I. Introduction – History and Present State of the CLIP Project

Whereas substantive intellectual property law is far advanced in terms of international harmonisation, issues of jurisdiction and applicable law for a long time remained untouched by comprehensive harmonisation measures. First steps in that direction were finally undertaken by the Hague Conference on Private International Law, which in 1999 launched its preliminary draft proposal for an international Convention on Jurisdiction and Enforcement in Civil and Commercial Matters (Draft Hague Jurisdiction Convention, DHJC).¹ The text proposed by the Hague Conference met with mixed reactions, and it was particularly contentious in the area of intellectual property.² When it became apparent that the 1999 DHJC was bound to fail, academic initiatives formed in the USA, Asia (Japan and Korea) as well as in Europe, with the aim to continue working on feasible ways of devising rules to be applied in cross-border conflicts involving intellectual property rights.

As the endeavours of the Hague Conference had been focused on jurisdiction only, it appeared natural for those initiatives to first concentrate on the rules determining the competence of courts. A primary example for that approach was provided by the draft Convention on Jurisdiction in Intellectual Property Matters by professors Rochelle Dreyfuss and Jane Ginsburg, which was presented at the WIPO Forum on Private International Law in 2001³. That initiative later-on developed into the American Law Institute’s project “Intellectual Property – Principles Governing Jurisdiction, Choice of Law, and Judgments in Transnational Disputes” (ALI Principles)⁴, which was successfully concluded in 2007.⁵

Parallel to the work commenced by professors Dreyfuss and Ginsburg, a working group was established within the Munich Max Planck Institute (MPI) for Intellectual Property and Competition Law, with the aim to promulgate a special provision on intellectual property litigation to be inserted into a Convention modelled on the 1999 DHJC.⁶ The proposal was presented at a workshop arranged by the MPI in 2003, and was subsequently published⁷. By the time when the workshop was arranged, it had become clear already that dealing with jurisdiction alone would not be able to address and solve the many issues of relevance in the field, but that the work must be extended to choice of law.⁸ It was therefore most wel-

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come that, after a conference arranged by the Hamburg Max-Planck Institute for Private Law on matters of intellectual property and applicable law, a joint project was started by the two Max-Planck-Institutes in Munich and in Hamburg, and was further-on conducted under the name of “European Max Planck Group on Conflicts of Law in Intellectual Property” (CLIP).

In addition to directors and members of the two institutes, the CLIP group consists of several high-profile European scholars in IP and private international law. The goal of the group is to draft a set of principles for conflict of laws in intellectual property and to provide independent advice to European and national law makers. For that purpose, regular meetings are held, and texts are prepared and discussed among the members. A first preliminary draft of the CLIP Principles was published in 2009, and was debated by a selected group of international experts during a 2-day workshop held at the MPI in Munich. Based upon those discussions, the draft was further amended, and was presented in its final form at an international conference in Berlin, November, 2011. Thereafter, the CLIP Principles will be published as a book, together with notes and comments on the individual provisions.

From the beginning, members of the CLIP group have entertained close contacts with other projects in the field, in particular with the ALI project and with the Japanese/Korean group of experts established in the framework of the Global COE project at Waseda University, led by professor Kidana. An opportunity to exchange views with Japanese experts in the field was also provided by a conference arranged in spring 2009 in the context of the Japanese Transparency project. It is a lucky coincidence that all those projects are now finalized or are close to finalization, thus allowing for a thorough comparison and discussion of the parallel features and remaining differences in the solutions endorsed.

II. The CLIP Principles – Overview on Contents (selected provisions)

1. General approach (Part 1 of the CLIP Principles)

a) Aims and policies

Although the CLIP Principles are aimed at the international level, they are basically rooted in European legal thinking. It appeared therefore natural for the group to base their proposals on the existing European legislation – the Brussels I Regulation on jurisdiction and enforcement, and the Rome I and Rome II Regulations regarding applicable law – and to promulgate different or additional provisions only where that was deemed appropriate for specific reasons. To mention just one example at this stage, the CLIP Principles propose to allow for consolidation of infringement claims involving foreign registered rights even when invalidity is claimed as a defence. It thereby aims to set aside the effects of the ECJ judgment GAT v. LuK, according to which the courts in the State where the right has been registered, or for which the registration has become effective, would have exclusive jurisdiction in such cases. In addition to such “corrections” of pertinent European law, the CLIP group has promulgated a number of provisions specifically addressing conflicts with potentially ubiquitous character, typically resulting from Internet communication. In that regard, it coincides with the other parallel projects, although the propos-
As a matter of principle, and in accordance with current European legislation, the proposed CLIP rules are committed to traditional concepts applying in the area of private international law and intellectual property, such as territoriality and *lex loci protectionis*. However, contrary to what is possible under current European law, the CLIP Principles allow for deference to party autonomy to the largest extent possible, i.e. where this does not clash with the very concept of intellectual property law. In addition, the CLIP Principles also allow to deviate from a strict application of the territoriality/*lex protectionis* rules in cases where a strict observation of those rules would lead to a serious obstruction of justice.²²

The aims and policies underlying the CLIP principles are addressed in the Preamble as follows:

**PREAMBLE**

Building on existing rules and initiatives regarding private international law and intellectual property, these Principles

*aim*

at reducing distortions and impediments to international trade involving intellectual property rights and facilitating the flow of information and cultural exchange across borders taking into account the development of digital communication technologies;

*aim*

at fostering judicial co-operation with regard to international disputes concerned with intellectual property rights, based on international comity and mutual trust;

*aim*

at improving the legal situation of plaintiffs and defendants to enforce, and to defend themselves against, claims concerned with intellectual property rights on an international scale;

*acknowledge*

that it is therefore necessary to provide legal certainty and predictability as to the jurisdiction of courts and the applicable law as well as to facilitate the recognition and enforcement of judgments concerned with intellectual property rights;

*recognize*

the need to consider and balance all interests involved, including the interests of owners of intellectual property rights, their contracting partners, and other users of intellectual property, and the broader public interest, in particular in access to, and use of, information as well as other public interests;

*recognize*

that intellectual property rights are limited in their exercise and enforcement to specific territories, and
that each sovereign State is free, subject to international obligations, to regulate whether and under which conditions intangible goods shall enjoy legal protection;

recognize

the freedom of private parties to choose the competent court and the applicable law to the largest extent possible.

b) Scope of application

The CLIP Principles are meant to apply primarily in civil matters involving “classical” intellectual property rights, i.e. patents, trademarks, copyright (including neighbouring rights) and industrial design. They also apply to “similar exclusive rights”, like, for instance, utility models or non-original databases, where such rights exist under national law. In addition, they apply mutatis mutandis to claims regarding undisclosed information or incorrect use of geographical indications, as well as, under certain circumstances’, claims based on unfair competition law (Article 1:101).

2. Part 2 of the CLIP principles: Jurisdiction

a) General and special jurisdiction

As was pointed out above, the CLIP Principles largely follow the scheme of European legislation, i.e. the Brussels I Regulation (2001/44/EC). The part on jurisdiction therefore relies on the distinction between general, special and exclusive jurisdiction which is reflected in the structure of the Brussels I Regulation (BR). Like in Article 2 BR, general jurisdiction is vested in the courts of the State where the defendant has his or her habitual residence (Article 2:101). In addition, several rules on special jurisdiction allow to instigate proceedings outside the defendant’s forum. Thus, in matters relating to a contract, a person may also be sued in the courts of the State where the obligation is to be performed (Article 2:201). If the contract has as its main object the transfer or license of an intellectual property right, the characteristic obligation is performed in the State for which the transfer or license is due (Article 2:101(2)).

Infringement claims can regularly be brought in the courts of the State where the infringement occurs or may occur, unless the activity cannot reasonably be seen as having been directed to that state, or the defendant has not taken substantial action there (Article 2:202). The provision ensures that a person is not amenable to proceedings in a State where the alleged infringement occurs by way of “overspill”, for instance if a trademark is displayed on the Internet and can thus be seen world-wide, without the message having been sent from, or being directed to, another State or States where the same or a similar mark exists. The rule is inspired by the WIPO Recommendation on the Protection of Trademarks, and Other Industrial Property Rights in Signs, on the Internet. Similar rules are also contained in the proposals made in the other projects.
As a matter of principle, the competence of courts which is (solely) based on infringement jurisdiction – i.e., other than the courts at the place of the defendant’s habitual residence – is restricted to the territory of that particular State (Article 2:203(1)). However, Article 2:203(2) provides for an important exception from that rule: in case of infringements carried out through ubiquitous media such as the Internet, courts may be competent to adjudicate upon foreign – and even global – infringements, if the acts causing the infringement do not have substantial effect in the defendant’s State (or States) of habitual residence, and if the defendant has either substantially acted in the forum state, or if the harm resulting from the infringement in that state is substantial in relation to the infringement in its entirety.  

Furthermore, a defendant may also be sued outside the State of habitual residence if he is one of a number of joint defendants, one of which is habitually resident in the forum state (Article 2:206). That rule follows the pattern of Article 6 (1) BR (multiple defendants). Proceedings can be consolidated if they involve essentially the same factual and legal situation. In defining those concepts, it is made clear that the legal situation can be essentially the same even if the intellectual property rights are formally separate, like European bundle patents deriving from one European patent granted by the EPO. The CLIP Principles thereby consciously opt for a different approach from that endorsed by the ECJ in its Roche v Primus and Goldenberg judgment.  

b) Prorogation  

In accordance with its policy to leave as much room for party autonomy as possible, it is clear that the CLIP Principles allow for choice of court agreements, and that appearance in court by the defendant is also a ground for assuming jurisdiction (Articles 2:301 and 2:302). Of course, this would not apply in case of another court having exclusive jurisdiction.  

c) Exclusive jurisdiction  

As in Article 22 (4) BR, the CLIP Principles confirm the principle that in disputes having as their object the validity and registration etc. of a registered intellectual property right, the courts in the State of registration have exclusive jurisdiction (Article 2:401). However, contrary to what the ECJ held in GAT v LuK, that rule does not apply if the issue arises other than by principal claim or counterclaim. The legal effect of decisions resulting from such disputes is confined to the parties of the proceedings, i.e. it does not affect the validity or registration of the right as against third parties.  

It is not ignored that the current developments in Europe and in the USA appear to go against such a rule. After GAT v LuK, a provision enshrining the principle that exclusive jurisdiction of the courts in the State of registration applies as soon as the defence of invalidity is raised was incorporated into Article 22 of the Lugano Convention. According to the Proposal submitted by the EU Commission for an amendment of the Brussels I Regulation, Article 22(4) BR shall be changed accordingly, thereby barring any possibility for a more flexible approach towards consolidation. Also in the USA, the Court of Appeals of the Federal Circuit (CAFC) has ruled that American courts are not competent to adjudicate upon law-
suits concerning infringement of foreign patents. Nevertheless, it is our conviction that to accept the possibility to bring cases concerning foreign infringements in the courts of defendant’s State of habitual residence, and thus to allow consolidation of multiple state infringement claims, is the only sensible way forward for the future. We feel confirmed by the fact that the ALI Principles and the Waseda Global COE project have adopted the same approach.

The general opinion on the issue might indeed change soon. The fact that the EU Commission in its proposals for amendment of the Brussels I Regulation remained reserved against any changes allowing for more consolidation is due to the expectation that the problems for patent litigation currently resulting from the fragmented state of jurisdiction would soon be overcome by the establishment of a common judiciary with competence for European (EPC) patents as well as for (the future) Community patents. However, in its legal opinion of 8 March 2011, the ECJ has declared that the establishment of such a judiciary would violate fundamental principles of EU law. The verdict also forecloses other, alternative solutions for adjudication of EPC patents which had been ventilated in the past under the title of “European Patent Litigation Agreement” (EPLA). As a result, the current, unsatisfactory situation with regard to patent litigation in Europe will persist. Before that backdrop, the CLIP group has considered to reiterate, in the framework of the pending reform of the Brussels I Regulation, its proposals to allow consolidation of multi-state patent litigation where that is sensible and feasible from a practical and legal point of view.

It is not completely unlikely that in view of the dramatic changes for the prospects to create a common European patent judiciary, the patent community and the political instances are more receptive to the proposal than they were a few years ago.

d) General provisions

The provisions on jurisdiction are complemented by a number of “general provisions”. Apart from defining the notion of habitual residence in a rather broad manner (Article 2:601), the section undertakes to clarify certain aspects which are rarely addressed explicitly in instruments dealing with jurisdiction, and which may therefore give rise to uncertainty. Most importantly, this concerns the following rules:

- actions for declaratory judgements may be brought on the same ground of jurisdiction as an action for substantive relief (Article 2:602);
- without prejudice for the court to apply one single law to cases of ubiquitous infringement, which is addressed in the part on applicable law, an injunction will only concern (future) activities affecting the State whose law has been applied by the court (Article 2:604).

e) Coordination of proceedings

If proceedings are pending before different courts between the same parties and concerning the same subject matter (“congruent proceedings”), other courts than the courts first seized must, as a matter of principle, stay their proceedings (Article 2:701). However, that rule does not apply if the court later seized has exclusive jurisdiction, or if it is manifest that the judgment from the court first seized will not be recognized under the Principles. The latter situation would arise in particular if the court first seized
manifestly lacks jurisdiction. Furthermore, the other courts may terminate the stay of proceedings if the proceedings before the court first seized do not proceed within reasonable time, or if the court first seized has decided not to hear the claim. Finally, it is clarified that claims for preliminary measures do not involve the same cause of action as main proceedings.

Those rules were inspired by the notorious “torpedo claims” which are a frequently lamented phenomenon in the context of Article 27 BR\textsuperscript{37}. Instead of choosing the radical remedy to grant claims for substantive relief precedence over claims for negative declaratory judgment, the CLIP proposals merely try to grant relief in cases of misuse, and allow the right holder to claim at least preliminary relief if the alleged infringer tries to block the main action.

If claims are not “congruent” in a strict sense, but only are related with each other, the CLIP Principles, in accordance with Article 28 BR, allow courts other than the court first seized to stay their proceedings, and they encourage them to cooperate with each other in every aspect which may be of relevance for the decisions (Article 2:702).

3. Part 3 of the CLIP Principles: Applicable law

a) General principles

As a general rule, it is set out in the Principles that the law applicable to the existence, validity, scope, and duration of an intellectual property right is the law of the state for which protection is sought (\textit{lex protectionis}; Article 3:102). In addition, the principle is confirmed that procedural matters are subject to the law of the forum (\textit{lex fori}; Article 3:101), and that, where that is possible, the parties may choose the law applicable to the dispute (Article 3:103).

b) Initial copyright ownership, transferability and co-ownership

Contrary to an opinion endorsed in many jurisdictions, in large parts of academia, and in the ALI Principles\textsuperscript{38}, the CLIP Principles have opted for application of \textit{lex protectionis} with regard to initial ownership, in particular regarding copyrighted works, instead of applying the law of the State of origin (Article 3:201). The main reason for this lies in the fact that by applying \textit{lex originis}, it would be possible for States to “export” their own approach towards the question of who may qualify as the author of a work – an issue forming not only a core element of copyright philosophy, but also potentially impacting the economic order a State strives to maintain on its own territory.\textsuperscript{39} In addition, whereas it can certainly be argued that efficiency aspects speak strongly in favour of \textit{lex originis}, the advantages of that approach are somewhat lessened by the fact that even if \textit{lex originis} is accepted in principle as determining ownership, a person figuring as the right owner will not be safe from others claiming personal rights in the work, to the extent those claims are found to be justified by \textit{ordre public}, or if they form part of internationally mandatory rules.\textsuperscript{40} Moreover, as \textit{lex protectionis} remains to be applicable regarding the existence and scope (and possibly also other aspects, like transferability) of the right, to espouse \textit{lex originis} with re-
gard to first ownership will necessarily lead to depeçage, which should preferably be avoided.

Nevertheless, the strength and validity of arguments militating in favour of lex originis shall not be doubted here. What appears more important anyhow than to become a faithful disciple of one or the other school is to spend thoughts on how the fault between them could best be bridged. For that purpose, the CLIP Principles have included the following clause:

If the situation has a close connection with another State that has a work made for hire doctrine or deems a transfer or exclusive license of all economic rights in the work to have taken place by virtue of the parties’ contractual relationship, effect may be given to such rules by constructing the parties’ relationship as involving a transfer or exclusive license of all economic rights in the work.

Less controversially than for initial ownership, lex protectionis is also applied with regard to transferability (Article 3:301). Regarding co-ownership, a differentiated approach was chosen: while initial ownership of each co-owner as well as transferability of shares are governed by lex protectionis, while in the framework of contracts, lex contractus applies to the right to claim a registered right (i.e., not to the registered right as such, where ownership is subject to the law applying in the State of registration; Article 3:401). In addition, the CLIP Principles stipulate that the relations between the co-owners are governed by a single law, which is either the law chosen by the parties, or, absent such a choice, the law with the closest connection (Article 3:402).

c) Contracts and related questions

It is self-evident that parties are free to choose the law applicable to a contract on license or transfer of an intellectual property right (Article 3:501). If no such choice has been made, default rules need to be provided for. The CLIP Principles refer in that context to the law of the State with which the contract is most closely connected, and provide a list of factors to be taken into account for the decision. If no clear decision can be made on the basis of those factors, it is stipulated that in case that the license or transfer concerns intellectual property rights for multiple states, it is presumed that the law most closely connected with the contract in its entirety is the state in which the transferor or licensor has his habitual residence (Article 3:502).

d) Infringement and remedies

As the law applicable on infringement in copyright cases will be the topic of another presentation in this volume, the remarks on this section can be rather brief. The most important features of the CLIP proposals can be summarized as follows:

De minimis rule: It is stipulated that courts shall only find for infringement under the lex protectionis if the defendant has substantially acted in, or if the actions specified in the claim are directed to, the State or the States for which protection is sought (Article 3:602). Quite deliberately, that clause was formulated as a substantive law rule, and not as a rule determining the
applicable law. We are aware that by inserting such a rule, the usual boundaries of Principles dealing with private international law have been substantially extended. Nevertheless, the group feels free to advance the view that ideally, the solution proposed for de minimis cases would be the most appropriate way to deal with the matter.\textsuperscript{44}

*Ubiquitous infringement*: In disputes concerned with infringement which is carried out through ubiquitous media such as the Internet and is arguably infringing wherever the signals can be received ("ubiquitous infringement") the CLIP Principles allow to apply a single law – the law of the State with the closest connection (Article 3:603). That law is determined on the basis of a set of factors. However, the defendant retains the possibility to adduce proof that the conduct is legal in another State where his actions are likewise effective; in that case, the court must apply both laws or, where that is not possible, the differences in the applicable laws must be taken into account for fashioning the remedy. Similar rules are also found in most other proposals. However, the proposals differ in a number of details, in particular concerning the notion of an infringement being "ubiquitous".\textsuperscript{45}

*Contributory infringement*: As far as can be seen, the CLIP Principles for the first time undertake to regulate the law applicable to contributory (or rather: secondary) infringement in a separate provision (Article 3:604), instead of treating it as an accessory to the main infringement which is governed by the same law. The group is of the opinion that although the traditional approach is suitable when the secondary infringer consciously made a contribution to an individual infringement, it fails to render appropriate results in cases when the secondary infringer only provides certain services, or provides technical facilities, which allow activities being carried out by a large number of persons, without having knowledge of the individual acts, as is typically the case with regard to Internet platforms.\textsuperscript{46} The proposal distinguishes between these two types of infringement: the first, "classical" type of contributory infringement is subject to the general rule that the law governing the contribution is the same as the law applying to the main infringement. For the second type, a new rule was developed which allows to apply a single law, namely the law of the State where the centre of gravity of the person offering the services is found. However, in order not to allow Internet platforms to easily avoid any liability for their activities, that rule is complemented by the following caveats:

- the single law will not be applied unless it conforms to certain minimum standards, namely that the person must react in cases of manifest infringement, and will not liable for active inducement of infringements
- the single law does not apply to claims relating to information on the identity and the activities of primary infringers.

*Choice of law regarding the remedies*: Finally, the CLIP Principles have opted for giving the parties of a conflict the possibility to choose a law applicable to the remedies to be applied. For that purpose, a distinction is made between the violation of an intellectual property right as such, which is necessarily subject to *lex protectionis*, and the obligations resulting from it, where par-
ties shall be free to make a (usually ex-post) choice of law. Although such cases are not likely to occur frequently in practice, making that distinction and allowing the choice were considered as a logical consequence of the approach adopted by the CLIP project, namely that room should be granted to party autonomy wherever that is feasible without interfering with core aspects of national sovereignty, which, in our opinion, would concern the infringement as such, but not the remedies. It is realised that although the CLIP Principles go beyond the current possibilities granted for choice of law under the Rome II Regulation\textsuperscript{47}, they are more conservative than the ALI Principles and the Waseda Global COE project, where parties may also choose the law applicable to the infringement as such\textsuperscript{48}.

e) Security rights

The law applicable on diverse aspects of intellectual property rights being given as security has been the object of much debate, not least in the context of UNCITRAL. Representatives of the CLIP group have participated in those discussions to some extent, but chose in the end to formulate a separate proposal (Article 3:801). The main features of the proposal are:

- the law applicable to the contractual obligation to create or transfer a security right in an intellectual property right is the law chosen by the parties, or, absent a choice, the law where the grantor has his habitual residence;
- the law applicable to security rights in intellectual property with regard to the security agreement creating or transferring the right, registration requirements in general security registers, the dependence on the secured obligation, the transferability of the security, and (with some reservations) the enforcement of the security right, are governed by the law of the grantor;
- issues concerning the intellectual property right as such, like the existence, validity and scope of the right, the ownership including issues such as \textit{bona fide} acquisition, registration requirements applying to intellectual property in the state where the right exists as well as priority and (other) third party effects are governed by \textit{lex protectionis}.

The aim of the provisions is to allow for a maximum of consolidation, thereby enhancing the efficiency of security takings, without disrupting the basic principles that intellectual property rights are and remain territorial in their nature.

f) Supplementary provisions

Similar to the structure of Part 2 (Jurisdiction), Part 3 of the CLIP principles ends with some supplementary provisions, concerning inter alia the circumstances under which effect may be given to mandatory provisions of other States (Article 3:901), or the application of a law identified by the principles may be refused for reasons of public policy of the forum state (Article 3:902), exclusion of \textit{renvoi} (Article 3:903) and a definition of habitual residence for the purpose of determining the applicable law, which is narrower than that to be used in the context of jurisdiction (Article 3:904).
4. Part 4 of the CLIP Principles: Recognition and enforcement

The last part of the CLIP Principles is dedicated to recognition and enforcement. As the principles do not purport to be, or to become, binding law, it is clear that there is no “automatic” enforcement of judgments handed down by a foreign court, even where the Principles have been observed. However, a link exists between the enforcement part and the part on jurisdiction in the sense that it is stipulated that a foreign judgment shall not be recognized and enforced if it was handed down without the deciding court having a ground for jurisdiction according to Principles (Article 4:201). Apart from that, the Principles stipulate that recognition and enforcement of foreign judgments should not be unduly encumbered, for instance by proceedings which are unnecessarily complicated or costly or entail unreasonable time-limits or unwarranted delays (Article 4:701). Furthermore, the principle is confirmed that the requested court shall not enter into substantive review (Article 4:601). However, this does not preclude the interpretation of an injunction in respect of its subjective, territorial and substantial scope (Article 4:103(3)). This is of relevance in particular in case that an injunction with potentially global reach has been issued, and the defendant subsequently limits her activities, or the impact of her activities, to a particular state or states whose law has not been applied by the rendering court.

Apart from lack of jurisdiction of the rendering court, recognition and enforcement of foreign can be denied for a number of reasons, among them

- manifest incompatibility with public policy in the state for which enforcement is requested;
- serious procedural deficiencies like violation of the right to be heard (the same principle is also endorsed with regard to ex-parte preliminary measures);
- irreconcilability with a previous judgment between the parties in the same state or in another state, if the latter judgement fulfils the requirements for recognition and enforcement in the requested state.

III. Concluding remarks

The CLIP project has finally has reached a state of maturity. After conclusion of the work and publication of the results, we are then looking forward to a period of comparison and debates with others engaged in similar projects. We hope that in the end it will be possible to identify the common denominators in all the different projects that have sprung up throughout the world, and to refine them so as to ultimately result in a “Meta-text” that leads to a better understanding, and a hopefully to a more uniform application, of private international law principles in intellectual property litigation worldwide.

Endnotes:

1 Preliminary draft Convention on jurisdiction and the effects of judgments in civil and commercial matters, 18.06.1999, with an explanatory report by Peter Nygh and Fausto Pocar, published as (HC) Prel. Doc. No. 11.


Jane Ginsburg and Rochelle Dreyfuss were joined in their function as ALI reporters by François Dessemontet (University of Lausanne).

The Principles were adopted by the American Law Institute on May 14, 2007 and were published in 2008 in the ALI's publication series.

The proposal was presented at a conference arranged by the MPI in 2003, and is published and commented in the annex to J. Drexel & A. Kur (supra fn 2), 309 – 334.


More information on the project is available at www.cl-ip.eu.

In alphabetical order, the members of the group are: Jürgen Basedow, Graeme Dinwoodie, Josef Drexel, Mireille van Eechout, Jean-Christophe Galloux, Christian Heinze, Annette Kur, Pedro de Miguel Asensio, Axel Metzger, Thomas Petz, Alexander Peukert, Heiki Pisuke and Paul Torremans.

Two members of the CLIP group, Graeme Dinwoodie and Annette Kur, also served as advisers in the ALI project.

Early versions of the CLIP project and the Japanese/Korean project were presented and discussed at an international workshop on intellectual property and private international law arranged at Waseda University, 27 November 2004.


Such a comparison is undertaken by project established under the aegis of the International Law Association (ILA), led by professors Kono, Metzger and de Miguel Asensio.


The decision has made it practically impossible to consolidate patent infringement proceedings with regard to claims pertaining to several States. The negative repercussions of that restrictive approach are particularly acute under the current conditions: in a legal opinion handed down on 8 March 2011, the ECJ has discarded the option to establish a common judicial system for European (EPC) patents and the envisaged unitary patents, meaning that EPC patents also in the future must be litigated separately in each State for which they become valid. See also below, 2 c.
21 For a more detailed comparison between the CLIP Principles and the ALI proposals in regard of copyright infringement on the Internet see the contribution to this volume by R. Matulionyte.


23 The BR refers to “domicile” instead of “habitual residence”. However, in practice the notions are not interpreted differently.


25 See § 204 of the ALI principles and Art. 203 of the Waseda Global COE proposal.

26 Also in that regard, similar rules are found in other projects. However, the CLIP Principles appear as more cautious than others, restricting extraterritorial jurisdiction of other courts than those at the defendant’s place of habitual residence to exceptional cases. For a comparison, see § 204 (1) of the ALI Principles and Art. 203 (1) and (2) of the Waseda Global COE proposal.

27 Case 539/03, Roche Nederland BV et al v Primus and Goldenberg, ECR I-6535. The situation will be reconsidered in Solvay v Honeywell, pending before the ECJ as C-616/10. See also pending case Case C-145/10 – Painer v Standard Verlags GmbH, where Advocate General Trstenjak in her opinion of 12 2011 openly criticized the ECJ for its restrictive interpretation of Article 6(1) BR in the Roche judgment.

28 Supra, fn. 19.


31 Voda v Cordis Corp., 476 F.3d 887 (Fed. Cir. 2007).

32 See ALI Principles, § 213; Waseda Global COE project, Article 209.

33 As envisaged by the Draft Agreement of 8 January 2009 on the European and Community Patents Court (Proposal 2009) and Draft Statute (Draft Statute ECPC), both Council Document No. 5072/09.

34 ”ECJ 8 March 2011, Opinion 1/09, Creation of a unified patent litigation system, paras. 64 seq.


36 The envisaged CLIP statement will be published under the title: A fresh approach after shattered hopes? – How the reform of the Brussels regulation could save European patent litigation from faltering after the ECJ’s opinion of 8 March 2011.


38 ALI Principles, §§ 311 – 313. The Waseda Global COE project is more complicated: it adopts the principle of lex protectionis as the general rule, but for copyrighted works, the law governing initial ownership is the law of the State where the work was originally created (Art. 308).

39 For an extensive discussion of the issue see J. Drexel, Internationales Immaterialgüterrecht , in R. Rixecker & F.-J. Säcker, Münchner Kommentar zum Bürgerlichen Gesetzbuch, Bd 11: Internationales
The point is demonstrated by the French cour de cassation's decision in the John Huston case. See Cour de Cassation, 28 May 1991, Cass.Civ.1re, JCP II 21731 with comment by Françon - John Huston II.


Similar to Article 2:202, the rule was inspired by the WIPO Recommendation on the protection of Trade Marks on the Internet; supra, fn. 24.

For a practical example illustrating the operation of a rule corresponding to the de minimis clause see German Federal Supreme Court (BGH) GRUR 2005, 431 – *Hotel Maritime*: Advertisements for „Hotel Maritim“, located in Copenhagen, had been distributed over the Internet in several languages, including German, and had reached a German audience. The Germany-based hotel chain “Maritime” sued for infringement on the basis of its trade name. The German Federal Supreme Court, applying German law, came to the result that the commercial effect was so unsubstantial that it did not amount to an infringement.

See in particular § 321 of the ALI proposal which allows to apply a single law when the infringement is ubiquitous or when the laws of several states are pleaded, which is more generous than the CLIP principles. Pursuant to Art. 18 of the Waseda Global COE project, the law of the closest connection applies if the infringement concerns “indefinite and multiple countries.


See Article 8(3) Rome II Regulation, which excludes any choice regarding the law applicable to the obligations resulting from intellectual property infringements.

ALI principles, § 302, where infringement is not mentioned as an issue to which choice of law may not pertain; Waseda Global COE project, Article 302, which even extends the applicability of the law chosen to existence, validity, revocation and transferability insofar as only the parties of the contract are affected.