



Rome II - Intellectual Property Provisions

Introduction and Scope

The Rome II Regulation¹ contains specific provisions for Intellectual Property Rights (IPRs), to determine the applicable law in the event of a cross-border dispute occurring within the EC. It does not cover which court has jurisdiction over a particular case, but rather what law or laws it should apply.

The provisions are contained in Articles 8 and 13. The effect of Article 13 is to make it clear that Article 8 has priority over other rules of applicable law within the Regulation including Article 4 (the general rule for tort). The one exception is that an action for passing off will fall within the rules on unfair competition contained in Article 6 rather than within Article 8.

It is not possible to derogate from, or contract out of (in other words), the rules contained within Article 8.

Intellectual Property Rights and Infringement

Recital 26 of the Regulation contains a wide definition of 'intellectual property rights' which extends to both registered and unregistered rights and includes copyright, trademarks, patents, design rights and plant breeders' rights.

Article 8 does not cover the question of validity of an IPR nor anything to do with creation, registration or transfer of IPRs. Any such questions are ones of status and will remain to be determined by the laws of the country of origin of the IPR or EC law, as applicable.

Article 8(1) and Article 8(2)

Article 8(1) deals with the applicable law for infringements of national IPRs and Article 8(2) deals with applicable law for unitary Community IPRs.

Article 8(1) states that the law applicable to non-contractual obligations arising from an infringement of an IPR (other than a Community IPR) is the law of the country for which protection is claimed. This does provide certainty but will require businesses

to continue to consider the IP protection in the various countries they are active in and may, of course, have the consequence of allowing a claimant to pursue several claims concurrently with each claim relating to the conduct complained of in a particular country.

Article 8(2) states that the applicable law for non-contractual obligations arising from an infringement of a unitary Community intellectual property rights is the law of the country in which the act of infringement was committed. However, Article 8(2) also states that this rule applies only to "any question that is not governed by the relevant Community instrument". So, the first step is to consider the provisions of the relevant Community instrument and then, only if this does not answer the question, the Rome II Regulation. The following rights are unitary Community IP rights:

- Community Trademarks²
- Community Design rights³
- Community Plant Variety rights⁴

Broadly, taking the Community instruments and Article 8(2) together, the applicable law for each of the unitary rights for any infringement claim will be the law of the country or countries in which the infringement takes place.

Patents under the European Patent Convention are not unitary community rights and will, therefore, fall within Article 8(1) and be governed by the law of the country for which protection is claimed rather than where the infringement occurred.

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¹Regulation (EC) No 864/2007 on the law applicable to non-contractual obligations

²Regulation (EC) No 40/1994 on the Community Trademark, as amended by Regulation (EC) No 422/2004

³Regulation (EC) No 6/2002 on the Community Design as amended by Regulation (EC) No 1891/2006

⁴Regulation (EC) No 2100/94 on Community Plant Variety Rights

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