



## 13th Annual BILETA Conference: '*The Changing Jurisdiction*'

Friday, March 27th & Saturday, March 28th, 1998.  
Trinity College, Dublin.

### **The Internet, Intellectual Property and International Litigation: The implications of the international scope of the internet on intellectual property infringements**

Stuart Dutson [1]

Centre for Commercial Law Studies

QMW

#### **I Introduction**

"The Net comprises a worldwide web, so foreign copyright issues will often arise and it may not be clear which law applies". [2] This article aims to indicate when an English court will be able to accept jurisdiction in a case in which an English or foreign intellectual property ("IP") right is infringed and what law that court will apply.

The word "Internet" derives from "The International Network". It can best be described as a network of networks - a multitude of computers around the world are linked together. The most significant services provided over the Internet are E-mail, file transfer protocol (FTP) and the Worldwide Web ("WWW"). The WWW is a series of information or web sites on the Internet - a service provided over the Internet. These web sites can link up and provide links with other web sites. The WWW also allows users to create multi-media works. These are web sites that incorporate drawings, sounds, images or are interactive. The web sites can also draw on information from other web sites concurrently. The parties that place information to be accessed over the Internet are known as web servers. Another service provided over the Internet is news groups. Designated computers or news servers are points to which news is transmitted. The information collated on these news servers forms a news group and users can access this information.

The first issue that addresses a conflicts lawyer when considering the internet is whether it is a novel form of communication, or nor more than the natural progression of existing methods of communication such as the telephone, facsimile, television etc. It is the present author's opinion that, from a conflict of laws' perspective, the latter is true. In terms of the issues relevant in the conflicts of laws it is generally to be considered no differently from existing means of mass communication. The conflict of laws principles that have been developed in light of, and have been applied to, the press, telephone, facsimile and television apply equally to this new form of communication: it is essentially old wine in new bottles from a conflicts perspective. Information placed by a web-site provider for access over the internet is sent by that person to others (potentially millions of others, simultaneously, in many different jurisdictions) just as a fax or letter or TV transmission is sent by its author, albeit that the information passively awaits access being made to it by web users. [3] Nevertheless, the ability that the internet creates of making information available simultaneously in every jurisdiction in the world (the only limit being the presence there of telephone lines and a computer with the relevant capacity and software), presents unique factual circumstances in which infringements of IP rights may be committed.

#### **II Territorial Limitations on IP Rights**

There are two distinct forms of jurisdiction that are relevant in any case viz. "personal jurisdiction" and "subject matter jurisdiction". [4] The former is jurisdiction in the sense of amenability of the defendant to the court's

writ. [5] The latter is jurisdiction in the sense of entertainment of disputes as to a particular subject matter. [6] Provisions which provide for "exorbitant" or "long arm" jurisdiction, such as RSC (England) O.11 r.1, deal only with personal jurisdiction, they do not provide a court with jurisdiction over the subject matter of the action. [7] In most cases both personal and subject matter jurisdiction must be established if a court is to be able to hear and determine any dispute. This distinction becomes particularly relevant if a court is considering a statutory right. [8] If the plaintiff's right is statutory the courts resolve the issue of subject matter jurisdiction by interpreting the statutory provisions and/or by applying the relevant choice of law rule. [9] The ability to effect service of proceedings on a foreign defendant under a long arm service provision such as RSC (England) O.11 r.1 will not conclusively establish the application of a statute of the forum to either the dispute or the foreign defendant. [10]

A Court's subject matter jurisdiction in cases in which the right or cause of action derives from the common law is determined by the application of the relevant choice of law rule. However, in cases of a statutory right or cause of action this method must be subordinate to the terms of the Act being characterised and the context, subject matter or object of the Act. [11] If, for example, the statute provides that it applies only to acts of a person within the UK, then it can have no application to acts which take place outside the UK notwithstanding the determination which the application of the applicable rule of private international law may generate. [12]

In cases dealing with statutory IP rights the court's subject matter jurisdiction is provided for expressly in the relevant legislation and the choice of law rules are therefore inapplicable in the determination of subject matter jurisdiction. The Patents Act 1977 ss. 60, 132(2)-(4); Copyright, Designs and Patents Act 1988 [13] ss. 1, 2, 16; and Trade Marks Act 1994 s.9(1) each provide in effect that the statute is limited in its operation to acts of infringement that take place within the UK. [14] Accordingly, an English court has subject matter jurisdiction to determine an action dealing with the infringement in England of an English statutory IP right, however it cannot determine an action dealing with the "infringement" outside England of an English statutory IP right. [15]

In contrast, the tort passing off is not territorially limited in this way. As a creature of the common law, its territorial scope is determined by the application of the appropriate choice of law rule in tort or delict.

### III Personal Jurisdiction

#### A. Introduction

As discussed above, generally a court must possess both personal and subject matter jurisdiction to determine any case. The issue of subject matter jurisdiction in cases in which an English statutory IP right is relevant has been dealt with above. What follows is a discussion of the assumption of personal jurisdiction by an English court.

In the case of an action commenced in an English court against a defendant domiciled within the EEA "personal jurisdiction" will be determined in accordance with the 1968 Brussels and 1989 Lugano Conventions [16] which were brought into force in the United Kingdom by the Civil Jurisdiction and Judgments Act 1982 (UK) (as amended to incorporate the Lugano Convention by the Civil Jurisdiction and Judgments Act 1991 (UK)). However, as against defendants domiciled outside the EEA, subject to any agreements as to jurisdiction made between the parties, [17] "personal jurisdiction" is determined in accordance with the traditional English rules as to service out of the jurisdiction - Order 11 of the RSC. [18]

#### B. Proceedings regarding the infringement in England of an English IP right committed by a foreigner

As discussed above, this kind of case raises no problems of subject matter jurisdiction.

Personal jurisdiction must be addressed in terms of the Convention and non-Convention States. Neither the Convention nor the non-Convention rules dealing with personal jurisdiction make any special provision for cases dealing with the infringement of IP rights. Accordingly, the general rules apply to infringement cases.

## 1. Defendant not domiciled in a Brussels/Lugano Convention country

The extraterritorial service provisions that may be relevant are: O.11 r. 1(1)(b), (c) and (f) and are each considered below.

O.11 r.1(1)(f) RSC (England) provides for extraterritorial service where a "claim is founded on a tort and the damage was sustained, or resulted from an act committed, within the jurisdiction". Whether an action is "founded on a tort" and whether the requirements of O.11 have been satisfied, is determined in accordance with the *lex fori*. [19]

In *The Electric Furness Company v Selas Corporation of America* [20] the Court of Appeal considered that an action for infringement of a patent came within the predecessor to O.11 r.1(1)(f). The law is the same in Australia. [21] Accordingly, O.11 r.1(1)(f) applies both to claims for the infringement of a statutory IP right and to the tort of passing off.

Prior to the amendment of O.11 in 1987 the English tort extraterritorial service rule provided for a claim founded on a "tort committed within the jurisdiction". The new version of the rule was adopted in order to bring O.11 into line with Article 5(3) of the Brussels Convention (which confers special jurisdiction on courts in matters relating to tort or delict) and the decision of the European Court of Justice in *Bier v. Mines de Potasse d'Alsace SA*. [22] In *Metall und Rohstoff A.G. v. Donaldson Lufkin & Jenrette Inc.* [23] the Court of Appeal considered O.11 r.1(1)(f) in some detail and in so doing provided the only authoritative guidelines for the interpretation of O.11 r.1(1)(f) reported to date. The court made no reference to the pre-existing law on where a tort is committed in the context of the new O.11 tort extraterritorial service provision. The court held that it is not necessary that all the damage should have been sustained within the jurisdiction; it is enough if some significant damage has been sustained in England. [24] Nor is it necessary that all the acts have been committed within the jurisdiction; [25] the court must look at the tort alleged in a common-sense way and ask whether damage has resulted from substantial and efficacious acts committed by the putative defendant within the jurisdiction, whether or not other substantial and efficacious acts have been committed elsewhere. [26] In cases under IP statutes the act will be the infringing act(s) identified in the statute (for example, the unauthorised use of a patented product, or the copying or performance of copyright material), and in passing-off cases it will be the receipt of the defendant's misrepresentation(s) (for example, that the defendant's business is related to the plaintiff's business) and the damage to the plaintiff's goodwill at the place where it exists. [27]

O.11 r.1(1)(b) provides for extraterritorial service where an injunction is sought ordering the defendant to do or refrain from doing anything within the jurisdiction (whether or not damages are also claimed in respect of a failure to do or the doing of that thing). This rule proved useful in *In re Burlands Trade Mark* [28] where the plaintiff obtained an injunction against a Scottish defendant in respect of infringements of its trademark in England. Again, an infringing act must have taken place within England for this rule to be utilised.

O.11 r. 1(1)(c) provides for extraterritorial service where the claim is brought against a person duly served within or out of the jurisdiction and a person out of the jurisdiction is a necessary or proper party thereto. The test applied to determine whether this rule is applicable is whether the party sought to be served could, if within the jurisdiction, have been joined in the original action. [29] In *Washburn v Cunard Steamship Company* [30] service was effected in reliance on this rule against the Irish owner of goods that infringed the plaintiff's patent after service had initially been effected on the Liverpool based party who had imported the goods into England. There are decisions which state that the secondary defendant cannot be served under this extraterritorial service head if the sole, as opposed to predominant, purpose of the action against the original defendant is to enable or facilitate jurisdiction against the secondary defendant. [31]

These decisions were based on the express requirement that the proceedings be "properly brought" against the original defendant. [32] In England this has been replaced by a requirement that an application made under this head be supported by an affidavit which includes a deposition to the effect that there is a real issue between the plaintiff and the original defendant which the plaintiff may reasonably ask the court to try. [33] There is no authority on whether this alteration affects the authority of the older English decisions, however, it appears that the end result will be the same under the new version of the rule.

A further method by which a defendant may be served under O.11 r.1 is the "common design rule". If a plaintiff can establish that defendants have collaborated in a common design to infringe his IP right then the defendants will be liable as joint tortfeasors. [34] If one of the defendants collaborating is outside England and the other is inside England then the foreigner can be served under O.11 r.1(1)(b), (c) and/or (f). [35]

Accordingly, if an English resident party has committed acts within England which are alleged to have constituted primary infringements of a plaintiff's IP rights and those acts were committed in furtherance of a common design between it and an overseas party such that the overseas party can be said to have procured or assisted the infringement, then the overseas party can be sued in England pursuant to O.11 r. 1(1)(b) (c) and/or (f).

## **2. Defendant domiciled in a Brussels/Lugano Convention country**

The primary rule provided for in the Conventions is that a defendant should be sued in his place of domicile. [36] However, subject to recent English, German and Dutch decisions, [37] in IP cases this rule can prove to be particularly problematic. Because of the territorial nature of statutory IP rights it may only be possible to obtain subject matter jurisdiction in an English Court in the jurisdiction in which the infringing act(s) took place. If this jurisdiction is not also the defendant's domicile then Article 2 is rendered nugatory. Rather, a plaintiff may be forced to turn to the special jurisdiction provisions of the Conventions in order to identify a jurisdiction in which this concurrence of subject matter and personal jurisdiction occurs.

Article 5(3) of the Conventions grants jurisdiction in matters relating to tort or delict to the court of "the place where the harmful event occurred". Disputes concerning the infringement of an intellectual property right are matters relating to tort, delict or quasi-delict. [38] This accords with the treatment of actions for infringement of intellectual property rights in the law of the contracting states to the Brussels Convention - they are regarded as actions in tort or delict.

Article 5(3) is also applicable in a common design case. [39] It appears that Article 6 (discussed below), would also be available in a common design case.

It is not an improper use of Article 5(3) or the common design principle to obtain jurisdiction under Article 5(3) solely in order to obtain discovery of documents in that party's possession. In *Molnlycke* the plaintiff joined the German defendant in the action with the particular aim of obtaining discovery of documents relevant to the claims against other defendants in that case as well as to the claim pleaded against the German defendant.

The meaning of the phrase "the place where the harmful event occurred" in Article 5(3) has been considered by the European Court of Justice in three types of cases: [40] where the place of the event giving rise to the damage and the place where the damage occurs, being a single instance of damage, are not the same; [41] where the plaintiff has suffered indirect damage; [42] and where it is difficult to ascertain the place in which the damage occurred because the causal event gave rise to more than one instance of damage. [43] In *Bier v. Mines de Potasse d'Alsace SA* [44] the court held that the place where the harmful event occurred under Article 5(3) encompassed both the place where the damage occurred and the place of the event giving rise to the damage. [45] In *Dumez France and Tracoba SA v. Hessische Landesbank* [46] the court pointed out that Article 5(3) supported the need for a close connecting factor between the dispute and the court hearing the case. [47] Consequently, the court held that the phrase "the place where the damage occurred" as used in *Bier* is the place where the tortious conduct which gave rise to the damage directly produced its harmful effects upon the person or the property of the person who is the immediate victim of that event. [48] The court further clarified the law in this area in *Marinari v. Lloyds Bank Plc.* [49] The court there stated that "the place where the harmful event occurred" could not be construed so extensively as to encompass any place where the adverse consequences of an event that had already caused actual damage elsewhere could be felt. [50] Consequently it did not include the place where financial loss resulting from initial damage suffered by the plaintiff in another State, is sustained or felt by the plaintiff. [51] In *Shevill v. Presse Alliance S.A.* [52] the Court stated that where a causal event gives rise to more than one instance of damage the "place where the damage occurred" as used in *Bier* means all of the places in which damage arose. Therefore a plaintiff would be entitled to commence proceedings in a tort action before the courts of: the defendant's domicile, the place of the harmful event, and the places in which the damage arose.

However, only the courts of the defendant's domicile and the place of the harmful event are competent in respect of all of the damage. The courts within whose jurisdiction damage has arisen only have jurisdiction with respect to the damage which has arisen within their own jurisdiction. Further, the court held that in determining whether it has jurisdiction qua court of the place where the damage occurred pursuant to Article 5 (3) "the criteria [that the court must employ] for assessing whether the event in question is harmful and the evidence required of the existence and extent of the harm alleged by the victim . . . are not governed by the Convention but by the substantive law determined by the national conflict of law rules of the court seised, provided that the effectiveness of the Convention is not thereby impaired." [53]

In the one factual situation which the European Court of Justice has not yet considered Article 5(3) in - a case in which there was more than one place where the place of the event giving rise to the damage could have taken place - an English court has adopted a different approach to that proffered in *Bier*. In *Minster Investments Ltd v. Hyundai Precision & Industry Co. Ltd.* Steyn J. resorted to the English "where in substance the cause of action arises" test in a case in which there was more than one place where the place of the event giving rise to the damage could have taken place. [54] He stated that this approach was derived from the terms of Article 5(3), and that the decision in *Bier* was not to be treated as providing comprehensive guidance on that provision. In *Jakob Handte GmbH v. Traitements Mecano-chimiques des Surfaces* [55] Advocate General Jacobs stated that "It is clear that Article 5(3) is intended to refer to any event which could give rise to liability in delict." [56]

Accordingly, in any case in which the owner of an IP right wishes to commence infringement proceedings and rely on Article 5(3) to establish the court's jurisdiction, it must carefully consider whether Article 5(3) is in fact appropriate in light of these decisions.

In so far as the tort of passing off is concerned, the damage is to the plaintiff's goodwill - the effect on its reputation. [57] Accordingly, the direct harmful effects are located wherever the plaintiff's goodwill is located and a plaintiff in a passing-off case has the option to commence his proceedings in that jurisdiction.

Article 6 of the Conventions provides that a person, who is one of a number of defendants, may be sued in the courts for the place where any one of them is domiciled. Article 6 is applied in the same circumstances as O.11 r.1(1)(c) - a party may be sued in England under this Article only if he could have been properly joined in the original action had he been within the jurisdiction. [58] In contrast to Article 5(3) it is improper to rely on Article 6 to sue a party in England merely to obtain discovery of documents in that party's possession. [59]

Article 24 of the Conventions allows for a plaintiff to obtain interlocutory injunctions against infringements in the place(s) of infringement whether or not that country has jurisdiction under Articles 2, 5 or 6. This provision will prove most valuable in passing off cases where the concurrence of personal and subject matter jurisdiction can be obtained in respect of more than one jurisdiction.

### **3. Different Defendants domiciled both in and outside a Brussels/Lugano Convention country**

There appears to be no reason why a plaintiff cannot use the Conventions' jurisdictional rules within the EEA against, for example, an EEA domiciled importer, in conjunction with utilisation of the traditional rules (O.11) against a non-EEA domiciled manufacturer: an American or Japanese domiciled manufacturer can therefore be joined in the same action as an English or German domiciled importer.

## **C. Proceedings regarding the "infringement" abroad of an English IP right**

### **1. Pre-Private International Law (Miscellaneous Provisions) Act 1995**

As discussed above, English statutory IP rights are strictly territorial in their operation. English IP legislation will apply to infringements in England of IP rights conferred by English legislation and will not apply to acts of infringement outside England. However, these territorial limitations are subject to the scope of the common law tort of passing off and the practical effect of the common design principle (where an extraterritorial defendant has a common design with a party within the jurisdiction to infringe an English statutory IP right within England). The common design principle will facilitate an action being brought against the foreigner in the English courts. Exceptionally, a contributory act towards the eventual infringement of an English IP right may take place outside England. [60] This is a question of interpretation of the territorial application of the statute and is not a matter giving rise to any questions of conflicts of law.

The common law tort of passing off is not subject to the same strict territorial limits as the statutory IP rights. Its territorial scope is determined by application of the choice of law rule in tort. The English law of passing off will be applicable to conduct in a foreign country which would have been actionable as passing off if it had occurred in England; and which is actionable in the country where committed. [61] However, before a court will grant an injunction to restrain a passing off that occurs in a foreign country, the plaintiff must provide the court with evidence of actionability under the foreign law. [62]

## **2. Post-Private International Law (Miscellaneous Provisions) Act 1995**

The Act (herein "the Act" or "PIL Act") abolishes the former choice of law rule in tort and provides as a general rule that the applicable law is the law of the country in which the events constituting the tort or delict in question occur. [63] Where elements of those events occur in different countries the applicable law under the general rule is the law of the country in which the most significant element or elements of those events occurred. [64] The Act also provides for an exception to these rules where it is substantially more appropriate for the applicable law to be the law of another country.

Sections 10, 14(2) and 14(4) of the Act provide

10. The rules of the common law, in so far as they:-

(a) require actionability under both the law of the forum and the law of another country for the purpose of determining whether a tort or delict is actionable; or

(b) allow (as an exception from the rules falling within paragraph (a) above) for the law of a single country to be applied for the purpose of determining the issues, or any of the issues, arising in the case in question.

are hereby abolished so far as they apply to any claim in tort or delict [which is not a defamation-type claim].

11. (1) The general rule is that the applicable law is the law of the country in which the events constituting the tort or delict in question occur.

11. (2)(c) Where elements of whose events occur in different countries, the applicable law under the general rule is to be taken as being the law of the country in which the most significant element or elements of those events occurred.

14. (2) Nothing in this Part affects any rules of law (including rules of private international law except those abolished by section 10 above.

14. (4) This Part has effect without prejudice to the operation of any rule of law which either has effect notwithstanding the rules of private international law applicable in the particular circumstances or modifies the rules of private international law that would otherwise be so applicable.

The result of the application of sections 10, 14(2) and 14(4) on the pre-PIL Act position is that the law dealing with the infringement of English statutory IP rights overseas remains unchanged. Section 14(4) will preserve the position that English IP legislation will be territorially limited in its operation. The English law of passing-off or a similar foreign law will now be applied in accordance with the choice of law rule provided for in s.11 of the Act. [66]

## **D. Proceedings in England regarding the "infringement" of foreign IP right**

### **1. Pre-Private International Law (Miscellaneous Provisions) Act 1995**

Until recently actions for the infringement of foreign IP rights were non-justiciable before English courts [67] for these reasons:

1. An action for the infringement of a foreign IP right is a local (as distinct from a transitory) action. Accordingly, the questions of the validity, title to and infringement of an IP right fall exclusively within the jurisdiction of the courts of the country by the laws of which the IP right was created. [68]
2. An action for the infringement of a foreign IP right falls foul of the first limb of the choice of law rule in tort - it is not actionable in England. [69]

However, courts in other EEA countries are becoming more willing to assume jurisdiction in actions for infringement of foreign IP rights; [70] and Cornish has suggested that English courts should entertain actions for the infringement of a foreign IP right where the other country is a member of the EEA, because this is consonant with the principles embodied in the Brussels and Lugano Conventions.

Cornish's hopes were fulfilled by the recent decision in *Pearce v. Ove Arup Partnership Limited*. [71] In that case Lloyd J. decided that the rule in *Tyburn* has been abrogated insofar as it precludes a court from hearing an action which, in accordance with the Brussels Convention, may or must be brought in an English Court. This creates an exception to the general rule that both personal and subject matter jurisdiction must be present in any case. He decided that an English Court can hear an action for infringement of a Dutch copyright brought against a defendant domiciled in the UK. His reasoning appears to extend beyond cases in which the IP law that was infringed is the law of a Convention country. However, he does not expressly decide this point. Whilst the case was only at the interlocutory stage and Lloyd J. was not required to apply any Dutch law, he stated that in his opinion the Convention required an English Court to both accept jurisdiction and to hear the action for breach of the Dutch copyright on its merits. In his reasons Lloyd J. referred, in support of his own conclusion, to the fact that Dutch and German courts have been granting relief in respect of the infringement of foreign IP rights. The Dutch courts have been exercising this jurisdiction in respect of both EEA and non-EEA countries (e.g. US, Canadian and Australian IP rights). [72] Accordingly, there is some ground for thinking that Lloyd J.'s decision applies equally to non-Brussels Convention country's IP laws. The Court of Appeal has recently approved Lloyd J.'s decision in so far as it relates to courts seized of jurisdiction pursuant to Article 2 or 5(3) of the Brussels Convention. [73]

Accordingly, an English court can hear and determine an action in which the court is seized of jurisdiction under the Conventions' rules and the relevant IP law is that of a Convention, or possibly non-Convention, country.

However in these cases complicating factors exist. Article 16(4) of the Conventions provides that in cases of proceedings concerned with the registration or validity of IP rights that are required to be registered (e.g. patents and trademarks) only the courts of the Contracting State in which the registration has been applied for or taken place can exercise jurisdiction. Article 19 provides that where a court is seised of a claim which is principally concerned with a matter over which the courts of another Contracting State have exclusive jurisdiction by virtue of Article 16, it shall declare of its own motion that it has no jurisdiction. Accordingly, if, in infringement proceedings, an attack is made on the validity of a registrable IP right (i.e. all bar copyright), the court must hand the validity proceedings over to the court with exclusive jurisdiction over that issue. The English courts have decided that because the issues of validity and infringement are so closely connected, the whole proceedings must be handed over to that court. [74] However, the Dutch courts dispute this and the question of which interpretation is correct is presently before the ECJ. Laddie J has stated that if a plaintiff's IP rights are being infringed both in England and in other Convention countries and the parties infringing the plaintiff's foreign IP rights in those countries are not the same entity as the one infringing the English IP right, it would be possible to bring proceedings for infringement of the foreign IP rights against them in England pursuant to Article 6(1) if the English and foreign IP rights are identical. [75]

In cases of patents registered through the provisions of the European Patent Convention ("EPC") in more than one EEA country this criteria may prove easy to satisfy. However, where the IP rights in different countries are materially different Article 6(1) will not be able to be utilised. [76] This may occur where the IP rights are different because they were applied for separately through national offices or, in the case of patents, because they began life as an EPC application but have been subject to different amendments in different countries after registration. The Dutch courts support Laddie J's interpretation of Article 6(1). However, the Court of Appeal has recently disapproved of this aspect of Laddie J's decision and the correct interpretation of Article 6(1) is currently in issue before the ECJ. [77]

Accordingly, recent High Court decisions have unearthed an English court's ability to accept jurisdiction and determine infringement actions in cases in which foreign IP laws must be applied. The result is that the potential may exist to consolidate in one action in an English court in which jurisdiction has been obtained over at least one defendant pursuant to the Conventions, infringement actions brought under English and/or foreign IP laws against different defendants infringing different countries' IP laws. For example, an action can be imagined where a plaintiff sues in an English court an English domiciled defendant for infringement of its English IP rights, an EEA domiciled defendant for breach of its English and/or foreign IP rights, and a non-EEA domiciled defendant for breach of its English IP rights. However, this potential to consolidate cross-border infringement claims is limited by the effect of Articles 16(4) and 19 as explained in *Coin Controls Ltd*, possibly the requirements in Article 6(1) and O.11 r.1(1)(c) that the English and foreign IP rights in the infringement actions in which the court is seized pursuant to those provisions be virtually identical (again as explained in *Coin Controls Ltd*), and, at least in cases in which the alternative forum is a non-Convention

State, [78] the application of the doctrine of forum non conveniens.

The result of the limitations imposed by Articles 16(4) and 19 is that registered and unregistered IP rights may be subject to different regimes and this may result in a proliferation of proceedings; for example an action for passing off in England and an action for infringement of trade mark in the country in which the mark is registered, and a plaintiff suing for infringement of an EPC patent throughout Europe may be required to commence suits in all EPC countries.

Some English judges have in terms expressed a willingness, if they thought that they had jurisdiction, to readily invoke the doctrine of forum non conveniens in cases in which the plaintiff is claiming for infringement of a foreign IP right. [79] Under this doctrine an English court will have to weigh on the one hand the desirability of having all related infringement claims determined in one court against, on the other, any unease that it has about applying a foreign country's IP law and any evidence that a foreign country is the forum conveniens for all (or some only) of the infringement actions. An action for infringement of a foreign IP right may well be ripe for the application of the forum non conveniens principle, particularly in cases in which the action for infringement of a foreign IP right is not joined with an action for infringement of an English IP right in England.

The result of these recent decisions is that a defendant can, in cases in which jurisdiction was obtained pursuant to the Conventions and the IP right was registered, within the limits of the place where the suit was commenced and the place where the IP right is registered, forum shop by deciding whether to attack the validity of the IP right in its defence. Correspondingly, in cases in which jurisdiction can be obtained pursuant to the Conventions, a plaintiff can forum shop: he has the potential to commence proceedings in every jurisdiction in which his IP right was infringed.

A practice that has been employed in defamation cases to great effect but has been stifled in cases in which an injunction has been sought to restrain passing off outside the jurisdiction, is to plead actionability under the foreign law and then rely on the English law presumption that an unproved foreign law is identical to English law. In these cases the plaintiff has contended that if the defendant wishes to disprove its liability then it must go to the considerable, and many times prohibitive, expense of proving each of the foreign defamation laws which the plaintiff relies upon.

The prospect of this potentially very expensive exercise is used as a tactic to force defendants to settle the action early. If the courts do not prevent a plaintiff employing this technique in an internet IP infringement case then one can foresee cases in which a defendant is required to positively prove manifold foreign laws (the reach of the internet being global) and prove that it is not liable under each those laws if it is to avoid liability. The expense involved in such an exercise may be enough to force many defendants to settle a case which they have otherwise have been able to successfully defend.

## **2. Post-Private International Law (Miscellaneous Provisions) Act 1995**

Lloyd J's decision in *Pearce v. Ove Arup* applies equally in both pre-and post-Act cases. Accordingly, the conclusions reached above regarding the pre-Act position apply equally here and what follows deal only with non-Convention cases (and possibly with Convention cases in which the relevant IP law comes from a non-Convention country).

The second reason that the courts have proffered for foreign IP rights not being the subject of actions in English courts - limb 1 of the rule in *Phillips v Eyre* - has been extinguished. Section 11 of the Act allows for an English court to apply the law of the country in which the events constituting the tort occur.

However, the first reason is left unscathed by the Act. Accordingly, actions dealing with foreign IP rights in which the court is not seized of jurisdiction pursuant to the Conventions remain non-justiciable before English courts. [80]

Another point that may prove significant is the law dealing with forum non conveniens as discussed above.

Accordingly, applying the law (as the Court of Appeal in *In re European Patent (UK) No 189958* in the name of *Akzo Nobel NV*, *In re a Petition by Fort Dodge Animal Health Ltd and Others* [81] has stated it), in cases in which it is alleged that an IP right has been infringed, the effect of the Conventions in IP infringement cases is as follows. If a plaintiff chooses to sue the alleged infringer in the court's of the defendant's domicile (Article

2), he can commence an action there with respect to each and every infringement of its IP rights (whether domestic or foreign) by that defendant. [82] He cannot use Article 6(1) to join actions against any other party domiciled within the Convention states with respect to claims for infringement of virtually identical rights such as patents granted under the EPC. [83] If the plaintiff chooses to sue the infringer in the place where the infringement occurred (Article 5(3)), then Article 6(1) cannot be utilized. Only actions in which the plaintiff can secure Article 5(3) jurisdiction can be joined in a state that is not the domicile of one of the defendants.

Registrable IP rights remain territorial in nature such that a registrable UK IP right can only be infringed by acts that take place within the UK and a, for example, Dutch registrable IP right can only be infringed by acts that take place within the Netherlands. [84] An action commenced in Ruritania using Article 5(3) cannot extend to the patent laws of countries other than Ruritania. [85] Accordingly, a plaintiff's claim will be limited to actions with respect to the Article 5(3) state's own registrable IP laws. [86] Where, in a passing-off case, the misrepresentation and damage to the plaintiff's goodwill occur in a number of jurisdictions, the plaintiff may be able to employ Article 5(3) to consolidate all of its claims against defendants domiciled within the EEA in the one jurisdiction. However, the better view is that in such a case the court should apply the rationale in *Shevill v. Presse Alliance S.A* [87] and the proceedings in an Article 5(3) jurisdiction will be limited to the local misrepresentation and damage to goodwill. [88] If the IP right is registrable then and its validity is challenged, Articles 16(4) and 19 will operate to restrict proceedings to the place where the right was registered. [89] Article 24 is subject to Articles 16(4) and 19. Accordingly, provisional relief in aid of any infringement proceedings can only be obtained in the courts of the state that granted the registrable IP right if the validity of the IP right is in issue. [90] Actions commenced against parties not domiciled within a Convention state will be limited to actions for infringement of a UK IP right and the ability to commence these proceedings will be governed by RSC O.11 as detailed above.

#### **IV Foreign Infringers Beyond the reach of the Law**

If a person with no presence in the UK uses the internet to infringe English IP rights what remedies can the injured party seek?

##### **A. Remedies in English law**

As has been discussed, English statutory IP laws are territorial in their application with the result that an infringer resident in a jurisdiction whose IP laws or the nature of its court system or its parochial judiciary offer no or limited protection to the foreign owner of an IP right (for example, China), can infringe English IP rights and disseminate information on the internet with impunity. An injured party's only recourse against the infringer in English law will be in an action in passing-off and an investigation of whether International IP conventions and treaties may be relevant. In these cases an English IP owner will be limited, subject to the availability of a passing-off action, to pursuing any persons who secondarily infringe his IP rights within the jurisdiction.

##### **1. Person requesting/ordering information from the internet**

The CPD Act 1988 defines the infringing act of "copying" to include the making of copies that are transient or are incidental to some other use of the work. [91] Because a receiving computer momentarily records the signals which it receives in order to display their content, it appears that the act of transmission is an act of copying. This act of copying is committed both the person ordering the transmission [92] and the person who supplies it from a data server if the act takes place in England. [93] Of course, if the person receiving the infringing material on his CDU then deals with that material, he will be liable for further acts of infringement of the English copyright such as copying (e.g. making a hard copy of an on screen image or downloading it to a computer disk), issuing copies to the public, performance or showing of the work in public, or broadcasting or inclusion in a cable programme.

##### **B. Remedies in foreign law**

The injured party should consider whether they have any causes of action under the infringer's country's laws.

##### **C. Remedies in US law**

The nature of the internet is such that any acts that take place in one country are likely to have some impact

in the USA. The rules dealing with when a US court will assume personal jurisdiction are more liberal than those pertaining in England. Applying their long-arm statutes US courts have assumed jurisdiction in cases in which a defendant's only contact with a State is over the internet, for example creating a web site that can be accessed in a US State. [94] If the plaintiff is able to extend US IP laws in their operation to non-resident defendants and infringing acts outside the jurisdiction and overcome any forum non conveniens argument, then the US courts could be a means whereby a plaintiff can pursue the foreign infringer.

#### **D. Enforcement**

However, the above discussion of the possible means of pursuing the foreign infringer presupposes that any judgment can be enforced. In these cases the utility of being able to assume jurisdiction and obtain an award of damages or an injunction against future infringements must be considered. Whilst a foreign infringer may have assets within the EEA, the only cause of action available against him may be in passing-off and this may not be appropriate in the circumstances of a particular cause. Accordingly, there may be many cases in which an aggrieved IP owner will be powerless and frustrated under English law.

### **V The liability we expose ourselves to in putting material on the Internet**

#### **A. Possible Exposure**

In putting material on to the internet we do not know who will access it, where they might be, or what laws may apply in that jurisdiction. A person may place material onto the internet via a web site in England that does not infringe an English IP right or constitute the tort of defamation etc. and yet find himself liable for just that in a foreign jurisdiction or perhaps before English Courts if they will apply foreign IP laws.

The nature of the internet is such that material placed onto the net in England can be transmitted and accessed throughout the world. Each of these jurisdictions will have their own IP and civil wrongs laws, and laws dealing with jurisdiction and choice of law. Accordingly, a web site provider in England should be aware that the potential exists that a foreign court will consider that it has jurisdiction over the English web site provider where his site is accessed in that country. If the material on the site infringes that country's laws, either IP or more general laws dealing with civil wrongs, then he may be held liable in that foreign jurisdiction.

As discussed above, it appears that in some cases an action for infringement of a foreign IP right cannot be brought in an English court. Therefore, in these circumstances the English web site provider may not be in danger of having infringement proceedings commenced against him in England. However, the potential does exist for a foreign plaintiff to commence an action in the English courts for infringement of the foreign IP law or any other relevant foreign tort alleging liability under the foreign law (being the law that the English choice of law rule would designate as the applicable law). Foreign laws (apart from IP laws) that could be relevant would be laws dealing with negligent or fraudulent misrepresentation in which the liability criteria or the class of persons able to claim are more widely drawn than in English law, defamation laws that do not have the defences that are available in English law (note s.13 PIL Act and Dicey and Morris Rule 203(2)), or causes of action that have no counterpart in English law (e.g. intentional interference with business relations in New York law).

#### **B. Limiting access to a web site**

One possible means of limiting or removing exposure to a particular jurisdiction would be to prevent persons in that jurisdiction gaining access to your web-site. It does not appear to be possible at present to limit access to web sites or to fence-off particular jurisdictions to prevent users in those jurisdictions from having access to your web-site. The use of domain names such as ".com" removes any trace of nationality, and information can be routed through a non excluded jurisdiction. In the absence of an effective limit or a fencing-off mechanism, the web-site owner may seek to limit its exposure to tort claims by the use of disclaimers.

### **VI Conclusion**

While the Internet is a medium that allows for communication on a previously undreamed of scale, the conflict of laws treats it as it does any other modern method of communication. Accordingly, international disputes in

which the Internet has a part to play are dealt with utilising the usual conflict of laws principles.

English statutory IP rights are strictly territorial in their nature such that an action for infringement only lies for infringing acts that occur within England. However, if the common design principle can be utilised or an overseas act is merely preparatory to infringing acts that take place in England, then an action for infringement may be able to be brought for what might prima facie appear to be a foreign infringement. The passage of the PIL Act does not alter the strictly territorial nature of these laws, however the new choice of law rule in the Act will apply to the common law tort of passing off.

Personal jurisdiction must be addressed in terms of Convention and non-Convention countries. In a non-Convention case O.11 r.1(1)(b), (c) and (f) may be relevant. In a Convention case Articles 2, 5(3), 6 and 24 may be relevant. The Convention and non-Convention rules may be utilised concurrently in the one case against different defendants.

Recent English decisions have paved the way for English courts to apply foreign IP laws to the infringement of foreign IP rights in cases in which the court is seized of jurisdiction pursuant to the Conventions. In these cases if one defendant can be sued pursuant to the Conventions' rules then the potential exists to consolidate in one English action claims against different defendants for the infringement of different IP rights. This ability to consolidate infringement actions is subject to Article 16(4), the requirements of Article 6(1) and O.11 r.1(1) (c), and the doctrine of forum non conveniens. However, in cases in which the court is seized of jurisdiction pursuant to the non-Convention rules, English courts will not be entitled to apply foreign IP laws.

In cases in which a foreign infringer is resident in a jurisdiction with lax IP laws, the injured party may be limited to pursuing those who secondarily infringe his IP rights within the jurisdiction.

A web-site provider must be aware that despite the fact that his web-site does not infringe English IP laws, it may infringe the IP or other laws of a foreign country in whose jurisdiction the web site can be accessed.

- [Return to index](#) 

---

## Notes

(1). LLB (Hons), B. Bus (QUT); PhD (Cantab.). Solicitor (England and Wales, and Queensland, Australia), Schmitthoff Lecturer in International Commercial Law, Centre for Commercial Law Studies, Queen Mary and Westfield College, University of London.

(2). Harbottle & Lewis (1995) 33 In House Lawyer at 52.

(3). Cf. *Shetland Times Limited v. Wills* (The Times, 21.1.97).

(4). See *MacKinnon v Donaldson, Lufkin and Jenrette Securities Corp.* [1988] Ch. 482, 493; *Flaherty v Girgis* (1987) 162 CLR 574 per Mason A.C.J., Wilson and Dawson J.J. at 598; *Mercedes-Benz AG v Leiduck* [1996] 1 AC 284 (PC) per Lord Nicholls of Birkenhead at 305 (dissenting but not on this point);

(5). Ibid.

(6). Ibid.

(7). See n. 4 above.

(8). Cf. Peter Nygh "Choice of Law Rules and Forum Shopping in Australia" (1995) 6 Public Law Review 237, 241.

(9). Dutson, Stuart "The Conflict of Laws and Statutes" (1997) 60 MLR 668.

(10). *Holmes v Bangladesh Biman Corporation* [1989] 1 AC 1112 per Lord Bridge of Harwich (Lords Griffiths, Ackner and Lowry agreeing) at 1135, *semble David Syme & Co. Ltd v Grey* (1992) 115 ALR 247 per Gummow J. at 257-260, and *cf. Theophile v Solicitor General* [1950] AC 186 per Lord Porter at 195.

(11). *Arab Monetary Fund v. Hashim* (No. 9) (unreported, High Court of Justice Chancery Division, Chadwick J., 29.7.94, digested at *The Times* 11 October 1994 at 503) at 11-14; *Molnlycke AB v. Procter & Gamble Ltd.* [1992] RPC 21 at 28; *Def Lepp Music v. Stuart-Brown* [1986] RPC 274. This will continue to be the law under the Private International Law (Miscellaneous Provisions) Act 1995 (UK).

(12). See *Def Lepp Music v. Stuart-Brown* [1986] RPC 274.

(13). Herein "CDP".

(14). See further *Def Lepp Music & Ors v. Stuart Brown & Ors* [1986] RPC 273, *Molnlycke AB v. Procter & Gamble Ltd (No. 4)* [1992] RPC 21, and *Waterford Wedgwood Plc v. David Nagili Ltd.* [1998] FSR 92 at 102.

(15). The statutory IP law applies throughout the UK. However, this article is solely concerned with actions commenced in English courts. Accordingly, only English courts and English IP rights are considered.

(16). Herein referred to collectively as "the Conventions". The provisions of the Conventions that are relevant to this article are identical.

(17). See Article 17 of the Brussels and Lugano Conventions.

(18). i.e. RSC (England) O.11. See Article 4 of the Brussels and Lugano Conventions. Note however that if an action has been commenced in one contracting State a court in another contracting State cannot duplicate those proceedings albeit that the proceedings in both, or one only, of the States were commenced by the court(s) assuming jurisdiction pursuant to their own traditional jurisdictional rules rather than under the Conventions: see Article 21 of the Conventions and *Overseas Union Insurance v. New Hampshire Insurance* (Case C-351/89) [1991 - I] ECR 3317 (ECJ).

(19). *Metall und Rohstoff A.G. v. Donaldson Lufkin & Jenrette Inc.* [1990] 1 QB 391 at 443 (CA), overruled in *Lonrho Plc. v. Fayed* [1992] 1 AC 448 but not on this point.

(20). [1987] RPC 23 (CA) at 30-31 and *semble Unilever plc v Gillett* (UK) Ltd [1989] RPC 583 (CA).

(21). *Spotless Group v Proplast* [1987] 10 IPR 668 at 670 and *Best Australia v Aquagas Marketing* [1988] 83 ALR 217 at 220.

(22). (Case 21/76) [1976] ECR 1735. See *Metall und Rohstoff A.G. v. Donaldson Lufkin & Jenrette Inc.* [1990] 1 QB 391 at 437, *Societe Commerciale de Reassurance v. Eras International Ltd.* [1992] 1 LI LR 570 (CA) at 589.

(23). [1990] 1 QB 391 (CA).

(24). *Metall und Rohstoff A.G. v. Donaldson Lufkin & Jenrette Inc.* [1990] 1 QB 391 at 437 (CA).

(25). This much is obvious on the wording of O.11 r.1(1)(f), however, the court did then proceed to verbalise a test of sorts for when this portion of the rule is satisfied.

(26). *Ibid.* at 437 (CA).

(27). *Cf. Mecklermedia Corporation v. DC Congress GmbH* [1998] Ch 40.

(28). (1889) 41 Ch D 542. where the plaintiff obtained an injunction against a Scottish defendant in respect of infringements of its trademark in England.

- (29). *Societe Commerciale de Reassurance v. Eras International Ltd* [1992] 1 L1LR. 570 (CA) at 592. Cf. *Jan Poulsen & Co v. Seaboard Shipping Co. Ltd.* [1995] ILPr 698 at 704 (S.Ct.B.C).
- (30). (1889) 6 RPC 398.
- (31). *Coppin v. Tobler Brothers Canberra Marine Centre Pty Ltd.* [1980] 1 NSWLR 183, *Rosler v. Hilbery* [1925] Ch 250, and *Multinational Gas Co. v. Multinational Gas Services Ltd.* [1983] Ch 258 (CA). The position is the same in Canada: *Jan Poulsen & Co. v. Seaboard Shipping Co. Ltd.* [1995] ILPr 698 at 702 (S.Ct. B.C.). However, the editors of Dicey and Morris favour the less stringent view of the minority in *Multinational Gas Co. v. Multinational Gas Services Ltd.*: Collins (ed.) *Dicey and Morris on the Conflict of Laws* (1993) at 325.
- (32). Cf. *Multinational Gas Co. v. Multinational Gas Services Ltd.* [1983] Ch 258 at 284-285 (CA).
- (33). RSC O.11 r.4(1).
- (34). *Unilever plc v. Gillett (UK) Ltd* [1989] RPC 583 at 608 and *Unilever Plc v. Chefaro Proprietaries Ltd.* [1994] FSR 135.
- (35). *Ibid.*
- (36). Article 2. Note that Article 16(4) of the Conventions does not apply to infringement actions: *Duijnstee v Goderbauer* (Case 288/92) [1983] ECR 3663.
- (37). Discussed in detail below
- (38). *Coin Controls Ltd v. Suzo International and others* [1997] 3 All ER 45, and *Pearce v. Ove Arup Partnership Ltd & Ors* [1997] Ch 293 at 4.
- (39). *Molnycke AB & anor v. Procter & Gamble Ltd & ors* (No 4) [1992] RPC 21 (CA).
- (40). Cf. *Shevill v. Presse Alliance S.A.* (Case C-68/93) [1995] 2 AC 18 (ECJ) per A.G. Darmon at 34.
- (41). i.e. *Bier v. Mines de Potasse d'Alsace SA* (Case 21/76) [1976] ECR 1735.
- (42). i.e. *Dumez France and Tracoba SA v. Hessiche Landesbank* (Case C-220/88) [1990] I ECR. 49.
- (43). i.e. *Shevill v. Presse Alliance S.A.* (Case C-68/93) [1995] 2 AC 18 (ECJ).
- (44). (Case 21/76) [1976] ECR 1735.
- (45). It is this interpretation of Article 5(3) which O.11 r.1(1)(f) patently attempts to, and does, replicate.
- (46). (Case C-220/88) [1990] I ECR 49.
- (47). Cf. *Shevill v. Presse Alliance S.A.* (Case C-68/93) [1995] 2 AC 18 (ECJ) per A.G. Darmon at 34.
- (48). Cf. *Shevill v. Presse Alliance S.A.* (Case C-68/93) [1995] 2 AC 18 (ECJ) per A.G. Darmon at 36.
- (49). (Case C-364/93) [1996] QB 217 (ECJ).
- (50). *Ibid.* at paragraph [14].
- (51). *Ibid.* at paragraphs [15] and [21]. Cf. *Kitechnology BV v. Unicor GmbH Plastmaschien* [1994] IL Pr 568 (English CA).

(52). (Case C-68/93) [1995] 2 AC 18 (ECJ).

(53). At 63-64.

(54). [1988] 2 LILR 621.

(55). (Case C-26/91) [1993] IL Pr 5.

(56). At 17 n.24.

(57). *Mecklermedia Corporation v. DC Congress Gessellschaft* [1998] Ch 40.

(58). *Kalfelis v Schroder, Munchmeyer, Hengst & Co* (Case C-198/87) [1988] ECR 5565, and *Molnlycke AB & anor v. Procter & Gamble Ltd & ors* (No 4) [1992] RPC 21 (CA) at 27.

(59). *Molnlycke AB & anor v. Procter & Gamble Ltd & others* (No 4) [1992] RPC 21 (CA) at 27.

(60). For example infringing acts with respect to material to be imported into the UK (s.27(3) (CDP Act), "authorising" a breach of an English copyright: CDP Act s. 16(2) and see *ABKCO v. Music Collection International* [1995] EMLR 449 (CA).

(61). *Dicey & Morris on the Conflict of Laws* (12th Ed) Rule 203, *Walker (John) & Sons Ltd v. Henry Ost & Co Ltd* [1970] 1 WLR 917, and *Alfred Dunhill Ltd v. Sunoptic SA* [1979] FSR 337 (CA).

(62). *Alfred Dunhill Ltd v. Sunoptic SA* [1979] FSR 337 (CA) at 368 and 377, *Intercontex v. Schmidt* [1988] FSR 575 at 578, *Waterford Wedgwood Plc v. David Nagli Ltd.* [1998] FSR 92 at 107.

(63). s. 11(1).

(64). s. 11(2)(c).

(65). s. 12.

(66). *Waterford Wedgwood Plc v. David Nagli Ltd* [1998] FSR at 107.

(67). *Pearce v. Ove Arup Partnership Ltd & Ors* [1997] Ch 293.

(68). *Tyburn Productions v. Conan Doyle* [1991] Ch 75, *Plastus Kreativ v. Minnesota Mining* [1995] RPC 438 at 446-7, *LA Gear v. Gerald Whelan & Sons* [1991] FSR 670 at 674 and 676 and compare *James Burrough Distillers plc v. Speymalt Whisky Distributors Ltd* [1989] SLT 561. This ground for the decision in *Tyburn* has been criticised in: North and Fawcett *Cheshire and North's Private International Law* 12th Ed, 1992 at 263; and Carter (1990) 61 BYIL 400.

(69). *James Burrough Distillers plc v. Speymalt Whisky Distributors Ltd* [1989] SLT 561 and compare *Def Lepp Music & Ors v. Stuart Brown & Ors* [1986] RPC 273.

(70). See Brinkhof "The Infringement of Foreign Patents" [1994] 8 EIPR 360.

(71). [1997] Ch 293. See also *Coin Controls Ltd v. Suzo International and others* [1997] 3 All ER 45.

(72). See Brinkhof "The Infringement of Foreign Patents" [1994] 8 EIPR 360.

(73). *In re European Patent (UK) No 189958 in the name of Akzo Nobel NV, In re a Petition by Fort Dodge Animal Health Ltd and Others* (unreported, Court of Appeal, 27 October 1997).

(74). *Coin Controls Ltd v. Suzo International and others* [1997] 3 All ER 45.

(75). *Coin Controls Ltd v. Suzo International and others* [1997] 3 All ER 45.

(76). *Coin Controls Ltd v. Suzo International and others* [1997] 3 All ER 45.

(77). *In re European Patent (UK) No 189958 in the name of Akzo Nobel NV, In re a Petition by Fort Dodge Animal Health Ltd and Others* (unreported 27 October 1997, Court of Appeal).

(78). Cf. *In re Harrods (Buenos Aires) Ltd.* [1992] Ch 72 (CA).

(79). See, for example, *Plastus Kreativ AB v Minnesota Mining and Manufacturing Co.* [1995] RPC 438 at 447.

(80). *Coin Controls Ltd v. Suzo International and others* [1997] 3 All ER 45 and *Pearce v. Ove Arup Partnership Ltd & Ors* [1997] 3 All ER 45. *LA Gear v. Gerald Whelan & Sons* [1991] FSR 670 at 674 and 676 and *Molnlycke AB v. Procter & Gamble Ltd* [1992] RPC 27 at 28.

(81). Unreported, 27 October 1997.

(82). With respect to non-registrable IP rights see *Mecklermedia Corp v. D.C. Congress GmbH* [1998] Ch 40 per Jacobs J at 52 and 55.

(83). The present author disputes the correctness of the Court of Appeal's decision on this point and favours the views of the Dutch courts. This will be covered in a forthcoming article.

(84). See Dutson "The internet, the conflict of laws, international litigation and intellectual property" [1997] JBL 495 at 495-497.

(85). Contrast the defamation action at issue in *Shevill v. Presse Alliance S.A.* (C-68/930) [1995] 2 AC 18 (ECJ) and the passing-off action in *Mecklermedia Corp v. D.C. Congress GmbH* [1998] Ch 40.

(86). Jacobs J in *Mecklermedia Corp v. D.C. Congress GmbH* [1998] Ch 40 at 52 and 55 appears to have failed to appreciate the importance of this distinction between registrable and non-registrable IP rights.

(87). (C-68/930) [1995] 2 AC 18 (ECJ).

(88). Cf. *Mecklermedia Corp v. D.C. Congress GmbH* [1998] Ch 40 per Jacobs J at 52 and 55

(89). The present author disputes the correctness of the Court of Appeal's decision on this point and favours the views of the Dutch courts. This will be covered in a forthcoming article.

(90). The present author disputes the correctness of the Court of Appeal's decision on this point and favours the views of the Dutch courts. This will be covered in a forthcoming article.

(91). s.17(6).

(92). Cf. *Bookmakers' Afternoon Greyhound Services Ltd v. Wilf Gilbert Ltd* [1994] FSR 723.

(93). Cornish *Intellectual Property* 3rd. ed., 1996 at paragraph 13 56.

(94). *Panavision Int'l L.P. v. Toepfen*, [1996] WL 534-83 (C.D. Cal, Sept. 19, 1996); *Inset Sys., Inc. v. Instruction Set, Inc.*, [1996] U.S. Dist. LEXIS 7160 (D. Conn. Apr. 17, 1996). Contrast *Bensusan Restaurant Corp. v. King*, [1996] U.S. Dist. LEXIS 13035 (S.D.N.Y. Sept 9, 1996).

- [Return to Index](#) 