The Role Conferred on the National Judge by Directive 2004/48/EC on the Enforcement of Intellectual Property Rights*

Marcus Norrgård**

I. Introduction

This article discusses the role conferred on the national judge by Directive 2004/48/EC on the Enforcement of Intellectual Property Rights ("the Enforcement Directive"). I will start off by stating that the Directive does not confer a very clear role on the national judge. It does, however, give the national judge different alternatives in construing the provisions, which in essence means that the national judge must actively take a role in the interpretation. The interpretation of the Directive is like Odysseus' journey in the strait between the two monsters Scylla and Charybdis. Since the Enforcement Directive gives room for varying interpretations, it is possible that the court's interpretation leads to too aggressive or too lax enforcement. Too aggressive enforcement is like being eaten by the sea monster Scylla, since it hampers legitimate business in an unacceptable manner. Too lax enforcement is like being swallowed by the whirlpool Charybdis, since piracy and counterfeiting are allowed to flourish. Since the idea is to sail between Scylla and Charybdis without being killed by either, the courts need to ascertain how best to sail between the two monsters. Perhaps it will happen as it did for Odysseus: He lost six crewmen to Scylla, but managed to get through the strait alive. It is perhaps impossible to steer clear of both the Scylla of too aggressive enforcement and the Charybdis of too lax enforcement without damage, but it is perhaps possible to minimise the loss and come out alive. This article investigates how it might be possible to find an optimal course between too aggressive and too lax enforcement of intellectual property rights. The purpose is thus to ascertain how this balancing act is to be done.

II. National Courts in the Community Legal Order

Enforcement of intellectual property law has traditionally been left to national law, through explicit reference to national law or through gaps in treaties and Community legislation. Although legislative action has been active in international intellectual property law, this has traditionally only applied to substantive regulation and registration formalities. This traditional view of enforcement as primarily a national issue becomes evident when we look at two of the main international instruments in the field of intellectual property law: the Berne Convention and the Paris Convention. The Conventions deal to only a minor degree with enforcement issues.

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** Marcus Norrgård, Juris doktor (Helsinki): Lecturer at the University of Helsinki. The author can be reached at marcus.norrgard@helsinki.fi.

The Berne Convention deals briefly with the right to institute infringement proceedings (Article 15). It also provides that there shall be a right to seizure according to national law (Article 16). The Paris Convention provides that the principle of national treatment in Article 2(1) also applies to remedies. Paris Convention Articles 9-10 provide for seizures on importation in trademark and trade name cases. Finally Article 10 provides for “appropriate legal remedies” that effectively repress all infringing acts.

The TRIPS Agreement constituted a paradigm shift in this respect: from only a few provisions on enforcement to detailed provisions on enforcement procedures, sanctions and measures. The TRIPS Agreement covers all essential remedies applicable in IP infringement cases: injunctions, preliminary injunctions, damages, destruction etc. The TRIPS Agreement altered the way of thinking: something that had been the domain of the national parliament and courts was now a matter of international law. The Enforcement Directive is part of this new paradigm. The Directive has its roots in the TRIPS Agreement, and it contains detailed rules and principles on sanctions, measures and procedures. The kinship between the TRIPS Agreement and the Enforcement Directive manifests itself especially in the rules of the Enforcement Directive that are virtually identical to the rules of the TRIPS Agreement.

The role of the national courts in the enforcement of Community law is, and has always been, of vital importance, since the Community does not as a rule have procedural law or laws governing sanctions of its own. It has been said that there are three discernible phases in the ECJ’s view on the Member States’ right to lay down national remedies for breaches of Community law. In the initial phase the Court laid down some basic principles, but restrained itself from using them too aggressively. In the second interventionist phase, the Court placed greater emphasis on the need to ensure effective protection of Community rights. This interventionist approach went perhaps too far, which is why the Court pulled back a bit and thus entered the third, more balanced approach. The Enforcement Directive represents again a more interventionist approach.

According to the Rewe/Comet Rule, which represents the initial phase (but which is still valid), it is, in the absence of any relevant Community rules, for the domestic legal systems of each Member State to designate the courts having jurisdiction and to determine the procedural conditions governing actions at law intended to ensure the protection of the rights which citizens have from the direct effect of Community law. This has been termed procedural autonomy or the procedural competence of the Member States. Although it was already envisaged in the Rewe and Comet decisions that there might one day be relevant

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