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Private Party Enforcement of International Intellectual Property Law

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- **International IP law is an increasingly complex web of international treaties**
  - IP-specific treaties (e.g., Berne, TRIPS)
  - Trade agreements (e.g., NAFTA)
  - Other treaties, including human rights treaties (e.g., the First Protocol to the European Convention on Human Rights)

- **The are concerns about effective enforcement of international IP obligations**
  - Enforcement mechanisms in the TRIPS Agreement, trade agreements, investor-state disputes

- **Eli Lilly v. Government of Canada**
  - An investor-state dispute under NAFTA (Notice of Arbitration, Sep. 12, 2013)
  - A number of important issues
    - Are patent application and maintenance fees an “investment” under NAFTA?
    - What degree of flexibility do countries enjoy as they design the utility requirement of patentability within the TRIPS Agreement framework?

- **Should private parties (as opposed to countries/ governments) be able to enforce international IP law?**

- **Traditional understanding of international IP law**
  - It is based on IP treaties
  - The treaties govern the relationships among countries
  - Any obligations imposed by the treaties are directed primarily at governments
  - The enforcement of obligations stemming from the treaties is in the hands of governments or, with their consent, overseen by international or regional organizations (e.g., WTO, ECJ)

- **Traditional understanding of the role that private parties play in the enforcement of international IP law**
  - Individuals, corporations, non-governmental organizations
  - Private parties typically are not expected to have standing and a cause of action to enforce international IP law
  - Private parties contribute to the enforcement of international IP law indirectly (e.g., by relying on national law, if it should be consistent with and interpreted in light of international IP law)

- **“Private Party Enforcement” of International IP Law**
  - The definition for the purposes of this paper
  - An act by a private (non-governmental) person or entity through which the person or entity relies directly on international IP norms in a dispute against a governmental or non-governmental actor
  - Such an act of enforcement may consist of an action in a national court, an international court, or an arbitration tribunal
  - A matter of existence of both standing (an available venue) and a cause of action

- **Existing Private Party Enforcement I**

  - **In International Courts**
  - Human rights treaties

  - **In Arbitration Tribunals**
  - Investor-state disputes
  - Arbitration proceedings between private parties using “general principles of international commercial law”

Existing Private Party Enforcement II

In National Courts I

- Self-executing provisions of international IP treaties (provisions with direct effect)
  - E.g., in the United States, the General Inter-American Convention for Trademark and Commercial Protection
  - E.g., in Portugal, TRIPS Article 33

- In the European Union:
  - Direct applicability of EU regulations
  - Vertical direct effect of some provisions of the EU Treaties and of some provisions of EU directives

- **Existing Private Party Enforcement II**
  - **In National Courts II**
  - Interpretation of national law consistent with international obligations
  - Potential indirect enforcement through the public policy filter in choice of law and the recognition and enforcement of foreign judgments
  - In regional courts in matters of regional IP rights (e.g., ECJ for EC trademarks, the Unified Patent Court for the EU unitary patent)

- **Arguments in favor of allowing private parties to pursue claims against countries, based on the countries' international obligations**

  - An increase in countries' compliance with their international obligations (emphasizing the legitimacy of international law)
  - An increase of access to justice for persons and entities irrespective of their own government's stance
  - An increase in consistency of interpretation of the international obligations (if actions are centralized before a single body, thus avoiding fragmentation)

- **Arguments against allowing private parties to pursue claims against countries, based on the countries' international obligations**

  - A lack of possibility for countries to make strategic decisions about when to tolerate a certain degree of noncompliance and when to pursue enforcement actions (i.e., a loss of discretion)
  - An increase in consistency of interpretation of the international obligations (if actions are centralized before a single body) potentially resulting in limitation of flexibilities
  - A further proliferation of courts and tribunals potentially leading to inconsistent interpretations of international law by various courts and tribunals

- **Effects of the possibility of private party enforcement on negotiations of international IP treaties**

  - Greater power to the executives negotiating the treaties: Because the legislatures are more likely to accept and/or ratify what the executives have negotiated, private party enforcement reinforces the position of the executives
  - Specificity of international treaty provisions: If private party enforcement of treaties is a permissible concept, treaty negotiators might employ one of the following negotiating tactics:
  - 1) propose treaty provisions that are specific enough to allow private parties to enforce the treaties; or
  - 2) propose treaty provisions that are vague enough to preclude private party enforcement

- Greater reliance by society on IP will result in an increase in the intersection of IP issues with the fundamental rights and freedoms.

- The greater the intersection of IP with the fundamental rights and freedoms, the greater the emphasis will be on the private party enforcement of international IP law.

- Any consideration of the possibility of private party enforcement of international IP law should include issues pertaining to both the holders of IP rights and to holders of competing rights, particularly if further IP treaties on rights and limitations are concluded in new treaties (such as the Marrakesh Treaty).

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