

SPECIALIZATION IN INTELLECTUAL PROPERTY OF TRIBUNALS AND JUDICIARIES

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I. Introduction

The question about the specialization or not of the tribunals in the subject of Intellectual Property (IP), is merely one chapter related to the debate on the specialization of tribunals in various aspects of juridical disciplines. Like in all branches of human knowledge, nowadays it is virtually impossible to know appropriately all topics of the different branches through which Law has been evolving and will diversify. “Hunter of many hares does not catch any of them”. Whoever intends to encompass all aspects of juridical knowledge matters, must at most choose some section if he wants to fully master it (option of the specialists) or, in any case, we will content to appreciate what does some surfaces like or to be acquainted with some legal subjects with more or less deepness (election of the generalists). This question could be solved sharing with all beings our information and knowledge, but to treat this exceeds our subject.

Specialization is here to stay in the Judiciaries of all nations, of regional blocks and international unions, as a necessity to attend properly to the demands of the most complexes and various requirements of integral jurisdictional protection the societies have. When certain disputes that have a focused problem or a complexity different from those of other areas reach certain rates or critical numbers, arises the need that these disputes be subject to a differentiated tutelage and a specialized jurisdiction, so that they could be adequately addressed, and to reinforce their protection.

Recognizing the reality expressed in the preceding paragraphs, the concern to circumscribe the scope of competence or thematic knowledge of the Courts to certain fields based on legal knowledge is proposed to improve the accessibility to justice, to substantiate it with economy of resources and to offer an effective resolution through Judges or experienced decision makers, with expertise in the subject matters and their peculiar issues at stake, in both substantive and procedural aspects.

* The author wants to thank Judge Aidelena Pereira (Panama) for her kind suggestions.

[1] Art. 41.5 of the TRIPS: “It is understood that this Part does not create any obligation to put in place a judicial system for the enforcement of Intellectual Property rights distinct from that for the enforcement of law in general, nor does it affect the capacity of Members to enforce their law in general. Nothing in this Part creates any obligation with respect to the distribution of resources as between enforcement of Intellectual Property rights and the enforcement of law in general.”.

Jurisdictional specialization is the *desideratum* of any Administration of Justice. However, the need to specialize jurisdictions by divisions or matters depends on the circumstances and needs of each society, on the complexities of the particular litigious issues that are addressed and the rules that must be applied to them, on the magnitude of the interests that they concur, on the strategic importance that the matter has in the design of the objectives, plans and policies of State in matter of welfare, security, development and promotion of investments, and on the national and international government commitments. To fulfill these demands plausibly, in the field of judicial government it is necessary to promote, create and train more qualified Courts, skilled and knowledgeable of the applicable rules for certain particular issues, especially those of substantial nature. But it is also necessary to organize them and provide them with resources in an appropriate manner.

When we refer to "specialization of a judiciary in Intellectual Property matters" we allude, in expressions of the International Bar Association, to the necessity of a "*a permanently organised body with independent judicial powers defined by law, consisting of one or more Judges who sit to adjudicate disputes and administer justice in the IP field*". For DE WERRA, it means "*An independent public judicial body than can operate at national or regional levels to adjudicate certain types of disputes relating to IP rights, but may also adjudicate other types of disputes*". Intellectual Property issues have characteristics that are uniquely different from those of general criminal, administrative, civil and commercial systems, although they draw on them and share some issues. All jurisdictional specialization seeks to contribute to improving the management and administration of the litigiousness of a problem, and in the matter of Intellectual Property the thing is not different. The specialization of a Judiciary that deals with Intellectual Property matters goes hand in hand with efforts to reinforce and give greater importance to these rights, and shows the concern with which society and its politicians consider these rights.

The particular characteristics of the topic on Intellectual Property, its normative inorganicity that involves various national, regional, community and global norms, the fact that it has technical aspects and its own language, its constant evolution that follows technological innovations and the challenges created to maintain the protection of these rights against illicit trafficking, have warned that these rights must be protected in a differential or independent way with respect to the rest of the Law and the various branches of Law. In the area of Courts, this requires knowledge, sensitivity and peculiar skills in their Judges. If Intellectual Property is not fully understood, not only errors and ignorance in the application of the rules on the matter will be revealed, but an effective protection will not be guaranteed to a sector that contributes through its knowledge, in an important way to the development and growth of a society.

The different countries that have adhered to or ratified the international conventions on Intellectual Property are not obliged to establish national specialized Courts in the field of Intellectual Property. Therefore, it is not considered that this lack or omission could affect its international commitments (article. 41.5 of the Agreement on Trade-Related Aspects of Intellectual Property Rights, or TRIPS) ([1]). Nevertheless, the States are obliged in any case to comply with, and effectively to protect, Intellectual Property

rights in accordance with the available national and international standards, ensuring an accessible, agile, transparent, impartial and effective jurisdiction (arts. 1., 2., 41 to 64 of the TRIPS). It is true that in order to reinforce an adequate observance according with international standards, as well as an indicator to consider the degree of compliance, the administration and management capacity, and the promotion of Intellectual Property, each country within its possibilities should establish specialized Courts in this matter; but each one is free to determine how to do it as long as it tends to make real the values of better justice for these rights.

II. Advantages and problems of judicial specialization in the field of Intellectual Property

We have observed in the previous Section that the discussion on the feasibility or not of specializing a jurisdiction in the area of Intellectual Property participates in similar arguments, for or against, to those that tend to be discussed in the debate on the specialization of the Judiciary in every different branch of Law. Of course, the particularities of the subject of Intellectual Property propose peculiar characteristics in this dilemma.

1. Advantages of specializing Courts to manage issues related to Intellectual Property litigation

National, regional and international rules on Intellectual Property, as well as the protected technologies and the topics to be addressed under them, are complex and dispersed. There is usually a scarce interest in judicial Magistrates, and they even think there is no need for them, to be trained in Intellectual Property matters. The proposals that suggest the necessity to specialize jurisdictions in matters of Intellectual Property arise precisely, as a reaction against the fact of the reality that warns the gaps of knowledge and disinterest that Judges generally show in this subject, who cannot keep up a level that require great technicality and solvency.

It is expected that a specialized judicial professionalization offers a more complete understanding and a better response to the evolution and the dynamics of Intellectual Property rights, where technological innovations are currently affecting them, with the possibility of quickly adapting to new requirements and instruments. The supporters of the jurisdictional specialization in Intellectual Property trust that this will improve the quality of justice in the decisions on that area, betting that the specialization favors instructing and training Judges with better knowledge, improving professionalism in the area. In this line, a Judiciary with expertise in the subject allows a more effective guardianship and management of the interests at stake, as well as more correct decisions of the cases within more time-consuming and more than reasonable periods, which is not always possible when Courts are not specialized and have to address issues of dissimilar nature. In addition, as specialization reduces the number of cases to be administered, and without the burden of having other tasks in many legal disciplines as ordinary general Courts may have, Judges with a primary responsibility in matters of Intellectual Property are at the disposal of develop and perfect their knowledge. It would also serve to decongest the Intellectual Property cases form ordinary Courts, which in many cases they have problems of management and delays in adopting a decision because the Jud-

ges, considering them "difficult", do not pay attention to them or do not provide adequate decisions, sometimes making mistakes.

In its social projection, the Intellectual Property Courts offer greater guarantees to their holders or beneficiaries with respect to the comprehensive protection of their rights, since by knowing the subject better they have better skills to understand the issues at stake, which it would even allow for alternative ways of elucidating the conflict through mediation or intra-procedural conciliation, and if necessary to arrive at a judgment with greater authority. Bearing in mind that Intellectual Property disputes are often related to commercial and business activity, strengthening the jurisdictional knowledge specialized in Intellectual Property could provide Trade and Industry a better access to justice, administered in the key of their interests. When the litigants in the field of Intellectual Property, such a particular and technical field, feel that a Judge with technical competencies in their activity attends them in a different way and shows them that he speaks their own language, that he knows the reality of the market and that he understands the inherent topics of the problem, they feel that their interests are being balanced with better understanding and feel that they are in good hands. Thus, the existence of Courts in the matter of Intellectual Property increases the confidence of the commercial, business and artistic community, especially when intellectual production is related with production and generates incomes, encourages research and knowledge, promotes foreign investment, fosters innovation, and contributes in the instance to economical growth of trade and industry.

This specialization would reduce the number of tribunals to intervene, concentrating and facilitating better access to this peculiar justice, reducing conflicts of intervention between Courts. In addition, by concentrating on legal technical issues, the analysis of the specialized Judges becomes purer and this gravitates in greater independence criteria. Regarding the development of processes and litigation on Intellectual Property issues, it is believed that judicial specialization can contribute to a better economy in terms of litigation costs, in less duration of the hearings and of the trials, and through the unification of procedural criteria and practices, with benefits in the agility and in the best use of the resources of the Justice Administration, increasing the efficiency in terms of time and cost of the processes, and the efficacy in the composition of the litigation.

In another order, it is trusted that a specialization of the Courts in the matter of Intellectual Property would concentrate the formation of a more uniform, solid, coherent and foreseeable Jurisprudence, that would generate its own databases of sentences that would be nourished of such experience and could solidify the knowledge. A dynamic justice according to the evolution of Law, technology and commercial uses, giving greater legal security. It would also promote a better respect, protection and effective observance of Intellectual Property rights, a fact that is currently relieved as an indicator of development for nations.

The specialization of the Judges, by the way, would promote the specialization of the Universities and legal professions in the subject of Intellectual Property, opening a field of work for jurists in general, which would be limited to a number that would require preparation, experience and peculiar skills, enabling greater economic profits.

2. Problems entailed in the implementation of a specialized Intellectual Property Judiciary

The International Bar Association Intellectual Property and Entertainment Law Committee found in a meeting held in 2013 that the lack of adequate knowledge of Intellectual Property in the Judges, is one of the greatest problems in achieving an satisfactory application of these rights. However, not everyone considers it worthwhile to specialize or train a Judiciary in the field of Intellectual Property.

Creating and operating specialized Courts in the field of Intellectual Property involves allocating economic, technological and human resources; not only political will is enough. All this has its cost and requires proper planning. It is necessary to analyze previously what kind of resources are available, because considering a specialization of Justice in the matter of Intellectual Property supposes overloading public budgets. Although assigning the specialization in whole or in part to existing Courts can reduce the cost or even bring it to "cost 0", there can always be unforeseen economic problems when considering doing a Justice reform in this sense. Anyway, it is always important to plan correctly. This implies establishing what expenses will have to be afforded and how they will be paid. It will eventually be necessary to reinforce or redirect funds, which is not without concern for the usually deficient judicial budgets. More precisely, it is crucial to obtain premises for its operation, acquire equipment, determine what kind of administrative and judicial personnel are needed and what allocation in money will require. The need for this investment may be feared it could be an expense. Thus, planning and evaluating "ex ante", how to distribute resources, must be balanced according to the supposed benefits it can provide to individuals and to the quality of the Justice service, whose results can not always be measured in the short term. Besides, to maintain Courts that might handle fewer cases, although of greater complexity, could have excessive costs of operability whose expenses could not be justified.

It is difficult for the different Administrations of Justice to determine what should be the profile and preparation that a specialized Judge in Intellectual Property should have, as well as in what way it should be recruited. For the kind of conflicts that they will process and decide, it is assumed that their remuneration should be commensurate with the particular training and preparation that is required, and that the salary that the State may have to pay should offer them a stimulus of compensation in due consonance.

There are those who believe that allocating Judicial Magistrates exclusively to these issues, because of their reduced margin of competence, means giving them too narrow a scope of legal attention because Intellectual Property is actually a subspecialization within Commercial Law, which in turn is a specialization of general Civil Law. In countries where the Judiciary has a system of promotions, some judicial magistrates may fear that over-specialization and long stay in Intellectual Property Courts may even affect their careers. It is criticized that this "overspecialization" could focus the perspective of these Judges in a very insular field of reality ("*tunnel vision*"), that would make them difficult to integrate other areas or to integrate the realness of the rest of the Law. It is believed that Judges could lose the general perspective whose background could also provide quality elements to solve Intellectual Property conflicts. But as a matter of fact, any specialized

Judges, even the Intellectual Property ones, must possess a good wealth of knowledge of the different disciplines of Law, because with them they enrich the Jurisprudence in Intellectual Property. More than this, centralization and tunnel vision could potentially perpetuate mistakes and wrong Jurisprudence, especially in systems of mandatory jurisprudential precedents.

Furthermore, Intellectual Property Law brings together contributions from all branches of Law, so the Judge who specializes in that area will not lose the general perspective and what is more, he will be able to integrate his knowledge of general Law and of different branches in decisions concerning the field of Intellectual Property. It is said that Intellectual Property, as every legal phenomenon, lives in the realness of the world and in the world of Law, so the specialized Judge in this subject should be integrated with all reality and with the entire legal world, whose tools will also help his resolutions on Intellectual Property disputes. Therefore, the Judge of this matter should not be in a bubble or in any height, since his work is integrated to the whole body of Law. Moreover, by using the tools of general Law to focus on the particular Law of Intellectual Property, he might even notice the contradictions or inconsistencies that specialized Courts sometimes show through their own Jurisprudence.

These disadvantages, however, could be overcome by integrating the Courts of Intellectual Property with Judges with previous generalist experience, or by making them part of the specialized Courts integrating (mixing) them in those tribunal bodies with the expert Judges. Against the perplexities and disadvantages of specialization in the Intellectual Property area, it has been proposed that the Judges who attend this subject could be rotated from time to time. But this causes that all the training of the practiced Judges is lost and their experience cannot be replicated or perfected by the new members, who must resume from scratch and exhibit errors due to their lack of experience, being the litigants those who will suffer in their own interests the negative effects of this replacement.

Some people believe that the over-specialization in Intellectual Property could make the judicial work repetitive and a routine, reducing the intellectual stimulation of the Judge, although in reality, the Intellectual Property is an area that requires continuous training and studying. Legislation and technology in this field are constantly evolving, especially in developed countries. This obliges the Intellectual Property Judges to have a continuous learning to get certain updated erudition and qualifications. After all, permanent training is an imperative for any branch of judicial work in modern times, thus in some countries it has been instituted as mandatory.

It has become a matter of concern that specialization may cause some imbalances and inequalities, which would be to the detriment of the parties and of the prestige of the Justice system.

It has been posed as a disadvantage of the specialization in Intellectual Property, that the members of these Courts could feel that they are a sort of elite, because it is requested in their profile knowledge or requirements more qualified than for the rest of the Magistrates, and because they handle issues of complexity where important interests may

be involved. This makes isolate themselves from their peers, increasing their insularity within the judicial corporation. Regarding that alert, it has been argued that the specialization in Intellectual Property could concentrate a more conservative Jurisprudence and less willing to face new directions, especially in those countries of mandatory jurisprudential precedents.

This class of Judges could also be tempted to alternate with political and economic spheres, forgetting their roles, running the risk that they seek to capture or ingratiate themselves with them, which leads to unwanted interests, ethical conflicts, and politic or economic influences. There is the possibility that specialization, which naturally creates a world of few where everyone knows, facilitates an atmosphere of familiarity and undue relations between Judges, Lawyers and clients. However, we must dismiss this criticism, because good relations are not incompatible with the sense of ethics of each legal operator who remembers that when the time of judgment and decision comes, everyone must be on the correct side they should. In addition, certain good relationships can help Judges or arbitrators to create mediation and conciliation environments, or give them the opportunity to invite them to dialogue and seek compromises or agreements, especially in those countries where intra-procedural conciliation is mandatory or part of the process.

Some people have the idea that Intellectual Property Judges could develop some kind of biases "pro individual" or "pro-Administration" (in the latter case, especially when they must resolve administrative conflicts or lawsuits against public agencies). There is also a risk that governments want to pressure or capture Intellectual Property Judges, with consequent loss of their independence. In practice, would an Intellectual Property justice favor the rights of the rightful owners or creators, or the privileges of the State? How would Intellectual Property rights be integrated into a specialized justice within the context of human rights, and how would they balance each other? It is said that the specialized or elite Judges are theoretically less independent and balancing rights than the generalist ones, and although there is really no evidence to support this affirmation, the suspicion is installed.

Another disadvantage of the jurisdictional specialization in Intellectual Property is that due to its reduced margin of competence, in practice these Courts would only work in large cities or in development poles, centralization that for many people would suppose due to being far from such nuclei, with consequent restrictions because of distances or difficulties of geographic access to that justice, or the discrimination that their cases for the simple reason of distance should be attended by the generalist Judges, usually not very affected to the matter, of their localities. In addition, the specialization would favor the creation of a circuit of lawyers and law firms very particularly prepared and inclined towards a commercial and business counselling practice, which could raise the costs of litigation. All this could cause difficulties of access to comprehensive and effective justice, overheating of expenses, an exclusivist and very competitive forensic environment, with nocive effects on equality rights.

It is believed that the specialized attribution of Intellectual Property to certain Courts could increase the litigation in the matter, which would collapse those tribunals. There

is no data to support that this possibility can happen, but if the system "dies of success", the Judges will suffer the personal consequences imposed by this overload. The statistics and the administrative monitoring of the Intellectual Property Courts movement in any case, will determine if this fear would have been or not founded.

Many operators consider that in practice, specialization does not ensure difference, nor uniformity, nor success, nor quality in judicial decisions, nor does it translate into higher levels of protection of those rights. Neither does it mean in the facts that those judgements will be quicker in their processing than in the rest of the general litigation. Some experiences, such as that of India, had not seen in 2016 significant results in terms of speed ([2]).

In order to try to solve the problems that arise in a process on Intellectual Property, or even on complex and technical issues such as patents, no Judge needs to be an expert. It is enough that he can be able to understand the problems concerned (this requirement is as necessary in a common generalist as in a specialized one) in each case, since most of them involving Intellectual Property are not so complicated in their elucidation as it is commonly believed. It is thought that as in all justice, it is good for Judges to have first of all his common sense (especially in matters of confusing or counterfeiting, where Judges must be mentally situated in a market and inside the mind of an average consumer), to study in depth their case, and if they know Intellectual Property Law, even better. It should be demystified the idea that Intellectual Property Justice should be elitist or specialized.

There is a prejudice that a non-specialized Judge would not understand the complexity of Intellectual Property Law. This supposes underestimating the intelligence and the ability to study or analyze of the Judges. The technical deficiencies or the unfamiliarity of Magistrates with the state of the art in the area of Intellectual Property can be compensated with the advice of experts who will provide them the data and technical knowledge the Judge naturally does not have, and as for the alleged legal difficulties, these can be always overcome with a greater study of the issues involved in every case, without necessarily having to import more time. But anyway, could not this be solved with opportunities of training for general Magistrates or for Judges with criminal, civil or commercial competence, and on the other hand proposing legislative reforms or international instruments that seek a certain simplification or codification of the subject of Intellectual Property? After all, many Magistrates who make up the specialized Intellectual Property Courts were recruited from the general justice system and made their experience gradually.

In South Africa, the Commission of Inquiry into the Structure and Functioning of the Courts (the Hoexter Commission) examined the creation of specialized Intellectual Property Courts and concluded that they have no justification. It was argued that the subtleties inherent in Intellectual Property rights could be entrusted to mere mortals; that the complexity of Patent Law was not to understand its principles, but to extract the essence of the facts to which they should apply; and that specialization could lead to narrow-mindedness. In very rare cases it can be said that the cases related to trademarks and copyright are really "technical" (possibly with the exception of computer programs,

musical works and patents). Sometimes, common sense may be more important than technical knowledge. The issues of falsification, in the point of view of that mentioned Commission, are very simple from the point of view of the Law, because there are no significant differences around the limits of the rights of the owner of the mark. The conduct of the counterfeiter, who imitates the goods and brands, is undoubtedly part of the type of conduct that the owner of the trademark has the right to avoid ([3]). The same can be said about copyright piracy. It does not follow from all this that there cannot be differences of opinion between sensible people (and between sensible Courts) in matters of Intellectual Property. Neither does it mean that more complex problems of private international and jurisdictional law related to cross-border and digital infractions are not going to arise, which are not very different from other cross-border crimes such as money laundering or smuggling. But with hard work and due technical advice, everything can be resolved judicially.

III. On the controversy “specialization vs. non-specialization”

Is a sub-specialization of Judges necessary in Intellectual Property? Is it worth, in relation to the number and nature of the cases they may have? We have seen pros and cons. This discussion will be fueled by reasons of values, interests and even prejudices.

Promoting Intellectual Property is necessary, because it is a tool for innovation, development and the achievement of the general interests of society. To ensure this promotion, the Intellectual Property rights should be backed by a swift and effective legal protection. But should this path be set in a dilemma about whether this protection should be specialized or not?

It is not possible to give a categorical answer to the question whether it would be beneficial to establish specialized Courts on Intellectual Property or not. It is true that the specialization of the various activities of human labor, and of course specialization in jurisdictional activity, is a global trend as we all know it has long been imposed in the legal world. However, in this particular question like specialization of Courts is, this must be framed within the particularities of the territory in which it operates.

In the very special subject of Intellectual Property, the discussion on whether or not to specialize jurisdictional knowledge in this regard should be established in the social and political sphere of each country and in the blocks of nations to which they are linked, because each one is free, within its reality, its resources and its needs, to decide how its Administration of Justice should act in this matter, and if so, to determine what type of judicial body or bodies should have jurisdiction to hear the related disputes.

With practical and realistic mind, the TRIPS (Art. 41.5) gave the nations the option to create or not specialized Courts in the matter of Intellectual Property. It means that it is an election whose decision is exclusive for each State. Within this line, countries can decide discretionally and sovereignly how Justice will be administered in conflicts on Intellectual Property in its territory, and through what kind of judicial organs: administrative, contentious administrative, ordinary or specialized ones. Or eventually favoring the decision of disputes on that matter through arbitral tribunals.

We could say that there is no single model for establishing an effective jurisdictional system of Intellectual Property that guarantees efficiency or that resolves the demands of society in the matter. Planning and designing a special system would merit considering many factors of each country and even of its different geographical regions, its different activities and economies, what impact do creativity and intellectual innovation have on the production and the Gross Domestic Product of each nation, how its social, political, legal and administration system of justice is, and which regional and international commitments they assumed. It is also necessary to assess in an objective, documented and unbiased form what budgetary resources, equipment and human personnel is counted and if not so, how they could be provided, what the real costs are, which likely number of cases would be met, and what the relationship between cost-benefit would be. This balance will emerge if necessary, or whether it is worthwhile, first to decide to specialize Courts on Intellectual Property, if this specialization should be partial or gradual, whether it should be limited to certain communities, whether it should cover all litigation relating to Intellectual Property or in its merit, what kind of conflicts it should address, in what instances of the procedure or at what judicial levels should the specialization be made.

Therefore, it cannot be established for each country, and even for the different regions within them, any supposed ideal model of specialization. What works well in a territory may not work in another.

In certain cases, this reform offers problems of legal nature, which would even require redesigning up to constitutional standards. For example, in Uruguay, the review of the acts of all State agencies is dealt with, according to its Constitution, by the Contentious Administrative Court (separate and independent branch of the Judiciary and the system of powers, similar to the french "Conseil d'État"); among them, this Court reviews jurisdictionally the administrative acts related to the concession, denial, nullity and expiration of Intellectual Property rights (in practice mainly, trademarks and patents, in copyright there are few cases). It can within their orbit be created first and second instance specialized Courts to handle these cases. But if the government wants to create Courts with special jurisdiction on all issues of Intellectual Property, including damages or cessation of use, it is necessary to make a constitutional reform that would give to the Contentious Administrative Court the knowledge of that cases, or that could move contentious administrative proceedings on Intellectual Property rights to the ordinary Judiciary.

Although there are some global or comparative studies on the reality of different countries regarding the organization of jurisdictional knowledge of Intellectual Property conflicts, currently analyzing how Intellectual Property Justice works in all countries, we believe that there are not any synoptic analysis of different realities which could establish standards or detect common patterns, in order to have a universally recognized classification on how the different models of Intellectual Property Justice could be grouped. Some lists of countries that are supposed they have jurisdictions specializing in Intellectual Property offer controversies regarding the criteria used for classification, because everything depends on how a Court is defined as "specialized in Intellectual Property". Perhaps it would be very laborious to make a classification and a universally defined list

of jurisdictional protection systems for Intellectual Property that would be supported by an international organization (such as, for example, the World Trade Organization or the World Intellectual Property Organization), and that could even be updated, but it would not be impossible. The different reports on the observance of Intellectual Property rights (Articles 7, 41 to 61 of the TRIPS) by the different countries could be a valuable input of analysis, so that based on them, we could watch strengths and weaknesses of their Judiciary Powers in the area of Intellectual Property, as well as to analyze their comparative characters and models of Administration of Justice, and what would be the *desiderata* of judicial enforcement in this area. The results of these investigations would not oblige the nations to adopt certain policies or guidelines regarding judicial policy for the enforcement of Intellectual Property rights, but they could provide material for self-criticism, to try solutions for improvement, or to improve the paths already advanced.

States, or rather, their political systems, do not always have an interest in considering Intellectual Property as a strategic tool or in understanding the contribution it could make to the development, security and welfare of a nation. In addition, the multiple needs that all societies and their governments have, require that in many cases the concerns and resources must be concentrated to meet other needs of priority and urgency. That is why it is natural to understand that the discussion on the need to specialize or not jurisdiction in matters of Intellectual Property may not always be part of the Governments Agenda, even appearing as an insular issue or of minor importance with respect to other issues (think for example, about Education, Health, internal and external Security), which does not involve a critical sector of the society.

The needs to provide specialized Courts in Intellectual Property are usually observed in matters for which special technical or constantly evolving knowledge is required, or which are in perpetual technological renovation, mostly in the case of patents and trademarks. However, copyright issues, considering the increasingly technified forms of reproduction and forgery, would also require particular knowledge.

In countries with a small number of Intellectual Property cases in their Courts, especially those in development, the need for specialization is not justified. In any case, this does not prevent their Judges from receiving special training in these matters, or that a partial specialization be established using pre-existing Courts. When for whatever reasons, a country does not have a specialization of Justice in matters of Intellectual Property, the desired thing would be that its Judges have opportunities for learning or training, or the possibility of accessing bibliography or specialized Jurisprudence banks of its territory or foreign systems.

Another issue is, once the creation of a specialized intellectual property judiciary is decided, what kind of issues will be given to them. In some cases it could be assigned to them all the Intellectual Property Rights conflicts, in others only some such as patents or trademarks, and in other cases all the different jurisdictions that may be involved, civil, commercial, administrative and criminal (Thailand).

Assuming that a country decides to concentrate and start up, whether or not it has been negotiated or passed a discussion on all the issues raised, a jurisdiction or Courts

in matters of Intellectual Property inside the structure of the Judiciary, which Judges should be selected or appointed to rise to the occasion? How should its structure and its human team be equipped? Within these issues, it should be studied what training would be required to these specialized or partially specialized Judges. Should they be recruited from among the existing judges and afterwards specialize them, or should they be sought outside the system with their own knowledge or training in the area of Intellectual Property? The profile of the Judges of Intellectual Property must require Judges with training in the Law of the subject, or technical expert judges. These Judges may have a disciplinary team of experts or experts to advise them by providing them with the technical knowledge that illustrates the Judges when deciding. Would we prefer setting up mixed Courts with legal Judges and lay technical Judges (as in the Federal Patent Court of Germany)? There is no dispute that the appointed Judges to manage Intellectual Property issues should have an official legal degree, because they handle mainly legal issues. Eventually Judges with technical qualifications or training may be required, in addition to an official legal degree, to have technical training. Or even lay judges, technical experts who do not need legal title, but who are appointed technicians to integrate the Court's membership through a specific designation process.

Once these specialized Intellectual Property Courts have been created or the assignment of the subject has been determined to some of the existing ones, it should be monitored how much more successful, efficient and better than the ordinary ones are. In practice, this never ceases to depend on the work capacity of the Judges who support these Courts.

It is more feasible that the specialization in Intellectual Property Justice occurs in the most developed and technified countries, which are generally those where there is an important economic movement or registrations of patents, trademarks or artistic works, influencing in the generation of its Gross Domestic Product, where the ordinary or administrative litigation of these rights is high. It could be noted that specialized jurisdictions in Intellectual Property are usually established in Capitals, important cities or jurisdictions generally located in centers of highly industrialized regions, or in cities where Industrial Property offices or sections of these offices are located, where the need for a specialized jurisdiction is naturally high.

As a matter of fact, specialization in Intellectual Property exists only for a small number of Courts. With a small number of Courts of first instance and Appeal Courts, the need for specialized judges can be met. A certain observation would allow to notice that the tendencies to the specialization in the subject of Intellectual Property are given from specializing some of the generalist or mercantile Courts already existing. Many countries have opted for the creation of Intellectual Property jurisdictions using, either exclusively or in a partially specialized form, preexisting civil or commercial Courts, assigning the specialized matter to their members or to certain Chambers or Sections of these Courts. This allows using the available infrastructure of the Judicial Powers, with optimization of resources and reducing the costs involved in organizing the creation of jurisdictions specializing in Intellectual Property. To avoid tunnel or insularity specialization, it is proposed to rotate the Judges from the ordinary Courts to Intellectual Property ones and *vice versa*, totally or partially.

The competence of specialized jurisdictions in Intellectual Property matters varies, depending on the type of rights in question (some jurisdictions only handle about specific Intellectual Property rights issues, usually trademarks or patents) or the type of issues which are of its exclusive competence (some Courts may be devoted to hearing the requests for invalidation or infringement). In addition, in some jurisdictions there is a monetary threshold for a dispute to be attributed to the jurisdiction of certain Courts. It must be decided whether the judicial specialization in Intellectual Property must be carried out for all the matter (possibly, a Court attending all -copyright, trademarks and patents-), or if it should be partially established, especially in areas where more complex and technical knowledge is required, such as patents or trademarks. Many nations have independent Courts specialized in cases of Intellectual Property, generally for questions about patents or trademarks, especially for cases related to disputes over their use. But other countries have organizations that deal with cases of Intellectual Property through administrative procedures, whose conflicts or claims by the resolutions of those bodies on validation, invalidation, concession or granting of rights can be reviewed by an administrative justice or Boards of Appeal within their bosom, or be submitted to a review in an independent Court of the Judiciary.

In some countries, administrative jurisdictions can be created within the same Industrial Property or Copyright organizations (the latter, the case of Colombia); that is, outside the Judicial Power. All this without prejudice to the fact that the decisions of these "administrative justice" Courts can be reviewed jurisdictionally. It is also the case of India (the Indian Intellectual Property Appellate Board understands appeals against administrative decisions of the competent bodies on trademarks and patents), or the Board of Trial at the level of the Korean Intellectual Property Office (South Korea, in case of patents and trademarks), appealable to the Court of Patents or to the District Courts (the latter in matters of Trademarks), and eventually to the Supreme Court. This is also the case of the Specialized Intellectual Property Chamber of the National Institute for Defense of Competition and Protection of Intellectual Property (INDECOPI) in Peru, that decides in appellation administrative decisions of the offices of this institute, whose decisions can be revised through jurisdictional litigation (similar is the Dominican Republic system). We think that entrusting the solution of conflicts or claims against decisions of the administrative bodies of Intellectual Property to an independent Judicial Power, could be considered a more advantageous option than resorting to "administrative Courts", to avoid the undue interference of the political powers over them, even if their decisions could be subject to judicial review. An intermediate regime, in case the States decide to establish administrative tribunals, must allow their resolutions to be appealed before Courts of the Judicial Power or Contentious Administrative Courts.

Generally, the specialization of Courts in the sphere of Intellectual Property is usually proposed more for civil or commercial Bodies than for criminal justice. Therefore, it is not common for there to be criminal Courts specialized in Intellectual Property crimes (these crimes tend to be prosecuted by the ordinary criminal justice system), except for certain forms such as organized piracy and counterfeiting which are adjudicated in criminal Courts against organized crime, or for some specialized tribunals in matters of Intellectual Property that share the criminal competence with the civil and commercial jurisdiction in that subject.

In different countries, specialized jurisdictions in Intellectual Property solve cases through Courts of first instance and Courts of Appeals, and ultimately or in cassation the dispute is usually decided by a High Court or a Supreme Court (not specialized) ([4]). In countries whose Supreme Court of Justice works with Chambers ("Salas", in the Latin American model), it has been proposed to give the problematic of Intellectual Property to a partially specialized Chamber, that usually considers commercial issues.

In other cases, the specialization is given not in the first instances, but in collegiate Tribunals or Courts of Appeals, such as the United States Court of Appeals for the Federal Circuit. In others, a specialized competence is established such as the Patent Courts (they are part of the Chancery Division of the High Court) and the County Patents Courts, which in appeals have a patent specialist Judge in the Commercial Court of Appeals, as in the United Kingdom. In other countries there is a specialized Court such as the Thailand Central Intellectual Property and International Trade Court that acts in civil and criminal matters, which includes career judges and experts in certain areas of Intellectual Property, whose appeals are addressed to an Intellectual Property and International Trade Division of the Supreme Court of Justice.

There is a tendency to specialize the Intellectual Property jurisdiction mainly for issues of patents and trademarks, leaving the other disputes in charge of ordinary Courts (a trend that can be seen in Europe, towards a Unified Patent Court).

Another option is to leave the civil, commercial and criminal Intellectual Property trials in charge of ordinary Courts, and submit to a specialized administrative contentious jurisdiction (sometimes outside the system of the Judiciary, such as the Court of Contentious Administrative) issues of administrative concession, refusal, nullity or expiration of trademarks and patents.

It is always necessary, no matter what system any country chooses, to provide its Courts with surveyors or technical experts, who complement the knowledge of those on technical issues the Judges lack. These experts could be part of the judicial body, its auxiliary personnel, or work as external advisors that the Judges prefer, or through a list that the parties choose or that the courts can resort to.

It could be proposed that the Intellectual Property Courts be of plurality of members or collegiate, with mixed integration of legal and technical Judges according to the type of Intellectual Property right at stake (for instance, the case of the Courts of Appeals in the United Kingdom). This solution could apply different knowledge and experiences in a confluent way, combining in the decision technical and juridical elements, complementing each other.

It can be questioned if the Intellectual Property Judge could be a technician, possibly layman in Law. The answer could be positive for strictly technical or administrative Courts, or in arbitrations where the technical issues are decisive. However, when assigning what right corresponds, they would not have the capacity to determine the legal issues at stake. Therefore, the Courts that resolve Intellectual Property issues must necessarily be integrated by Judges of Law, although the number of collegiate Courts could be integrated in

some proportion by lay technicians, notwithstanding the fact that in practice the technicians usually work at the judicial level as assistants experts or experts providing for the illustration of the Judges, in a non-binding or obligatory way in their decisions.

The regionalization of Intellectual Property has led to the establishment of jurisdictions that contemplate the requirements of the International Community or the federal countries internally, especially in the field of patents and trademarks. It is the example of the Andean Community Court of Justice, and the Unified Patent Court in the European Union (in process).

The liberation of the resolution of conflicts in the matter of Intellectual Property to Chambers or Courts of Arbitration is considered as a solution to solve privately in a faster, cheap and specialized way those questions, decongesting the work of the jurisdictional Courts or administrative litigation. However, nothing ensures that this arbitral justice will be more economical, quicker and more effective than the work of the judicial Courts. A problem that also have arbitrations, is how to execute their decisions if the parties do not agree to the decision voluntarily; for which they end up needing to resort to the Judicial Powers.

IV. Different specialization models

Following the International Bar Association, Brian Pearce and the International Intellectual Property Institute with our modifications, we could establish a tentative classification on different systems in which the judicial specialization in Intellectual Property matters has been organized. It is a strictly personal proposal, subject to discussions:

1. Countries with specialized Courts, with special jurisdiction in cases of Intellectual Property (f. i., Thailand, Kenya, United Kingdom);
2. Countries that created Courts that deal with cases of Intellectual Property (Australia, Singapore);
3. Countries with general jurisdiction Courts with special Divisions that deal with cases of Intellectual Property with specialized Judges (Brazil, Canada);
4. Countries whose commercial Courts address Intellectual Property issues in addition to other commercial issues (Argentina, Morocco, Spain);
5. Countries with Courts of Appeals with specialization for Intellectual Property cases (United States);
6. Countries with administrative Courts, whose decisions can be reviewed jurisdictionally (India, Peru);
7. Regions with specialized Courts or with competence in Intellectual Property matters (Andean Community Court of Justice, "Unified Patent Court" of Europe);
8. Countries without specialization (Uruguay, Trinidad and Tobago).

V. By way of conclusions

Although certain countries are not obliged to have a specialized jurisdiction in Intellectual Property matters nor to follow a model in this respect, the demands of Industry, Commerce and Technology require consideration for the best effective protection of Intellectual Property rights, and thus the alternative of creating or giving specialization in that matter to some Courts in a total or partial manner.

We have warned along these considerations the pros and cons that are often argued in the debate on the specialization of Justice in Intellectual Property, as we have also seen some solutions adopted by certain countries. The final definition will be subject to the political decisions taken by each nation, balancing costs and available resources, what kind of Judges should be needed, how important countries consider Intellectual Property rights in their development, and what commitments they have in this regard.

We do not intend to establish a position on this subject, but to present a panorama on the main elements to consider in the debate "judicial specialization vs. non-judicial specialization in the area of Intellectual Property. In our understanding, the *desideratum* of each country, to decide on the specialization or not of its Judges in IP, must contemplate complying with the procedural standards required by Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), such as:

- a) They must be destined to comply with the TRIPS (article 1.1 of the same);
- b) They must guarantee protection quickly and effectively (principle of effective judicial protection), in accordance with arts. 41.1, 42 and 43 and ccs. of said Agreement;
- c) They must have mechanisms to adopt rapid and effective injunctions, provisional or precautionary measures (articles 44, 51 and 52 of TRIPS);
- d) They must ensure due contradiction and defense (articles 41.3 and 50.4 of TRIPS);
- e) They must guarantee a fair, equitable and impartial justice, with written, well-founded and reasonable decisions, based on evidence support, that will stop unlawful practices and, if appropriate, grant appropriate compensations or satisfactions (articles 41.2 and 41.3 , 42, 43 to 45 TRIPS);
- f) They must ensure an adequate standard of double instance (Article 41.4 TRIPS).

An intellectual Property Judge must first of all be an expert in Law, but the should be provided with adequate training and education in the relevant areas. It is not necessary for him to know the technical issues, especially when this knowledge can be provided or advised by experts, eventually external or independent (possibly within an official List of experts who have evaluated them to have a certain standard of seriousness), or as a stable official of the Judiciary, whose opinion does not have to be binding or mandatory for the Judge.

Geneva, 8 November 2018

Bibliography

Comité Asesor sobre Observancia, Undécima sesión, Ginebra, 5 a 7 de septiembre de 2016, “Mecanismos para resolver controversias de Propiedad Intelectual de forma equilibrada, holística y eficaz. Contribuciones preparadas por el Pakistán, Portugal, la Federación de Rusia, Sudáfrica, Tailandia, el Reino Unido, la Cámara de Comercio Internacional y el Profesor Jacques de Werra, de la Universidad de Ginebra (estudio conjunto de CEIPI-ICTSD)”, WIPO/ACE/11/7, Geneva, 20 June 2016.

Comité Asesor sobre Observancia, Duodécima sesión, Ginebra, 4 a 6 de septiembre de 2017, “Mecanismos para resolver controversias de Propiedad Intelectual de forma equilibrada, holística y eficaz. Procedimientos judiciales eficaces. Contribuciones preparadas por Egipto, Panamá y Suiza”, WIPO/ACE/12/6, Geneva, 30 de junio de 2017.

FRILET MARC - KARILA Laurent, “The critical role of judicial experts in construction litigation and arbitration in France”, *Construction Law International*, Volume 8 Issue 2 June 2013, ps. 42-44.

INTERNATIONAL INTELLECTUAL PROPERTY INSTITUTE, “Study on specialized Intellectual Property Courts”, en “<https://iipi.org/wp-content/uploads/2012/05/Study-on-Specialized-IPR-Courts.pdf>”, paper, 2012.

PEARCE Brian, “Is there a need for specialization by the Courts and the Prosecutors?”, paper, in “<https://www.asean.org/uploads/archive/21388-4.pdf>”.

POPA Gheorghe, NECULA Ionel , “Study on expert status in the European judicial system”, in “*Agora International Journal of Juridical Sciences*” No. 3, 2013, ps. 161-168.

WERRA Jacques de, “Specialized Intellectual Property Courts - Issues and Challenges”, with contributions by Denis Borges Barbosa and Pedro Marcos Nunes Barbosa, Hong Xue, Shamnad Basheer and Susan Isiko Štrba, Issue Number 2, ICSTD - CEIPI, Geneva, 2016.

THE INTERNATIONAL BAR ASSOCIATION - Intellectual Property and Entertainment Law Committee, “International Survey of Specialized Intellectual Property Courts and Tribunals”, International Bar Association, London, 2017.

[2] WERRA Jacques de, “Specialized Intellectual Property Courts - Issues and Challenges”, with contributions by Denis Borges Barbosa and Pedro Marcos Nunes Barbosa, Hong Xue, Shamnad Basheer and Susan Isiko Štrba, Issue Number 2, ICSTD - CEIPI, Geneva, 2016, p. 56.

[3] HARMS Louis, “La experiencia sudafricana”, in COMITÉ ASESOR SOBRE OBSERVANCIA, Undécima sesión, Ginebra, 5 a 7 de septiembre de 2016, “Mecanismos para resolver controversias de Propiedad Intelectual de forma equilibrada, holística y eficaz. Contribuciones preparadas por el Pakistán, Portugal, la Federación de Rusia, Sudáfrica, Tailandia, el Reino Unido, la Cámara de Comercio Internacional y el Profesor

Jacques de Werra, de la Universidad de Ginebra (estudio conjunto de CEIPI-ICTSD)”, WIPO/ACE/11/7, Geneva, 20 de junio de 2016. WERRA Jacques, “Specialized...” cit., ps. 26-27. Nevertheless, South Africa has a “Court of the Commissioner of Patents” with exclusive jurisdiction in patent matters, whose appellations go to an ordinary Appellation Court integrated with at least one specialist Judge in patent subjects.

[4] There are, for example, Courts with different degrees or levels of specialization in Intellectual Property matters, like in Germany, Belgium, Brazil, Chile, China, Slovakia, Slovenia, Spain, United States of America, France, Kenya, Hong Kong, Holland, Hungary, Israel, India, Italy, Jamaica, Japan, Mexico, Norway, New Zealand, Pakistan, Peru, Portugal, United Kingdom, Republic of South Korea, Romania, Russia, Singapore, South Africa, Sweden, Switzerland, Thailand and Turkey.