



UK and EU enforcement options

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UK options for enforcement post-Brexit:

- National enforcement options remain – High Court and IPEC, customs authorities
- Brexit transitional provisions ended 31 December 2021
- Proceedings begun at General Court or Court of Justice may continue with UK representatives
- England & Wales courts will continue to recognise judgments from cases begun before the end of transition, and will continue to recognize court settlements and “authentic instruments” approved before end of transition

UK options for enforcement post-Brexit:

- Choice of law in agreements: EU member state courts will continue to respect an express choice of English law
- Equally English courts will continue to respect an express choice of the law of an EU member state

Enforcement conventions

- UK has applied to join Lugano Convention – seeks to clarify which national courts have jurisdiction in cross-border civil and commercial disputes and ensure that judgements taken in such disputes can be enforced across borders
- Awaiting decision from Lugano members as to acceptance
- Hague Convention on choice of courts still applies...

Hague – choice of court in agreements

- Three basic rules that give effect to choice of court agreements:
 1. The chosen court must in principle hear the case (Art. 5);
 2. Any court not chosen must in principle decline to hear the case (Art. 6); and
 3. Any judgment rendered by the chosen court must be recognised and enforced in other Contracting States, except where a ground for refusal applies (Arts 8 and 9)

Hague – Judgments Convention

- Not yet in force, but sets out principles that:

Where a judgment is on the face of it enforceable under the Judgments Convention, it must be recognised and enforced without any review of the merits.

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2. *Any court not chosen must in principle decline to hear the case (Art. 6); and*
3. *Any judgment rendered by the chosen court must be recognised and enforced in other Contracting States, except where a ground for refusal applies (Arts 8 and 9)*

Problems - Hague

- Complex list of requirements to get foreign court to enforce judgment
- English choice of court/jurisdiction agreements/clauses entered into prior to 1 January 2021 may need to be restated to provide certainty that EU member state courts will apply the Hague Convention to such clauses and any resulting judgments
- However, English courts will apply the Hague Convention to agreements entered into from 1 October 2015.

Overview

- What are the relevant rules regarding IP enforcement in the EU? (1)
- Regulation No. 593/2008 of the European Parliament and of the Council of 17 June 2008 on the **law applicable** to contractual obligations (“Rome I”)
- Regulation No. 864/2007 of the European Parliament and of the Council of 11 July 2007 on the **law applicable** to non-contractual obligations (“Rome II”)
- Regulation No. 1215/2012 of the European Parliament and of the Council of 12 December 2012 **on jurisdiction** and the recognition and enforcement of judgments in civil and commercial matters (“Brussel 1a”)

Overview

- What are the relevant rules regarding IP enforcement in the EU? (2)
- Regulation No. 2017/1001 of the European Parliament and of the council of 14 June 2017 on the European Union trade mark (“EUTMR”).
- Regulation No. 1393/2007 of the European Parliament and of the Council of 13 November 2007 on the service in the **Member States of judicial and extrajudicial documents** in civil or commercial matters (“Service of documents”)
- Directive No. 2004/48 of the European Parliament and of the Council of 29 April 2004 **on the enforcement of intellectual property rights** (“Enforcement directive”)

Overview

- What has changed since “Brexit”?
- The European rules **no longer** apply to the UK.
- The UK is **not** member of Convention of 21 December 2007 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (“Lugano Convention”).
- The EU-UK Trade and Cooperation Agreement (“TCA”) of December 24, 2020 **does not include** any provisions regarding cross-border disputes.

Overview

- What are the relevant rules regarding IP enforcement in the UK?

The UK are member of various international Conventions (which also apply to the EU) in particular:

- Convention of 30 June 2005 on **Choice of Court Agreements** (“Hague Convention”)
- Convention of 15 November 1965 **on the Service** Abroad of Judicial and Extrajudicial Documents in Civil or Commercial Matters (“Hague Service Convention”)
- Convention of 18 March 1970 on the **Taking of Evidence** Abroad in Civil or Commercial Matters (“Hague Taking of Evidence Convention”)

Enforcement actions in the EU

- What are the relevant actions that could be taken by IP owners against the unauthorized use of their IP by infringing third parties?
- Civil enforcement actions
- Criminal enforcement actions
- Customs actions

Enforcement actions in the EU

- Civil enforcement actions
- Which type of proceedings?
 - Cease and desist letter
 - Provisional measures before the courts
 - Court proceeding
- Applicable law and venue
 - Some aspects of civil enforcement are harmonised at EU level: Applicable law and venue
 - The concrete aspects of civil litigation procedures are governed by national laws.
 - Applicable law – *Rome II: Infringement of intellectual property rights (Art. 8):*
 - Venue – *EUTMR Art 125 / Article 25 and 26 of Brussel 1a Regulation*

Enforcement actions in the EU

- Criminal enforcement actions
- Counterfeiting and piracy
- Criminal enforcement procedures are not harmonised at EU level
- The EU provides for several mechanisms aiming to enhance police and judicial cooperation in criminal matters (EUROJUST, EUROPOL and EJM)



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Enforcement actions in the EU

- Customs actions
 - EU Customs Union - customs have the power to detain goods at the border upon request of the right holder who believes such goods infringe their IP rights or *ex officio* where there is a suspicion of infringement.
 - Regulation (EU) 608/2013 concerning customs enforcement of intellectual property rights).
 - The harmonized basic procedure:
 - Notification
 - Verification
 - Confirmation
 - Opposition

Thank you

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