



## Resolution

### 2020 – Study Question – General

#### Standing to litigate and effect on remedies

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##### Background:

- 1) This Resolution addresses the *locus standi* / standing requirements for parties in specific types of intellectual property cases.
- 2) This Resolution is without prejudice to any possibilities under national law of representation *ad litem* whereby the interests of a party (the principal or mandator) are represented in proceedings by another entity (an agent, proxy or any equivalent thereof).
- 3) Furthermore, this Resolution is without prejudice to any additional standing requirements under national law for a claim for declaratory relief such as that the declaration should have a useful purpose, not be hypothetical or be of actual and concrete benefit to the party seeking the declaratory relief.
- 4) In paragraph 1(c) below, “exclusive rights of the owner” does not include a bare right to claim infringement of the IP right.
- 5) This Resolution does not require the introduction of new procedures. Specifically, if it is not possible under national law to seek an *inter partes* declaration of invalidity or non-infringement, this Resolution is not intended to mandate the introduction of such a procedure.
- 6) 34 Reports from AIPPI's National and Regional Groups and Independent Members providing detailed information and analysis regarding national and regional laws relating to this Resolution were considered. These Reports were reviewed by the Reporter General Team of AIPPI and distilled into a Summary Report (see links below).
- 7) At the AIPPI World Online Congress in October 2020, the subject matter of this Resolution was further discussed within a dedicated Study Committee, and again in a full Plenary Session, following which the present Resolution was adopted by the Executive Committee of AIPPI.

**AIPPI resolves that:**

Infringement actions

- 1) Any person should have standing to bring a claim for infringement of an IP right if:
  - (a) the person is the owner or a co-owner, of the IP right; or
  - (b) the person is the exclusive licensee of the IP right; or
  - (c) the person is otherwise exclusively authorised (whether directly or indirectly, including by sublicense) to exercise those of the exclusive rights of the owner comprised in the IP right that the person alleges to have been infringed.
- 2) If an IP right is subject to co-ownership, and unless an agreement of co-ownership provides otherwise, each co-owner should have standing to bring a claim for infringement individually, provided that the other co-owner(s) is/are informed of the claim before the proceedings are initiated in order for them to have the opportunity to join the proceedings. A co-owner that chooses not to join the proceeding should no longer have standing to bring the same claim against the same defendant(s) in relation to the same act(s) of infringement afterwards.
- 3) A person with standing to bring a claim for infringement of an IP right should be entitled to seek all available remedies in relation to infringement according to national law.

In rem revocation actions

- 4) Anyone may bring a claim for revocation of an IP right with *in rem* effect generally without any standing requirements taking, however, into account specific standing requirements related to the specific ground for revocation (such as the so-called relative grounds for revocation under trade mark law).
- 5) A claim for revocation of an IP right with *in rem* effect must be brought against at least all owners of record, i.e. including all co-owners, of said IP right, without regard to actual participation by any owner or co-owner.

Inter partes declarations of invalidity

- 6) A claim for an *inter partes* declaration of invalidity of an IP right may be brought:
  - (a) if the claimant is affected by the IP right in some sufficiently actual and concrete way warranting the declaration sought, or

- (b) by a defendant accused of IP infringement. Such a defendant has the right to invoke the invalidity of the IP right as a defence, irrespective of whether the claimant is the IP right owner or not.
- 7) Subject to the conditions in paragraph 6 above being fulfilled, a claim for an *inter partes* declaration of invalidity may be brought against any person with standing to claim infringement of the IP right as specified in paragraph 1) above. A claim for an *inter partes* declaration of invalidity of an IP right must be notified to all owners of record of that IP right, and each owner of the IP right should have the right to join or intervene in the proceedings in which the declaration of invalidity is sought.

#### Inter partes declarations of non-infringement

- 8) A claim for an *inter partes* declaration of non-infringement may only be brought if the claimant is affected by the IP right in some sufficiently actual and concrete way warranting the declaration sought. For a claim for a declaration of non-infringement relating to some proposed subject matter such as a proposed product or process or mark, this principle would require a sufficiently defined and concrete description of the proposed subject matter.
- 9) Subject to the conditions in paragraph 8 above being fulfilled, a claim for an *inter partes* declaration of non-infringement of an IP right may be brought against anyone with standing to claim infringement of the IP right as specified in paragraph 1) above.

#### Administrative tribunals

- 10) The standing requirements should be the same for the same processes in courts and administrative tribunals (such as IP offices).

#### **Links:**

- [Study Guidelines](#)
- [Summary Report](#)
- [Group Reports](#)