental constitutional principles, i.e. the doctrine of separation of powers, the independence of judiciary and the basic structure of the Constitution (the decision, *Shamnad Basheer v. Union of India*, is at <http://indiankanoon.org/doc/165688854>); see 'Specialist IP Adjudication: The Indian Experience', the country case study by Shamnad Basheer (who was the claimant in this case) in Part Two of this issue (section on 'Does the IPAB Suffer a Pro IP Owner Bias?').
- 19 That is, they arise in connection with one or several contracts (such as a licence agreement or R&D agreement).
- 20 See Hiroko Yamane, *Competition Analyses of Licensing Agreements: Considerations for Developing Countries under TRIPS* (ICTSD, 2015) (<http://www.ictsd.org/themes/innovation-and-ip/research/competition-analyses-of-licensing-agreements-considerations-for-0>).
- 21 These specific enforcement mechanisms which have been adopted in order to fight against IP infringement (specifically copyright infringement) activities in the online environment (specifically the so-called 'graduated response') will not be analysed in this paper; on this issue, see Rebecca Giblin, 'Evaluating Graduated Response', *Columbia Journal of Law and the Arts* 37.2 (2014): 147–210; see (for other academic papers on this topic) http://graduatedresponse.org/new/?page_id=14.
- 22 These two categories are the ones focused on by the *Study on Specialized Intellectual Property Courts*, joint project between the International Intellectual Property Institute (IPI) and the United States Patent and Trademark Office (USPTO), Jan. 2012 (hereinafter 'the IPI Study'), at <http://iipi.org/wp-content/uploads/2012/05/Study-on-Specialized-IPR-Courts.pdf>, see p. 2.

reflected in the way national or regional lawmakers and regulators have structured their IP dispute resolution systems. Recent studies demonstrate that although there is no unique global system or even a prevailing system,²³ there is a perceivable trend towards specialisation or centralisation of certain types of IP disputes.²⁴ This can be observed in Europe: reference can particularly be made to the Unified Patent Court (UPC),²⁵ which has been instituted by the Agreement on a Unified Patent Court,²⁶ and (less recently) to the European Union (EU) trademark and design law systems.²⁷ This can also be observed in other parts of the world.²⁸ However, this trend does not remove the

23 See the IBA Survey and the IIPI Study.

24 See e.g. for China, Binxin Li and He Wengang, 'China Patents: Latest Developments on IP Specialised Courts', 26 Jan. 2015 (<http://www.managingip.com/Article/3421120/China-Patents-Latest-developments-on-IP-specialised-courts.html>); for Russia, see Lyudmila Novoselova, 'Russia's New IP Court', *WIPO Magazine* 1 (Feb. 2014) (http://www.wipo.int/wipo_magazine/en/2014/01/article_0006.html), and Daria Kim, 'Russia Establishes Specialised Court For Intellectual Property Rights', *Intellectual Property Watch*, 1 Mar. 2013 (<http://www.ip-watch.org/2013/03/01/russia-establishes-specialised-court-for-intellectual-property-rights/>); for Austria, Graf & Pitkowit, 'Amendment of IP-Related Statutes Will Come into Force Shortly', 12 Aug. 2013: 'The amended Trademark Act contains further important changes, one of which concerns the concentration of all trademark disputes with the Vienna Commercial Court. At present, the court has exclusive jurisdiction for patent disputes, as well as disputes regarding utility models, solid-state contractors and designs. In future, this exclusive competence will also include trademark disputes. The Trademark Act also concentrates criminal proceedings – to be initiated at the request of trademark holder only – with the Vienna Regional Criminal Court'; for Finland (centralisation of civil IP disputes before the Market Court) as from 1 Sept. 2013, see Markus Myhrberg, 'New Centralized IP Court', 10 Apr. 2013, at <http://lexia.fi/2013/04/10/new-centralized-ip-court/>; for a presentation of the German system (particularly from the perspective of the Bundespatentgericht – Federal Patent Court), see Joachim Bornkamm, 'Intellectual Property Litigation under the Civil Law Legal System; Experience in Germany', WIPO doc. WIPO/ACE/2/3 (4 June 2004) (http://www.wipo.int/edocs/mdocs/enforcement/en/wipo_ace_2/wipo_ace_2_3.pdf).

25 Agreement on a Unified Patent Court of 19 Feb. 2013, at www.unified-patent-court.org/images/documents/upc-agreement.pdf; see recitals 24 and 25 of Regulation 1257/2012 of 17 Dec. 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection: '(24) Jurisdiction in respect of European patents with unitary effect should be established and governed by an instrument setting up a unified patent litigation system for European patents and European patents with unitary effect; (25) Establishing a Unified Patent Court to hear cases concerning the European patent with unitary effect is essential in order to ensure the proper functioning of that patent, consistency of case-law and hence legal certainty, and cost-effectiveness for patent proprietors. It is therefore of paramount importance that the participating Member States ratify the Agreement on a Unified Patent Court in accordance with their national constitutional and parliamentary procedures and take the necessary steps for that Court to become operational as soon as possible; the system of the European patent with unitary effect will be implemented after the requested ratifications of the UPC by the Member States, now that the challenges raised by Spain against the relevant regulations (i.e. Regulations 1257/2012 and 1260/2012) have been rejected by the European Court of Justice by its decisions of 5 May 2015 (cases C-146/13 and C-147/13).

26 Available at <http://www.unified-patent-court.org/images/documents/upc-agreement.pdf>; see the dedicated site <http://www.unified-patent-court.org/>.

27 Art. 95 para. 1 of the EU Trademark Regulation (Council Regulation (EC) No 207/2009 of 26 Feb. 2009 on the Community trade mark (codified version)) requests that 'the Member States shall designate in their territories as limited a number as possible of national courts and tribunals of first and second instance' which shall be designated as 'Community trade mark courts'; Art. 80 para. 1 of Council Regulation (EC) No 6/2002 of 12 Dec. 2001 on Community designs (as amended by Council Regulation No1891/2006 of 18 Dec. 2006 amending Regulations (EC) No 6/2002 and (EC) No 40/94 to give effect to the accession of the European Community to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs) similarly imposes that 'the Member States shall designate in their territories as limited a number as possible of national courts and tribunals of first and second instance' that shall be designated as 'Community design courts'.

28 See Trevor Cook, 'Alternative Dispute Resolution (ADR) as a Tool for Intellectual Property (IP) Enforcement', WIPO doc. WIPO/ACE/9/3 (21 Jan. 2014) (http://www.wipo.int/edocs/mdocs/mdocs/en/wipo_ace_9/wipo_ace_9_3-main1.pdf), para. 53 p. 17; see more generally the WIPO document 'Synthesis of Issues Concerning Difficulties and Practices in the Field of Enforcement', WIPO doc. WIPO/CME/3 (26 July 2002) (http://www.wipo.int/edocs/mdocs/enforcement/en/wipo_cme/wipo_cme_3.pdf), para. 70 pp. 17–18: 'A large number of the responses favored either establishing specialized intellectual property courts or, alternatively, that consideration be given by governments to train a number of judges to deal with intellectual property cases; taking this approach could assist in the adjudication of complex intellectual property matters, as well as possibly being useful in obtaining well-calculated damage awards. To assist in particular developing countries with limited experience and resources in intellectual property matters, several responses suggested that it could also be useful to establish intellectual property reference libraries with reading material and case law from different jurisdictions.'

differences which can remain about the scope of the jurisdictional power of specialised IP courts. While some courts have jurisdiction over all types of IP disputes, others focus on patent disputes and leave the other types of IP disputes to (non-specialised) courts of general jurisdiction. Similarly, certain specialised IP courts have exclusive jurisdictional power that is restricted to particular types of legal issues, most specifically, for disputes relating to the validity of the IP rights at issue (and specifically patents).²⁹ The jurisdiction of certain specialised IP courts is limited to civil disputes and excludes criminal matters.³⁰ Diversity can also exist with respect to the jurisdictional level at which the specialisation is implemented: some specialised IP courts have been instituted as trial courts (i.e. courts of first instance) and others as courts of appeal (such as the US Court of Appeals for the Federal Circuit).

An analysis of specialised IP courts (and of their legitimacy) must not neglect the growing importance of alternative dispute resolution (ADR) mechanisms for solving IP disputes.³¹ While ADR is expanding in many areas,³² this trend is particularly visible with respect to IP disputes.³³ This is confirmed by the dynamic development of the WIPO Arbitration and Mediation Center (which was established in 1994).³⁴ This is also confirmed by the provision of mediation services through various national³⁵ or regional³⁶ intellectual property offices and by the upcoming creation of a Patent Mediation and Arbitration Center which is provided for in Article 35 of the Agreement on a Unified Patent Court.³⁷ Its creation interestingly demonstrates that ADR mechanisms can be connected to specialised IP courts. From this perspective, the availability and efficiency of IP ADR mechanisms as an alternative to traditional IP court litigation may have an impact on the advantages of and need for specialised IP courts.

29 This is the case of the German Federal Patent Court (Bundespatentgericht), see http://www.bundespatentgericht.de/cms/index.php?option=com_content&view=article&id=2&Itemid=8&lang=en.

30 This is the case of the Unified Patent Court (see note 25) and of the Swiss Federal Patent Court (see note 6).

31 This is particularly reflected in recent projects conducted by the Australian Advisory Council on Intellectual Property (which advises the Australian government on intellectual property matters and on the strategic administration of IP Australia), see the project 'Consideration of Extending the Jurisdiction of the Federal Magistrates Service to Patent, Trade Marks and Designs Matters' (at <http://www.acip.gov.au/reviews/all-reviews/federal-magistrates-services/>) and the project 'Review of Post-Grant Patent Enforcement Strategies' (at <http://www.acip.gov.au/reviews/all-reviews/review-patent-enforcement/>).

32 Whereby regulations have been adopted in order to promote the use of certain types of ADR, particularly mediation, in different countries, see, for the European Union, the European Directive 2008/52/EC of 21 May 2008 on certain aspects of mediation in civil and commercial matters.

33 See e.g. Jacques de Werra, 'Arbitrating International Intellectual Property Disputes: Time to Think beyond the Issue of (Non-)Arbitrability', *International Business Law Journal*, no. 3 (2012): 299–317 (http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2149762).

34 See <http://www.wipo.int/amc/en/>.

35 See the 'IPO Mediation Service' offered by the UK Intellectual Property Office: <http://www.ipo.gov.uk/ipenforce/ipenforce-dispute/ipenforce-mediation.htm>; it can be noted in this respect that the UK IP Office Mediation Service launched a call for evidence on its mediation service in 2012 in order to assess interest (knowing that it was not intensively used) and that this may lead to future adaptations of its mediation services: see *Response to the Call for Evidence on the IPO Mediation Service* (Nov. 2012) at <https://old.ipo.gov.uk/c4e-mediation-response.pdf>.

36 See the mediation services which are offered for certain types of trademark and design disputes by OHIM, which is in charge of the registration of EU (community) trademarks and design; this results from Decision No 2011-1 of the Presidium of the Boards of Appeal of 14 Apr. 2011 on the amicable settlement of disputes ('Decision on Mediation'; see the dedicated website at <https://oami.europa.eu/ohimportal/en/mediation>; on this issue, see Sven Stürmann, 'Mediation and Community Trade Marks: New Gimmick or Real Benefit?', *Journal of Intellectual Property Law and Practice* 8.9 (2013): 708–15.

37 See note 25; for an analysis, see Jacques de Werra, 'New Developments of IP Arbitration and Mediation in Europe: The Patent Mediation and Arbitration Center Instituted by the Agreement on a Unified Patent Court', *Revista Brasileira de Arbitragem* (2014): 17–35 (<https://archive-ouverte.unige.ch/unige:39878>).

As a result, the legitimacy and necessity of establishing specialised IP courts must be assessed in a broader context which takes into account the entire IP dispute resolution ecosystem, in which ADR mechanisms cannot be ignored.³⁸

1.3 Advantages and Disadvantages of Specialised IP Courts

The goal of this section is to identify the advantages and disadvantages of establishing specialised IP courts. Special attention will be given to the situation in developing countries, whereby the debate about specialised IP courts largely reflects the more fundamental discussion about the pros and cons of specialised courts in general.³⁹

Advantages

Specialised IP courts are deemed to improve the quality of justice given that the court's expertise makes it possible to decide the dispute on the basis of the experience that the court has gained in solving previous IP disputes.⁴⁰ The expertise of the court is of particular importance for IP disputes because the courts are frequently requested to render decisions on an application for temporary relief⁴¹ within a short period of time and thus to 'order prompt and effective provisional measures'.⁴² These time constraints make it essential that such courts have the ability to decide quickly and efficiently.

Another advantage of specialised IP courts is their ability to keep pace with the dynamic developments of IP law and to adapt quickly.⁴³ The expertise of the court is further perceived as an advantage in view of the risk that non-specialised courts, because of the technical complexity of disputes, may tend to delegate their decision-making powers to (court-appointed or even party-appointed) technical experts who will then decide the case instead of the judges.⁴⁴ In any case, proactive measures should

38 IBA Survey, p. 4 (noting that ADR 'is especially important in the absence of specialised IP courts; yet even in jurisdictions with such courts, ADR is still viewed as a viable alternative'); on the use of ADR in the field of IP, see Cook, 'Alternative Dispute Resolution', report prepared for the Ninth Session of the WIPO Advisory Committee on Enforcement (3–5 Mar. 2014), para. 53 p. 17 on the interaction between ADR and specialised IP courts; IP ADR mechanisms will not be further analysed in this paper which focuses on specialised IP courts.

39 See Zimmer, 'Overview of Specialized Courts', p. 1.

40 See Zimmer, 'Overview of Specialized Courts', p. 2; IBA Survey, p. 26 (whereby this document somehow vaguely indicates that 'Judges may produce more reasoned and practical decisions owing to their experience in IP issues' – as the practicality of decisions does not necessarily appear as the most relevant factor in rendering justice); see also IPI Study, pp. 4–5; for a scholarly discussion of specialised (IP) courts, see Paul R. Gugliuzza, 'Rethinking Federal Circuit Jurisdiction', *Georgetown Law Journal* 100 (2012): 1437–505, at 1447–8 (listing efficiency, accuracy and uniformity as the three main arguments made in the legal literature in support of specialised courts) (<http://georgetownlawjournal.org/files/2012/06/Gugliuzza.pdf>).

41 i.e. the IP owner will typically request that the alleged infringer shall stop its infringing activity.

42 See Art. 50 para. 1 TRIPS; Art. 50 and specifically its para. 3 impose certain conditions on the order of provisional measures ('The judicial authorities shall have the authority to require the applicant to provide any reasonably available evidence in order to satisfy themselves with a sufficient degree of certainty that the applicant is the right holder and that the applicant's right is being infringed or that such infringement is imminent, and to order the applicant to provide a security or equivalent assurance sufficient to protect the defendant and to prevent abuse').

43 See IBA Survey, p. 26; IPI Study, p. 8.

44 This process is referred to as 'démision du juge', see Werner Stieger, 'Bundespatentgericht ante portas!', in *Der Weg zum Recht: Festschrift für Alfred Bühler* (Schulthess, 2008), p. 183 (http://www.homburger.ch/fileadmin/publications/BPatG_ante_portas_01.pdf); it remains, however, that courts can valuably benefit from the appointment of experts for clarifying factual/technological issues in IP disputes, which is established under certain national regulations; see e.g. the

be taken in order to maintain the expertise of a specialised court by ensuring that sitting judges are able to remain informed about the latest developments in the legal fields. The expertise of the judiciary is also enhanced by ensuring that judges remain in office for a certain period of time (in order to avoid an undue loss of expertise) and that measures are taken in order to anticipate judicial turnover.⁴⁵ This aspect should not be underestimated as it appears essential in maintaining the expertise of a specialised IP court and thus is a potential advantage over non-specialised courts.

Specialised IP courts can further improve the time and cost efficiency of the proceedings.⁴⁶ This is attractive for all stakeholders, particularly litigants who will not have to wait for a sometimes extensive period of time before the dispute is finally decided on the merits. This is particularly important in a time when technologies are commercialised and business decisions must be made at a fast pace. It is also attractive for courts because their expertise makes it possible to adequately manage their caseload and can thus contribute to a reduced risk of backlog.⁴⁷

Specialised IP courts can also promote consistency and uniformity in the law. This produces more predictable court outcomes which benefit potential litigants⁴⁸ and society as a whole, thereby improving efficiency. However, uniformity cannot be a goal in itself given that 'uniformity says nothing about quality or accuracy'.⁴⁹

possibility to appoint 'scientific advisers' under sec. 115 of the Indian Patent Act which provides that (para. 1): 'In any suit for infringement or in any proceeding before a court under this Act, the court may at any time, and whether or not an application has been made by any party for that purpose, appoint an independent scientific adviser, to assist the court or to inquire and report upon any such question of fact or of opinion (not involving a question of interpretation of law) as it may formulate for the purpose' (at http://www.ipindia.nic.in/IPActs_Rules/updated_Version/sections/ps115.html); on this issue, see Basheer, 'Specialist IP Adjudication: The Indian Experience' in Part Two (section on 'The Role of Experts'); see also the opportunity to appoint technical investigators under Chinese law, as resulting from the 'Provisional Stipulations on Several Issues concerning the Participation of Technical Investigators in the Proceedings of Intellectual Property Courts' of 21 Jan. 2015; on this issue, see the country case study by Hong Xue, 'Specialised Intellectual Property Courts in China', in Part Two (section on 'Improvement of Professionalism').

45 See recommendation No 4 in the IPI Study, p. 9 ('anticipate judicial turnover and be prepared to train replacement judges').

46 See IPI Study, p. 5 (referring to the 'effectiveness of decision'); see Court of Appeals for the Federal Circuit – 1981: Hearings on H.R. 2405 Before the Subcomm. on Courts, Civil Liberties, & the Admin. of Justice of the H. Comm. on the Judiciary, 97th Cong. 42-43 (1981) (statement of Howard T. Markey, C.J., Court of Customs and Patent Appeals) ('if I am doing brain surgery every day, day in and day out, chances are very good that I will do your brain surgery much quicker, or a number of them, than someone who does brain surgery once every couple of years'); Harms, 'The Role of the Judiciary in Enforcement of Intellectual Property Rights', p. 9: 'Cases before experienced IP judges are shorter and cheaper than those run by novices'; see Zimmer, 'Overview of Specialized Courts', p. 1, who distinguishes between 'judicial system efficiency' (i.e. increased efficiency in the court system resulting from the fact that 'judges in the general jurisdiction courts no longer have to wrestle with, or expend the effort to remain current on, the issues in that field of law') and 'legal system efficiency' (i.e. increased efficiency because 'the litigants have more confidence in the abilities and expertise of the specialized court judges' so that 'counsel feel less compelled to establish a comprehensive record, and cost and delay are commensurately reduced'); see also (from the perspective of trademark litigation) the Board Resolutions of the International Trademark Association (INTA) on Specialized Trademark Judiciaries, 7 Nov. 2001 (<http://www.inta.org/Advocacy/Pages/SpecializedTrademarkJudiciaries.aspx>); the improvement of the pendency rate is however not always achieved by the creation of specialised courts, see, for India (relating to IPAB), Basheer, 'Specialised IP Adjudication: the Indian Experience', in Part Two.

47 IBA Survey, p. 27.

48 See generally Zimmer, 'Overview of Specialized Courts', p. 2; IBA Survey, p. 26; IPI Study, pp. 5–6; see also Gugliuzza, 'Rethinking Federal Circuit Jurisdiction', p. 1447.

49 Diane P. Wood, 'Keynote Address: Is It Time to Abolish the Federal Circuit's Exclusive Jurisdiction in Patent Cases?', *Chicago-Kent Journal of Intellectual Property* 13.1 (2013): 1–10, at 3 (<http://scholarship.kentlaw.iit.edu/ckjip/vol13/iss1/1>); see also Craig Allen Nard and John F. Duffy, 'Rethinking Patent Law's Uniformity Principle', *Northwestern University Law Review* 101 (2007): 1619–75 (http://scholarlycommons.law.case.edu/cgi/viewcontent.cgi?article=1590&context=faculty_publications), at 1620: 'Yet uniformity is not a proxy for quality. That a policy is uniformly applied says very little about its soundness or desirability.'

The creation of centralised specialised IP courts also contributes to an avoidance or reduction in the risk of forum shopping. This phenomenon occurs when litigants (and particularly the IP owners) can choose between different fora depending on their respective attractiveness.⁵⁰ The existence of various courts in the same country which all have the jurisdictional power to hear IP cases creates the risk of a de facto concentration of IP cases because of their expertise and/or their attractiveness for litigants.⁵¹ The centralisation of IP disputes before certain courts may also avoid the risk of competition between courts which could otherwise be inclined to develop procedural tools and strategies in order to attract litigation.⁵²

The establishment of specialised IP courts is also considered to be a useful approach for adopting special procedural rules which would be tailored to IP disputes.⁵³ Finally, specialised IP courts are perceived as raising 'the profile of IPR within a country by signalling that the government considers it an important area to protect'.⁵⁴

Disadvantages

Various disadvantages of establishing specialised IP courts have been identified. First, the costs of creating and maintaining specialised IP courts are viewed as a disadvantage, particularly in countries where there is 'a general lack of resources, a low IP case load and little IP expertise'.⁵⁵ The legitimacy and proportionality of such costs depend in particular on the caseload⁵⁶ and on the way these costs can be covered by available resources.⁵⁷ The assessment of the potential costs associated with the establishment of a specialised IP court should also include an evaluation of the costs of identifying, attracting, and keeping judges. The lack of human resources may thus constitute a major hurdle,

50 See Zimmer, 'Overview of Specialized Courts', p. 2; for the US, see Mark A. Lemley, 'Where to File your Patent Case', *AIPLA Quarterly Journal* (American Intellectual Property Law Association) 38.4 (Fall 2010): 1–37; the Court of Appeals for the Federal Circuit was created in the US also for the purpose of reducing the risks of forum shopping, IIPI Study, p. 131.

51 As this appears to be the situation in Germany, where nine courts have jurisdiction for patent infringement disputes, while three of them get half of the cases (courts in Düsseldorf, Mannheim and Munich), see Bornkamm, 'Intellectual Property Litigation under the Civil Law System; Experience in Germany', p. 4; see also Peter Heinrich, 'Latest Developments in Concentration and Specialisation of Courts on the National Level', *Swiss Review of Intellectual Property, Competition and Information Law* (2004): 161 (https://www.sic-online.ch/fileadmin/user_upload/Sic-Online/2004/documents/161.pdf), who distinguishes between direct and indirect concentration, whereby the first one results from a regulation (providing for the centralisation of IP litigation before one designated court) and the second one refers to the case of de facto concentration before the courts selected by the claimants among different courts.

52 See Jonas Anderson, 'Court Competition for Patent Cases', *University of Pennsylvania Law Review* 163.3 (2015): 631–98 (<http://www.pennlawreview.com/print/?id=466>).

53 IIPI Study, p. 5; IBA Survey, p. 27.

54 IIPI Study, p. 6.

55 Harms, 'The Role of the Judiciary in Enforcement of Intellectual Property Rights', p. 10.

56 If the expected caseload of such a court is relatively low, these costs will not be justified; IBA Survey, p. 37; see Susan Isiko Štrba, 'Specialised Intellectual Property Courts in Africa: The Case of Uganda', in Part Two of this issue (in the concluding part of her note on 'Policy considerations for SIC [specialised intellectual property courts]')).

57 An interesting approach that was adopted in Switzerland is to cover the budget of the newly created Swiss Federal Patent Court by the court fees as well as by revenues generated by the Swiss Institute of Intellectual Property relating to the patent fees that it receives, see Art. 4 of the Federal Act on the Federal Patent Court (financing) which provides that '[t]he Federal Patent Court is financed by court fees and contributions from the Swiss Federal Institute of Intellectual Property (IPI) taken from the patent fees annually collected by the IPI' (at <http://www.admin.ch/opc/en/classified-compilation/20071763/index.html>); see also the 'Regulations on Litigation Costs at the Federal Patent Court', at http://www.patentgericht.ch/fileadmin/web-dateien/014.223_Reglement_ueber_die_Prozesskosten_beim_Bundespatentgericht_EN_per_121212.pdf, which regulates both Court fees as well as the compensation for costs of legal representation.

potentially inhibiting the establishment of specialised IP courts.⁵⁸ The cost assessment should consequently also reflect the cost of adequately managing judicial human resources.⁵⁹ This may be challenging due to the asymmetry of wages when compared to the private sector. As candidates may be drawn from the private sector there is a need to increase judicial wages. This will particularly apply if judges sitting on the specialised IP courts are part-time judges who are practitioners. This may prove difficult given the interest in ensuring a certain equality of treatment or at least a certain balance between specialised and generalist judges in order to avoid tension between them.⁶⁰ The limited pool of experts who can be considered for an appointment on the specialised (IP) court further makes it necessary to adopt appropriate rules and principles governing conflicts of interests. Any conflicts must be treated with utmost care in the process of appointing part-time judges.⁶¹ All these costs and hurdles should consequently be compared to the benefits which are expected to result from the creation of specialised IP courts (specifically judicial efficiency).⁶²

Access to justice is also a potential problem. Litigants may be forced to bear the costs resulting from the centralisation of specialised IP courts and may thus have to plead before a court which may not be easily reachable from a geographic perspective.⁶³

58 This is what appears as the most decisive factor in the recommendation of the so-called 'Hoexter Commission' in South Africa (Hoexter Commission of Inquiry into the Rationalisation of the Provincial and Local Divisions of the Supreme Court, 1997); see <http://www.polity.org.za/polity/govdocs/commissions/> and the specific part relating to specialized IP courts: <http://www.polity.org.za/polity/govdocs/commissions/1997/hoexter3-2b2.html> (or <http://www.polity.org.za/polity/govdocs/commissions/r3v1b2.pdf>); the Hoexter Commission came to the conclusion that a specialist intellectual property court should not be established in South Africa because the Commission found that 'the pool of suitably qualified persons [...] from which appointments to the Bench of a specialist intellectual property court might be made is unacceptably small' (para. 10.13) and that 'it will be difficult to find a suitable candidate for appointment as President of a specialist intellectual property court' (para. 10.15).

59 This can particularly imply taking measures in order to '[a]nticipate judicial turnover and [to] be prepared to train replacement judges' (IPI Study, p. 9) in the face of the possibility that the tenure of specialised IP judges may be short; see also the European Patent Lawyers Association's Resolution Concerning Concentration and Specialisation of National Patents Courts, adopted by the Congress on 21 Nov. 2003, at <http://www.eplaw.org/Downloads/11.pdf>, which recommends (among other measures): '1) that in each European country the number of courts having jurisdiction in patent matters be reduced to a very minimal number, in most countries to one court only, and 2) that within these courts, the patent cases be brought systematically before the same chamber and the judges be given the possibility to stay in office for a reasonably long time in that chamber and thereby to acquire experience; [...]'; see also Heinrich, 'Latest Developments in Concentration and Specialisation of Courts on the National Level'.

60 This is reflected in Opinion (2012) No. 15 of the Consultative Council of European Judges (CCJE) on the Specialisation of Judges adopted at the 13th plenary meeting of the CCJE, Paris, 5–6 Nov. 2012 (<https://wcd.coe.int/ViewDoc.jsp?Ref=CCE%282012%294&Language=lanEnglish&Ver=original&BackColorInternet=DBDCF2&BackColorIntranet=FDC864&BackColorLogged=FDC864>), para. 57: 'The principle of equal status for generalist and specialist judges should also apply to remuneration'.

61 This is what was done in Switzerland for the newly created Federal Patent Court (http://www.patentgericht.ch/en/?no_cache=1) in the 'Guidelines on Independence' in order to ensure the independence of the members of the Federal Patent Court (http://www.bundespatentgericht.ch/fileadmin/web-dateien/015.222_Richtlinien_zur_Unabhaengigkeit_EN_guelting_ab_150101.pdf), see the decision of the Swiss Supreme Court ATF 139 III 433 (ref. 4A_142/2013) of 23 Aug. 2013 (holding that a part-time judge – who was a patent attorney – appointed to the Swiss Federal Patent Court had to resign from a case because its company was working with a company affiliated with one party involved in the dispute).

62 IPI Study, p. 7 (it is however difficult to assess precisely the financial impact of improved judicial efficiency).

63 IBA Survey, p. 37; IPI Study, p. 7; see also Zimmer, 'Overview of Specialized Courts', p. 4; this difficulty may potentially be managed by making it possible for the court to sit and hold hearings in other places so that the court and the judges can move to the place where the litigants are located.

Another risk is that a specialised court may be more easily subject to political or economic influences.⁶⁴ This is due to the fact that generalist courts are often considered to be more independent than specialised courts.⁶⁵ This risk can materialise ex ante, that is, in the process of appointing judges to the specialised courts.⁶⁶ The risk can also materialise subsequently because of the closer interaction between counsel and judges before a specialised court.⁶⁷ Such interaction may be problematic and detrimental to the court's legitimacy,⁶⁸ as it generates a risk that the courts will become 'captured' by special interest groups to the detriment of broader societal interests.⁶⁹ The capture may materialise itself in a (perceived) loss of independence and bias towards certain frequent players and stakeholders. From this perspective, it is suggested that generalist courts can provide the 'antidote' to this risk.⁷⁰

An additional risk is that the vision of the specialised IP courts may narrow. This may lead the court to neglect the overall legal and policy framework that surrounds certain IP disputes,⁷¹ in spite of the

64 See Jay P. Kesan and Gwendolyn G. Ball, 'Judicial Experience and the Efficiency and Accuracy of Patent Adjudication: An Empirical Analysis of the Case for a Specialized Patent Trial Court', *Harvard Journal of Law and Technology* 24.2 (Spring 2011): 393–467 (<http://jolt.law.harvard.edu/articles/pdf/v24/24HarvJLTech393.pdf>), at 407.

65 Kesan and Ball, 'Judicial Experience and the Efficiency and Accuracy of Patent Adjudication', at 407; see also Gugliuzza, 'Rethinking Federal Circuit Jurisdiction', at 1449 (presenting this view).

66 See Baum, *Specializing the Courts*, pp. 221–2.

67 Certain specialised counsels are likely to be recurrent players and not one-shooters; see Baum, *Specializing the Courts*, p. 38.

68 Reference can be made here to the recent resignation of Judge Rader, who was Chief Justice of the US Court of Appeals for the Federal Circuit, following an email that he sent to a lawyer who is a patent litigator (i.e. Edward E. Reines from the law firm Weil Gotshal & Manges (see <http://ipkitten.blogspot.com/2014/05/chief-judge-rader-leaves-his-us-patent.html>); in his letter of resignation as Chief Justice of 23 May 2014 (based on an extract from the letter available in the preceding url), Judge Rader admitted that he had 'engaged in conduct that crossed lines established for the purpose of maintaining a judicial process whose integrity must remain beyond question' and that he particularly regretted 'an email message I sent to an attorney who had argued before the court. The email reported, with certain inaccuracies, a conversation I had with another member of the court who had praised the attorney's performance. I added my own praise and urge the attorney to show the email to others [...]'. this letter was sent after Judge Rader resigned from panels in cases in which the relevant lawyer was involved (see <http://patentlyo.com/patent/2014/05/microsoft-datatern-withdrawn.html>; and the case *Microsoft Corporation v. DataTern, Inc.*, with the order vacating the original opinion (indicating the resignation of Judge Rader): <http://patentlyo.com/media/2014/05/Microsoft-Order.pdf>, and the new order (rendered without Judge Rader): <http://patentlyo.com/media/2014/05/New-Opinion.pdf>); Judge Rader stepped down as chief judge as of 30 June 2014 and subsequently retired completely from the court with effect as of 30 June 2014 (see <http://www.ipwatchdog.com/2014/06/13/cafc-shock-judge-randall-rader-announces-retirement/>).

69 This is reflected in Opinion (2012) No. 15 of the CCJE on the Specialisation of Judges, para. 59: 'If a specialist judge is likely to be dealing with only a small and specialist group of lawyers, or even litigants, he/she may need to take caution in his own conduct to ensure his/her impartiality and independence.'

70 See *Holmes Grp., Inc. v. Vornado Air Circulation Sys., Inc.*, 535 U.S. 826, 839 (2002) (Stevens, J., concurring) ('occasional decisions [on issues of patent law] by courts with broader jurisdiction will provide an antidote to the risk that the specialized court may develop an institutional bias').

71 See generally Rochelle Dreyfuss, 'Specialized Adjudication', *Brigham Young University Law Review*, no. 1 (1990): 377–441 (<http://www.law2.byu.edu/lawreview/archives/1990/1/dre.pdf>), at 429: 'The possibility of doctrinal deviation is significantly increased when there is no generalist input into a case'; this point was recently made about the UPC by Clement Salung Petersen, Thomas Riis and Jens Schovsbo, 'The Unified Patent Court (UPC) in Action – How Will The Design of the UPC Affect Patent Law?', in Rosa Maria Ballardini et al. (eds), *Transitions in European Patent Law: Influences of the Unitary Patent Package* (Kluwer, 2015) (the paper's abstract at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2450945 states that '[t]he UPC will be a very specialised court that i.a. recruits judges from specialists' circles and has as part of its mission to develop a coherent and autonomous body of case law. The article points out that the UPC because of this design will be biased towards technology based values and uniformity at the expense of other values and interests e.g. non-economic public interests, and values associated with diversity').

important values underlying the IP framework that are reflected in the TRIPS Agreement.⁷² TRIPS expressly provides that the 'enforcement procedures' regulated in its Part III 'shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse'.⁷³ This provision illustrates the need to ensure that the judicial enforcement of IP rights shall not affect the legitimate interests of third parties. Thus, there is a risk that specialised IP courts⁷⁴ could develop 'tunnel vision',⁷⁵ or a 'myopic view of the law'⁷⁶ which may be prejudicial to the coherent development of the law. IP is not (and should not be) isolated from the rest of the law.⁷⁷ This is essential because IP disputes frequently raise legal issues outside of the IP realm, such as constitutional, human rights, contract, tort, or competition law. Therefore there may be a risk that an IP specialised court will adopt and define rules over general legal principles, such as tort or contract law, which are not congruent with the evolving principles applicable to these areas of the law.⁷⁸

The argument is further made that '[j]udicial specialization reduces the cross-pollination of legal ideas'.⁷⁹ This aspect of specialised patent courts has particularly been identified and discussed, with scholars intensively debating whether and under what conditions they can be justified. In this respect, the view has been expressed⁸⁰ that the absence of centralisation would better promote a 'marketplace of ideas'⁸¹ and that decentralisation and diversity can solve patent disputes more

72 See the preamble of the TRIPS Agreement ('Recognizing the underlying public policy objectives of national systems for the protection of intellectual property, including developmental and technological objectives') and Arts 7 and 8.

73 Art. 40 para. 1 TRIPS; see also the first recital of the preamble of the TRIPS which provides that 'Desiring to reduce distortions and impediments to international trade, and taking into account the need to promote effective and adequate protection of intellectual property rights, and to ensure that measures and procedures to enforce intellectual property rights do not themselves become barriers to legitimate trade' (emphasis added).

74 For a position supporting generalist courts, see Wood, 'Keynote Address'.

75 Harms, 'The Role of the Judiciary in Enforcement of Intellectual Property Rights', p. 9; see also Baum, *Specializing the Courts*, p. 34, and IBA Survey, p. 28 (referring to 'Loss of generalists' overviews' and to 'isolation').

76 Ahmed Davis, 'The Specialized IPR Court Regime in the United States', in IPI Study, p. 131: 'In order to protect against the court becoming so specialized that it began to take a myopic view of the law, Congress granted the Federal Circuit authority over other areas of the law – among them, appeals for the International Trade Commission, the Court of International Trade, the Court of Federal Claims, and the Merit Systems Protection Board.'

77 See Simon Rifkind, 'A Special Court for Patent Litigation? The Danger of a Specialized Judiciary', *American Bar Association Journal* 37 (1951): 425–6, at 425: 'The patent law does not live in the seclusion and silence of a Trappist monastery. It is part and parcel of the whole body of our laws. It ministers to a system of monopolies within a larger competitive system. This monopoly system is separated from the rest of the law not by steel barrier but by a permeable membrane constantly bathed in the general substantive and procedural law. Patent lawyers tend to forget that license agreements are essentially contracts subject to the law of contracts; that infringements are essentially trespasses subject to the law of torts; that patent rights are property rights; and that proof in patent litigation is subject to the law of evidence. Changes in all these branches of the law today have an effect on the patent law as well. As long as judges exercising a wide jurisdiction also try patent cases, so long do the winds of doctrine, the impulses towards slow changes and accommodation, affect the patent law to the same degree as they affect the general body of the law.'

78 Zimmer, 'Overview of Specialized Courts', p. 3 (indicating that '[s]pecialized court judges [...] are removed from the mainstream of legal thought'); IBA Survey, p. 28 (which refers somehow imprecisely to 'overlap with other areas of the law').

79 Richard A. Posner, 'Will the Federal Courts of Appeals Survive until 1984? An Essay on Delegation and Specialization of the Judicial Function', *Southern California Law Review* 56 (1983): 761–91, at 787.

80 From a US perspective based on the experience of the Federal Circuit.

81 Wood, 'Keynote Address', at 9: 'My question is a more modest one: should we eliminate its exclusive jurisdiction over patent cases, and re-introduce into the country the same kind of marketplace of ideas at the court of appeals level that we have for almost every other kind of claim. Under the alternative regime I envision, parties would have a choice: they could take their appeals to the Federal Circuit, thereby benefiting from that court's long experience in the field, or they could file in the regional circuit in which their claim was first filed.'

efficiently.⁸² Centralisation may entail certain risks because it can potentially perpetuate errors, particularly in common law systems where the *stare decisis* rule applies.⁸³ On this basis, scholars have articulated various proposals in order to improve the functioning of the US patent litigation system,⁸⁴ and specifically of the Federal Circuit.⁸⁵ The goal of these efforts is to ensure that the US judicial patent dispute resolution system fosters technological⁸⁶ and legal innovation.⁸⁷ One way to reduce this risk is to ensure that judges deciding IP cases also have jurisdiction to decide on non-IP

82 See Nard and Duffy, 'Rethinking Patent Law's Uniformity Principle'.

83 *Moba v. Diamond Automation, Inc.*, 325 F.3d 1306, 1322 (Fed. Cir. 2003) (Rader, J., concurring) ('Whenever a Federal Circuit panel makes an error interpreting the patent code, every district court in the nation, and even every later Federal Circuit panel, is obliged to follow and perpetuate the error. Even the Supreme Court has difficulty identifying errors for correction because this court's national jurisdiction requires universal application of a mistake'); quoted by Cecil D. Quillen Jr, 'Response Essay: Rethinking Federal Circuit Jurisdiction – A Short Comment', *Georgetown Law Journal Online* 100 (2012): 23–7, at 24 (<http://georgetownlawjournal.org/files/2012/06/QuillenOnlineFinal.pdf>).

84 See, for the creation of specialised trial courts, Arti Rai, 'Specialized Trial Courts: Concentrating Expertise on Fact,' *Berkeley Technology Law Journal* 17.2 (2002): 877–97 (<http://scholarship.law.berkeley.edu/cgi/viewcontent.cgi?article=1378&context=btlj>); Arti Rai, 'Allocating Power over Fact-Finding in the Patent System', in Symposium Issue 'Ideas Into Action: Implementing Reform of the Patent System', *Berkeley Technology Law Journal* 19.3 (2004): 907–22; see also Kimberly A. Moore, 'Forum Shopping in Patent Cases: Does Geographic Choice Affect Innovation?', *North Carolina Law Review* 79 (2001): 889; Kimberly A. Moore, Judge, 'Juries and Patent Cases – An Empirical Peek Inside the Black Box', *Michigan Law Review* 99 (2000): 365; Kimberly A. Moore, 'Are District Court Judges Equipped to Solve Patent Cases?', *Harvard Journal of Law and Technology* 15.1 (Fall 2001) (<http://jolt.law.harvard.edu/articles/pdf/v15/15HarvJLTech001.pdf>); John Pegram, 'Should There Be a U.S. Trial Court with a Specialization in Patent Litigation?', *Journal of the Patent and Trademark Office Society* 82 (2000): 766; Paul M. Schoenhard, 'Judging Trial Judges', *IP Law and Business*, (Mar. 2006): 22 (<http://www.ropesgray.com/~media/Files/articles/2006/03/schoenhard-no-need-for-patent-judges.pdf>); see also Donna M. Gitter, 'Should the United States Designate Specialist Patent Trial Judges? An Empirical Analysis of H.R. 628 in Light of the English Experience and the Work of Professor Moore', *Columbia Science and Technology Law Review* 10 (2009): 169.

85 See Gugliuzza, 'Rethinking Federal Circuit Jurisdiction' (this article 'offers a structural remedy that might help cure a frequently discussed problem with Federal Circuit patent law: that it is not sufficiently sensitive to innovation policy. By replacing some of the court's current non-patent docket with a variety of commercial disputes (over which the Federal Circuit would not have exclusive jurisdiction) [(including not only antitrust cases but also securities cases, bankruptcy cases and copyright cases)], the court might better understand the role that patents play in stimulating (or impeding) innovation in different industries.' This will make it possible for the court to better understand 'the larger commercial context in which patents operate and patent disputes arise', Paul R. Gugliuzza, 'Pluralism on Appeal', *Georgetown Law Journal Online* 100 (2012): 36–43, at 40 (<http://georgetownlawjournal.org/files/2012/10/GugliuzzaPluralism.pdf>); see the reactions by Quillen ('Response Essay') and by Ori Aronson, 'Response, Innovation, Aggregation, and Specialization', *Georgetown Law Journal Online* 100 (2012): 28–35 (<http://georgetownlawjournal.org/files/2012/08/AronsonProof.pdf>).

86 Nard and Duffy, 'Rethinking Patent Law's Uniformity Principle', at 1620: 'As the novelty of having a uniform set of circuit precedents for patent law has worn off, commentators have increasingly turned to evaluating the Federal Circuit's precedents on the merits. The issue is whether Federal Circuit precedent adequately reflects current knowledge regarding the beneficial functions of the patent system in generating technological innovation, the potential problems of patent rights in foreclosing legitimate competition, and the need for predictable rules capable of curtailing litigation costs. The answers thus far have not been encouraging'; see also the response to their article by S. Jay Plager and Lynne E. Pettigrew, 'Rethinking Patent Law's Uniformity Principle: A Response to Nard and Duffy', *Northwestern University Law Review* 101.4 (2007): 1735.

87 See Nard and Duffy, 'Rethinking Patent Law's Uniformity Principle', at 1675: 'Consideration of patent law's appellate institutional architecture invokes a more general problem that manifests itself in numerous fields, including law, politics, economics, and business. This problem relates to the difficulty of trying to gauge the respective benefits and shortcomings of, on the one hand, centralization and uniformity and, on the other hand, decentralization and diversity. Patent law, since 1982, has opted for the former. But uniformity has its costs and is only one of several considerations that should guide the institutional design of our patent system. Equally important guiding principles include diversity and competition, both of which have been largely absent from patent law for more than twenty years. The Federal Circuit is an important institution, but it suffers from structural constraints that deprive the court of sister-circuit competition and a mechanism that would allow for incremental and tested innovations in the law. In this Article, we have framed the issue of institutional design as one of optimization, and have argued that reconfiguring patent law's appellate design to include two or three additional circuit courts trends towards optimality more so than the current centralized structure'; for a critical analysis of the (US) patent system, see also Adam B. Jaffe and Josh Lerner, *Innovation and Its Discontents: How Our Broken Patent System Is Endangering Innovation and Progress, and What to Do about It* (Princeton University Press, 2004).

related cases. This flexibility was conceived for the US Court of Appeals for the Federal Circuit,⁸⁸ but what ultimately counts is not the regulatory objective but rather the issue of whether the courts do indeed get effective exposure to other legal areas on a sufficiently intensive basis. The IP judicial regime in the United Kingdom is similarly based on a system in which judges deciding IP cases are exposed to non IP-related issues, which makes it possible for them to understand and apply IP within a broader legal context.⁸⁹

The establishment of specialised IP courts further raises the question of the distinction between the court's special jurisdictional powers and the special or general jurisdictional powers of other (non-IP) courts.⁹⁰ Case law frequently shows that such delimitation can be delicate.⁹¹ Creating specialised courts is therefore 'a source of potentially serious boundary problems'.⁹² Ultimately, the costs of fragmented jurisdictional powers may be borne by parties involved in an IP-related dispute who face the risk of having to clarify the boundaries of the jurisdictional powers of the respective courts. The special jurisdictional power must therefore be carefully defined and should not be conceived too narrowly. In this respect, it would not appear adequate to limit the jurisdiction of specialised IP courts to IP infringement cases.⁹³

1.4 Policy Choices

The diversity of legal systems and regimes makes it difficult to envision a single way to set up an efficient IP court system that promotes innovation and social welfare. Similarly, there is no evidence that specialised IP courts would better promote innovation than non-specialised courts.⁹⁴

88 Davis, 'The Specialized IPR Court Regime in the United States', p. 131.

89 Michael Fysh, 'Intellectual Property and Particularly Patent Litigation in the United Kingdom', in IPI Study, p. 125: 'Patents judges are a part of the general judicial system and play an active role in deciding non-IPR cases. Depending on the workload, patent judges may spend a third of their time on other work. In the Court of Appeal, about two-thirds of the judges' time is unrelated to IPR. This approach, where judges are both specialists and generalists, has worked well. It provides judges with a wider perspective which helps them to balance IPR laws in the context of broader commercial law.'

90 See Baum, *Specializing the Courts*, p. 33 (referring to the need to 'litigate jurisdictional boundaries').

91 See, by way of example, the recent US case *MDS (Canada) Inc. et al. v. Rad Source Tech., Inc.*, 720 F.3d 833 (11th Cir. 2013) in which the Eleventh Circuit held (see the short analysis of this case at <http://georgiaiplit.blogspot.ch/2013/07/11th-circuit-retains-jurisdiction-in.html>) that even where patent law is a necessary element of one of a plaintiff's well-pleaded state law claims, if the claim does not truly involve a 'substantial' question of federal patent law, original jurisdiction does not exist; with reference to and quote from *Christianson v. Colt Indus. Operating Corp.*, 486 U.S. 800 in which the Supreme Court confirmed the opinion of the Federal Circuit that it lacked jurisdiction and ruled that a case was not 'one arising under' federal patent law' unless 'the plaintiff ... set up some right, title, or interest under the patent laws, or at least makes it appear that some right or privilege will be defeated by one construction, or sustained by the opposite construction, of those laws.' *Ibid.*, at 807–8 (quoting *Henry v. A. B. Dick Co.*, 224 U.S. 1, 16, 56 L.Ed. 645, 32 S.Ct. 364 (1912)).

92 Posner, 'Will the Federal Courts of Appeals Survive until 1984?', at 787.

93 The Intellectual Property Organization of Pakistan Act, 2012 (at <http://ipo.gov.pk/UploadedFiles/IPO-Act-2012.pdf>) provides in this respect that (sec. 18 para. 1) 'All suits and other civil proceedings regarding *infringement* of intellectual property laws shall be instituted and tried in the Tribunal' (emphasis added) and that (para. 2) 'Notwithstanding anything contained in any other law for the time being in force, the Tribunal shall have exclusive jurisdiction to try *any offence* under intellectual property laws' (emphasis added).

94 The assessment of the role of courts in supporting innovation is a complex issue, also because it is not limited to IP law and policy but it may depend on other legal areas, and particularly contract law, arbitration law, civil procedure, see Erin O'Hara O'Connor and Christopher R. Drahozal, 'The Essential Role of Courts for Supporting Innovation', *Texas Law Review* 92 (2014): 2177–210 (<http://www.texaslrev.com/the-essential-role-of-courts-for-supporting-innovation/>) (analysing the role of courts in promoting innovation on the basis of a statistical analysis of the types of dispute resolution clauses – courts versus arbitration – used in innovation agreements, particularly from the perspective of the enforceability of specific performance clauses).

However, it is clear that a sufficient level of judicial experience and expertise can significantly improve the quality of justice in IP disputes. This appears particularly important as many IP disputes start with an application for preliminary injunctive relief (made by IP owners) on which the court is expected to decide expediently.⁹⁵

On this basis, certain practices for establishing a specialised IP court have been recommended, including the appointment of judges with a representative level of expertise in the relevant areas.⁹⁶ Depending on the technicality of the disputes at issue, this would involve considering a combination of judges with legal and technical expertise, trying IP cases by judges rather than juries, and providing adequate continuing training for the judges.⁹⁷ Given the rapid evolution of IP and of IP litigation,⁹⁸ it is essential to ensure that judges deciding IP issues benefit from appropriate training and education opportunities. This helps ensure that judges possess a sufficient degree of knowledge about the latest developments affecting IP law (at the local, regional and international levels) as well as about other important legal concepts and developments beyond IP law (in order to avoid the risk of developing 'tunnel vision'⁹⁹). This may materialise in different ways, including formal or informal contacts and exchanges with other IP judges in other countries. A dynamic legal and IP knowledge ecosystem should therefore be conceived and fostered.¹⁰⁰

The court's expertise in handling IP disputes can also result in the more efficient management of cases, given that judges would be in a better position to provide direction and guidance to the attorneys so that proceedings could be conducted more efficiently.¹⁰¹ It can also be reflected in the issuance of non-binding preliminary opinions on the merits of the case which can promote settlement between the parties.¹⁰² Non-IP specific procedural tools may also be of relevance in this context in order to

95 See Louis Harms and Owens Dean, 'South Africa's Specialized Intellectual Property Courts Regime', in IPI Study, p. 110: 'Lack of experience is especially a problem when dealing with urgent matters'; see also above text at note 41.

96 See e.g. for China, the 'Supreme People's Court Guiding Opinions on Selection and Appointment of the Judges of the Specialized IP Courts (Trial Implementation)' published on 28 Oct. 2014 according to which (Arts 3 and 4) only senior judges with at least six years of IP trial experience are eligible for appointment to the newly established Chinese specialised IP courts (see Hong Xue, 'Specialised Intellectual Property Courts in China', in Part Two (section on 'Improvement of Professionalism')).

97 IPI Study, p. 8; this is also expressed by Štrba, 'Specialised Intellectual Property Courts in Africa: The Case of Uganda', in Part Two.

98 At least as far as technology-related areas are concerned.

99 See text at note 75; see also Jens Schovsbo, Thomas Riis and Clement Salung Petersen, 'The Unified Patent Court: Pros and Cons of Specialization – Is There a Light at the End of the Tunnel (Vision)?' (editorial), *International Review of Intellectual Property and Competition Law* 46.3 (May 2015): 271–4 (http://link.springer.com/article/10.1007/s40319-015-0331-2/fulltext.html?wt_mc=alerts.TOCjournals) (at 274: 'To counterbalance the strong focus on technology, the UPC should thus make sure that the judges also are trained in issues of a non-technical nature in an attempt to widen the focus to include other parts of law that are considered essential for the normal construction of legal order').

100 IBA Survey, p. 34 (recommending among the proposals for actions to 'provide comprehensive IP training to help judicial systems further improve the administration of justice' and to 'promote information exchange among IP judges, i.e. study visits, regional conferences, and collections of significant court decisions from various countries'); online communication and education tools (e.g. MOOC (massive open online course) and other online education tools) could be conceived and made available in order to reach this goal.

101 See Zimmer, 'Overview of Specialized Courts', p. 2.

102 See *Weight Watchers (UK) Ltd & Ors v. Love Bites Limited & Ors* [2012] EWPCC 11 and *Fayus Inc & Anor v. Flying Trade Group Plc* [2012] EWPCC 43 (20 Sept. 2012), at <http://www.bailii.org/ew/cases/EWPCC/2012/43.html>: '13. [...] One matter discussed in court was whether the court would be prepared to give a preliminary, non-binding opinion on the merits along the lines of my decision in *Weight Watchers v. Love Bites* [2012] EWPCC 11. In that decision (paragraph 4) I said the following about the preliminary and non-binding opinion provided in that case: 4. [...] I should emphasise again that this is a preliminary view. It is not intended to be binding on me and it is not binding on the parties. It is something, however,

improve the time and cost efficiency of IP proceedings.¹⁰³ The court's interest in adopting certain procedural tools should be assessed on the basis of the entire IP system in the relevant jurisdiction, given that other institutions may also offer attractive dispute resolution mechanisms.¹⁰⁴

While specialisation may promote efficiency, overspecialisation can generate the risk of 'tunnel vision'.¹⁰⁵ From this perspective, it would appear adequate to implement a court system under which judgments rendered by courts (potentially specialised IP courts) are appealable to a non-specialised court.¹⁰⁶ This helps ensure that such non-specialised courts have the opportunity to acquire a sufficient level of expertise in the relevant field, particularly in patent disputes.¹⁰⁷ Creating an avenue for appeal may also incentivise specialised courts to ensure that their decisions are 'persuasive to the generalists';¹⁰⁸ if not, they may be overturned. This also means that the scope of the jurisdictional

which has been ventilated as a possibility that will be conducted in the Patents County Court. It seems to me that in an appropriate case it may well be a useful procedure. Also, as I have already indicated, it is a procedure which, in fairness to both sides, the Patents County Court will only embark on when both sides agree that it should be done. 14. The procedure is one which must be used with care and in fairness to both sides. Since the defendant in this case was not in a position to agree or disagree to this course I told the claimants' representatives that I was not prepared to embark on expressing such an opinion at that stage. However the directions made at the hearing included a provision giving the defendant the opportunity to state whether or not it was prepared to consent to the court expressing such an opinion. 15. It is likely that an appropriate circumstance in which this procedure might be used is one in which it may well help the parties to settle a case (c.f. CPR r 1.4(2)(f)). If the expression of a view is not likely to help the parties settle then it is hard to see what purpose it could achieve. If both parties wish to ask the court to express such an opinion then it is likely to be useful in helping them settle'; for a comment, see <http://www.nortonrosefulbright.com/knowledge/publications/65267/uk-patents-county-court-continues-to-innovate>.

103 See Eve Heafey, 'Are Your Evidentiary Ducks in a Row? Summary Trials in Trademark Litigation' (regarding the increased use of summary judgments in Canada thanks to a change of the Federal Court Rules), 11 May 2015 (http://www.smart-bigger.ca/fr/articles_detail.cfm?news_id=975) presenting the cases: *MC Imports Ltd v. Afod Ltd* (2014 FC 1161); *Lum v. Dr Coby Cragg Inc* (2014 FC 1171); *Sadhu Singh Hamdard Trust v. Navsun Holdings Ltd* (2014 FC 1139); see also Karen F. MacDonald and Elizabeth E. Farries, 'Summary Judgment and Summary Trial: Factors Affecting Availability of Summary Disposition in IP Disputes under the New Federal Courts Rules', at http://www.smart-bigger.ca/en/articles_detail.cfm?news_id=530, with reference to two recent IP cases: *Louis Vuitton Malletier S.A. and Burberry Limited et al. v. Singga Enterprises et al.*, 2011 FC 776 (copyright and trademark infringement) and *Teva Canada Limited v. Wyeth LLC*, 2011 FC 1169 (issue whether the plaintiff was entitled to pursue a claim under section 8 of the Patented Medicines (Notice of Compliance) Regulations).

104 By way of example, it can be noted that the UK IP Office offers a 'patent opinion service' under which the Office (i.e. a patent examiner) will offer, for a modest fee, a non-binding opinion on the infringement of UK patents and on certain aspects of their validity at the request of interested parties (see <http://www.ipo.gov.uk/types/patent/p-dispute/p-opinion.htm>); this service does not appear to have been very successful as of today even if the plan seems to expand this service beyond patents; see Cook, 'Alternative Dispute Resolution as a Tool for Intellectual Property Enforcement' (WIPO doc.), para. 24 pp. 7–8.

105 See text at note 73.

106 See also the dissenting opinion of Justice Breyer in *Laboratory Corporation of America Holdings v. Metabolite Laboratories, Inc. and Competitive Technologies, Inc.*, cert. dismissed as improvidently granted, 548 U.S. 124 (2006) (<http://www.supremecourt.gov/opinions/05pdf/04-607.pdf>): 'a decision from this generalist Court could contribute to the important ongoing debate, among both specialists and generalists, as to whether the patent system, as currently administered and enforced, adequately reflects the "careful balance" that "the federal patent laws ... embod[y]". *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989).'

107 See Darren Smyth, 'Patent Law Decisions from Supreme Courts: How Can Non-Specialist Judges Decide This Field of Law?', *Journal of Intellectual Law and Practice* 9.1 (2014): 31–9, at 39 (concluding his article by stating that 'the superior courts should be supplemented with judges having patent experience for such cases, since all jurisdictions in fact have a considerable number of specialized patent practitioners to draw upon').

108 See John F. Duffy, 'The Federal Circuit in the Shadow of the Solicitor General', *George Washington Law Review* 78.3 (2010): 518–52, at 552 (<http://groups.law.gwu.edu/lr/ArticlePDF/78-3-Duffy.pdf>) ('The patent attorneys typically arguing before the Federal Circuit are specialists, and they present their cases with arguments that seem sensible within the specialty. In deciding those cases, however, the Federal Circuit must fashion opinions that are persuasive to the generalists who hold final authority to review all patent appeals. In an era when the Supreme Court has resumed its traditional practice of reviewing a significant number of federal patent cases, attention to the ultimate generalist audience – the Justices – is essential to the long-term success of any actor in the patent system').

power of the court that is to ultimately review and scrutinise the decisions taken by specialised IP courts should be carefully defined.¹⁰⁹

In this respect, it has been convincingly claimed that if non-specialised judges cannot understand the complexity of IP law, this should not lead to the creation of specialised IP courts, but should rather lead to changes in substantive IP law itself.¹¹⁰ In any case, a model of 'limited specialisation' of judges may also help ensure that the courts remain cognisant of the broader policy context and societal environment when rendering IP decisions.¹¹¹ IP regulations are integrated in a general legal framework that reflects fundamental principles and values (particularly constitutional rights) that must also be observed when hearing IP disputes. This aspect should also be taken into account in the recruiting processes, where strategies should be adopted in order to ensure a sufficient diversity of expertise and of knowledge of general legal principles.¹¹²

In considering the need to establish specialised IP courts, it is important to assess whether specialised IP courts will be limited to specific types of IP disputes¹¹³ or rather open to all types of IP disputes. Certain models show that specialised patent courts can be justified because of the specificities and technicalities that patent litigation raises. However, it may be prudent to centralise all IP disputes in order to ensure the coherent development of IP law, as certain issues which are frequently litigated are (or should be) common to the different types of IP rights (such as damages, conditions for injunctive relief, IP transactions and licensing agreements¹¹⁴ etc.). Centralisation may further avoid or at least reduce the risks associated with delineating the boundaries and jurisdictional powers of the specialised courts.¹¹⁵ It should also be decided whether the specialised IP courts have jurisdiction to hear civil IP disputes and criminal disputes.¹¹⁶

109 Should it be *de novo* review (etc.); for a discussion from the perspective of the US Supreme Court, see John M. Golden, 'The Supreme Court as "Prime Percolator": A Prescription for Appellate Review of Questions in Patent Law', *UCLA Law Review* 56 (2009): 657–724 (<http://www.uclalawreview.org/pdf/56-3-3.pdf>).

110 See Rifkind, 'A Special Court for Patent Litigation?', at 426: 'If the patent law has already become so esoteric a mystery that a man of reasonable intelligence cannot comprehend it, then something has gone seriously wrong with the patent law. If that is so – and I do not hold this view – the cure lies in correcting the law, not in tinkering with the Bench.'

111 Gugliuzza, 'Pluralism on Appeal', at 42: 'to the extent that economic activity is regulated by many doctrinal fields outside of patent law, then the judges who decide patent cases should be familiar with those fields so as to better understand the full impact of their decisions on economic activity. A generalist judge who specializes in patent cases will appreciate the consequences of a particular decision on the patent system while also being more likely to situate the decision within a broader context of promoting economic competition and encouraging technological innovation'; for a pleading for the maintenance of generalist courts, see Diane P. Wood, 'Generalist Judges in a Specialized World', *SMU Law Review* 50 (1997): 1755–68, concluding her speech by stating that 'In my view, the contributions of the generalist judiciary are still far too great to abandon. The greatest pressure to move toward specialization appears to be coming from the business community, which would like faster justice for itself, but who does not want that? [...] More than ever, we need these generalist judges in our specialized world.'

112 See (about the UPC) Schovsbo, Riis and Petersen, 'The Unified Patent Court: Pros and Cons of Specialization' (at 274: 'In the recruitment of legally qualified judges, it should be regarded as a particular strength for candidate judges to (also) have a broader (generalist) legal experience. To support legal creativity and the further dynamic development of substantive patent law, the UPC should recognize diversity amongst the judges and the various divisions of the court of first instance as a value').

113 Specifically patent disputes.

114 For which harmonised rules should apply irrespective of the type of IP right which is the object of the relevant licence agreement; for a collection of essays on this issue, see Jacques de Werra (ed.), *Research Handbook on Intellectual Property Licensing* (Edward Elgar, 2013) (www.ip-licensing.info).

115 See text at notes 92–5.

116 The Thailand Intellectual Property and International Trade Court has jurisdiction for both civil and criminal cases, see <http://www.ipitc.coj.go.th/?co=en>; for an analysis, see Andrea Morgan, 'Trips to Thailand: The Act for the Establishment of and Procedure for Intellectual Property and International Trade Court', *Fordham International Law Journal* 23.3 (1999): 795–847.

The discussion about specialised IP courts should not ignore the fact that these new courts may not necessarily improve the efficiency of the proceedings if they do not adopt adequate methods for managing IP cases. From this perspective, the establishment of specialised IP courts should be distinguished from the creation of specific rules applying to IP disputes, given that specific rules for IP cases can be adopted without creating specialised IP courts.¹¹⁷ The experiences of developed countries in IP litigation¹¹⁸ could be of value in this respect. Special reference must be made to the measures which can enhance the accessibility and affordability of IP litigation,¹¹⁹ which can be achieved by the establishment of courts and procedures for less complex IP disputes¹²⁰ and/or small claims.¹²¹ Ensuring access to justice to (small) innovators is and should remain an important aspect of the promotion and protection of innovation.

Sound IP policymaking should be based on evidence.¹²² This guiding principle should not be limited

117 See the specific rules which apply to intellectual property claims at <http://www.justice.gov.uk/courts/procedure-rules/civil/rules/part63>.

118 Reference can be made to the interesting statements made by Lord Woolf in the report 'Access to Justice - Final Report', <http://webarchive.nationalarchives.gov.uk/+/http://www.dca.gov.uk/civil/final/contents.htm>, and particularly in Chapter 19 (dealing with 'Specialist Jurisdictions'), <http://webarchive.nationalarchives.gov.uk/+/http://www.dca.gov.uk/civil/final/sec4d.htm#r19>: '16. Clearly improvements could be made to the ways in which intellectual property litigation is handled. It continues to suffer from the vices of cost, delay and complexity. As the new draft rules make clear, dealing with a case justly includes handling it so as to ensure that, so far as is practicable, the parties are on an equal footing, and handling it in ways which are proportionate to the amount of money involved, the importance of the issues and the parties' financial position. I recognise that these matters may point in different directions, when it comes to considering which court should hear a case in intellectual property litigation. For example, the likely commercial effect on each party if relief is, or is not, granted, may not be apparent from a figure representing the value of the right being litigated. 17. In my view there is a pressing need for both the Patents Court and, more especially, the Patents County Court to develop procedures which go further than existing ones in providing rapid resolution of disputes, with a strict timetable and a trial limited in time, and a fixed budget for costs, as I am recommending for the fast track. This will enable smaller firms to compete on a more level footing with larger companies. I outline my proposals for such a procedure in chapter 5'; see also for Scotland, Robert Buchan and Gill Grassie, 'Scotland's New Regime for Effective Intellectual Property Dispute Resolution', *Journal of Intellectual Property Law and Practice* 8.5 (2013): 383–7 (<http://jiplp.oxfordjournals.org/content/8/5/383.full>).

119 Particularly for small and medium enterprises and for individuals.

120 This was the goal of the UK Patents County Court, which has been replaced by the Intellectual Property Enterprise Court (IPEC) as of 1 Oct. 2013 (see <https://www.justice.gov.uk/courts/rcj-rolls-building/intellectual-property-enterprise-court>); the IPEC is a specialised list in the Chancery Division of the High Court which has jurisdiction to hear cases in which the damages or profits recoverable do not exceed £500,000 (unless the parties agree that IPEC shall have jurisdiction to award damages or profits recoverable in excess of this limit (Civil Rules of Procedure, Part 63 (Intellectual Property Claims), rule 63.17A, at <http://www.justice.gov.uk/courts/procedure-rules/civil/rules/part63>); as indicated in the *Intellectual Property Enterprise Court Guide* (<https://www.justice.gov.uk/downloads/courts/patents-court/intellectual-property-enterprise-court-guide.pdf>), p. 6: 'the IPEC has been established to handle the smaller, shorter, less complex, less important, lower value actions and the procedures applicable in the court are designed particularly for cases of that kind. The court aims to provide cheaper, speedier and more informal procedures to ensure that small and medium sized enterprises and private individuals are not deterred from innovation by the potential cost of litigation to safeguard their rights. Longer, heavier, more complex, more important and more valuable actions belong in the Patents Court or the general Chancery list of the High Court'; for a presentation of the IPEC, see Angela Fox, *The Intellectual Property Enterprise Court: Practice and Procedure* (Sweet & Maxwell, 2014).

121 See the small claims track available before the UK IPEC for claims where the amount in dispute is £10,000 or less, see *Guide to the Intellectual Property Enterprise Court Small Claims Track* (July 2014) (<https://www.justice.gov.uk/downloads/courts/patents-court/patents-court-small-claims.pdf>). The establishment of small claims tracks is analysed in the US: on 18 Dec. 2012, the USPTO published a request for comments on patent small claims proceedings; ; comments are available at: <http://www.uspto.gov/patents-getting-started/international-protection/public-comments-patent-small-claims-proceedings>; see also Robert P. Greenspoon, 'Is the United States Finally Ready for a Patent Small Claims Court?', *Minnesota Journal of Law, Science and Technology* 10.2 (2009): 549–66 (http://mjlst.umn.edu/prod/groups/ahc/@pub/@ahc/@mjlst/documents/asset/ahc_asset_366031.pdf).

122 See Recommendation 1 of the UK report by Ian Hargreaves, *Digital Opportunity: A Review of Intellectual Property and Growth* (Department for Business Innovation and Skills, May 2011), p. 98 (<http://www.ipo.gov.uk/ipreview-finalreport.pdf>): '1. Evidence. Government should ensure that development of the IP System is driven as far as possible by objective

to issues relating to substantive IP laws and policies¹²³ but should also apply to procedural IP issues, and particularly to the decision to establish specialised IP courts. This requires a comprehensive and detailed monitoring system relating to IP litigation activity on the basis of which policy choices and recommendations could be formulated. For instance, a constant increase of IP litigation cases and a significant backlog could contribute to justifying the creation or expansion of specialised IP courts.¹²⁴ In this respect, particular attention should be paid to the two difficulties that have been identified in IP policymaking activities: 'a near-total lack of high-quality evidence on some issues and an overabundance of effective lobbying'.¹²⁵

1.5 Conclusion

How advantageous and potentially necessary it is to establish specialised IP courts in any given jurisdiction depends on a number of factors which are not limited to IP issues.¹²⁶ Rather, the debate must reflect upon the economic, legal¹²⁷ and societal characteristics of the country.¹²⁸ On this basis, the creation of specialised IP courts cannot be recommended irrespective of the situation in the country at issue.¹²⁹ A decision relating to the establishment of specialised IP courts must consequently be made on the basis of a fully informed, transparent, and unbiased analysis of the situation which prevails in the relevant territory. In this respect, the (alleged) efficiency gains and need for expertise and uniformity should not necessarily be deemed prevalent, as they might hide less valuable interests.¹³⁰

evidence. Policy should balance measurable economic objectives against social goals and potential benefits for rights holders against impacts on consumers and other interests. [...]; the Hargreaves Report further emphasises in its Executive Summary (p. 3) that 'Evidence should drive policy'; see the interesting recent report assessing the impact of the IPEC commissioned by the UK Intellectual Property Office from Christian Helmers, Yassine Lefouili and Luke McDonagh, *Evaluation of the Reforms of the Intellectual Property Enterprise Court 2010–2013*, 22 June 2015 (https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/447710/Evaluation_of_the_Reforms_of_the_Intellectual_Property_Enterprise_Court_2010-2013.pdf).

123 i.e. the existence and scope of protection of IP rights.

124 IIPI Study, p. 10; it should be noted that the TRIPS Agreement requires (Art. 63 para. 1) that 'final judicial decisions and administrative rulings of general application, made effective by a Member pertaining to the subject matter of this Agreement (the availability, scope, acquisition, enforcement and prevention of the abuse of intellectual property rights) shall be published, or where such publication is not practicable made publicly available, in a national language, in such a manner as to enable governments and right holders to become acquainted with them'.

125 *The Government Response to the Hargreaves Review of Intellectual Property and Growth*, Aug. 2011 (https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/32448/11-1199-government-response-to-hargreaves-review.pdf), p. 3.

126 The need to potentially improve the enforcement of IP rights is one among many other factors that should be taken into account in this respect.

127 Common law countries are sometimes considered to be less inclined to have specialised courts than civil law countries, see Baum, *Specializing the Courts*, p. 23 (even if this statement seems difficult to verify as far as specialised IP courts are concerned).

128 See also the Board Resolutions of INTA on Specialized Trademark Judiciaries, indicating that 'Many factors must be considered in designing and administering a court system, including local custom and practice, budgetary constraints, constitutional and jurisdictional issues, and many other factors. Nonetheless, as a matter of general principle, the development and implementation by some means of specialised and experienced judiciaries to hear trademark matters will benefit trademark owners and users and should be encouraged.'

129 See more generally about the creation of specialised courts, Baum, *Specializing the Courts*, pp. 226–7.

130 On this issue, see in general Baum, *Specializing the Courts*, p. 207.

It should also be emphasised that, perhaps contrary to common perception, there is no clear evidence that establishing specialised IP courts¹³¹ would necessarily benefit IP owners.¹³² From this perspective, it does not appear justified to consider that the creation of specialised IP courts will automatically improve IP protection and generate an increase in foreign direct investment.¹³³ The goal of creating such a court is not necessarily increasing the level of IP protection. Rather, it is ensuring an efficient and equitable dispute resolution mechanism that is conducted by expert judges for the benefit of all stakeholders, including the IP owners, the users of goods and services, and society as a whole.¹³⁴ The goal of finding a balanced system between competing interests reflects the essence of the ongoing work of WIPO's development agenda.¹³⁵ In addition, the global economy makes the goal of finding a balanced approach more essential. As countries and companies increasingly interact and cooperate across borders, stakeholders will increasingly become both owners of IP rights and users of third party IP rights, further justifying the adoption of a well-balanced system.¹³⁶

The decision to establish a specialised IP court cannot be legitimised solely by the need to fight IP counterfeiting activities, as counterfeiting cases are not so complex as to necessitate the establishment of specialised IP courts.¹³⁷ This is also confirmed by the fact that other governmental bodies and institutions are the primary actors in the fight against counterfeiters.¹³⁸ Depending on the situation in the relevant country, there might be a need to create 'specialised intellectual property enforcement units' (i.e. governmental entities in charge of combating IP counterfeiting activities).¹³⁹ However, the need for such IP enforcement units should not be confused with the need to create specialised IP courts.

There is a broad range of policy options and thus some flexibility between the use of generalist courts and the establishment of specialised IP courts to the extent that some intermediate solutions

131 Particularly patent courts.

132 See Mark A. Lemley, Su Li and Jennifer M. Urban, 'Does Familiarity Breed Contempt among Judges Deciding Patent Cases?', *Stanford Law Review* 66 (May 2014): 1121–57 (http://www.stanfordlawreview.org/sites/default/files/66_Stan_L_Rev_1121_LemleyLiUrban.pdf), concluding their paper (at 1155) by noting that 'As judges gain experience with patent cases, they are less likely to rule for patentees on infringement. Our finding is strong and highly significant, robust across districts, across time, and across areas of technology. This both challenges existing assumptions about forum shopping in patent cases and suggests that specialized patent trial courts may benefit accused infringers over patentees'; this is also discussed with respect to the IPAB in India, see Basheer, 'Specialist IP Adjudication: The Indian Experience', in Part Two (section on 'Does the IPAB Suffer a Pro IP Owner Bias?').

133 The IBA Survey, p. 28, however states that 'an increase in foreign direct investment may be realised by countries that create specialised IP courts'.

134 It is therefore too restrictive to consider only the interests of the IP owners and of the governments as such (see however the IPI Study, p. 10, which indicates that 'Specialized courts benefit the IPR owners and the government alike as they are more efficient and expedient').

135 See 'Development Agenda for WIPO', at <http://www.wipo.int/ip-development/en/agenda/>.

136 This applies to IP law as such as well as to other legal areas which are part of the IP ecosystem, such as IP licensing rules, see Jacques de Werra, 'Keeping the Genie of Licensing Out of the Bottle: Managing Inter-dependence in Licensing Transactions', *International Review of Intellectual Property and Competition Law* 45.3 (May 2014): 253–5; on the development of global IP licensing policies, see de Werra, *Research Handbook on Intellectual Property Licensing*.

137 See IPI Study, p. 111, which refers to and quotes Jason Bosland, Kimberlee Weatherall and Paul Jensen, *Trademark and Counterfeit Litigation in Australia*, Melbourne Law School Legal Studies Research Paper No. 208 (Feb. 2006) (http://papers.ssrn.com/sol3/papers.cfm?abstract_id=961527), p. 6: 'The striking feature about counterfeit cases is that they are legally very simple: they do not involve serious disputes over the boundaries of the trademark owner's rights.'

138 Particularly law enforcement agencies, customs and public prosecution offices and institutions.

139 IPI Study, p. 9.

may also be contemplated. Developing IP expertise in non-specialised IP courts has been identified as a valuable policy option for developing countries,¹⁴⁰ which may lead to the creation of specialist IP benches within regular courts.¹⁴¹ In this respect, establishing specific programmes to promote the judicial specialisation in certain IP matters may also be considered. Reference can be made to the US Patent Pilot Program (PPP), which was launched to channel patent cases in 14 test districts¹⁴² to judges who have opted to hear them,¹⁴³ thereby promoting the specialisation of these judges for hearing patent cases. This example shows that a process of judicial familiarisation and of specialisation in IP disputes does not necessarily require the creation of specialised IP courts at the trial level. Thus, the education of judges in IP matters does not presuppose the establishment of specialised IP courts. Ultimately, the most important factor is judicial expertise in IP disputes, which should be promoted as the primary goal.¹⁴⁴

What also appears relevant and interesting in this respect is implementing a system that maximises the opportunities for benefiting from existing expert knowledge in order to promote judicial efficiency. For example, Taiwanese law permits IP courts to ask the Taiwan Intellectual Property Office (TIPO) to intervene in court proceedings in which one party¹⁴⁵ claims patent invalidity. This affords TIPO the opportunity to express its view on the validity of the patent in dispute.¹⁴⁶ The sharing of knowledge and expertise can also mean that non-IP specific procedural tools can be used to obtain guidance, potentially in the form of a preliminary opinion, from a third party institution. This would help ensure

140 IBA Study, p. 7 ('An attractive approach for developing countries is probably to create or strengthen a commercial court which may hear IP related cases *inter alia* and provide improved access to justice for the business sector as a whole'); see also one of the proposals for action evoked in the IBA Survey, p. 34: 'Create specialised divisions for IP matters within courts of general jurisdiction and rotate judges throughout these divisions'; see also IIPJ Study, p. 7: 'It is also important to consider that while IPR case loads may not justify the establishment of an independent court that exclusively hears IPR cases, there are many alternative regimes that may better suit a country's needs, such as specialized divisions and judges'; see Fysh, 'Intellectual Property and Particularly Patent Litigation in the United Kingdom', p. 125.

141 See Basheer, 'Specialist IP Adjudication: The Indian Experience', in Part Two (section on 'Alternative Institutional Arrangements: Specialist IP Benches?') (this is also what resulted from an online poll conducted by this scholar, see Shamnad Basheer, 'A Specialist IP Court: Knowing More about Less?', 2 Apr. 2012, at <http://spicyip.com/2012/04/specialist-ip-court-knowing-more-about.html>).

142 The PPP started in 2011 and will run for ten years; see <http://www.uscourts.gov/statistics-reports/key-studies-projects-and-programs-annual-report-2011#patent> (which lists the selected districts).

143 See Lemley, Li and Urban, 'Does Familiarity Breed Contempt among Judges Deciding Patent Cases?', at 1123 ('The PPP is not itself a specialized court, but it encourages specialization within a district, concentrating experience with patent cases in the hands of a few judges').

144 It is therefore not surprising that this point constitutes the first proposal identified in the IBA Survey in the list of proposals for action, p. 33 ('Promote the specialization of IP judges, with initiatives including: specialist judges sitting interstate where there is not a specialist IP judge in that registry; and programmes to assist judges in keeping up to date with the latest developments and international trends in the IP field'); see also IIPJ Study, p. 8, listing as the first recommendation to 'appoint judges who have a background in intellectual property issues'; see also the resolution passed by four IP judges specialising in intellectual property respectively coming from Germany, Australia, the UK and the US (the resolution constitutes an annex to the IBA Survey, pp. 44–5) stating that 'WE: (i) agree that specialised IP judges are needed to ensure that IP law is adequately interpreted and applied for the benefit of IP right owners, consumers and the economy; (ii) Resolve that judges with specialist experience and understanding of IP and who keep abreast of current developments are likely to reduce hearing times, costs for litigants, increase efficiency, improve precision and predictability of adjudication and provide unification and consistency of legal principles; and therefore (iii) Urge that it is desirable both at the international and local level to implement effective IP enforcement systems which deliver efficient, consistent and cost-effective adjudication of disputes and that this is best achieved through appropriately resourced specialized IP courts, tribunals and judges set up in a way best suited to each jurisdiction's situation.'

145 Generally the defendant.

146 See Hsiu-Ru Chien, 'Taiwan IP Court asked to designate how TIPO assists litigants', *Journal of Intellectual Property Law & Practice* (2015) 10 (1): 15-16.

a correct and uniform application of IP laws, such as the procedures for referral for a preliminary ruling to another court, which can be done at the national¹⁴⁷ or regional level.¹⁴⁸

The establishment of specialised IP courts should not be viewed as a self-sufficient and free-standing policy instrument, but rather as *one* tool in the overall IP/innovation policy toolbox. It should consequently be complemented with policy instruments in order to promote creativity, foster innovation, and improve the quality of justice in IP disputes.

Increasing expertise and knowledge about IP issues can also be achieved by fostering opportunities for participation and for transparency in the judicial process. This can occur either *during* the course of litigation (such as admitting the filing of *amicus curiae* in IP litigation cases¹⁴⁹) or after the litigation

147 See for Singapore for the Copyright Tribunals which can refer a question of law to the High Court, Copyright Act (Chapter 63) (Original Enactment: Act 2 of 1987): '169. (1) A Tribunal may, of its own motion or at the request of a party, refer a question of law arising in proceedings before it for determination by the High Court' (http://statutes.agc.gov.sg/aol/search/display/view_w3p;page=0;query=DocId%3Ae20124e1-6616-4dc5-865f-c83553293ed3%20%20Status%3Ainforce%20Depth%3A0;rec=0#P1V1I-).

148 The Andean Community Tribunal of Justice (which was established by the Treaty creating the Andean Tribunal of Justice of 28 May 1979 (18 ILM 1203) (see www.tribunalandino.org.ec) has jurisdiction to interpret Andean legal provisions at the request of national judges on the basis of a procedure for preliminary rulings; see Laurence R. Helfer and Karen J. Alter, 'Legal Integration in the Andes: Law-Making by the Andean Tribunal of Justice', *European Law Journal* 17 (2011): 701–15; the Tribunal is based on the model of the European Court of Justice, see Karen J. Alter, Laurence R. Helfer and Osvaldo Saldias, 'Transplanting the European Court of Justice: The Experience of the Andean Tribunal of Justice', *American Journal of Comparative Law* 60 (2012): 629–64 (http://scholarship.law.duke.edu/faculty_scholarship/2458/); this may be used for IP law: see Laurence R. Helfer, Karen J. Alter and M. Florencia Guerzovich, 'Islands of Effective International Adjudication: Constructing an Intellectual Property Rule of Law in the Andean Community', *American Journal of International Law* 103 (2009): 1–47.

149 See the country case study by Denis Borges Barbosa and Pedro Marcos Nunes Barbosa, 'Specialised Intellectual Property Courts in Brazil', in Part Two of this issue, where they consider that the introduction of *amici curiae* before IP specialised courts and before the Superior Tribunal de Justiça in Brazil was an 'important catalyst for change in judicial decisions' along with other factors; for a discussion, see Denis Borges, 'Patents and the Emerging Markets of Latin America', in Frederick M. Abbott, Carlos M. Correa and Peter Drahos (eds), *Emerging Markets and the World Patent Order* (Edward Elgar, 2013), vol. 1, pp. 135–54. See also Jeremy Phillips, "'With friends like that ...': Amicus Briefs in Europe", IPKat blog post, 18 Oct. 2012, at <http://ipkitten.blogspot.ch/2012/10/with-friends-like-that-amicus-briefs-in.html> (interpellations in the original): 'What did the panelists think? From the Court of Justice, Sir Konrad Schiemann was quite blunt: there was no provision in that court's rules for the submission of amicus briefs and it was not in the hands of the court to change those rules: nor should they be welcomed since their inevitable effect would be to make cases take longer [this Kat notes that, in at least one recent case, the Advocate General has treated a submission from a United Nations agency as "an unofficial *amicus curiae* brief": Case C-31/09 *Bolbol*. In Joined Cases C-466/09 *Philips/Nokia* the Advocate General refers to the INTA's submissions but does not clarify their legal status. In its judgment the Court describes INTA as an "intervener", suggesting that it has the status of a party]. Sir Konrad later observed that, in proceedings before his court on a reference from a national court which did admit amicus briefs, the content of such briefs would automatically form part of the corpus of relevant materials on which his court would focus when reaching its decision. Sir David Kitchin took a different line: if amicus briefs are admitted, he suggested, this should be done at first instance. If this does not happen, the appellate court in receipt of such a brief may be effectively deciding the case *de novo*. If this is so, then it should be possible for the other side to submit its own material in response, in order to level out the uneven playing field. Daniel Alexander was quite well-disposed towards amicus briefs in IP litigation, particularly where the court consists of a panel of non-specialists [of which the Court of Justice of the European Union, Merpel notes without any disrespect, is the paradigm]. In particular, where a panel of non-specialists is required to give a ruling which may have far-reaching consequences, it may be good for its members to know the consequences of their decision. While the European Commission and Member States often make submissions to the Court, this may not entirely cover the range of issues that an amicus brief might raise. This Kat ventures to suggest that amicus briefs should be welcome in Europe, but on the following terms: (i) they should be introduced as early as possible in the proceedings, so that they can be studied carefully and, if necessary, made the subject of amicus briefs to contrary effect; (ii) to the extent that they purport to speak on behalf of the public at large or a general public interest, they should be made fully available to the public and (iii) as a matter of common sense rather than legal policy they should be deployed as sparingly as possible since, the fewer they are in number, the greater is likely to be their individual impact: the judges already have enough to read and should not be unnecessarily burdened.' On the positive impact of *amici curiae* on the development of IP case law in Brazil, see Barbosa and Barbosa, 'Specialised Intellectual Property Courts in Brazil'; in this respect, it can be noted that scholars discussing the pros and cons of the UPC have advocated for an increased dialogue of the UPC with interested third parties beyond patent circles, see Schovsbo, Riis and Petersen, 'The Unified Patent Court: Pros and Cons of Specialization' (at 274: 'the UPC should find ways to engage in a dialogue with interested circles and not just patent specialists').

by publishing the decisions rendered in IP cases,¹⁵⁰ and by making available databases of IP cases,¹⁵¹ thereby increasing the transparency of the IP litigation system in the relevant country¹⁵² and making these useful resources available to interested parties (including foreign courts and judges).¹⁵³ What should also be promoted are international exchanges between judges and courts dealing with IP cases. International organisations¹⁵⁴ have led initiatives and projects for the purpose of building and sharing expertise. These efforts have resulted in constructive opportunities for mutually enriching and stimulating exchanges. Fostering such dialogues appears essential, given that many IP issues, particularly internet-related IP matters, are global in nature even though they remain largely governed by local rules. These activities and efforts must be pursued and encouraged and should help identify the platforms and methods that maximise the attractiveness and use of capacity-building opportunities that will be made available to IP judges around the world.

Taking into account the entire IP ecosystem implies a careful analysis of the respective missions of all relevant institutions that play a role in the IP environment. In particular, this implies an identification of the processes by which IP rights are granted in the relevant jurisdiction, given that the need for specialised IP courts may increase if the relevant IP rights have been previously granted without a complete examination of their validity at the time of registration. An assessment of the entire IP ecosystem is critical because the efficiency of IP dispute resolution mechanisms in any given jurisdiction not only depends on the judiciary, but also on other players, specifically lawyers who plead before such courts.¹⁵⁵ The issue to consider is thus whether, as is done in certain countries, there is a need to create and request special professional (continuing) education for lawyers practising in certain legal areas¹⁵⁶ (including intellectual property law).

150 Subject to the protection of the legitimate interests of the parties, specifically in trade secrets misappropriation cases.

151 See the WIPO project listing 'Internet Sources for Intellectual Property Case Law', at http://www.wipo.int/enforcement/en/case_law.html.

152 Art. 63 para. 1 TRIPS requires in any case that 'final judicial decisions and administrative rulings of general application, made effective by a Member pertaining to the subject matter of this Agreement (the availability, scope, acquisition, enforcement and prevention of the abuse of intellectual property rights) shall be published, or where such publication is not practicable made publicly available, in a national language, in such a manner as to enable governments and right holders to become acquainted with them'; it is surprising that this requirement of transparency and of publication of decisions is made in the interest of 'governments and right holders', given that transparency also serves the interests of third parties and of society at large, which have a strong interest in knowing the existence and the limits of protection of IP rights which have been litigated; reference can be made in this respect to the major Japanese 'Transparency of Japanese Law Project' which covered many different legal fields, including intellectual property law, for which the relevant Japanese sources were presented in the English language; on this project, see Toshiyuki Kono, *The 'Transparency' Project: Its Achievements, and Some Cross-Cutting Issues* (11 Jan. 2012), at <http://ssrn.com/abstract=1983591>; see also the publication policy of the Swiss Federal Patent Court (as set forth in the Information Regulations of the Federal Patent Court, at http://www.patentgericht.ch/fileadmin/web-dateien/014.222_Informationenreglement_fuer_das_Bundespatentgericht_EN_per_121212.pdf) which aims at 'an open and transparent information policy' (Art. 2 para. 1) and which provides that the 'Federal Patent Court shall publish its final decisions on the Internet ten days upon dispatching same to the parties to the proceeding' (Art. 3 para. 1).

153 See Štrba, 'Specialised Intellectual Property Courts in Africa: The Case of Uganda', in Part Two, identifying 'access to jurisprudence and other reference materials' as a requirement for the efficient functioning of the courts having to decide intellectual property disputes.

154 For example: WIPO, WTO and the United Nations Conference on Trade and Development (UNCTAD).

155 Harms, 'The Role of the Judiciary in Enforcement of Intellectual Property Rights', p. 9: 'any advantage gained by having expert judges is often diluted when lawyers without a smattering of IP knowledge try their hand at an IP case'.

156 This is the case in Germany for specialised lawyers ('Fachanwälte'), for industrial property rights ('gewerblicher Rechtsschutz') and for copyright and media law ('Urheber- und Medienrecht'), see Fachanwaltsordnung of the German federal association of lawyers (Bundesrechtsanwaltskammer) in its version of 1.11.2012, at http://www.brak.de/w/ files/02_fuer_anwaelte/berufsrecht/fao-stand-01.11.12.pdf.

The need to adopt a broader perspective is also reflected by the measures that an IP owner can exercise before formally lodging a case with a court, in order to avoid unjustified threats of IP infringement actions.¹⁵⁷ On this basis, an efficient IP dispute resolution ecosystem should also seek to eliminate vexatious IP infringement actions against innocent third parties. Such a practice helps ensure that courts are not unnecessarily burdened by meritless claims and can remain available to litigants entangled in non-frivolous IP disputes.¹⁵⁸

In sum, the balance of competing interests, which is at the core of the substantive IP system, should also be implemented in the mechanisms by which IP disputes are solved. This will ensure that all interests are duly considered in an equitable manner. Any decision to establish specialised IP courts should consequently reflect this balance and be taken on the basis of a thorough analysis in the light of the situation prevailing in the relevant jurisdiction.

157 By way of example, the UK Law Commission conducted a consultation and published a report on the topic *Patents, Trade Marks and Design Rights: Groundless Threats*, LAW COM No. 346, Cm 8851, Apr. 2014 (http://www.lawcom.gov.uk/wp-content/uploads/2015/03/lc346_patents_groundless_threats.pdf); in its response to the Law Commission's report on 26 Feb. 2015, the government accepted the Law Commission's conclusion that the threats provisions should be retained but with some reforms, see <https://www.gov.uk/government/publications/government-response-to-law-commissions-groundless-threats-report>.

158 Without of course unduly restricting the legitimate right to access justice and without implying either that IP disputes the financial value of which would be low shall be considered as frivolous or meritless.

Part Two

Current Situation in Selected Emerging Countries

Specialised Intellectual Property Courts in Brazil

Denis Borges Barbosa and Pedro Marcos Nunes Barbosa

In 1996 Brazil enacted the Industrial Property Law which makes reference to the creation of specialised courts in the field of intellectual property.¹ However, it was not until five years after its approval that Brazil created a special trial or appellate intellectual property court.

Federal courts in Brazil decide cases brought against federal entities. Therefore, the validity of patent issuances and trademark registrations are discussed in those courts. However, infringement suits are, as a general rule, decided by the 27 courts of the state judicial system. Until a recent change in the case law, invalidity claims were raised in both federal (*principaliter*) and state courts (incidentally), even though in the latter case it only occurred as a matter of defence. In other words, the defendant in an infringement suit could raise the invalidity of the patent or trademark as an argument against the plaintiff.

Thus, there is some risk of divergent readings of the same federal statute. However, a minimum level of national coherence is assured through a mid-level federal court sitting in Brasilia (the Superior Tribunal de Justiça – STJ), which hears third-level appeals from both state and federal appellate courts. The Supreme Federal Court only has an opportunity to analyse a particular dispute if it involves constitutional issues.

Nonetheless, in 2001 the Second Federal Regional Court, the jurisdiction where the Brazilian Patent and Trademark Office (INPI) is located, issued an internal order whereby four trial courts received suits discussing industrial property on an exclusive basis.²

Federal plaintiffs are not obliged to select the INPI headquarters as the venue for proceedings. However, as most prefer to do so, there are enough litigants to justify the existence of four dedicated federal trial courts. These courts are the only specialised courts in Brazil. However, they also deal with social security matters, which usually represent 95 to 97 per cent of their overall number of cases. Although patents, trademarks, designs, etc., only represent a small portion of the judicial workload, these are conceivably the court's most interesting and economically meaningful tasks. Perhaps for these reasons, the intellectual property decisions are usually the most expeditious items on the court's docket.

1 Law 9.279/96, 'Article 241 – The Judiciary is authorized to create special courts to settle questions relating to intellectual property'. This authorization could only have a symbolic purpose, as under Art. 96 of the Constitution the judiciary itself is the only source of proposals allowed to add new judges and courts. That is to say, the Industrial Property Law, which was not originally proposed by the judiciary, had no power to grant what had not already been requested. Furthermore, even in the event that the authorization was deemed valid, a Federal Law could not authorize state courts to reorganize their own services. On the other hand, the concentration of a legal issue in the trial or appellate court, without creating new jobs or incurring budgetary increases, can be and was done without statutory change.

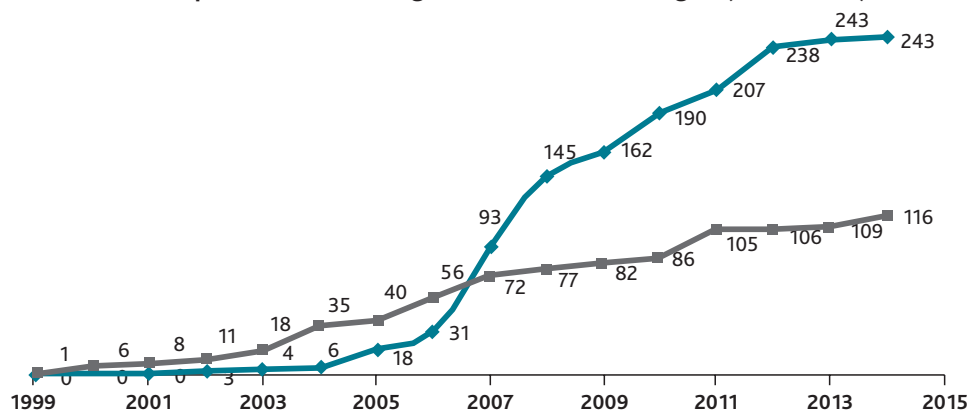
2 The specialized jurisdiction was introduced by Art. 47, III and sole paragraph of the Provimento no. 01, of 31 Jan. 2001, of the Corregedoria-Geral da Justiça Federal da 2ª Região.

Another significant change occurred in 2005 when two specialised appellate panels were added to the trial courts of the Second Federal Regional Court.³ Whenever a sectional decision *en banc* is mandated by the Court's rules of procedure, the two specialised panels sit in a joint session.⁴

By 2004 the then President of INPI, Ambassador Jaguaribe, was quite aware of the doctrinal changes experienced by the intellectual property law judicial system in the United States after the creation of specialised courts in the early 1980s. A number of Brazilian academics and public policy officials believed that the specialised US judiciary had increased the quality of decisions. However, there is a perception of bias towards the interests of patent or trademark holders – potentially to the detriment of public interest. Therefore, the INPI and some academic institutions strove to provide the newly specialised judges (appellate and trial) and their staff with the opportunity to obtain information and engage in broader discussions with both professional entities and intellectual property university programmes.

These opportunities apparently contributed to a noticeable change in the content of the decisions of the specialised trial and appellate levels of the Second Federal Regional Court. For example, since 1999 there has been a general decline in the number of decisions favouring patent holders on particular issues, including the controversial pipeline patent dispute.⁵

Figure 1. Number of court decisions accepting or declining patent extensions in the case of pharmaceuticals, agrochemicals and biologics (1999-2015)



In Figure 1, the blue line represents courts decisions favouring the extension of original patent rights for pharmaceutical, agrochemical and biotechnological patent holders. The grey line represents the number of decisions declining those extensions. The data appear to indicate that the special trial and appellate courts are able to achieve a more prudent and informed outcome. This is a result of the courts becoming more familiar with IP issues and learning to rely on the technical expertise of the Patent and Trademark Office.

3 The special appellate courts were created by Art. 18 of the Resolução no. 36, of 25 Nov. 2004, to come into force by Feb. 2005.

4 That happens, for instance, where an appeal is decided by the three-judge panel with a divergent vote; a new appeal may be directed to the enlarged panel.

5 On the Brazilian version of the pipeline patent, see Pedro Marcos Nunes Barbosa, 'A Brief Note Concerning Pipeline Patents in Brazil', WIPO-WTO Colloquium Papers: Research Papers from the WIPO-WTO Colloquium for Teachers of Intellectual Property Law, 2012, p. 31 (http://www.wto.org/english/tratop_e/trips_e/wipo_wto_colloquium_aug12_e.pdf).

Once this new trend became apparent, large-scale plaintiffs tended to file more actions outside Rio's Federal Court,⁶ not necessarily achieving different results in all cases. The STJ has not demonstrated specific deference to the Federal Courts of Rio de Janeiro. However, the Brasilia Court also works in a somewhat specialised manner, as all matters dealing with IP law are submitted to two permanent panels. Until the present, most Rio court decisions were confirmed by the STJ in Brasilia.

Another important catalyst for a change in judicial decisions was the commencement of *amicus curiae* proceedings before the specialised courts and, in some cases, before the STJ.⁷ This procedural instrument allowed for the introduction of opinions and contributions from trade associations, non-governmental organisations, and other concerned entities into what were essentially private suits discussing patent, data protection and related matters. *Amicus curiae* briefs have become one of the most extensively used means to present policy and even strictly factual issues before the courts.

Recently, some state courts have chosen to specialise in appellate courts or, in one case, a trial court. This has occurred in venues where intellectual property matters are comparatively more litigated. For example, the Rio de Janeiro state court has only specialised at the trial level and has recently included copyright suits within the purview of general commercial courts. However, most practitioners regard these actions as not having produced a noticeable change in the quality or expediency of the Rio state courts.

In São Paulo and Rio Grande do Sul, the local system has begun to include two specialised IP chambers in the last two to three years. These panels, and their federal counterpart,⁸ also hear commercial disputes, but exclude copyright issues, which are under the jurisdiction of the general civil panels.

However, it has become apparent that specialisation has improved the quality and consistency of individual decisions. To a considerable extent it has also improved the content of the public policy of these chambers. This trend is particularly clear in the case of São Paulo where the new court has operated for a longer period of time.

Some academics are of the view that the new specialised federal and state courts have transformed themselves into mainstream purveyors of the substantive intellectual property law in Brazil. These courts have displayed an ability to be balanced in their attention to both the private and public interest of this field of law.

6 Aiming at a non-specialised trial, in which the arguments might sound more persuasive to a less experienced judge.

7 Other important reasons may have caused the change in decision-making in the Brazilian specialised courts. See Denis Borges Barbosa, 'Patents and the Emerging Markets of Latin America', in Frederick M. Abbott, Carlos M. Correa and Peter Drahos (eds), *Emerging Markets and the World Patent Order* (Edward Elgar, 2013), vol. 1, pp. 135–54, where we suggest that besides the court specialization and the *amicus curiae* proceedings, the enhanced role of the Ministry of Health in IP issues, the governance provided by the Interministerial Committee on IP (GIPI) and the Innovation Law have been contributing significantly to the Brazilian IP environment.

8 At the Second Federal Regional Court, the appellate panels also take criminal, social security and tax cases. Industrial property matters are usually handled in specialised sessions where multiple cases are heard and decided, sometimes with deep and heated discussion.

Specialised Intellectual Property Courts in China

Hong Xue

China's first specialised intellectual property (IP) court was officially unveiled in Beijing on 6 November 2014. The other two specialised IP courts were established later in Shanghai and Guangzhou respectively before the end of 2014. These specialised IP courts have accepted their first batch of cases.

The specialised IP courts were established according to the Chinese National People's Congress (NPC) Standing Committee's 'Decision to Establish the Specialised Intellectual Property Courts in Beijing, Shanghai and Guangzhou' (NPC Decision) on 31 August 2014.¹ The NPC is the highest legislative body in the country, and the decisions of its Standing Committee are functionally equivalent to codified law. The NPC Decision entered into effect on 31 August 2014.

To implement the NPC Decision, the Supreme People's Court (SPC), the highest judiciary of China, issued the 'Stipulations on the Scope and Jurisdiction of the Specialised Intellectual Property Courts in Beijing, Shanghai and Guangzhou' (SPC Stipulations) on 31 October 2014. The SPC Stipulations entered into effect on 3 November 2014.²

The establishment of specialised IP courts is a new initiative for the Chinese judiciary. It has both advantages and disadvantages that may impact on the Chinese legal and judicial system.

Reform of Jurisdiction

Scope and jurisdiction

The Chinese judicial hierarchy has four levels of courts: the SPC, high people's courts, intermediate people's courts, and basic people's courts.³ The specialised IP courts are generally at the intermediate court level.

Specialised IP courts were included in the Chinese strategic policy to deepen and further judicial reform. The SPC Stipulations define the scope of the specialised IP courts' judicial power. According to the Stipulations, specialised IP courts are responsible for the following types of cases:

- all first instance civil or administrative cases involving invention, utility and design patents, plant variety protection rights, layout designs of integrated circuits, ownership of technical secrets, and copyrights for computer software;⁴

1 NPC Decision was passed by 10th Session of 12th NPC Standing Committee on 31 Aug. 2014. See *Legal Daily*, 1 Sept. 2014 (http://www.legaldaily.com.cn/index/content/2014-09/01/content_5743387.htm); see also <http://chinaipr.com/2014/09/02/specialized-ip-courts-established-in-beijing-shanghai-and-guangzhou-song-xiaoming-new-chief-ip-judge/>

2 The SPC Stipulations were passed by 1628th Conference of the SPC Trial Committee on 27 Oct. 2014. See *People's Court Daily* at <http://www.chinacourt.org/law/detail/2014/10/id/147980.shtml>.

3 Collectively referred to as the 'people's courts'.

4 In the Chinese IP legal system, plant varieties and layout designs of integrated circuits are subject to *sui generis* protection independent of patents and copyright, and trade secrets are in the arena of unfair competition.

- appeal cases against administrative decisions made by the departments of the State Council and local governments above county level involving copyright, trademarks, and unfair competition; and
- all the civil cases where the recognition of a well-known trademark is involved.⁵

Provided that the dispute involves one of the aforementioned topics, it is within the jurisdiction of the specialised IP courts' judicial power irrespective of whether it contains other unspecified IP issues.

Civil and administrative proceedings

Under the SPC Stipulations, the judicial power of specialised IP courts' only extends to the listed types of civil cases, rather than all civil cases involving IP disputes. The first instance jurisdiction for all unspecified civil cases⁶ will be determined according to the general rules of the Chinese Civil Procedure Law.⁷

The specialised IP courts are empowered to cover both civil and administrative cases. This flexibility allows them to maintain consistency in related civil and administrative proceedings⁸ and improve judicial efficiency.

With respect to administrative cases, the judicial power of specialised IP courts is more extensive. These courts are empowered to hear all appeals brought against administrative decisions regarding subsistence, ownership and infringement of IP rights. They also have jurisdiction over first instance administrative cases involving specified subject matter such as patents, plant varieties, layout designs of integrated circuits, technical secrets, and computer software copyright.

Under the new specialised IP court system, the Beijing IP Court is of special importance as it will be solely responsible for dealing with appeal cases against the following:

- administrative decisions relating to the grant, validity or scope of IP rights involving patents, trademarks, plant variety protection and layout designs of integrated circuits made by the State Council departments;
- administrative rulings by State Council departments involving compulsory licences and related disputes with regard to patents, plant variety protection and layout designs of integrated circuits; and
- other administrative acts involving the grant, validity or scope of IP rights made by the State Council departments.⁹

5 See the SPC Stipulations, Art. 1. Compared with the NPC Decision, the SPC, based on its authority in the judicial system, puts first instance civil and administrative cases involving copyright of computer software and all civil cases involving recognition of well-known trademarks in the judicial power of the specialized IP courts.

6 For example, a copyright ownership or infringement dispute involving copyright works other than computer software.

7 Chinese Civil Procedure Law, adopted at the 4th Session of the 7th National People's Congress on 9 Apr. 1991 and amended in 2007 and 2012, provides that a civil action instituted against a citizen shall be under the jurisdiction of the basic people's court at the place of domicile of the defendant.

8 Such as a civil dispute of patent infringement and the related administrative case to invalidate the patent.

9 See the SPC Stipulations, Art. 5.

According to these stipulations, the judicial power of the Beijing IP Court extends to almost all the administrative cases involving decisions made by the State Council departments responsible for intellectual property protection. This includes judgments from the Patent Re-examination Board of the State Intellectual Property Office and the Trademark Review and Adjudication Board of the State Administration of Industry and Commerce, which supervise patent and trademark matters. Since all the State Council departments are located in Beijing it is reasonable to assign these administrative cases to Beijing IP Court.

Enhancement of Judicial Independence

Transterritorial jurisdiction

The NPC Decision and the SPC Stipulations clearly establish the transterritorial jurisdiction of the specialised IP courts.¹⁰ Transterritorial jurisdiction is intended to break through 'local protectionism' and ensure the independence and impartiality of the judicial system. Establishing the court's transterritorial jurisdiction is one of the important measures for judicial reform.

Under the Chinese Civil Procedure Law, jurisdiction is territorially based. Thus, a civil action instituted against a citizen or legal person is under the jurisdiction of the people's court at the defendant's place of domicile.¹¹ Although the rule is not absolute, territorial jurisdiction is the fundamental principle. Notwithstanding the rationale of territorial jurisdiction, the people's court at the defendant's place of domicile may be unduly influenced by the local government for local economic and other interests. This bias may result in protectionist judgments or decisions.

In contrast, transterritorial jurisdiction prevents the specialised IP courts from local protectionism. Thus, the principle allows IP courts to render judgments and decisions independently and impartially. Under the SPC Stipulations, the first instance jurisdiction of specified types of cases is independent of the IP local enforcement route that precedes the filing of the case and applies to both civil and administrative cases.¹² With respect to first instance cases, the Beijing and Shanghai IP Courts are responsible for the specified types of cases in their respective municipalities, while the Guangzhou IP Court's jurisdiction extends to cases arising across the Province of Guangdong.¹³ Appeal from the judgments and decisions of the specialised IP courts will go to the respective high people's courts in Beijing, Shanghai and Guangdong Province following the existing standard approach.¹⁴

Through transterritorial jurisdiction, the specialised IP courts are empowered to accept all appeals against first instance judgments involving copyright, trademarks, technological contracts, and unfair competition made by the basic people's courts in cities of the specialised IP courts. Under such

10 See the NPC Decision, Art. 2, and the SPC Stipulations, Art. 2. The NPC Decision provides for general transterritorial jurisdiction for the specialised IP courts, while the SPC Stipulations actually limit their transterritorial jurisdiction to their respective municipalities or provinces in the first three years of their establishment.

11 See Chinese Civil Procedure Law, Art. 21.

12 Under the NPC Decision, transterritorial jurisdiction may develop further to enable three specialised IP courts to compete in a healthy way for the first instance technical matter cases, depending on their expertise and speciality.

13 For example, based on the SPC Stipulations, Guangzhou IP Court is responsible for all the specified technical matter cases irrespective of the location of defendants or the administrative agencies in Guangdong Province, which has 21 cities, 54 municipal districts, 23 towns and 41 counties.

14 See the NPC Decision, Art. 4; SPC Stipulations, Art. 7.

an approach, the specialised IP courts can ensure the uniformity and consistency of IP protection standards within their respective territory.

Centralised jurisdiction

The specialised IP courts provide centralised jurisdictions for the specified technical matter cases in both civil and administrative proceedings. Under the SPC Stipulations, with the establishment of the specialised IP courts, the intermediate people's courts in Beijing, Shanghai and Guangzhou no longer accept civil or administrative cases involving IP matters. The intermediate people's courts in other parts of Guangdong Province¹⁵ and the basic people's courts in Beijing, Shanghai and Guangzhou no longer accept cases that fall within the jurisdiction of the specialised IP courts.

The concentration of jurisdiction has had a large impact on the previous state of IP jurisdiction. Beijing courts have an established history of hearing IP cases. In 1993, the Beijing intermediate people's court established the country's first IP trial divisions. By 2013, courts in Beijing had heard over 15,000 IP cases, accounting for up 13 per cent of the nation's cases. All administrative appeals made after government rulings were heard in Beijing courts.

Supervision

To ensure the institutional independence of the specialised IP courts, the NPC Decision provides that trials are supervised by the Supreme People's Court and the high people's courts in the respective municipalities or provinces, as well as the Supreme People's Procuratorate in the respective territories. A specialised IP court is responsible for reporting the respective location to the People's Congress.¹⁶

The chief judge of the specialised IP court is appointed by the Standing Committee of the National People's Congress of the respective region at the recommendation of the director of the Standing Committee. The deputy chiefs and other primary judges are appointed by the Standing Committee of the People's Congress of the respective region at the recommendation of the chief judge.¹⁷

Improvement of Professionalism

Apart from the chief judges and deputy chief judges who are appointed by the respective legislatures, specialised IP courts consist of professional IP judges with experience hearing IP disputes at the trial level. According to the 'SPC Guiding Opinions on Selection and Appointment of the Judges of the Specialised IP Courts (Trial Implementation)', published on 28 October 2014, only senior judges with at least six years' IP trial experience are eligible for appointment to the specialised IP courts.¹⁸

15 This refers to the intermediate people's courts in the parts of Guangdong Province other than Guangzhou, the capital city of the Province.

16 See the NPC Decision, Arts 5 and 6.

17 See the NPC Decision, Art. 6. For example, the jurist Mr Su Chi was appointed as the Chief Judge of the Beijing IP Court along with experienced judges who had tried more than 600 IP cases.

18 See 'SPC Guiding Opinions on Selection and Appointment of the Judges of the Specialised IP Courts (Trial Implementation)', Arts 3 and 4.

The specialised IP courts also appoint technical investigators to assist the judges with technical cases. The SPC released 'Provisional Stipulations on Several Issues concerning the Participation of Technical Investigators in the Proceedings of Intellectual Property Courts' on 21 January 2015, which outlines the first set of rules for technical investigators.¹⁹

Unlike expert witnesses, technical investigators assist judges in understanding the technical issues. According to the Provisional Stipulations, technical investigators are hired by the specialised IP Court as judicial auxiliary staff. Upon the judge's request, the technical investigator may help the judge on the following aspects:

- pinpointing the focus of dispute as to technical facts by consulting litigation documents and evidential materials;
- making recommendations as to the scope, sequence and method of investigation of technical facts;
- participating in investigation, evidence collection, inspection and preservation, and making recommendations as to the methods and procedures thereof;
- participating in inquiries, hearings and trials;
- advancing technical examination opinions, and attending collegiate panel deliberations;
- assisting the judge, when necessary, in calling together appraisers and professionals in related specific technical fields to gather appraisal opinions and advisory opinions thereof;
- completing other tasks assigned by the judge.²⁰

In attending case deliberations, the technical investigator gives his or her opinion with regard to case-related technical issues, and responds to the judge's inquiries about technical issues. The technical investigator does not have the right to vote in the case's adjudication. The technical investigator's opinions, duly signed, are to be kept in the notes of deliberations.²¹ The technical examination opinions offered by the technical investigator may serve as a reference for the judge to discover the technical facts.²²

Conclusions

After more than 20 years of fast growth the Chinese economy is slowing down and transitioning from a manufacturing economy to a knowledge economy. The Chinese authority is of the view that innovation and creativity are facilitated through a system of IP rights and their effective enforcement.

In November 2013, at the 3rd Plenary Session of the 18th Communist Party of China (CPC) Central Committee, the Communist Party of China, the ruling party, released the roadmap for China's social and economic reform and development. In that landmark policy document, the CPC made a

19 See Intellectual Property Judicial Protection Network, at <http://www.chinaiprlaw.com/index.php?id=504>.

20 See the Provisional Stipulations, Arts 1 and 6.

21 See the Provisional Stipulations, Art. 8.

22 See the Provisional Stipulations, Art. 9.

commitment to strengthen the protection of intellectual property rights, improve the mechanisms for encouraging innovation, and explore ways of setting up the specialised IP courts. In line with the roadmap, the State Council, China's highest administrative body, published the '2014–2020 Action Plan for the Thorough Implementation of the National Intellectual Property Strategy' on 10 December 2014. This document aims to significantly improve China's capacity to create, use, protect, and manage IP and benchmarks the metrics for accumulating more IP rights (such as annual figures for approved patents, registered trademarks and registered copyright works).

Although many scholars have asserted that China needs to build a more balanced IP system, the overwhelming tendency is to strengthen IP protection and enforcement.²³ It seems clear that the current strategic goal of Chinese national IP policy is to create and stimulate (indigenous) proprietary IP rights with vigorous enforcement, rather than improve access to the knowledge and information and openness to the people at large.

The new initiative of the specialised IP courts reflects this kind of national policy.²⁴ The specialised IP courts, equipped with resources, capacity and legal support, are no doubt a milestone in Chinese IP enforcement and judicial reforms. With the reform of jurisdiction, enhancement of independence, and improvement of professionalism, the IP courts should be able to quickly acquire authority, expertise, and specialisation. Notwithstanding the potential of specialised IP courts, the progression towards IP enforcement is unlikely to ensure a more balanced IP system. The professional IP judges of these courts could overemphasise the exclusiveness of IP rights and overlook the broader social and policy implications. Although it is premature to conclude how the newly established specialised IP courts will contribute to the Chinese IP ecosystem in the long run, the challenges which confront these courts will be considerable.

23 In legislative terms, the Chinese Trademark Law and Patent Law have been revised substantively in recent years and the Copyright Law is undergoing another substantive revision. Scholars have criticised the lack of vision in the legislative process on balancing IP protection with general public interests. See Hong Xue, 'One Step Ahead, Two Steps Back: Reverse Engineering the Second Draft for the Third Revision of the Chinese Copyright Law', *American University International Law Review* 28.1 (2012): 295–309.

24 The Supreme People's Court Annual Report stated that Chinese courts accepted a total of 42,931 IP cases in 2010 and rendered verdicts in 41,718; the number of accepted cases grew to 110,000 cases in 2014. The number of intellectual property cases in Beijing has been soaring. In the first ten months of 2014, Beijing's courts saw IP cases increase by 180% compared to 2013.

Specialised IP Courts: The Indian Experience

Shamnad Basheer*

Introduction

Specialised courts are often touted as offering numerous advantages over regular courts, including speedier dispute resolution, improved decision making and greater consistency and uniformity in jurisprudence.¹

This assumption impelled India to create the Intellectual Property Appellate Board (IPAB), a specialised tribunal for select intellectual property disputes. Established via the 1999 amendments to India's Trademark Act,² this judicial body was tasked with two key functions:

- Deciding appeals from the Indian Patent and Trademark Office.
- Determining the validity or otherwise of granted patents and trademarks.³

However, it was not until 2003 that the IPAB began functioning. This owed itself to several factors, chief amongst which was a highly politicised contestation around the location of the IPAB, with members of the IP bar lobbying for it to be placed within their local precincts. It is rumoured that the choice finally swung in favour of Chennai, owing to the influence of the then Commerce Minister, Murasoli Maran, who hailed from this city.⁴

While the IPAB is similar in some respects to other specialised courts such as the Court of Appeals for the Federal Circuit (CAFC) in the United States,⁵ or the Patents County Court in the United Kingdom,⁶ it also differs in important particulars. Illustratively, the IPAB has a fairly limited jurisdictional role and cannot adjudicate upon the most contentious of all IP disputes, namely IP infringement.⁷

* I wish to thank Thomas J. Vallianeth, Mathews P. George and Balaji Subramaniam (all associates at SpicyIP); and Shruthi Anand, Gauri Pillai and Ankita Parasar (all students at the West Bengal National University of Juridical Sciences, Kolkata) for outstanding research assistance. I also wish to thank Justice Prabha Sridevan (former Chairman of IPAB), Prashant Reddy and Sai Vinod for helpful comments.

1 See Paul R. Gugliuzza, 'Rethinking Federal Circuit Jurisdiction', *Georgetown Law Journal* 100 (2012): 1437–505, at 1447–8 (listing efficiency, accuracy and uniformity as the three main arguments made in the legal literature in support of specialised courts) (<http://georgetownlawjournal.org/files/2012/06/Gugliuzza.pdf>).

2 Trademark Act 1999, §83.

3 Trademark Act 1999, §91 (appeal); Trademark Act 1999, §§ 47, 57, 125 (validity and rectification); see, generally, Intellectual Property Appellate Board: Jurisdiction, at <http://www.ipabindia.in/jurisdiction.aspx>.

4 See Shamnad Basheer, 'Pondering the "Legal" Competence of the IPAB', 13 Dec. 2010, at <http://spicyip.com/2010/12/pondering-legal-competence-of-ipab.html>.

5 The CAFC has, *inter-alia*, exclusive jurisdiction to hear all patent appeals from US district courts, appeals from the Patent Trial and Appeal Board and appeals from decisions of the International Trade Court (ITC). See 28 U.S. Code § 1295.

6 See *International Survey of Specialised Intellectual Property Courts and Tribunals*, International Bar Association Intellectual Property and Entertainment Law Committee (London, Sept. 2007) ("IBA Survey"), p. 5.

7 The IPAB's jurisdictional purview is also limited to two IP categories, namely patents and trademarks, and does not extend to the others, namely: Copyright, Industrial Designs, Trade Secrets (Breach of confidence), Protection of Integrated Circuits, Geographical Indications, Plant Variety Protection, Rights of Publicity, and Biodiversity Protection. For more details on the protected IP categories in India, see Shamnad Basheer, 'Intellectual Property Overlaps: An Indian Perspective', in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (Oxford University Press, 2012), p. lix.

Given that the IPAB has been mired in a serious constitutionality challenge⁸ and characterised thus far by a woeful inadequacy in availability of resources,⁹ it is difficult to subject the performance of the IPAB to a fair and rigorous assessment. As such, the desirability or otherwise of a specialised IP tribunal may continue to remain an open ended debate in India. However, to the extent that there may be some theoretical merit to specialised adjudication, such that judges who are repeat players in the game of deciding complex patent disputes cultivate expertise along the way and arrive at speedier decisions, this paper will explore the most optimal option for a developing country such as India.¹⁰

While acknowledging that infrastructural and other resource constraints at the IPAB make it near impossible to subject it to a fair assessment, this paper attempts, albeit sketchily, to measure the performance of the IPAB on various counts, including expected advantages such as speedier dispute resolution and the extent of alleged specialist expertise.

It then discusses alternative means of nurturing specialised intellectual property expertise. Ultimately, to the extent that some form of specialisation is desirable, I lean in favour of fostering expertise through specialised benches or divisions within the existing High Courts, a policy solution better suited for India (and perhaps other developing countries) with severely backlogged courts,¹¹ and far fewer resources to dedicate to the nurturing of specialist expertise. My suggestions for such specialisation are however confined to patent disputes,¹² an area of law often involving complex technology and therefore requiring a more intense investment of time and resources for resolution. To this extent, patent disputes may warrant slightly different treatment than other IP disputes (copyright, trademark, designs etc), which are broadly on par with more general legal disputes (at least in terms of the relative lack of technological complexity).

While the recent Commercial Courts Act is a step in the right direction, it does not go far enough in terms of creating a rigorous framework for nurturing intellectual property expertise, whilst at the same time guarding against the engendering of highly insular and overly formalistic jurisprudence.

8 See text accompanying note 31 referring to a public interest litigation (PIL) petition challenging the constitutionality of the IPAB and a consequent decision of the Madras High Court holding certain aspects of the IPAB to be unconstitutional (*Shamnad Basheer v. Union of India*, MIPR 2015 (2) 75).

9 'Report of the Chairman, Intellectual Property Appellate Board as per the Orders of the Hon'ble High Court of Madras dated 06.06.2011' at http://www.spicyip.com/docs/CCF09212011_00001.pdf. See also C.H. Unnikrishnan, 'Patent tribunal's admission places question mark against tribunals', 27 Sept 2011, at <http://www.livemint.com/Home-Page/Xc1g8IX9OGmioVzh2KvoLP/Patent-tribunal8217s-admission-places-question-mark-again.html>.

10 Although India is repeatedly referred to as a "developing country" in this paper, it is more appropriately labeled as a "technologically proficient developing country". See Shamnad Basheer & Annalisa Primi, 'The WIPO Development Agenda: Factoring in the 'Technologically Proficient' Developing Countries', *Implementing WIPO's Development Agenda*, Jeremy DeBeer, ed., Wilfred Laurier University Press, 2009.

11 *Arrears and Backlog: Creating Additional Judicial (wo)manpower*, Report No. 245, LAW COMMISSION OF INDIA (July 2014), at <http://lawcommissionofindia.nic.in/reports/Report245.pdf>

12 "Patent litigation stands among the most complex, with disputes about cutting-edge technology mud-died with esoteric and arcane language, laws, and customs. Even with the assistance of legal and technical experts as well as special masters, generalist judges and juries are often at sea almost from the beginning of a patent case. When compared to other adversarial actions, patent cases benefit significantly from having a judge hear the case who is familiar with technical issues." See Lawrence M. Sung, *Strangers in a Strange Land: Specialized Courts Resolving Patent Disputes*, BUS. L. TODAY, Mar./Apr. 2008, at 27, 27.

Measuring Merit

Pendency Rates

One of the main reasons touted for the creation of the IPAB was the preposterous pendency rates at the High Courts. Given the urgency of IP disputes and the commercial stakes involved, it was felt that these disputes ought to be subject to speedier adjudication at the hands of a specialist forum.¹³

However, a perusal of the pendency rates at the IPAB demonstrates that it has fared no better than High Courts on this count; rather it may have fared worse. The average overall pendency rate of the IPAB between the years 2005 and 2012 was 50.53 per cent,¹⁴ whereas the pendency rate at the various High Courts was a little over 10 per cent. Put another way, while the disposal rate of the IPAB was hardly 50 per cent, the disposal rate of the High Courts during the same period was almost 90 per cent.¹⁵ However, while making this comparison, the following factors must be borne in mind:

- The High Court figures for pendency/disposal comprise all cases, including civil and criminal cases. The IPAB figures, however, capture only with those IP cases over which the IPAB possesses jurisdiction. An ideal comparison ought to have therefore been between the rate of disposal of IP disputes by High Courts, and that of the IPAB.¹⁶ One would expect a patent case to take longer to resolve than a regular civil dispute in the High Court, particularly since judges are often likely to lack the technical expertise to appreciate patent issues as swiftly as they do a regular property or family dispute.¹⁷
- The pendency figures do not account for the overall judicial strength of the two fora, as also the differences in access to state of the art infrastructure and other resources such as support staff.

Getting It Right?

The lead paper in this issue notes (see part one)¹⁸ that patent infringement suits often involve complex technical issues, necessitating a fair amount of sophisticated knowledge on the part of the

13 The Statement of Objects and Reasons annexed to the Trademarks Bill 1999 set out, *inter alia*, that the bill seeks to provide for "an Appellate Board for speedy disposal of appeals and rectification applications which at present lie before High Courts". See also Parliament of India, XIII Lok Sabha Debates, Session II (Winter Session), Wednesday, 22 Dec. 1999/Pausa 1, 1921 (Saka) at <http://parliamentofindia.nic.in/lsdeb/ls13/ses2/2422129901.htm>. It bears noting that prior to the creation of the IPAB, most disputes (under the current jurisdictional purview of the IPAB) were decided by the various High Courts.

14 This data was procured through a Right to Information (RTI) application C-30016/4/2005-IPAB/1865, dated 25 Feb. 2015, filed by me under the RTI Act 2005. The pendency rate of patent cases (2005–12) is 68.01% and that of trademark cases (2005–12) is 47.94%. Similar data collected by way of Right to Information (RTI) applications filed in 2014 by Alok Prasanna Kumar of the Vidhi Centre for Legal Policy reveals that the pendency rate of the IPAB (for all cases including patents, trademark and even geographical indications) is 50.60%. See Alok Prasanna Kumar and Ketan Paul, *State of the Nation's Tribunals* (June 2014), at http://static1.squarespace.com/static/551ea026e4b0adba21a8f9df/t/5570341ae4b0b7fae0aa395a/1433669017863/140708_State+of+the+Nation's+Tribunals+-+IPAB+Final+Draft.pdf (hereinafter 'Prasanna and Paul'), p. 28.

15 'Based on publicly available figures, between 1 Jan. 2005 and 31 June 2013, all High Courts in India managed to dispose of 90.50% of the cases filed before them, whereas subordinate courts managed to dispose of 97.96% of the cases filed before them.' See Prasanna and Paul, *ibid* p. 18. See also Court News 1.1 (2006) to 8.3 (2013) (<http://supremecourtfindia.nic.in/courtnews.htm>), as cited in Prasanna and Paul.

16 Even if 'civil' cases are segregated from the overall pendency figures (comprising both civil and criminal cases), one finds that the rate of disposal by the High Courts is still high, when compared with the IPAB (90.14%). See Prasanna and Paul, *supra* n. 14, p. 18.

17 See Sung, note 12.

18 See Jacques de Werra, 'Specialised IP Courts: Issues and Challenges' (hereafter "Lead Paper").

adjudicator. It is widely assumed that a specialised tribunal will come to possess expertise over time and will therefore have a greater propensity to arrive at relatively more correct decisions.¹⁹ Little wonder then that IP practitioners overwhelmingly vote in favour of such specialist courts.²⁰

In the Indian context, this assumption has not been empirically validated as yet. One way of gauging performance on this count is to examine the extent to which IPAB decisions are appealed to higher fora and reversed. It bears noting though that the mere reversal of IPAB decisions is not problematic in and of itself, and is to be expected as part of the regular judicial process. However, should the data reveal a significantly high rate of reversal by the High Courts, it strikes at the very heart of the *raison d'être* for the IPAB.²¹

Unlike the creation of the Court of Appeals for the Federal Circuit (CAFC) in the US or other similar specialised IP courts, the history of the creation of the IPAB did not explicitly include "consistency" as a touted virtue i.e. arriving at a consistent body of IP jurisprudence.²² Even if this purported virtue were to have informally informed law-makers at that point in time, it may not apply on all fours to the Indian context, given that the IPAB cannot divest High Courts of their IP jurisdiction in its entirety. Rather, the various High Courts across India are constitutionally empowered to exercise their supervisory jurisdiction over the IPAB through judicial review, and continue to do so, with gay abandon.²³ Further, as for the High Courts themselves, being equal in stature to each other, they are not bound by decisions of other High Courts.

In any case, "consistency" by itself, absent quality or accuracy,²⁴ means nothing! And can do more

19 Markus B. Zimmer, 'Overview of Specialized Courts', *International Journal for Court Administration* (Aug. 2009): 1–15, at 1.

20 See the IBA Survey, *supra* n. 6, p.3. A poll conducted on the popular Indian blog SpicyIP also showed that the majority of those who took the poll preferred a specialist body for IP dispute resolution. Only 3% voted in favour of steering clear of specialist courts. See Shamnad Basheer, 'A Specialist IP Court: Knowing More about Less?', SpicyIP, 2 Apr. 2012, at <http://spicyipindia.blogspot.in/2012/04/specialist-ip-court-knowing-more-about.html>.

21 In this regard, a US study bears attention. See JP Kesan and GG Ball, *Judicial Experience and the Efficiency and Accuracy of Patent Adjudication: An Empirical Analysis of the Case for a Specialized Patent Trial Court*, 24 *Harvard Journal of Law & Technology* 2 (2011), 443 ("We also explored the relationship between experience and the accuracy of rulings in patent cases, as measured by the probability of being overturned on appeal.we find that specialized experience, whether recent or cumulative, reduces the probability of being reversed on appeal on rulings of preliminary injunction, judgment as a matter of law, or infringement..")

22 "The "central purpose" of the Act [creating the CAFC]... was "to reduce the widespread lack of uniformity and uncertainty of legal doctrine that exist[ed] in the administration of patent law." See Diane P. Wood, *Is It Time to Abolish the Federal Circuit's Exclusive Jurisdiction in Patent Cases?*, 13 *CHICAGO-KENT J. INTELLEC. PROP.* 1 (2013)

23 Although the power of supervisory review is limited under Article 227 of the Constitution of India, the various High Courts continue to exercise this power rather liberally, effectively converting the limited review into a full fledged appellate assessment. The Supreme Court, has repeatedly cautioned against this: See *State of Haryana & Ors vs Manoj Kumar AIR 2010 SC 1779* which while endorsing a long line of precedent, repeated thus: "The supervisory jurisdiction conferred on the High Courts under Article 227 of the Constitution is limited "to seeing that an inferior Court or Tribunal functions within the limits of its authority."....In exercising the supervisory power under Article 227, the High Court does not act as an Appellate Court or Tribunal. It will not review or reweigh the evidence upon which the determination of the inferior court or tribunal purports to be based or to correct errors of law in the decision."

24 The paradox notwithstanding, it is well nigh impossible to define the term "accuracy" with precision in a context such as this. Much in line with Professor Dreyfuss, I therefore use it in close conjunction with the term "quality" and take it to broadly refer to decisions that are in conformity with the overall policy of the legal regime under consideration. And to use it in close conjunction with the term "quality". See Dreyfuss, *Institutional Identity*, *supra* note 5, at 796, noting that "Accuracy, in turn, depends on quality—law that is cohesive in that the elements work together to further overall policies, and decisions that are explicated in a manner that makes the policy goals the court understands the law to be achieving both transparent and persuasive.". Rochelle Cooper Dreyfuss, *In Search of Institutional Identity: The Federal Circuit Comes of Age*, 23 *BERKELEY TECH. L.J.* 787 (2008) 796.

harm than good. As Judge Diane Wood tellingly puts it:²⁵ "...uniformity says nothing about quality or accuracy. A broken clock tells the time with impeccable uniformity: the only problem is that it is right only twice a day."

Specialised Courts: Cautionary Caveats?

Specialist courts raise a number of issues, and have been castigated in the past for their purported bias towards patent owners and the risk of developing an insular tunnel vision and an overly technical jurisprudence that is divorced from developments in law and policy more generally.²⁶ These cautionary caveats are explored below:

The IPAB and Institutional Bias

While the lead paper cautions against the development of an "institutional bias" and the propensity to political and economic capture, particularly by repeat players (IP owners) who bring frequent lawsuits before the specialist body,²⁷ it notes that, till date, there is no empirical evidence supporting this assumption. In fact, prominent US IP academics suggest that specialist IP courts will, over time, be less likely to rule in favour of patentees.²⁸

This appears to be the position in India as well, where an empirical study of the various IPAB decisions (particularly around patent validity) reveals that the vast majority of decisions went against the patentee i.e. 83.3 % of challenged patents before the IPAB were invalidated.²⁹ This certainly dispels any notion of undue bias towards IP owners.

However, an important qualification bears mention here. The notion of capture rests to a large extent on the assumption that a greater number of victories in favour of IP owners translates to the institution of more cases before the tribunal, thereby increasing its revenues and overall influence. Since the IPAB has no jurisdiction to decide IP infringement law suits, this assumption does not hold true for the IPAB; consequently, there is less likelihood of an institutional bias or skewing in favour of IP owners.

However, it is possible that the IPAB suffers another kind of bias in favour of the government. For, a majority of the disputes entertained by the IPAB are between the government on one side, and the IP owner/applicant on the other.³⁰ Given the influence of the government in the constitution and

25 See Diane Wood, note 22.

26 See Lead Paper, Section 1.3.

27 'Another risk is that a specialized court may be more easily subject to political or economic influences' than a generalized court as 'generalized courts are often considered to be more independent than specialized courts'. See *Holmes Grp., Inc. v. Vornado Air Circulation Sys., Inc.*, 535 U.S. 826, 839 (2002) (Stevens, J., concurring) ('occasional decisions [on issues of patent law] by courts with broader jurisdiction will provide an antidote to the risk that the specialized court may develop an institutional bias').

28 See Mark A. Lemley, Su Li and Jennifer M. Urban, 'Does Familiarity Breed Contempt among Judges Deciding Patent Cases?', *Stanford Law Review* 66 (May 2014): 1121–57 (http://www.stanfordlawreview.org/sites/default/files/66_Stan_L_Rev_1121_LemleyLiUrban.pdf) concluding their paper (at 1155) by noting that 'As judges gain experience with patent cases, they are less likely to rule for patentees on infringement....This...suggests that specialised patent trial courts may benefit accused infringers over patentees.'

29 Results of author's own study and analysis along with his research associates, Shruthi Anand, Gauri Pillai and Ankita Parasar, available with author.

30 This flows naturally from the fact that the majority of disputes at the IPAB are appeals from decisions of the Indian Patent and Trademark Office, a government agency which then becomes a party before the IPAB.

functioning of the IPAB, one might suspect some skewing in favour of the government. However this needs to be empirically tested.

The undue influence of the government in the functioning of the IPAB was highlighted by me through a public interest litigation (PIL) petition instituted before the Madras High Court.³¹ The PIL contended that the IPAB was not sufficiently independent of the government; that qualifications for the appointment of judicial members on the board were contrary to the law of the land, and that irregular appointments were the norm.³²

Last year, the court agreed with my submissions and declared key provisions governing the constitution of the IPAB as unconstitutional, particularly provisions relating to the appointment of tribunal members ("judicial" and "technical"), and provisions granting pre-eminence to government bureaucrats in selecting adjudicators for the tribunal.³³ The court made it amply clear that the selection panel must be predominated by members of the judiciary, so as to foster more independence in the functioning of the tribunal.

In pertinent part, the court noted that tribunals that have taken over erstwhile functions of the High Court (such as the IPAB) need to be vested with the same judicial gravitas as a regular High Court, particularly in terms of the eligibility of adjudicators and its independence from the Executive.³⁴ It endorsed an earlier Supreme Court precedent that laid down in clear terms that:³⁵

"The issue is not whether judicial functions can be transferred from courts to Tribunals. The issue is whether judicial functions can be transferred to Tribunals manned by persons who are not suitable or qualified or competent to discharge such judicial powers or whose independence is suspect. We have already held that the Legislature has the competence to transfer any particular jurisdiction from courts to Tribunals provided it is understood that the Tribunals exercise judicial power and the persons who are appointed as President/Chairperson/Members are of a standard which is reasonably approximate to the standards of main stream Judicial functioning. On the other hand, if a Tribunal is packed with members who are drawn from the civil services and who continue to be employees of different Ministries or Government Departments by maintaining lien over their respective posts, it would amount to transferring judicial functions to the executive which would go against the doctrine of separation of power and independence of judiciary."

The government unsuccessfully appealed this decision to the Indian Supreme Court (the highest court in the land). While refusing to admit the appeal, the apex court noted that the law was fairly well settled and there was no reason to interfere with the decision of the Madras High Court.³⁶

31 See the public interest litigation (PIL) petition challenging the constitutionality of the IPAB in Shamnad Basheer v. Union of India (www.spicyip.com/docs/IPABwrit.doc). See also Prashant Reddy, 'Madras High Court Admits Petitions Challenging the Constitutionality of the IPAB and the Copyright Board', SpicyIP, 21 Jan. 2011, at <http://spicyipindia.blogspot.in/2011/01/breaking-news-madras-high-court-admits.html>.

32 *Id.*, Shamnad Basher v. Union of India.

33 Shamnad Basheer v. Union of India, MIPR 2015 (2) 75. For an analysis of the decision, see Shamnad Basheer, 'Tribunals in Troubled Waters: Highlights of the IPAB Decision', SpicyIP, 16 Mar. 2015, at <http://spicyip.com/2015/03/tribunals-in-troubled-waters-highlights-of-the-ipab-decision.html>.

34 Shamnad Basheer v. Union of India, *ibid.*

35 Union of India v. R Gandhi, 2010 (5) SCALE 514, para 45.

36 Order of the Supreme Court of India in Union of India v. Shamnad Basheer and Ors., SLP No. 18142/2015, Supreme Court of India (27 July 2015).

Specialised Insularity?

The lead paper also suggests that specialised courts run the risk of specialised jurisprudence developing in isolation from the general body of law.³⁷ Given that the IPAB has mostly been headed by a retired High Court judge who is often a generalist and does not sit at the IPAB for more than five years or so,³⁸ this fear may be overstated. In any case, the limited jurisdictional purview of the IPAB and the fact that it has been in operation for only ten years or so, may make it relatively premature for a robust assessment on this front.

Alternative Modes of Specialisation: The Commercial Courts Act

Informal IP Benches

While the IPAB constitutes a formalised framework for specialised IP dispute resolution, India is also home to a more informal arrangement at some of the High Courts, where IP disputes are allocated to select judges, who are either perceived to be familiar with intellectual property law or manage to cultivate such expertise over time.³⁹

However, this informal arrangement is often contingent on the whims of the Chief Justice heading the High Court at that point in time and is not compelled by a specific statutory or legal mandate. As such, one option would be to formalise this arrangement, with specialised benches in those High Courts that are home to a significant volume of IP litigation.⁴⁰

The recent enactment of the Commercial Courts Act represents one such attempt at formalisation, albeit within the larger context of commercial disputes, as elaborated upon below.

Commercial Courts Act

The Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act, 2015⁴¹ (hereafter "Commercial Courts Act") sets up two sets of commercial courts (as below) to

37 See Lead Paper at Section 1.3, pp. 20-21. See Stefan Kirchner, 'Legal Unity through Specialized Courts on a European Level?', *German Law Journal* 6.1 (2005): 217-26; Lawrence Baum, 'Specialization and Authority Acceptance: The Supreme Court and Lower Federal Courts', *Political Research Quarterly* 47.3 (1994): 693-703.

38 An exceptional case was that of Z. S. Negi, a government bureaucrat who went on to become the Chairman of the IPAB, despite the lack of appropriate judicial qualifications. After having served as a Secretary to the Government of India in the Ministry of Law and Justice, Negi was appointed to the IPAB as a member. He then rose to be Vice Chairman of the IPAB. Subsequently, after a mere two years of service, he was elevated to the position of Chairman, which is equivalent to that of a High Court judge. See the public interest litigation (PIL) petition challenging the constitutionality of the IPAB in *Shamnad Basheer v. Union of India* (www.spicyip.com/docs/IPABwrit.doc). See also A. Subramani and Pushpa Narayan, 'Plea Seeks to Expose Patent Tribunal Anomaly', 22 Jan. 2011, at <http://timesofindia.indiatimes.com/city/chennai/Plea-seeks-to-expose-patent-tribunal-anomaly/articleshow/7368425.cms>.

39 Interviews with leading IP attorneys in India, including Pravin Anand (Managing Partner, Anand & Anand) and Lakshmi Kumaran (Managing Partner, Lakshmikumaran & Sridharan).

40 An earlier study conducted by me along with my research associates revealed that of the 85 patent infringement litigations that had been decided by courts up to July 2012, 74 were concentrated in the courts of New Delhi, Chennai, Mumbai, Kolkata and Gujarat. See Shamnad Basheer, Jay Sanklecha and Prakruthi Gowda, 'Pharmaceutical Patent Enforcement: A Development Perspective', in Ruth L Okediji and Margo A. Bagley (eds), *Patent Law in Global Perspective* (Oxford University Press, 2014), p. 604.

41 The Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act, 2015 Available at <http://www.prsindia.org/uploads/media/Commercial%20courts/Commercial%20courts%20Act,%202015.pdf>

exclusively adjudicate all "commercial disputes" above a certain pecuniary value⁴²:

- "Commercial Divisions" to be constituted at all High Courts vested with ordinary original civil jurisdiction (i.e. the High Courts of Delhi, Bombay, Calcutta, Madras and Himachal Pradesh);
- "Commercial Courts" to be newly instituted at the district level.⁴³

The term "commercial dispute" has been liberally defined⁴⁴ to encompass a wide variety of issues including "intellectual property".⁴⁵ As such, it represents a new scheme for specialist IP adjudication in the country, albeit via a broad based set of "commercial courts" (a term of convenience to include both "commercial courts" and "commercial benches", as envisaged under the Act).⁴⁶

Progressive Procedural Provisions

On the positive side, the Commercial Courts Act contains a number of procedural provisions aimed at speeding up commercial disputes, which will invariably help IP disputes as well. Illustratively, strict timelines have been prescribed and judges have been vested with the discretion to impose heavy costs on parties who indulge in frivolous litigation and delay.⁴⁷ A case management model has been introduced, which includes a strict timeline for the framing of issues and oral arguments, and a compulsory submission of all notes of arguments.⁴⁸ All of these are likely to contribute to a speedier resolution of IP disputes.⁴⁹ However, the proof of the pudding is in its eating and one has to wait to see if these progressive provisions play out in practice.

On the negative side however, there are a number of concerns with the optimality of the Commercial Court Act for the speedy and consistent resolution of IP disputes, as outlined below.

42 §2 (1)(i) of the Act stipulates that the "specified value" shall be either Rs 1 crore rupees (approximately USD 147122) or higher, as notified by the Central Government.

43 §5 of the Commercial Courts Act also provides for the setting up of a Commercial Appellate Divisions in High Courts to hear appeals against decisions of Commercial Courts or Commercial Divisions of High Courts (as the case may be).

44 Section 2 (1) (c) of the Act defines "commercial dispute" to include a wide diversity of disputes including disputes pertaining to banking, admiralty and maritime law, carriage of goods, infrastructure contracts, licensing and technology agreements; joint venture agreements, shareholders agreements, partnership agreements, intellectual property rights, sale of goods, insurance, and such other commercial disputes as may be notified by the Central Government.

45 Ibid. § 2(1)(c) (xvii) of the Commercial Courts Act makes clear that the term "commercial dispute" includes one rising also out of "...intellectual property rights relating to registered and unregistered trademarks, copyright, patent, design, domain names, geographical indications and semiconductor integrated circuits..."

46 The Government of India had initially promulgated this new specialised scheme through an ordinance, a form of Executive law making to be resorted to in exceptional circumstances when the Parliament (India's law making body) is not in regular session. See Art. 123 of the Constitution of India. Subsequently, upon the enactment of 'The Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act, 2015' by both the Houses of Parliament in December, 2015, this Ordinance lapsed. The new Act was then notified in the Official Gazette on 1 January, 2016, but deemed to have come into force on 23rd of October, 2015.

47 See amendment made to the Code of Civil Procedure 1908 vide Rule 2 of the Schedule to the Commercial Courts Act, which empowers judges to impose costs on parties for frivolous litigation that wastes the time of the court. .

48 See amendment made to the Code of Civil Procedure 1908 vide Rule 7 of the Schedule to the Commercial Courts Act, which adds Order XV-A to the Code, providing for Case Management Hearings that did not previously exist. Illustratively, the Court shall ensure that all oral arguments are concluded no later than six months from the date of the first Case Management Hearing.

49 See Pratibha M Singh, 'Justified business: New commercial courts law promises to cure the 'tareek pe tareek' culture', 13 Jan. 2016, Available at <http://blogs.timesofindia.indiatimes.com/toi-edit-page/justified-business-new-commercial-courts-law-promises-to-cure-the-tareek-pe-tareek-culture/>.

Lack of Eligibility?

Surprisingly, the Commercial Courts Act merely states that the judges to be appointed to the commercial courts are those that "have experience in dealing with commercial disputes",⁵⁰ without providing for more specifics. Illustratively, it is not clear as to quantum and range of commercial disputes that one ought to have engaged with prior to being qualified as one "having experience" in "commercial disputes". More importantly, from an IP perspective, merely because a judge has dealt with a series of banking or insurance cases, could he or she have said to have gained "intellectual property" experience of a degree sufficient enough to have her function as a specialised IP judge?

One might argue that a judge with a chemistry background may be better equipped to handle a pharmaceutical patent dispute than a judge with alleged "commercial experience" comprising of nothing more than insurance or contractual matters. Alternatively, one may contend that a patent dispute is not that significantly different from any other ordinary commercial dispute; but if this be the case, then one might equally well contend that a patent dispute is not that significantly different from any other legal dispute. In other words, given the nature of patent disputes today, one would be hard pressed to persuasively argue that prior experience with ordinary commercial disputes vest one with a significantly superior adjudicatory prowess to one who is well versed with general legal disputes such as tort law, property law or even administrative law; issues that could be said to constitute the core essence of a patent precept.⁵¹

Given the above framework, it is not immediately clear as to whether the Commercial Courts Act necessarily filters in the right kind of specialised expertise for IP disputes, an aspect dealt with below.

Whither Expertise?

It is an irony that while the new law provides for a specialised set of commercial courts, it does nothing by way of providing a robust eligibility filter at the entry level or more importantly, for the fostering of such expertise after entry. Rather, the Act leaves it to the discretion of the State Governments to nurture expertise through training programmes and the like, if they so wish.⁵²

As noted earlier, specialised courts need not always possess a strict entry-level filter. Rather, specialisation could be nurtured amongst generalist judges by having them adjudicate a similar string of cases over time. The history of IP adjudication bears testimony to this sentiment, where a number of outstanding IP judges did not possess any (significant) prior IP experience, but cultivated this over time as they were handed a similar series of cases to adjudicate upon. Some of the reputed names in this regard include Judge Randall Rader, former Chief Judge of the Court of Appeals to the Federal Circuit (CAFC)⁵³ and Judge Toshiaki Iimura, former Chief judge of the

50 See §3(3) and 4(2) of the Act.

51 Simon Rifkind, *A Special Court for Patent Litigation? The Dangers of a Specialised Judiciary*, 37 ABA JOURNAL 425 (1951).

52 See § 20 of the Commercial Courts Act: "The State Government may, in consultation with the High Court, establish necessary facilities providing for training of Judges who may be appointed to the Commercial Court, Commercial Division or the Commercial Appellate Division in a High Court".

53 Judge Rader is widely acknowledged to be one of the leading IP judges in the world. His ascent to the bench was preceded by a career that did not include any significant litigation experience, much less IP litigation. Rather he came with a background on the legislative/policy making side, having been counsel to various committees and subcommittees of the U.S. Senate and the House of Representatives. He also has no science or engineering degree, but majored in English (B.A.) from Brigham

Japanese Intellectual Property High Court.⁵⁴

Closer home, Justice Prabha Sridevan⁵⁵ of the IPAB, Justice Ravindra Bhat⁵⁶ of the Delhi High Court and more recently Justice Gautam Patel⁵⁷ of the Bombay High Court stand out in terms of creating a strong and sophisticated body of IP jurisprudence through their various rulings, despite having had no significant prior IP experience. All of them were ranked (in one year or another) amongst the top fifty most influential figures in the world of Intellectual Property.⁵⁸ This is not to suggest that all generalist judges who went to gain IP experience after mounting specialised benches came to be renowned for their IP expertise. But simply to make the point that there may be some truth to the notion that IP expertise could be nurtured through repeat play, even in the absence of any prior IP experience. The ultimate test of whether a judge turns out to be good or bad will also depend on the general adjudicative qualities and legal acumen of the person so chosen. In this regard, it bears noting that India is also home to specialised IP judges who performed rather poorly despite extensive IP experience on the bar; with their decisions often reflecting a blind adherence to IP formalism and a woeful lack of clarity and analytical rigour.

Unfortunately, the Commercial Courts Act does nothing by way of intentionally furthering this end of ensuring that relevant IP expertise on the specialised IP court/bench is gained through repeat play. To this extent, it is a missed opportunity and one hopes that future amendments stipulate the following:

Young University, before moving onto a J.D. from George Washington University Law School in 1978. See Rader, Randall Ray, *Biography of Federal Judges*, Federal Judicial Center available at <http://www.fjc.gov/servlet/nGetInfo?jid=1952&cid=999&ctype=na&inststate=na>.

- 54 Judge Jimura was appointed as a judge within two years of obtaining his law degree, leaving no time for prior specialisation in intellectual property. See biography at <http://www.worldtrademarkreview.com/wtr1000/directory/Detail.aspx?g=7aec7a77-5c19-42dc-ae3d-4cd08891b21e>.
- 55 Justice Sridevan, who is a graduate in English literature, pursued law after a period of thirteen years. As a lawyer, her practice areas included a diverse array of legal subject matter, but no significant IP cases. Similarly, her tenure as a High Court judge, though extremely distinguished had little to do with intellectual property, save a couple of cases, the most prominent of which involved a constitutionality challenge to section 3(d) of India's patent act by Novartis, a Swiss pharmaceutical major (Novartis AG vs. Union of India, 2007 4 MLJ 1153). It was only during her tenure as the Chairman (Chief Judge) of the IPAB that she really grappled with complex IP cases in all their majesty. A brief profile of hers can be found at <http://www.thehindulfi.com/1272-2>.
- 56 As a practitioner, Justice Bhat's experience was dominated by public law, banking, taxation, labour and service matters. Justice Bhat is renowned for several landmark IP decisions in India, including one that crystallised the importance of public interest (and affordability of drugs) as a key factor in patent injunction jurisprudence. (Hoffman-La Roche Ltd. v. Cipla Ltd., (2008) 37 P.T.C. 71 (Delhi H.C.)). See also Shamnad Basheer "The Rhetoric of Patent Busting", Indian Express (12 April 2008), available at: < <http://archive.indianexpress.com/news/the-rhetoric-of-patent-busting/295890/>>. For a brief profile of Justice Bhat, see CJ and Sitting Judges, High Court of Delhi, <http://delhihighcourt.nic.in/cjsittingjudges.asp>
- 57 Justice Patel's background as a practitioner did not involve any significant IP cases, but centred around public law (constitutional law/administrative law), environmental law and a mix of private law matters. It was only after his ascent to the Bombay High Court and the assignment of IP cases to him by the Chief Justice (through an informal mechanism of specialised benches at the various High Courts as outlined in this paper) that he came to unleash a series of decisions renowned as much for their jurisprudential depth as much for their clarity and concision. See Justice Gautam Shirish Patel, High Court of Bombay, <http://bombayhighcourt.nic.in/jshow.php?auth=amdldGkPTM5>. See also Mathews P. George, 'Three Indians make it to MIP's List of 50 most influential IP personalities', 16 Dec. 2015, at <http://spicyip.com/2015/12/three-indians-make-it-to-mips-list-of-50-most-influential-ip-personalities.html>
- 58 Managing Intellectual Property, 'The 50 Most influential people in IP', 27 July 2015, at <http://www.managingip.com/Article/3471167/The-50-most-influential-people-in-IP.html>. Also see Mathews P. George, 'Three Indians make it to MIP's List of 50 most influential IP personalities', 16 Dec. 2015, at <http://spicyip.com/2015/12/three-indians-make-it-to-mips-list-of-50-most-influential-ip-personalities.html> & Anju Cletus, 'Justice Gautam Patel, Justice Prabha Sridevan, and Prof Shamnad Basheer in MIP's List of 50 World's most influential personalities in IPR', 17 Dec. 2015 at <http://www.livelaw.in/justice-gautam-patel-justice-prabha-sridevan-and-prof-shamnad-basheer-in-mips-list-of-50-worlds-most-influential-personalities-in-ipr>. See also Arnab Roy, 'Justice Bhat and Controller General Kurian make it to MIP's list of 50 most influential people in IP', 28 Aug 2010 at <http://spicyip.com/2010/08/justice-bhat-and-controller-general.html>

- A minimum mandatory tenure for judges picked to man specialised courts, such that they are exposed to enough "special" cases to foster the relevant expertise.
- Even after the relevant "specialised" expertise has been cultivated, a minimum mandatory period of time on the specialised bench/court, such that the gained expertise could translate to the purported efficiencies and advantages that come with specialised courts, namely speedy and more competent dispute resolution.

The Risk of "Insular" Jurisprudence?

As noted earlier, a key risk with specialised courts is the likelihood of excessively technocratic, formalistic and insular jurisprudence that may often be at variance with the general body of law.

This concern is more starkly felt in the context of developing countries where a holistic and balanced approach to intellectual property is often critical to fair and equitable justice dispensation. This is not to suggest unrestrained judicial activism where judges are untethered to statutory structures and the language of precedent and law (particularly in common law countries), but signals a progressive freeing of narrow patent precepts from excessive formalism to situate them more appropriately within the general bounds of law (particularly constitutional and other public law that appropriately protects against the erosion of larger public policy goals such as the right to health and the right to food security etc.)

Developing countries can ill afford to skew IP regimes unduly in favour of rights owners, at the cost of the larger public interest. A more holistic and balanced approach towards intellectual property paves the way for a more progressive jurisprudence, such as the notion of "user rights" articulated by the Canadian courts.⁵⁹ Similarly in India, the prospect of more affordable access to medication by an infringing generic competitor constitutes a valid "public interest" factor that militates against the grant of a temporary injunction or restraining order.⁶⁰

As Judge Rifkind noted more than half a century ago:⁶¹ "...the judicial process requires a different kind of expertise - the unique capacity to see things in their context. Great judges embrace within their vision a remarkably ample context. But even lesser men, presiding in courts of wide jurisdiction, are constantly exposed to pressures that tend to expand the ambit of their ken. Patent law does not live in the seclusion and silence of a Trappist monastery. It is part and parcel of the whole body of our law. It ministers to a system of monopolies within a larger competitive system. This monopoly system is separated from the rest of the law not by a steel barrier, but by a permeable membrane constantly bathed in the general substantive and procedural law."

59 See *CCH Canadian Ltd v. Law Society of Upper Canada* [2004] SCC 13 (at para 48): "The fair dealing exception, like other exceptions in the Copyright Act, is a user's right. In order to maintain the proper balance between the rights of a copyright owner and users' interests, it must not be interpreted restrictively."

60 See *Hoffman-La Roche Ltd. v. Cipla Ltd.*, (2008) 37 P.T.C. 71 (Delhi H.C.). See also Shamnad Basheer "The Rhetoric of Patent Busting", *Indian Express* (12 April 2008), available at: <<http://archive.indianexpress.com/news/the-rhetoric-of-patent-busting/295890/>>

61 *Supra* n. 51.

One must therefore ensure that specialised courts are continually exposed to other areas of general law so that their vision and context remain "ample".⁶² In the context of the proposed European Unified Patent Court (UPC),⁶³ it has been rightly suggested that: 'To counterbalance the strong focus on technology, the UPC should thus make sure that the judges also are trained in issues of a non-technical nature in an attempt to widen the focus to include other parts of law that are considered essential for the normal construction of legal order'.⁶⁴

The CAFC is an interesting model in this regard, where non-IP matters were deliberately added to the jurisdictional docket, so that judges would not be exclusively confined to patent disputes. However, these non-IP cases constitute a limited range of legal subject matter such as government contracts, money claims against the United States government, federal personnel, veterans' benefits, and public safety officers' benefits claims.⁶⁵ Added to this is the fact that the proportion of such cases has been reducing compared to IP cases, whose resolution takes up a larger percentage of the courts' time.⁶⁶

A more optimal option would be to have judges exposed to a wide range of other cases as well, even outside of the narrow field of veteran's benefits and other areas currently within the jurisdictional purview of the CAFC.

The UK specialised courts for IP (trial and appellate court) are more optimally designed in this regard, with judges at the appellate court spending up to two-thirds of their time on non-IP cases.⁶⁷

While judges on the proposed commercial court/bench are likely to be exposed to a wide range of commercial disputes, they may lack exposure to other important areas of law such as public law (constitutional law and administrative law), public health law, tort law and property law; areas of law that often circumscribe the scope and extent of intellectual property rights. This ought to be remedied by amending the existing institutional design, as discussed below:

62 Paul R. Gugliuzza, 'Pluralism on Appeal', *Georgetown Law Journal Online* 100 (2012): 36–43, at 40 (<http://georgetownlawjournal.org/files/2012/10/GugliuzzaPluralism.pdf>): 'A generalist judge who specializes in patent cases will appreciate the consequences of a particular decision on the patent system while also being more likely to situate the decision within a broader context of promoting economic competition and encouraging technological innovation'.

63 The Unified Patent Court (UPC) is meant to be a common European court with exclusive jurisdiction over European patents (including the proposed unitary patent). For more, see <https://www.unified-patent-court.org/>.

64 See Jens Schovsbo, Thomas Riis and Clement Salung Petersen, 'The Unified Patent Court: Pros and Cons of Specialization – Is There a Light at the End of the Tunnel (Vision)?' (editorial), *International Review of Intellectual Property and Competition Law* 46.3 (May 2015): 271–4 (http://link.springer.com/article/10.1007/s40319-015-0331-2/fulltext.html?wt_mc=alerts.TOCjournals) (at 274:)

65 See 28 USC § 1295, which confers jurisdiction over fourteen subject areas to the CAFC.

66 See PR Gugliuzza, 'Rethinking Federal Circuit Jurisdiction' supra note 1, pg 1485: "Turning specifically to patent law, the proportion of patent cases on the court's docket has grown from roughly 25% in the 1980s to over 40% today. Moreover, these patent cases almost surely occupy a disproportionate share of the court's working time. Judge Michel, for example, has suggested that patent cases, due to their complexity, 'take perhaps ten times the work of [a] personnel case.'"

67 Michael Fysh, 'Intellectual Property and Particularly Patent Litigation in the United Kingdom', Study on Specialized Intellectual Property Courts, joint project between the International Intellectual Property Institute (IPI) and the United States Patent and Trademark Office (USPTO), Jan. 2012 (hereinafter 'the IPI Study'), at <http://iipi.org/wp-content/uploads/2012/05/Study-on-Specialized-IPR-Courts.pdf>, p. 125: 'Patents judges are a part of the general judicial system and play an active role in deciding non-IPR cases. Depending on the workload, patent judges may spend a third of their time on other work. In the Court of Appeal, about two-thirds of the judges' time is unrelated to IPR. This approach, where judges are both specialists and generalists, has worked well. It provides judges with a wider perspective which helps them to balance IPR laws in the context of broader commercial law.'

Choosing the Right Option?

The central question posed in this paper relates to which is the optimal option for a developing country such as India. The above framework yields three possible options:

- i) To have no specialised courts/benches in IP at all
- ii) To have a stand alone court/tribunal, such as the IPAB
- iii) To foster specialisation through IP benches at existing High Courts?

Given that the empirical evidence thus far has not unequivocally supported the case for IP courts (more general courts handling IP disputes), the first option appears safest.

As for the second option, the Indian experience with the IPAB (as also the Copyright Board, dealt with a later section) has not been a happy one.

While the third option is being increasingly deployed across various High Courts in India, and is now being formalised through the Commercialised Courts Act, it has not been subject to any rigorous empirical analysis. The anecdotal evidence (mainly from attorneys) appears to suggest a proclivity in favour of such specialised benches.

As such, I remain agnostic on the overall desirability of specialised justice. However, to the extent that some form of specialised IP justice dispensation is desirable at least in so far as complex patent disputes are concerned,⁶⁸ I lean in favour of specialised benches at the High Courts, for the following reasons:

- A stand-alone tribunal or court requires the investment of more intense resources.
- Given the woeful history of tribunalisation in India, any stand-alone tribunal is likely to carry the risk of capture by the government and a consequent lack of independence.
- A specialised bench falls within the overall supervisory and jurisdictional purview of the High Court and is therefore likely to be vested with the same judicial gravitas, reputational currency and most importantly, a fair degree of independence from the government.⁶⁹

However, in order for such a specialised bench to work well, I propose the model of the Commercial Courts Act.

First, the provision for an entry-level filter for IP judges. A very strict filter may not work well for developing countries that struggle to fill up even regular judicial vacancies.⁷⁰ Therefore, one might

68 As noted earlier in the paper, to the extent that specialization is desirable, it ought to be confined to patent disputes and not IP disputes as a whole.

69 Specialised benches within the existing High Courts were in fact proposed as the more appropriate option by certain Parliamentarians during discussions preceding the passage of the Trademarks Bill 1999 that provided for the creation of the IPAB. See Speech of Shri Rupchand Pal, Discussion on the Trade Marks Bill, 1999 on 22 December 1999, available at <http://www.legalindia.com/judgments/discussion-on-the-trade-marks-bill-1999-on-22-december-1999>.

70 As per the latest data, almost 40% of all judicial posts at the various High Courts remain vacant i.e. while the sanctioned strength of High Courts in India is 1044, only 601 judges are currently in operation. See 'Statement showing the Approved strength, Working Strength and Vacancies of Judges in the Supreme Court of India and the High Courts (As on 01.01.2016)', Department of Justice, Ministry of Law and Justice', Government of India at [http://doj.gov.in/sites/default/files/userfiles/Vacancy-\(1.1.2016\).pdf](http://doj.gov.in/sites/default/files/userfiles/Vacancy-(1.1.2016).pdf).

envisage a relatively lower filter that, at the very least, screens for candidates with some basic level of interest in science and technology and a keenness to adjudicate patent disputes. This need not however equate to a formal degree in any of the sciences. In fact, some of the most well known IP judges such as Judge Rader from the US and Justices Sridevan, Bhat and Patel from India were never formally educated in the sciences, but their judgements reveal a nuanced engagement with the technological niceties that often crop up in patent dispute.⁷¹

In any case, even assuming a judge is to have a science or technology background, in what specific areas of technology would that have to be? One might argue that a judge with a degree in civil engineering (presumably rendering one proficient in the art of building dams and roadways) is likely to be as much at sea with a drug patent dispute as another judge with no science background. As Judge Rifkind rightly counselled more than half a century ago. "It is hardly to be supposed that the members of a patent court will be so omniscient as to possess specialised skill in chemistry, in electronics, mechanics and in vast fields of discovery as yet uncharted. The expert in organic chemistry brings no special light to guide him in the decision of a problem relating to radioactivity."⁷²

Given that patent disputes are often about the application of legal norms to facts centred around science and technology, a court could easily gather the relevant scientific expertise for such factual assessment from the relevant experts, as discussed later in this paper.⁷³

Second, the provision for specialised IP training. This is a very important requirement, particularly for those judges that are recruited to specialised courts without any prior IP experience. Such training must be given on a continuous basis.

Third, a well-established tenure for specialised judges, need not necessarily be judges for life on this bench,⁷⁴ but a term of 10 years at the very minimum would help cultivate sufficient expertise and pave the way for creating a more robust IP jurisprudence during their tenure. This term could then be extended depending on their performance, level of interest, etc.

Fourth, a docket that comprises not only IP cases, but a wide array of other matters necessary to ensure against a narrow technocratic tunnel vision. In the specific context of the Commercial Courts Act, I would recommend that at least one judge in the Commercial Court be specifically assigned to patent cases. As noted earlier, patent disputes often involve complex technology and may therefore require a more intense investment of time and resources for resolution, warranting a slightly different treatment than other IP disputes (copyright, trademark etc) which may equate more broadly to other commercial disputes (at least in terms of the relative lack of technological complexity).

71 See Donald Dunner, 'The evolution of patent jurisprudence, from Giles Rich to Howard Markey to Randall Rader', IPWatchdog, <http://www.ipwatchdog.com/2014/05/27/the-evolution-of-patent-jurisprudence/id=49770/> As the profiles of the judges discussed in this piece show, none of them obtained a science degree prior. Supra n. 51, 52, 53. See also Toshiko Takenaka, 'Chief Judge Rader's Contribution to Comparative Patent Law', 7 Wash J.L. Tech & Arts 379 (2012) at <http://digital.law.washington.edu/dspace-law/bitstream/handle/1773.1/1127/7/WJLTA379.pdf?sequence=4>:

72 Rifkind, supra n. 51.

73 Id.

74 While US judges enjoy tenure for life, this option is not open to High Court judges, who have to retire at the age of 62.

For this patent judge, an optimal portfolio might be as below:

- Patent Cases: 50% of overall portfolio
- Other Commercial Cases: 30%
- Other cases (non commercial): 20%

This distribution will pave the way for cultivating IP expertise without compromising significantly on a wider range of legal experience necessary to infuse a more holistic framework in IP decisions.

The Role of Experts

The Indian legal regime makes ample provision for the procurement of specialised "technical" expertise courts adjudicating patent disputes. While the Code of Civil Procedure⁷⁵ contains some general provisions in this regard, the Patents Act, 1970 (section 115) is more specific and enables courts to appoint 'independent scientific advisers', as below:

"In any suit for infringement or in any proceeding before a court under this Act, the court may at any time, and whether or not an application has been made by any party for that purpose, appoint an independent scientific adviser, to assist the court or to inquire and report upon any such question of fact or of opinion (not involving a question of interpretation of law) as it may formulate for the purpose."

Pursuant to this provision, the Indian Patent Office, had, in the past, a list of appropriate scientific experts whom courts could appoint while adjudicating patent disputes.⁷⁶

Section 115 has been deployed in some of the leading patent cases. Illustratively in *Bayer Corporation v. Cipla Ltd*,⁷⁷ after procuring the consent of all parties to the dispute, Justice Bhat of the Delhi High Court decided to move ahead with the trial directly (as opposed to deciding the interim injunction application). In order to obtain specialist technical advice and expedite the trial, he appointed scientific experts under Section 115.⁷⁸

However, in what may come as a surprise, Section 115 was never invoked in what many see as India's biggest patent battle to date, namely the Glivec case, involving the patentability of Novartis's revolutionary anti-cancer medication.⁷⁹ Interestingly, this provision was brought to the notice of the court by me (in my capacity as intervenor-cum-amicus), as the court struggled with the underlying chemistry. While the court appreciated the potential value of such a provision and requested all those present in court to suggest the names of competent independent experts, one

75 Section 75(e) of the Code of Civil Procedure 1908 empowers courts "to hold a scientific, technical or expert investigation". Order 26 Rule 10A of the Code allows courts to appoint commissioners to undertake scientific investigation in any suit where such investigation is required.

76 This list may be accessed at http://www.ipindia.nic.in/List_ScientificAdvisors_05October2010.pdf.

77 Refer here to order passed on the 23 July 2010 by the High Court of Delhi in *Bayer v. Cipla* CS(OS) 523/2010

78 See Order passed by the High Court of Delhi on 23 July 2010 in *Bayer v. Cipla* CS(OS) 523/2010. See also *Vringo v. Indiamart Intermesh Ltd*, 2014 (60) PTC 437 (Del) where the single judge and later the Division Bench of the Delhi court (Order in FAO (OS) 369/2014) 13 Aug. 2014) grappled with the issue of determining the appropriate qualifications for an expert under S.115.

79 *Novartis A.G. v. Union of India* AIR 2013 SC 1311.

of the counsels objected, stating that most academic experts in India were biased and could not be relied upon.

Notwithstanding a lost opportunity in the Novartis case, the key advantage of such a provision for a developing country with limited resources is that it spares us the need to appoint full-time technical experts to courts. More importantly, while a full-time expert on the bench is likely to be well versed in only a few areas of science/technology, a temporary expert an ad-hoc set of experts with a diverse range of technological expertise would ensure that courts are able to draw on the appropriate expert for a particular patent case involving a specific technological domain.

Other Specialised Fora for IP Dispute Resolution

Copyright Tribunal

Apart from the IPAB, India boasts other specialised IP tribunals too. The most prominent is the Copyright Board, a body that has, unfortunately fared worse than the IPAB, and has not been functional in the recent past. Under the scheme of the Copyright Act, 1957 (as amended by the 2012 amendments), the specialised tribunal is tasked with adjudicating issues pertaining to:

- Registration and assignment of copyright.
- Grant of compulsory and statutory licences over certain kinds of copyrighted works (works withheld from the public, unpublished Indian works, adaptation of works to enable access to people with disabilities).⁸⁰
- Tariff schemes fixed by copyright societies.⁸¹

Much like the IPAB, the Copyright Board has been mired in constitutional challenges, given its regulatory control by the government and the lack of adequate judicial competence of adjudicators selected. In 2010, the South Indian Music Companies' Association (SIMCA), a body of music producers, filed a writ petition in the Madras High Court, challenging §§11 and 12 of the Copyright Act 1957, and Rule 3 of the Copyright Rules, 1958, as contravening the Constitution of India.⁸²

The petitioners alleged that members of the Copyright Board, did not possess the requisite judicial experience⁸³ and that the government (executive) exercised a disproportionate amount of control over this tribunal, in terms of fixing salaries and of employment of the Board members.⁸⁴ All of this, the petitioners argued would lead to unbridled executive interference and contravene the separation of powers between the executive and the judiciary, a cardinal principle constituting one of the fundamental cores that lies at the heart of the Indian Constitution.

80 See generally the Copyright Rules, 2013; 'Copyright Board', at <http://copyright.gov.in/frmcopyrightboard.aspx>.

81 Rule 57 of the Copyright Rules, 2013.

82 Constitution of India, 1950, Articles 14, 19(1)(g), 21, 50, 245, and 300-A. See writ petition at <http://www.spicyip.com/docs/CopyrightBoardWrit.doc>.

83 Indian Copyright Act 1957, §§11 and 12.

84 See petition at <http://www.spicyip.com/docs/CopyrightBoardWrit.doc>, para. 19.

Recently,⁸⁵ the Madras High Court ruled that all appointments to the Copyright Board opt to conform to the norms laid down for the IPAB in *Shamnad Basheer v. Union of India*.⁸⁶ However, as of the date of writing the government has taken no serious steps to institutionalise the Copyright Board on more secure legal/constitutional foundations. Right to Information (RTI) requests filed by the petitioner (SIMCA) reveal that the various advertisements for posts to the Copyright Board and the processes attendant thereto are in clear contravention of constitutional norms.⁸⁷ Given that various vacancies at the Copyright Board are yet to be filled up,⁸⁸ this body remains a non functional at the moment, causing tremendous consternation to several radio stations and other parties keen on using licensed copyrighted content. Parties have therefore directly petitioning courts to set such royalty rates.⁸⁹

Lastly, the adjudicative competence of the Copyright Board has not been one that inspires confidence. Illustratively, in *Entertainment Network v. Super Cassettes Ltd*, one of the most significant disputes to have come before the Board, the Supreme Court quashed the determination of royalty rates by the Board, finding them to be arbitrary and remanding the same for a fresh determination.⁹⁰ Further, various High Courts have in the past found serious egregious errors with orders passed by the Board.⁹¹ As mentioned earlier, given the nature of the judicial process and the relative lack of precision in the law, one expects some rate of reversal by higher courts or adjudication fora. However, if a majority of decisions rendered by a lower tribunal are called into question by higher courts (as seems to be the case with the Copyright Board in its short sordid history), it points to a larger systemic malaise with the tribunal and its composition.

Much like the IPAB, unless the Copyright Board is resuscitated and placed on firmer constitutional and legal moorings, it will be difficult to subject it to a fair assessment in order to answer the larger issue of whether or not specialised tribunals confer more advantages than disadvantages for India.

85 Owing to amendments to the Copyright Act in the year 2012, the earlier Public Interest Litigation (PIL) by the South Indian Music Companies' Association (SIMCA) was withdrawn at the insistence of the court and a new one filed (W.P. No. 6604/2015, High Court of Madras).

86 See note 31 and accompanying text.

87 See Thomas Vallianeth, 'An Update on the Challenge against the Copyright Board', SpicyIP, 6 Sept. 2015, at <http://spicyip.com/2015/09/an-update-on-the-challenge-against-the-copyright-board.html>.

88 Id. The Board's staffing has been a subject of constant controversy. See Prashant Reddy, 'Copyright Rules, 2013 designed to fail the Copyright Board', SpicyIP, 20 Mar. 2013, <http://spicyip.com/2013/03/copyright-rules-2013-designed-to-fail.html>.

89 See Prashant Reddy, 'Copyright Board crippled due to lack of quorum – APAA moves Delhi High Court', SpicyIP, 30 Nov 2011, <http://spicyip.com/2011/11/copyright-board-crippled-due-to-lack-of-quorum.html>; See also Prashant Reddy, '47% vacancy at the Copyright Office', SpicyIP, 9 Apr 2012, <http://spicyip.com/2012/04/47-vacancy-at-copyright-office.html>; Anubha Sinha, 'Dandi Salt v. Union of India: Copyright Board may consider Review Applications', SpicyIP, 19 Aug 2014, <http://spicyip.com/2014/08/dandi-salt-v-union-of-india-copyright-board-may-consider-review-applications.html>

90 2008 (37) PTC 353 (SC). See also Shamnad Basheer, 'Breaking News : Supreme Court Stays Copyright Board Order', SpicyIP, 18 Mar. 2011, <http://spicyip.com/2011/03/breaking-news-supreme-court-stays.html>.

91 Prashant Reddy, 'Madras High Court 'stays' the 'Compulsory Licensing Order' of the Copyright Board against SIMCA & Super Audio', 3 Dec. 2010, at <http://spicyip.com/2010/12/madras-high-court-stays-compulsory.html>. See also Amlan Mohanty, 'Copyright Compulsory Licensing Disputes : Copyright Board lacks jurisdiction', SpicyIP, 17 Apr. 2011, <http://spicyip.com/2011/04/copyright-compulsory-licensing-disputes.html>.

Indian Domain Name Dispute Resolution Policy

Much like the Uniform Domain Name Dispute Resolution Policy (UDRP), a form of specialised dispute resolution for global top level domain name extensions such as .com and .org (gTLD's),⁹² India boasts a regional policy for .in, its country code top level domain (ccTLD).⁹³

Prior to the advent of the Indian Domain Name Dispute Resolution Policy (INDRP), domain name disputes were adjudicated by ordinary civil courts. In fact, the lack of a specialised forum to adjudicate domain name disputes was highlighted by the Supreme Court of India in 2004, in *Satyam Infoway v. Sifynet Solutions*: "As far as India is concerned, there is no legislation which explicitly refers to dispute resolution in connection with domain names. But although the operation of the Trade Marks Act, 1999 itself is not extra territorial and may not allow for adequate protection of domain names, this does not mean that domain names are not to be legally protected to the extent possible under the laws relating to passing off."⁹⁴

The procedure envisioned by the INDRP involves mandatory submission of the domain name registrant to an arbitration proceeding under the Indian Arbitration and Conciliation Act, 1996.⁹⁵ Much like the UDRP, the INDRP arbitration framework was established to address a narrow subset of domain name disputes – those that involved bad faith registration on the Registrant's part. However, decisions of the Delhi High Court⁹⁶ may have skewed the policy too much in favour of trademark owners who are more likely to find it easier to stake their claim even against domain name registrants with some legitimate interest in the domain name.⁹⁷

Being a private mode of Alternative Dispute Resolution [ADR], the INDRP arbitral panel is not a specialised IP court.⁹⁸ However, this private mode of dispute resolution this private mode of

92 See "Uniform Domain Name Dispute Resolution Policy" at <<https://www.icann.org/resources/pages/help/dndr/udrp-en>>

93 See ".IN Domain Name Dispute Resolution Policy (INDRP)" at <https://www.registry.in/IN%20Domain%20Name%20Dispute%20Resolution%20Policy%20%28INDRP%29>. For more background, see < <https://www.registry.in>>: ".IN is India's Country Code Top Level domain (ccTLD). The Govt. of India delegated the operations of INRegistry to NIXI in 2004. The INRegistry operates and manages India's .IN ccTLD. The National Internet Exchange of India or NIXI is a Not-for-Profit Company incorporated under section 25 of the Indian Companies Act, 1956, with an objective of facilitating improved internet services in the country."

94 AIR 2004 SC 3540.

95 See paragraph 4, INDRP Rules of Procedure, available at <https://www.registry.in/INDRP%20Rules%20of%20Procedure>

96 See Stephen Koenig v. Arbitrator, National Internet Exchange of India (Nixi) & Anr., 2012 (49) PTC 304 (Del.) which appears to suggest that the elements of paragraph 4 of the INDRP (corresponding broadly to paragraph 4(a) of the UDRP) need not be satisfied cumulatively in order for the trademark owner/complainant to win. This decision could potentially be held up to support the proposition that "bad faith" is not an essential ingredient to be proved for an INDRP claim to succeed. See Shannad Bashaer, 'A Distinct IP Domain for India?', SpicyIP, 10 Jan. 2012, <<http://spicyip.com/2012/01/distinct-ip-domain-for-india.html>>. The decision in Koenig was further affirmed by a Division Bench of the Delhi High Court (Bhat and Sharma, JJ.) in November 2015. See Stephen Koenig vs Arbitrator Nixi And Anr (judgment dated 2 Nov. 2015 in FAO(OS) 42/2012), available at <http://lobis.nic.in/dhir/dhc/SRB/judgement/05-11-2015/SRB02112015FAOOS422012.pdf>.

97 It bears noting that the INDRP claim success rate for trademark owners was 100% for the years 2010 and 2011. For the period 2006-11, the success rate stood at 95% See 'Resolution of Domain Name-Trademark Disputes in India', available at <http://ir.inflibnet.ac.in:8080/jspui/bitstream/10603/71803/9/chapter%205.pdf>

98 See Lead paper (section 1.2) which defines a "specialised IP court" as "an independent public judicial body which has the primary mission to adjudicate certain types of disputes relating to intellectual property rights at the national or regional level..". Although NIXI which administers the in domain name extension is a public body, the arbitrators that decide domain name disputes under the INDRP are drawn from a private pool, comprising a number of private law practitioners. In any event, this arbitration cannot be said to constitute a public "judicial" function, which lies in the sole prerogative of the judiciary (courts/tribunals) as recognised under the Indian constitution.

dispute resolution compulsorily thrust on every domain name applicant throws up an important constitutional issue. If a domain name is tantamount to a form of private property,⁹⁹ in which rights in rem subsist as against the world at large. If this be the case, there is a good argument to be made (as per Indian constitutional law, where a "lis" can only be adjudicated upon by a public court of law, vested with judicial functions under the Constitution of India¹⁰⁰) that domain name disputes have to be necessarily adjudicated by "judicial bodies" such as courts or independent tribunals, and cannot be left to private arbitral bodies.¹⁰¹ More so, when such arbitral bodies are not subject to ordinary appeals, but challengeable only under very narrow grounds before the courts of the land.¹⁰²

Patent Office

The Indian Patent Office is known to be a quasi-judicial body, with some of its decision-making powers mirroring those of the courts.¹⁰³ The compulsory licensing provisions are an excellent example, with the office adjudicating whether or not a compulsory license can be granted to a third party. In this regard, it bears noting that a determination in this particular case is not a mere matter of government discretion, but a statutory entitlement in favour of any third party who meets the eligibility criteria in section 84 of the Patents Act.

In an earlier note to the government of India,¹⁰⁴ I argued that given India's constitutional jurisprudence, a compulsory licensing dispute could only be adjudicated upon by a court or tribunal and not by an executive agency such as the patent office.¹⁰⁵ However, for the purposes of this paper, this issue is simply touched upon, and not more elaborately dealt with, as it raises a number of issues that impact the larger subject of patentability decisions by the patent office (which one might argue are a quasi-judicial determinations, requiring as they do, an interpretation of the law and its application to the facts at hand).¹⁰⁶

Conclusion

The prevalent perception, at least amongst attorneys, is that a specialised IP dispute resolution bodies foster speedier justice and more consistent IP jurisprudence.¹⁰⁷ While there is, as yet no

99 Illustratively, see *Tucows.Com Co. v Lojas Renner S.A.* [2011] O.J. No. 3576, where a court in Ontario (Canada) held a domain name to be property.

100 See *Kihoto Hollohan vs. Zachillhu* 1992 Supp (2) SCC 651, where it was held by the Supreme Court that where the authority is called upon to decide a lis on the rights and obligations of the parties, there is an exercise of judicial power.

101 See supra note 100.

102 See *Stephen Koeing vs Arbitrator Nixi And Anr* (judgment dated 2 Nov. 2015 in FAO(OS) 42/2012), available at <http://lobis.nic.in/ddir/dhc/SRB/judgement/05-11-2015/SRB02112015FAOOS422012.pdf>, where it was held that the scope of review of arbitral decisions flowing from the INDRP is rather limited. Section 34 of the Arbitration and Conciliation Act 1996, under whose legal shadow the impugned arbitral decision was rendered restricts judicial review to only cases of patent illegality, violation of public policy or morality etc.

103 Shamnad Basheer, 'Policy Style' Reasoning at the Indian Patent Office', 3 *Intellect. Prop. Quart.* 309 (2005).

104 See Shamnad Basheer and Prashant Reddy, 'Constitutional Infirmities in the Compulsory Licensing Scheme' (October 2010), available at [http://dipp.nic.in/English/Discuss_paper/Feedback_ShamnadBasheer\(I\)_01October2010.pdf](http://dipp.nic.in/English/Discuss_paper/Feedback_ShamnadBasheer(I)_01October2010.pdf) and [http://dipp.nic.in/English/Discuss_paper/Feedback_ShamnadBasheer\(II\)_01October2010.pdf](http://dipp.nic.in/English/Discuss_paper/Feedback_ShamnadBasheer(II)_01October2010.pdf).

105 *Kihoto Hollohan vs. Zachillhu* 1992 Supp (2) SCC 651.

106 See Basheer and Reddy, supra n. 104.

107 See the IBA Survey, supra n. 6, p.3.

conclusive empirical evidence on this count, the Indian experience with the IPAB suggests that these advantages may not have played out, at least in the first twelve years of its operation. To be fair, this could be attributed to the complex constitutional morass that it found itself in, with excessive government control over IPAB appointments, and very little infrastructural and personnel support. It will be a while before the IPAB is resuscitated and placed on firmer legal moorings so as to enable us to subject it to a fairer assessment.

The other specialised IP tribunal, Copyright Board, has fared even worse and as of the date of writing, continues to remain a non functional body.

To the extent that some form of IP specialisation in IP dispute resolution is desirable, I lean in favour of a specialised bench within existing High Courts. While the Commercial Courts Act is a step in the right direction, it does not go far enough in terms of creating a robust framework for cultivating specialised expertise. Neither does it ensure that specialised IP judges experience an eclectic range of legal issues that enlarge their vision and pave the way for a more holistic IP jurisprudence that optimally balances private IP rights against the larger public interest.

Specialised Intellectual Property Courts in Africa: The Case of Uganda

Susan Isiko Štrba

Introduction

While countries are not obliged to establish specialised intellectual property courts (SIC) in order to fulfil their international obligations,¹ SIC are often considered an indicator of the effective administration, management, and enforcement of IP.²

A number of countries provide for the establishment of SIC in their constitutions³ or intellectual property instruments.⁴ SIC take the form of independent adjudicatory bodies such as tribunals,⁵ special units within existing general purpose courts,⁶ or IP institutions.⁷ Some are permanent⁸ while a number are created on an ad hoc basis.⁹ 'Specialised' therefore connotes 'special purpose' rather than 'separate entity'.¹⁰

By exploring the experiences of selected African countries, and taking into account the public interest in IP, this short piece illustrates the extent to which SIC are needed. Although its focus is on Uganda, this paper will draw from the experiences of other countries where appropriate.

SIC in Action: The Case of Uganda

The Registrars of Copyright, Patents and Trademarks

The Uganda Registration Services Bureau hosts the Registrars of Copyright, Patents and Trademarks. Apart from recording the different intellectual property rights granted, each Registrar has quasi-

1 TRIPS Agreement, Art. 41(5).

2 International Intellectual Property Institute (IIPI) and United States Patent and Trademarks Office (USPTO), *Study on Specialized Intellectual Property Courts* (Jan. 2012) (hereafter 'the IIPI Study'); International Bar Association Intellectual Property and Entertainment Law Committee, *International Survey of Specialized Intellectual Property Courts and Tribunals* (Sept. 2007) (<http://www.ibanet.org/Document/Default.aspx?DocumentUid=7F5A1221-6C07-4CE7-A628-1F457A2433A5>).

3 For example the Nigerian Constitution 1999, s. 251(1)(f). The Federal High Court has the sole jurisdiction of over civil causes and matters relating to IP.

4 For example, Zimbabwe Intellectual Property Tribunal Act 2001 (came into force 2010).

5 Examples include the Kenya Industrial Property Tribunal (for a detailed analysis of Kenyan IP tribunals, see the IIPI Study); Industrial Property Tribunal of Mauritius; and the Intellectual Property Tribunal of Zimbabwe.

6 The majority exist as Commercial Courts within the High Court. Examples include Nigerian Federal High Court, Uganda Commercial Court and Tanzania Commercial Court.

7 Ethiopia has just amended the Copyright Law to provide for setting up an Intellectual Property Tribunal within the IP Office. See Proclamation to Amend the Copyright and Neighbouring Rights Protection Proclamation, 2014, sec. 44.

8 Kenya Industrial Property Tribunal.

9 Malawi Commercial Court.

10 For example, the African Regional Intellectual Property Organization (ARIPO) has ten specialized IP courts within its member states. On the list are Commercial Divisions of High Courts, such as the Commercial Court of Uganda, which is a special branch of the High Court responsible for all commercial disputes. Email communication from Mr Fernando dos Santos, Director General of ARIPO, on 21 Jan. 2015.

judicial authority to hear opposition proceedings.¹¹ In the case of patents, no disputes have been recorded since patents are filed through the African Regional Intellectual Property Organization (ARIPO). In any case, the number of filings is low, limited to about ten per year.

While the Registrar of Copyright is not a court of law, it has adjudicatory powers.¹² These powers are best demonstrated by the *Mpenkoni* decision.¹³ In this case the registration of President Museveni's rap song for his 2012 presidential campaign was challenged by indigenous communities who claimed ownership of the original poems or folklore on which the song was based. The Registrar's decision covered much more than just copyrightability issues.¹⁴ On the question of copyrightability, the Registrar of Copyrights argued, "the transformation of a folksong is to my mind an original creation which as expressed constitutes a derivative work [...] the idea seems obvious but the expression is original." She ruled that the President's rap song was a derivative work, which, by selection and arrangement of its content, constituted an original work and was thus entitled to copyright protection by virtue of section 5(1) of the Copyright and Neighbouring Rights Act of Uganda.¹⁵ The Registrar, however noted that "copyright in a derivative work covers only the additions, changes or other new material appearing for the first time in the work and does not extend to any pre-existing material and does not prevent anyone else from using the existing work for another derivative work".¹⁶

In conclusion, the Registrar assured the objectors that the applicant was not attempting to monopolise a piece of heritage. The poems or folklore had not in any way been misappropriated, but instead could now be enjoyed by anyone "including the young generation whom, I hazard to say, may relate to the applicant's new arrangement of the said works".¹⁷

The outcome of the case can be said to have been mutually beneficial for the indigenous people or objectors and the applicant for copyright protection. The President received copyright in the rap song while the indigenous people received the assurance that the original folklore was still free for use by all.

Although not decided in a court of law, this case demonstrates the wide adjudicatory powers of the Registrar. This decision may imply that when seeking to define 'specialised IP tribunals', an institution exercising its powers might be more important than the functions conferred upon it by statute.

The Commercial Court

The Commercial Court was established in 1996 as a division of the High Court of Uganda. It was devoted to hearing and determining commercial disputes – company causes, bankruptcy, and intellectual property – with current jurisdiction The Court is tasked with delivering an expeditious

11 See, for example, Copyright and Neighbouring Rights Act 2006, secs 42 to 44, and Trademarks Act 2010, sec. 12.

12 Copyright and Neighbouring Rights Act 2006, sec. 42, and Copyright and Neighbouring Rights Regulations 2010, Reg. 6, read together.

13 In the Matter of an Application No. 25 of 2010 for registration of Copyright by Yoweri Kaguta Museveni in the song 'You want another rap' and In the Matter of an Objection by Mr. Mwambusya Ndebesa and Dr. Katono Nzarwa Deo.

14 For a detailed analysis of the case, see Anthony Kakooza, 'The Cultural Divide: Traditional Cultural Expressions and the Entertainment Industry in Developing Economies', dissertation, University of Illinois at Urbana-Champaign, 2014.

15 Kakooza, 'The Cultural Divide', p. 7.

16 Kakooza, 'The Cultural Divide', p. 7.

17 Kakooza, 'The Cultural Divide', p. 7.

and cost-effective mode of adjudicating disputes that directly and significantly affect the economic, commercial and financial life of Uganda.¹⁸

In order to expedite cases and reduce costs, there is a mandatory mediation session for all commercial disputes. While the majority of the cases before the Commercial Court concern trademark disputes, the number of copyright cases is increasing.¹⁹ The Commercial Court is a court of first instance for matters relating to IP.²⁰ It is also a court of appeal for decisions from the Registrar, including matters relating to trademark or patent registration.²¹

The Commercial Court has jurisdiction over both civil and criminal matters. However, thus far the Court has exercised civil jurisdiction exclusively, awarding civil remedies instead of criminal penalties.

The volume of IP cases remains low. On average, there are 10 to 12 on IP decisions a year.²² Similar to criminal cases, IP disputes are decided quickly, generally taking two to three years.²³

In terms of expertise and capacity building for judicial officers, a number of local institutions offer training. For example, the Centre for Human Rights and Development provides limited training through media fellowships, focusing on the social welfare aspects of intellectual property. The Judicial Studies Institute provides limited training for judicial officials, but with no particular focus on IP or the Commercial Court.²⁴ On a regional level, as Uganda is a member of the East African Community (EAC),²⁵ its judicial officials receive training through the EAC Judicial Education Committee. Overall, the expertise in IP remains limited.

The judges appear to have found a balance between knowledge of IP rights and public interest flexibilities.²⁶ Public interest considerations have come into play during hearings, but the final decision largely depends on the evidence before the Court. In other words, the judges do not appear to be influenced by the sociological effect of sitting in a commercial court.²⁷ However, the decisions are too few to draw general conclusions.

18 Legal Notice No. 4 of 1996 and Instruction Circular No. 1 of 1996.

19 Commercial Court decisions are available on the website of the Uganda Legal Information Institute, at <http://www.ulii.org/ug/judgment/commercial-court>.

20 See for example, the Patents Act 1993, secs 26(2) and (3); Copyright and Neighbouring Rights Act 2006, sec. 45 (any person whose rights are in imminent danger of being infringed or are being infringed may institute civil proceedings in the Commercial Court); the Trademarks Act 2010, sec. 35.

21 Trademark Act 2010, secs 7, 50, 51, 52 and Patents Act 1993, sec. 22.

22 In 2014, the number of decisions in the commercial court was 242, with IP-related decisions totalling only 12. This number of IP decisions remains the highest since the Commercial Court started hearing IP disputes (information based on authors own calculation from data available on the Commercial Court website.)

23 Owing to the high case load, especially in the High Courts, cases are generally not decided quickly. While criminal cases which are priority can take on average 2 to 3 years to be decided, civil cases take much longer. However, IP disputes, just like all disputes before the Commercial Court, tend to be decided much faster than ordinary civil disputes.

24 Laurence Gidudu, 'Annual Report', Judicial Studies Institute, 2012 (on file with author).

25 Members of the EAC are Burundi, Kenya, Rwanda, Uganda and Tanzania.

26 The most vivid example is the recent judgment in *Angella Katatumba v. the Anti-Corruption Coalition of Uganda (ACCU)*, Civil Suit No. 307 of 2011 (decided on 18 Aug. 2014).

27 Judges' decisions are likely to be influenced by the sociological environment in which they find themselves. See Susan Isiko Štrba, 'A Model for Access to Educational Resources and Innovation in the Developing world', in Daniel Gervais (ed.), *Intellectual Property, Trade and Development: Strategies to Optimize Economic Development in a TRIPS-Plus Era*, 2nd edn (Oxford University Press, 2014), pp. 287–313, at p. 309.

Policy Considerations for SIC

A major argument for the creation of specialised IP courts is the lack of expertise among judicial officers of the general courts. However, it is worth noting that many countries in Africa do not offer basic IP education in universities.²⁸ Thus, there is widespread lack of knowledge and expertise in IP. Given resource constraints and overall public interest, it is prudent to begin with the creation of human capacity for existing SIC or any judicial body to handle IP cases. The following guiding points can help achieve this goal.

SIC courts should include legally and technically qualified judges. Education and training are key in this respect. The Ugandan Commercial Court includes IP qualified judges and it is evident from its decisions that these judges are well versed in the legal and technical issues. Although some have undergone tailored training programmes,²⁹ it is important to provide continuous advanced specialised training and courses for judicial and other law enforcement officers.

Education and training should not be limited to enforcement, but include a range of IP issues. In its provision of training for IP judicial officials, the EAC has made an effort to provide general knowledge on IP, including public interest flexibilities.³⁰ Regional policies like the EAC Regional IP policy on the Utilization of Public Health Related WTO-TRIPS Flexibilities and the Appropriation of National Intellectual Property Legislation and the EAC Anti-Counterfeit Policy are some of the considerations that are taken into account when designing the training programme.³¹

However, several challenges remain. First the EAC Judicial Education Committee is only one of many institutions providing training and capacity building. The other agencies may not be interested in providing training and capacity building that takes the public interest into account. Second, there is a conflict of interest between Kenya, the only developing Member of the Community, which has the obligation to implement TRIPS, and the other Member States which are least developed countries (LDCs) and can benefit from flexibilities.³²

Access to jurisprudence and other reference materials is another requirement. The unique needs of the specialised courts are unlikely to be fully met by existing national reference centres. The establishment of a special IP section in the Commercial Court library may be required. This will necessitate financial support for the purchase of hard copy reference materials and subscriptions to key legal resources.

In the case of Uganda, the limited number of IP cases, the accessibility of the Commercial Court, and the expediency with which decisions are taken would suggest that there is no need for a SIC. It might therefore be useful to conduct a detailed study on the impact and necessity of SIC in Uganda in particular and African economies in general in the medium and long term.

28 For example Swaziland and Malawi (based on author's field visits to these countries).

29 Email communication from Anthony Kakooza, private practitioner and lecturer, Dean, Faculty of Law, Uganda Christian University, 22 Jan. 2014.

30 Recent training which took place in Arusha, Tanzania, 27–30 Oct. 2014, included defences on the agenda. See 'EAC Judicial Officers Train in Intellectual Property Law and Practice', East African Community, at http://www.eac.int/index.php?option=com_content&view=article&id=1703:-eac-judicial-officers-train-on-intellectual-property-rights-law-and-practice&catid=146:press-releases&Itemid=194. The participants received general training on IP before focusing on enforcement. Interview with Saudin Jacob Mwakaje, Lex Law Advocates, Tanzania, a regular participant in the EAC training sessions as regional expert on Intellectual Property, 23 Jan. 2015.

31 'EAC Judicial Officers Train in Intellectual Property Law and Practice'.

32 Interview with Saudin Jacob Mwakaje.

The Center for International Intellectual Property Studies (CEIPI) is a constituent part of the University of Strasbourg devoted to research and training in the domain of intellectual property. CEIPI faculty is composed of almost 400 academics and practicing attorneys in 22 countries and 41 cities in Europe. Since 1963 CEIPI has trained nearly 42 000 professionals and students through its various programmes, and has developed joint research and teaching programs with leading intellectual property organizations and academic centers.

Founded in 1996, the International Centre for Trade and Sustainable Development (ICTSD) is an independent think-and-do-tank based in Geneva, Switzerland, with operations throughout the world, out-posted staff in Brazil, Mexico, Chile, Senegal, Canada, and Russia, and a first regional office in Beijing, China. By enabling stakeholders in trade policy through information, networking, dialogue, well-targeted research and capacity-building, ICTSD aims to influence the international trade system so that it advances the goal of sustainable development. ICTSD co-implements all its programmes through partners and a global network of hundreds of scholars, researchers, NGOs, policymakers and think-tanks around the world. ICTSD acknowledges the contribution of its donors in supporting this project.

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