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OLGA GURGULA*/MACIEJ PADAMCZYK**/NOAM SHEMTOV***

Specialised IP Judiciary: What Are the Key Elements to Consider when Establishing or Reforming an Effective IP Court?

Intellectual property ('IP') is one of the key instruments for fostering innovation and promoting the growth of national economies. Given both the economic significance and the legal complexities associated with IP rights due to constant technological development, the benefits of having a specialised IP judiciary are being increasingly recognised across the globe. Many countries have either established or have been considering the introduction of various forms of such a specialised judiciary. This paper examines this trend and explores some key considerations in relation to the efficacy of an IP judiciary. It draws on some of the findings of a recently completed project funded by the UK government on the creation and functioning of a new IP court in Ukraine. While there is no 'one-size-fits-all' model when creating a specialised IP judiciary, the discussion in this article sheds light on a number of key factors that should be taken into account and carefully assessed when establishing or reforming such a judiciary. This includes specific considerations related to the structure of an IP judiciary, its location, the specialisation of IP judges, exclusive jurisdiction and other procedural issues. We believe that the guidance provided in this article will assist policymakers in their choices regarding the most suitable design of an IP judiciary for a particular jurisdiction, leading to the enhancement of its operation for the benefit of all the stakeholders in the IP enforcement system.

I. Introduction

Intellectual property ('IP') has become one of the key instruments for fostering innovation and promoting the growth of national economies.[1] It has gained a prominent role as economic growth has become more than ever dependent on knowledge-based industries. In Europe, IP-intensive industries created 29.2% of all jobs in the EU during the period 2014-2016 and employed 63 million people, generating almost 45% of gross domestic product (GDP) in the EU, worth €6.6 trillion.[2] Similarly, in the US, IP-intensive industries support at least 45 million US jobs and contribute more than $6 trillion dollars (38.2%) to the US GDP.[3] According to an Organisation for Economic Co-operation and Development study, 'IP's overall role in economies has evolved from a policy area that was mainly relevant to a handful of industries to a force that influences a wide swath of demand and sectors'.[4] IP is now viewed as a core asset for businesses as it strengthens their market position and improves competitiveness.

Governments in both developed and developing countries have been using IP as an important policy tool that is aimed at attracting investments in knowledge creation and innovation, fostering economic growth, stimulating foreign direct investment (FDI) and supporting small and medium-sized enterprises (SMEs).[5] These goals, however, may only be achieved if they are supported by a well-functioning IP legal ecosystem, which, in turn, includes effective IP protection and enforcement mechanisms, providing certainty for IP rightholders.[6] It is not surprising,

*PhD, LLM, Senior Lecturer in Intellectual Property Law at Brunel Law School, Brunel University London, UK.
**PhD candidate at Queen Mary University of London, UK.
***Professor and Deputy Head of CCLS, Queen Mary University of London, UK.
Corresponding author: <Olga.Gurgula@brunel.ac.uk>.

1 World Intellectual Property Organization, 'Economic Aspects of Intellectual Property in Countries with Economies in Transition' (2020) 4 <https://www.wipo.int/edocs/pubdocs/en/wipo_pub_transition_8.pdf> accessed 10 October 2021; Keith Maskus, *Intellectual Property Rights in the Global Economy* (Institute for International Economics 2000) 73; World Bank, 'Global Economic Prospects 2008 – Technology Diffusion in the Developing World' (*The World Bank*, 2008) 147-48 <https://openknowledge.worldbank.org/bitstream/handle/10986/6335/Global-Economic-Prospects-2008-Technology-diffusion-in-the-developing-world.pdf?sequence=5&isAllowed=y> accessed 10 October 2021.

2 European Union Intellectual Property Office, European Patent Office, 'IPR-intensive industries and economic performance in the European Union Industry-Level Analysis Report' (2019) <https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/observatory/documents/IPContributionStudy/IPR-intensive_industries_and_economicin_EU/WEB_IPR_intensive_Report_2019.pdf> accessed 10 October 2021.

3 United States Patent and Trademark Office and Economics and Statistics Administration, 'Intellectual Property and the U.S. Economy: 2016 Update' (2016) <https://www.uspto.gov/sites/default/files/documents/IPandtheUSEconomySept2016.pdf> accessed 10 October 2021.

4 Organisation for Economic Co-operation and Development, 'Enquiries into Intellectual Property's Economic Impact' (2015) 9 <http://www.oecd.org/sti/ieconomy/KBC2-IP.Final.pdf> accessed 10 October 2021.

5 On the role of IP rights in fostering growth and supporting SMEs in both developing and developed countries, see International Chamber of Commerce Commission on International Trade and Business Action to Stop Counterfeiting and Piracy, 'Intellectual Property: Powerhouse for Innovation and Economic Growth' (2011) <https://iccwbo.org/content/uploads/sites/3/2011/02/Intellectual-Property-Powerhouse-for-Innovation-and-Economic-Growth.pdf> accessed 10 October 2021.

6 European Commission, 'A Balanced IP Enforcement System Responding to Today's Societal Challenges' COM(2017)707 <https://ec.

therefore, that the creation of a robust legal IP landscape has been a top priority in many jurisdictions,[7] a key element of which is an effective judicial system.

Given both the economic significance and the legal complexities associated with IP rights due to constant technological development, the benefits of having a specialised IP judiciary are increasingly recognised across the globe. Many countries have either established[8] or have been considering the introduction of various forms of such specialised judiciary functions.[9] For example, since 1982 the Court of Appeals for the Federal Circuit (CAFC) has had exclusive jurisdiction over certain types of IP cases that covers the entire territory of the US. The UK has a specialised IP judiciary that comprises several courts, including the Intellectual Property and Enterprise Court (IPEC) that became operational in 2013. In the EU, the majority of Member States introduced either a specialised IP court or specialised IP divisions within the general courts.[10] Moreover, in 2014, 25 Member States of the European Union signed an international agreement which is aimed at establishing the Unified Patent Court.[11] Also in 2014, China established specialised IP courts in Beijing, Shanghai and Guangzhou.[12] Many Central and Eastern European countries have set up specialised IP courts or specialised IP divisions, including Azerbaijan, Belarus, Croatia, Czech Republic, Hungary, Lithuania, Macedonia, Poland, Romania, Russia, Slovakia and Slovenia.[13]

This paper examines this trend at two separate yet interrelated levels: it enquires to what extent a specialised tribunal or court is desirable for considering IP disputes, and, to the extent that it is so desirable, examines some key considerations in relation to the efficacy of its operation. In doing so, this paper draws on some of the findings and conclusions of a recently completed consultancy project funded by the UK government and conducted by the Centre for Commercial Law Studies (QMUL) on the creation and functioning of a new IP court in Ukraine. The authors of this paper formed part of the team of experts that prepared the project's report, which provided recommendations to the Ukrainian government on possible ways to improve the legal framework related to the establishment and operation of this new IP court (the 'Final Report').[14] To achieve this, the project team carried out an extensive comparative study of best practices on specialised IP judiciary functions in five mature IP jurisdictions: the United States, the United Kingdom, Germany, France and the Netherlands. In examining these jurisdictions, the project grappled with legal and operational questions that policymakers that consider introducing a specialised IP judiciary or reforming an existing one are likely to confront. It is these aspects of the project that are discussed, elaborated and further developed in this paper.

The discussion below examines pivotal considerations in relation to the key issues pertaining to the establishment and operation of a specialised IP judiciary: (a) its structure, (b) its location, (c) the specialisation of judges, including the role of technical judges and court advisors, and (d) exclusive jurisdiction and other procedural matters. The paper highlights various solutions developed in five selected jurisdictions, i.e. the United States, the United Kingdom, Germany, France and the Netherlands, and examines the underlying policy considerations that underpin their respective approaches. This examination is conducted by reference to mechanisms adopted in these jurisdictions, while assessing their effectiveness and suitability for various legal environments. On the basis of the aforementioned analysis, this paper presents a set of policy guidelines which may prove vital to policymakers that operate in this sphere regardless of the jurisdiction at issue.

II. The role of a specialised IP judiciary in the effectiveness of IP enforcement

The creation and effective functioning of a specialised IP judiciary is a policy-driven decision which aims at encouraging innovation and investment, raises greater awareness of IP rights and signals governmental priorities in this respect. A number of studies on specialised IP courts suggest that the establishment of specialised courts may have a range of positive outcomes.[15] One of the main societal

europa.eu/transparency/regdoc/rep/1/2017/EN/COM-2017-707-F1-EN MAIN-PART-1.PDF> accessed 10 October 2021.

7 ibid; European Commission 'Making the most of the EU's innovative potential. An intellectual property action plan to support the EU's recovery and resilience' COM(2020) 760; United Kingdom Intellectual Property Office, 'Protecting creativity, supporting innovation: IP enforcement 2020' (2016) <https://assets.publishing.service.gov.uk/government/uploads/system/uploads/attachment_data/file/571604/IP_Enforcement_Strategy.pdf> accessed 10 October 2021.

8 International Chamber of Commerce, 'Adjudicating Intellectual Property Disputes' (ICC, 2016) <https://iccwbo.org/content/uploads/sites/3/2016/04/ICC-report-on-Specialised-IP-Jurisdictions.pdf> accessed 10 October 2021.

9 eg, Kazakhstan is currently in the process of developing its IP Strategy 2021-2025, which also discusses the establishment of a specialised IP judiciary. See the Decree of the Government of Kazakhstan 'On the Approval of the IP Concept for the development of intellectual property in the Republic of Kazakhstan in 2021-2025' <https://legalacts.egov.kz/npa/view?id=5772344> accessed 10 October 2021.

10 European Union Intellectual Property Office, 'Specialised IP Rights Jurisdictions in the Member States. A compilation of available studies' (2018) <https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/observatory/documents/reports/2018_Specialised_IP_Rights_Jurisdictions_in_Member_States/2018_Specialised_IP_Rights_Jurisdictions_in_Member_States_EN.pdf> accessed 10 October 2021; eg, Poland has recently introduced specialised IP divisions in the first instance courts of five Polish cities: Warsaw, Lublin, Gdańsk, Poznań and Katowice; the specialized IP appeal divisions have been established in Warsaw and Poznań (see Ministerstwo Sprawiedliwości, 'Ruszają specjalistyczne sądy chroniące własność intelektualną' <https://www.gov.pl/web/sprawiedliwosc/ruszaja-specjalistyczne-sady-chroniace-wlasnosc-intelektualna> accessed 10 October 2021. Also, the UK is constantly developing its specialised IP system, for instance by establishing permanent regional divisions of the IP courts (see HM Courts & Tribunals Service, 'The Intellectual Property Enterprise Court Guide' (*UK Government*, 2019) <https://assets.publishing.service.gov.uk/government/uploads/system/uploads/attachment_data/file/823201/intellectual-property-enterprise-guide.pdf> accessed 10 October 2021).

11 Agreement on a Unified Patent Court, Official Journal of the European Union 2013/C 175/01.

12 Justice Tao Kaiyuan , 'China's Commitment to Strengthening IP Judicial Protection and Creating a Bright Future for IP Rights' (2019) 3 WIPO Magazine 21 <https://www.wipo.int/wipo_magazine/en/2019/03/article_0004.html> accessed 10 October 2021 ('Since 2017, the Supreme People's Court has approved the establishment of IP tribunals by intermediate people's courts in Nanjing and 18 other cities').

13 United States Patent Trademark Office and International Intellectual Property Institute, 'Study on Specialised Intellectual Property Courts' (2012) <https://iipi.org/wp-content/uploads/2012/05/Study-on-Specialized-IPR-Courts.pdf> accessed 10 October 2021; EUIPO (n 10).

14 'Ukraine DFID/FCO IP Court Project: the Final Report' (2020) Centre for the Commercial Legal Studies, QMUL <https://www.qmul.ac.uk/media/qmul/media/2019/Report_QM_10.28_ENG.pdf> accessed 10 October 2021.

15 See eg Markus B Zimmer, 'Overview of Specialised Courts' (2009) 2 International Journal for Court Administration 46 <https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2896064> accessed 10 October 2021; Jacques de Werra, 'Specialised Intellectual Property Courts – Issues and Challenges, Global Perspectives for the Intellectual Property System' (2016) CEIPI-ICTSD publication series 2; USPTO and International Intellectual Property Institute (n 13); International Chamber of Commerce (ICC), 'Adjudicating

advantages of the establishment of a specialised IP court is that it signals to the public that the state is interested in and will protect intellectual property.[16] This may increase faith in the IP system as a whole and in turn encourage investment and innovation.[17] Another positive outcome envisaged by the creation of a specialised court is that it is more capable of keeping abreast of developments in its specific areas of law than the non-specialised courts.[18] In addition, the increase in the level of judicial expertise may result in less reliance on technical experts in decision making, which, in turn, improves the quality and impartiality of such decisions.[19] Moreover, greater consistency and more uniform judicial practice is another likely outcome as IP disputes would be adjudicated by a set cadre of judges, each possessing a greater level of experience and expertise in such disputes.[20] Case outcomes may therefore become more predictable. This, in turn, may improve business confidence, reduce the caseload for IP courts and the duration of the proceedings.[21] Moreover, it may enable parties to settle their disputes because it may be possible to predict the likely outcome of the dispute due to the consistent application of IP rules.[22]

When considering the creation of a specialised IP judiciary, some potential drawbacks should also be taken into account.[23] These include a narrow focus of specialised courts, i.e. such courts may place too much importance on the IP dimension of the litigation at hand while not giving enough consideration to other dimensions such as e.g. contract and competition law in transactional disputes.[24] Another drawback is accessibility, as specialised courts may be situated in one fixed location which is inaccessible to many based in other parts of the country, thus creating a barrier to justice for some litigants.[25] In addition, countries may face certain challenges when establishing a specialised judiciary. The creation and effective functioning of an IP court requires significant investments in human resources. Furthermore, it may be necessary to develop specifically tailored procedural laws to ensure the effective operation of a specialised IP judiciary. Therefore, when establishing a specialised IP judiciary these drawbacks and challenges should be adequately addressed to ensure the effective functioning of such courts.

III. Specific considerations relevant to the establishment and effective functioning of an IP judiciary

The choice of an optimal solution with respect to the organisational and procedural matters of an IP judiciary requires a thorough analysis of a variety of factors, including deciding on certain structural and procedural issues. With respect to the former, relevant questions may include the following. Should an IP judiciary be set up in the form of a separate court or rather as a specialised division within the general courts? Should it be established at first instance, appellate level or both? What should be the selection requirements for judges in this specialised judiciary? If it is decided to create an IP court, where should it be located and how is adequate access to justice to be ensured? There are also a number of procedural issues that should be considered. These, for example, include such matters as the ambit of the exclusive jurisdiction of a specialised IP judiciary, the composition of the court, preliminary injunctions and the role of experts in IP disputes, to name but a few. A careful consideration of these issues should be carried out with a view to devising solutions that are tailor-made to the specific features of a given jurisdiction.

1. The role and structure of a specialised IP judiciary

The choice of a specific structure of an IP judiciary is typically linked to certain policy objectives and has different underpinning considerations. For instance, in Ukraine the key objective of establishing a specialised IP court was to assemble all IP disputes within the jurisdiction of one court. Such disputes have traditionally been considered by three different types of courts, commercial, civil and administrative, which routinely generated confusion as to the jurisdiction of those courts. It also resulted in lengthy judicial processes and divergent court practices when considering identical IP issues. Furthermore, different courts and procedures, as well as uneven levels of judicial expertise, often led to unpredictable and inconsistent outcomes in IP disputes.[26] Therefore, when establishing a separate IP court in Ukraine, the goal was to improve the quality of IP adjudication. Similarly, in the US, the main aim for vesting the CAFC with the exclusive jurisdiction over a specific subject matter was the expectation that this would create uniformity and reliability in the interpretation of the law by the district courts of all circuits.[27] On the other hand, in Germany, the function of the Federal Patent Court is to infuse the technical expertise within the German judicial system. Finally, the IPEC in the UK was established with a clear purpose of providing a forum that would be more accessible and convenient for SMEs.

As to the structure of a specialised judiciary, while each of the jurisdictions analysed in the Final Report provides for some form of such a judiciary, their design differs considerably. Some jurisdictions have established separate specialised IP courts either as courts of first instance or as appellate courts. For example, the specialised IP judiciary in the UK comprises the courts of first instance, i.e. the Patents Court, the IPEC, and the general Chancery Division of the High Court.[28] Similarly, in Germany, the

Intellectual Property Disputes' (2016) <https://iccwbo.org/publication/adjudicating-intellectual-property-disputes-an-icc-report-on-specialised-ip-jurisdictions/> accessed 10 October 2021.
16 USPTO and International Intellectual Property Institute (n 13) 6.
17 ibid.
18 De Werra (n 15) 24.
19 ibid.
20 ibid 25.
21 ibid.
22 ibid.
23 For a detailed discussion on this matter, see eg Zimmer (n 15) 3-4; de Werra (n 15) 26.
24 ibid.
25 ibid.
26 See Decree of the Parliament of Ukraine, 'On the Recommendations to the Parliamentary hearings "Protection of intellectual property in Ukraine: problems of legislative framework and its enforcement"' (N 1243-V, 27 June 2007).
27 Howard T Markey, 'The Phoenix Court' (1982) 10 American Intellectual Property Law Association Quarterly Journal 227, 230-31.
28 HM Courts & Tribunals service, 'Chancery Guide' (Government UK, February 2020) <https://assets.publishing.service.gov.uk/government/uploads/system/uploads/attachment_data/file/869071/chancery-guide-eng.pdf> accessed 10 October 2021 (These courts are part of the High Court and may deal with all types of IP disputes. Allocation and transfer of IP disputes between them depends on the type of IP

Federal Patent Court is the court of first instance.[29] However, Germany has a bifurcated system, and thus, while the Federal Patent Court deals with disputes related to the validity of IP rights, IP infringement disputes are considered by specialised divisions of the regional courts.[30] In the US, the specialised IP judiciary is set at the appellate level and is performed by the CAFC.[31] In other jurisdictions, IP disputes have been allocated to specialised IP chambers within the civil or commercial courts. For example, special IP chambers were introduced in France,[32] Germany (for infringement proceedings)[33] and in the Netherlands.[34] Moreover, specialisation in these jurisdictions is ensured by allocating IP disputes only to a limited number of first instance courts.[35] As a result, in France and the Netherlands there is only one first instance court dealing with patent disputes,[36] while in Germany there are 12 such courts.[37]

Therefore, when considering the introduction of an IP judiciary or the reform of an existing one, it is important to clearly identify the role and place of a specialised judiciary within the general structure of the judicial system.

2. Location of specialised IP judiciary and access to justice

The choice of a location for the IP judiciary may have a significant impact on access to justice. For example, in Ukraine, the new IP Court will be established in Kyiv.[38] This has raised concerns regarding effective access to this court by litigants from other regions. To facilitate access to justice in Ukraine, our recommendations included developing a videoconferencing system and introducing additional regional divisions to support the IP Court in Kyiv. Other jurisdictions may select a different option as to how access to their IP judiciary can be ensured, as exemplified by the approaches taken in the selected jurisdictions.

In particular, those jurisdictions that have a specialised IP court (as opposed to jurisdictions that have allocated an exclusive competence to hear IP cases to non-specialised courts) allow hearings to be conducted in various locations outside the court, which increases access to justice for litigants. For example, in the US, while the CAFC is located in Washington DC, it is also authorised to sit in other cities throughout the US in order to satisfy the needs of litigants.[39] Moreover, an effective use of videoconferencing systems, which, under appropriate circumstances, allow parties to participate in hearings from any location, may also significantly increase access to justice.[40] Similarly, in the UK, while all the specialised IP courts are situated in London, they operate under the umbrella name 'the Business and Property Courts', which includes the main London office and regional offices in the six cities (Manchester, Birmingham, Leeds, Cardiff, Newcastle and Bristol).[41] Other jurisdictions, notably those that have no specialised IP courts, such as Germany (for infringement proceedings), France and the Netherlands, have allocated an exclusive jurisdiction to hear certain types of IP cases to a number of first instance courts.[42] They have thereby increased the number of courts that can decide on IP disputes, as well as the number of locations in which such hearings are available. In addition, in some jurisdictions, certain measures, such as preliminary injunctive relief, can be filed with a court other than the specialised IP court that has jurisdiction to hear the main lawsuit.[43] This measure increases the number of courts that are competent to consider IP-related matters in urgent circumstances, and thus the number of locations where such measures may be requested. Therefore, while the creation of specialised IP chambers within the general courts increases the number of choices available for litigants, an option of establishing a separate IP court can also provide sufficient access when additional mechanisms are introduced.

3. Specialisation of IP judges and technical court experts

One of the most important considerations when establishing a specialised IP judiciary is to ensure a high quality of IP adjudication. This may only be possible when the IP judiciary consists of experienced IP judges. For example, the analysis of the current selection criteria for IP judges in Ukraine revealed that they may result in some of the judges lacking sufficient knowledge in IP and/or relevant technical background for the adjudication of complex IP

right in question, the value of the claim and the complexity of the dispute).

29 The Federal Patent Court is competent to deal with disputes concerning the validity of registered IP rights and compulsory licences, as well as appeals from the decisions of the German Intellectual Property Office.

30 The Final Report (n 14) Part III, section 2.2. of the Comparative Study.

31 The CAFC was established in 1982 by the Federal Courts Improvement Act of 1982, which merged the United States Court of Customs and Patent Appeals and the appellate division of the United States Court of Claims. It has exclusive jurisdiction over certain types of IP cases that covers the entire territory of the US (28 U.S. Code §§ 1291, 1292(c) and 1295); for more information see the Final Report (n 14) Part I, sections 1.1. and 2.2. of the Comparative Study.

32 The Final Report (n 14) Part IV, section 2.2. of the Comparative Study.

33 The Final Report (n 14) Part III, section 2.2. of the Comparative Study.

34 The Final Report (n 14) Part V, section 2.2. of the Comparative Study.

35 The Final Report (n 14) Parts I, III, IV and V, sections 1.3 and 2.2. of the Comparative Study.

36 The Final Report (n 14) Parts IV and V, section 1.3. of the Comparative Study.

37 The Final Report (n 14) Part III, section 1.3. of the Comparative Study.

38 Decree of the President of Ukraine, 'On the Establishment of the High Court on Intellectual Property' (No 299/2017, 29 September 2017) <http://zakon2.rada.gov.ua/laws/show/299/2017> accessed 10 October 2021.

39 In the US, the CAFC judges may travel to consider a case outside the Court's regular venue in Washington D.C. The decision to hold hearings outside Washington D.C. is made by the CAFC with 'a view to securing reasonable opportunity to citizens to appear before the court with as little inconvenience and expense to citizens as is practicable' (28 U.S. Code § 48(d)). The list of possible locations where a hearing could take place is limited to those indicated in 28 U.S. Code §48, which include such venues as a courthouse or a law school.

40 The Final Report (n 14) Part I, section 1.3 of the Comparative Study.

41 While typically it is the London office that deals with the majority of IP claims at all stages of the proceedings, the district registries may also conduct case management and trial if an appropriate judge is available. Moreover, IP disputes considered outside the regular venues of the IPEC, the Patents Court or the general Chancery Division are dealt with by the judges of these courts who travel to one of the six Business and Property Court district registries. There are, however, exceptions in relation to the small claims track.

42 The Final Report (n 14), Parts III, IV and V, section 1.3. of the Comparative Study.

43 eg this is the case in Germany (see § 942 of the Rules of Civil Procedure 1950 (*Zivilprozessordnung 1950*); for more information see the Final Report (n 14) Part III, section 2.4.2. of the Comparative Study.

disputes.[44] Therefore, we recommended establishing a general requirement that all judges should have adequate knowledge in the field of IP, as well as introducing the institution of 'scientific advisors', and considering the possibility of reserving a certain number of posts for IP judges with a relevant technical or scientific background.

These recommendations are based on the approaches taken in the leading IP jurisdictions, where IP judges have considerable knowledge in the field of IP law. For example, the majority of the judges of the CAFC have a significant IP background.[45] Likewise, in the Netherlands, most of the IP judges have prior experience of practice as IP/patent litigators or as patent attorneys.[46] In some jurisdictions, IP judges also have a technical or scientific background. For example, a unique feature of the Federal Patent Court is that its judges include not only lawyers, but also natural scientists, referred to as 'technical' judges, who sit on all cases which relate to the properties of an invention.[47] In the UK, while there are no 'technical judges', a certain degree of technical expertise is required of the judges of the Patents Court.[48] Additionally, in some jurisdictions the judges are assisted by a special type of court advisor whose role is to explain the technical details of the case to the judge.[49] Therefore, high-quality IP adjudication can be achieved by selecting a combination of the following options: (a) requirement of IP experience as one of the selection criteria for IP judges; (b) participation of technically qualified judges in the proceedings; and (c) creation of a special type of court advisor whose main task would be to ensure that the judges understand the technical details of the case.

4. Jurisdiction of IP courts

The exclusive jurisdiction of an IP judiciary is an important factor that sets the ambit of its authority. Importantly, it should be defined in a manner that would eliminate overlaps and confusion as to the jurisdiction of a specialised IP judiciary and other types of courts, including civil, commercial and administrative. In Ukraine, to avoid any overlaps between, on the one hand, the jurisdiction of the new IP Court, and, on the other hand, the administrative courts and other state authorities, as well as bearing in mind the aim of establishing this Court, we recommended clarifying its exclusive jurisdiction, for example by extending its competence to customs and tax disputes involving an IP element.[50]

Such an approach, however, may not be suitable for other jurisdictions that want to design the exclusive jurisdiction of an IP judiciary narrowly by focusing on purely IP disputes. In particular, in the selected jurisdictions, the allocation of IP disputes between the specialised IP courts and other types of courts typically takes into account several factors. First, when determining the jurisdiction of a specialised IP court, it is considered whether an IP issue in a dispute relates to private law (i.e. civil and commercial law) or public law. Specifically, IP disputes between private parties are typically considered to be a matter of private law and thus fall within the jurisdiction of specialised IP courts, while issues that arise from the exercise of powers by state authorities fall outside the jurisdiction of such courts. The latter, for example, include tax or customs disputes, even if they are IP-related.

Secondly, the jurisdictions analysed tend to have two different approaches when defining the breadth of subject-matters that fall within the jurisdiction of specialised IP courts. Some jurisdictions take a liberal approach when defining what qualifies as an IP dispute within the ambit of private law. In such jurisdictions, most cases that involve IP matters, including a remote relation to IP rights such as the contractual interpretation of IP licensing agreements, will fall within the jurisdiction of specialised IP courts.[51] On the other hand, some jurisdictions take a more restrictive approach as to what constitutes an IP dispute. In those jurisdictions, these will be the disputes comprising IP-related matters stemming directly from the statutes that regulate IP rights (i.e. a patent act), such as the validity or infringement of an IP right, and closely related matters of a non-IP nature.[52] While the approaches to defining whether an IP-related matter falls within the jurisdiction of a specialised IP court differ, it appears that most of the jurisdictions analysed tend towards the broad approach, which includes matters not strictly related to IP rights.

Therefore, when defining the jurisdiction of a specialised IP judiciary, it is important to set the boundaries of its competence clearly, avoiding any overlap with the jurisdiction of other types of courts. This will ensure clarity for litigants and facilitate the effective functioning of the judicial system in general.

5. Other factors to be taken into account when establishing or reforming an IP judiciary

In addition to the factors discussed above, other considerations may be equally important in contributing to the effective functioning of an IP judiciary. This in particular includes procedural issues, such as the composition of the

44 This is because while the selection criteria for IP professionals such as patent attorneys and attorneys-at-law are quite strict and require at least five years of IP practice with sufficient evidence of such experience, the threshold for judges is set at a minimum level, i.e. three years of being a judge with no requirement of adjudicating IP cases (see art 28 of the Law of Ukraine, 'On the System of Justice and the Status of Judges' (No 1402-VIII, 2 June 2016) <http://zakon3.rada.gov.ua/laws/show/1402-19> accessed 10 October 2021).

45 The Final Report (n 14) Part I, section 3.2.2. of the Comparative Study.

46 The Final Report (n 14) Parts I and V, section 1.2. of the Comparative Study.

47 In Germany, of the overall 102 judges, 55 have life science or technical knowledge (Bundespatentgericht, 'Organisation') <https://www.bundespatentgericht.de/DE/dasGericht/Organisation/organisation_node.html> accessed 10 October 2021.

48 The Final Report (n 14) Part II, section 1.2. of the Comparative Study (eg, in the UK most of the IP judges at the first instance of the specialised IP courts, as well as judges in the Court of Appeal who hear IP cases, have a technical/scientific background. Cases at the Patents Court are categorised according to the technical nature of their subject matter on a scale of 1-5, and typically judges who sit on category 4 and 5 cases must have a science degree or be 'suitably qualified deputy High Court judges'; see Chancellor of the High Court, 'Chancellor of the High Court' (*Judiciary UK*, April 2019) 2 <https://www.judiciary.uk/wp-content/uploads/2019/04/Patents-Court-Guide-April-2019.pdf> accessed 10 October 2021).

49 eg in the UK, the judges may make use of so-called 'assessors' who have expertise in a relevant technical field or, in the Patents Court, 'scientific advisors' who help the court understand the technical aspects of the case (see Final Report (n 14) Part II, section 2.3.2. of the Comparative Study).

50 Final Report (n 14), section 2.2.1.1.(ii) of the Recommendations.

51 Final Report (n 14) Part III, section 2.2. of the Comparative Study (eg in Germany).

52 Final Report (n 14) Parts I and IV, sections 2.2. of the Comparative Study (eg in US and France).

court, preliminary injunctions and the role of experts. While these matters are also important to non-IP disputes, IP disputes have their particularities in terms of subject matter and complexity and may therefore require different approaches and considerations compared to other types of disputes.

a) Composition of the court

A specific composition of the court in IP disputes may have a significant impact on the quality and speed of IP adjudication. In Ukraine, IP cases at first instance will be considered by a panel of three judges,[53] which could create a significant backlog, as the currently envisaged 21 judges at first instance would be able to hear a much lower number of cases if every hearing had to be conducted by a panel of three. In turn, this may affect the speed of court proceedings. Therefore, we advised that IP disputes may be dealt with by a single judge, rather than a panel of three judges; the latter would only be engaged in more complex cases.[54] The choice for other jurisdictions may depend on the specific setting of the IP judiciary, including the number of IP judges and their workload.

The approach to this matter in the selected jurisdictions varies. The analysis demonstrates that in the majority of the jurisdictions, IP disputes are considered by a single judge at first instance as the default option.[55] In some of these jurisdictions, however, there is a possibility to have the case heard by a three-judge panel in appropriate circumstances, typically in more complex disputes.[56] In other jurisdictions the default is reversed to a three-judge panel.[57] In those jurisdictions, the option of having disputes that are legally and factually not complex heard by one judge is available in appropriate circumstances.[58] In some of them, the parties may jointly request the court to transfer their dispute to a single judge.[59] Furthermore, in those jurisdictions where a panel of three judges decides IP disputes, preliminary measures may, nevertheless, be considered by a single judge, e.g. by the president of the court or the chair of the three-judge panel.[60] Alternatively, in some jurisdictions, the president of the court may appoint a 'motions panel' of three judges that can review motions filed before the main lawsuit is filed with the court.[61]

Therefore, when considering the rules on a specific composition of the court in IP disputes, various factors need to be taken into account, including the number of IP judges in an IP judiciary and their workload. These considerations may have a significant impact on the efficiency and speed of IP adjudication.

b) Preliminary injunctions

While the grounds for preliminary measures issued in IP disputes are typically the same as in non-IP disputes, some jurisdictions have introduced IP-specific interlocutory injunctions. The logic behind such provisions is that since IP disputes may have some particularities in terms of a required preliminary relief, a specially designed preliminary injunction may help to improve the effectiveness of IP litigation. For example, measures such as delivery-up of goods are of particular importance in IP infringement cases. In the EU, the IP Enforcement Directive[62] provides a minimum and standard set of measures that allow the effective civil enforcement of IP rights,[63] including preliminary measures.[64] However, as the Directive provides only a minimum harmonisation,[65] some EU Members have introduced certain IP-specific preliminary injunctions which may go beyond these minimum standards. For example, in addition to the preliminary measures under general civil procedure, France has introduced a vast range of IP-specific preliminary injunctive reliefs.[66] Also Germany,[67] the UK[68] and the Netherlands[69] have created some IP-specific measures.[70] Therefore, when considering the establishment or reform of an IP

53 art 33 of the Commercial Procedural Code of Ukraine.
54 Final Report (n 14) section 2.2.1. of the Recommendations.
55 Final Report (n 14) Parts I, II, and V, section 2.1. of the Comparative Study (eg, cases are heard by a single judge in the US, the UK, the Netherlands and Germany (subject to certain exceptions)).
56 Final Report (n 14) Parts III and V, section 2.1. of the Comparative Study (eg German and Dutch law provides for such a possibility).
57 Final Report (n 14) Part IV, section 2.1. of the Comparative Study (eg in France).
58 Final Report (n 14) Parts III and IV, section 2.1. of the Comparative Study (eg, in France, where IP disputes are generally heard by a three-judge panel at the tribunals, the president of the court or the president of the panel may delegate any matter to a single judge, provided that it would be appropriate for the case to be heard by a single judge).
59 Final Report (n 14) Part III, section 2.1. of the Comparative Study (eg, at the commercial chambers of the regional courts in Germany, where IP disputes are usually heard by a three-judge panel, the parties may jointly authorise the president of a chamber to decide a case on the merits).
60 Final Report (n 14) Part IV, section 2.1. of the Comparative Study (eg, in France and Germany).
61 Final Report (n 14) Part I, section 2.1. of the Comparative Study (eg in the US).
62 Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (OJ L157, 30 April 2004).
63 European Commission, 'Guidance on certain aspects of Directive 2004/48/EC of the European Parliament and of the Council on the enforcement of intellectual property rights' (2017) COM (2017) 708, 1 <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A52017DC0708> accessed 10 October 2021.
64 Directive 2004/48/EC sets out two types of preliminary injunctions. First, under art 9(1)(a) Member States are obliged to ensure that the rightholders are in a position to apply for an interlocutory injunction against an infringer or an intermediary. Second, art 9(1)(b) obliges Member States to ensure that the competent judicial authorities may 'order the seizure or delivery up of the goods suspected of infringing an intellectual property right so as to prevent their entry into or movement within the channels of commerce' (see Guidance on certain aspects of Directive 2004/48/EC (n 63) 16).
65 ie art 2 of the Directive 2004/48/EC explicitly allows national legislation to provide for means that are more favourable to rightholders.
66 The Enforcement Directive was implemented in France by Law n° 2007-1544 of 29 October 2007 on the fight against IP rights infringement (Loi n° 2007-1544 du 29 octobre 2007 de lutte contre la contrefaçon', for more information see Legifrance (2008) <https://www.legifrance.gouv.fr/dossierlegislatif/JORFDOLE000017758176/> accessed 10 October 2021). The Law introduced the following provisions into the French Intellectual Property Code 1992 (*Code de la propriété intellectuelle 1992*): art L615-3 (patents), art L623-27 (plant varieties), art L622-7 (semi-conductor topographies), art L521-6 (designs), art L722-3 (geographical indications), art L716-6 (trademarks), art L343-2 (copyrights in databases).
67 Bundesgerichtshof, 'Gesetz zur Verbesserung der Durchsetzung von Rechten des geistigen Eigentums' <https://www.bundesgerichtshof.de/DE/Bibliothek/GesMat/WP16/G/geistigesEigentum.html> accessed 10 October 2021.
68 The Intellectual Property (Enforcement, etc) Regulations 2006.
69 Ministerie van Justicie, 'Staatsblad van het Koninkrijk der Nederlanden'(Overheid.nl, 22 March 2007) <https://zoek.officielebekendmakingen.nl/stb-2007-108.html> accessed 10 October 2021.
70 See, however, Danny Friedmann, 'The Effects of the Enforcement Directive on the Dutch Patent Law' (2006) <https://papers.ssrn.com/sol3/papers.cfm?abstract_id=1706070> accessed 10 October 2021 (this author questions whether the introduction of IP-specific preliminary measures brought any substantial changes to the Dutch law in view of the relatively general character of the document and the availability of

judiciary, one of the issues that may need to be explored is whether the existing preliminary measures would be suitable for IP disputes, and whether there is a need to implement IP-specific preliminary injunctions to make IP enforcement more effective.

c) The role of an expert in IP disputes

In some jurisdictions, notably those that do not have an IP judiciary, there is significant reliance by the court on expert opinion. In the past, Ukrainian judicial practice developed in such a manner that the questions referred to an expert were often closely intertwined with issues of law. For example, when deciding on the validity of a patent, the court could often request an expert opinion on such legal matters as to whether a particular feature of a product is new and inventive.[71] However, while the role of an expert may be key in resolving an IP dispute, it is important that they do not assume the role of a judge when providing their assessment of the subject matter in a given IP dispute. In the leading IP jurisdictions, the main role of an expert is to provide judges with knowledge concerning technical matters of the case. Moreover, the law strictly prohibits court experts assuming the role of a judge in deciding legal matters, i.e. an expert testimony is permissible as far as it pertains to questions of fact, not law.[72] For example, the US Supreme Court stated that while in patent cases an expert can explain the state of the art by elaborating upon the meaning of technical terms used in the claim, experts cannot be used to prove 'the proper or legal construction of any instrument of writing'.[73] The latter would be construed as a question of law and thus would fall within the competence of the court. A similar position is followed in all other selected jurisdictions where courts are cautious when examining the scope of an expert opinion since the failure to exclude any questions of law is considered a grave judicial error. Therefore, it is important to clearly delineate the roles of judges and experts in IP proceedings by separating legal and technical issues for the purpose of conducting such an analysis, i.e. while the former issues would be part of a judge's competence, the analysis of the technical side of an IP object would fall within the competence of experts.

IV. Conclusions

The analysis of the leading IP jurisdictions demonstrates that the establishment of a specialised IP judiciary typically leads to high quality judicial practice signalling to individuals and businesses that their investments in IP will be effectively protected. These jurisdictions consistently increase the specialisation of their judiciary in the field of IP, which, in turn, positively influences the quality of their IP jurisprudence. Our analysis of the mature IP jurisdictions reveals that specialised experience and knowledge of IP judges allow them to deal with IP cases efficiently and speedily and to deliver more accurate judgments.[74] In addition, the establishment of a specialised IP judiciary entails the creation of a subject-matter expertise that supports the emergence of an innovation-friendly environment.[75] While there is no 'one-size-fits-all' model when creating a specialised IP judiciary, the discussion in this article sheds light on a number of key factors that should be taken into account and carefully assessed when establishing or reforming such a judiciary. This includes specific considerations related to the structure of the IP judiciary, its location, the specialisation of IP judges, exclusive jurisdiction and other procedural issues. We believe that the guidance provided in this article will assist policymakers in their choices regarding the most suitable design of an IP judiciary in a specific jurisdiction, leading to the enhancement of its operation for the benefit of all the stakeholders involved in the IP enforcement system.

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adequate measures under the general national civil procedure and IP law).

71 Also, the courts in Kazakhstan rely heavily on expert opinion; see the discussion on this matter in the public consultation of the new IP strategy 2021-25 of the Republic of Kazakhstan <https://legalacts.egov.kz/npa/view?id=5772344> accessed 10 October 2021.

72 'Expert Legal Testimony' (1984) 97(3) Harvard Law Review 797, 798.

73 *Winans v New York & Erie R. Co.*, 21 How. 88, 100-101, 16 L.Ed. 68 (1859).

74 USPTO and International Intellectual Property Institute (n 13); Jay P Kesan and Gwendolyn G Ball, 'Judicial experience and the efficiency and accuracy of patent adjudication: an empirical analysis of the case for a specialised patents trial court' (2011) 24 Harvard Journal of Law & Technology 394.

75 EUIPO (n 10).