ARTICLE 42

1.1 Text of Article 42

**Article 42**

*Fair and Equitable Procedures*

Members shall make available to right holders\(^{11}\) civil judicial procedures concerning the enforcement of any intellectual property right covered by this Agreement. Defendants shall have the right to written notice which is timely and contains sufficient detail, including the basis of the claims. Parties shall be allowed to be represented by independent legal counsel, and procedures shall not impose overly burdensome requirements concerning mandatory personal appearances. All parties to such procedures shall be duly entitled to substantiate their claims and to present all relevant evidence. The procedure shall provide a means to identify and protect confidential information, unless this would be contrary to existing constitutional requirements.

(footnote original)\(^{11}\) For the purpose of this Part, the term "right holder" includes federations and associations having legal standing to assert such rights.

1.2 "right holders"

1. In *US – Section 211 Appropriations Act*, the Appellate Body considered that the term "right holders" included not only persons who had been established as owners of rights but also persons who claimed to have legal standing to assert rights:

"We agree with the Panel that the term 'right holders' as used in Article 42 is not limited to persons who have been established as owners of trademarks. Where the TRIPS Agreement confers rights exclusively on 'owners' of a right, it does so in express terms, such as in Article 16.1, which refers to the 'owner of a registered trademark'. By contrast, the term 'right holders' within the meaning of Article 42 also includes persons who claim to have legal standing to assert rights. This interpretation is also borne out by the fourth sentence of Article 42, which refers to 'parties'. Civil judicial procedures would not be fair and equitable if access to courts were not given to both complainants and defendants who purport to be owners of an intellectual property right."\(^{1}\)

1.3 Rights covered by Article 42

2. In *US – Section 211 Appropriations Act*, the Appellate Body considered the nature of the rights covered by Article 42:

"From all this, we understand that the rights which Article 42 obliges Members to make available to right holders are procedural in nature. These procedural rights guarantee an international minimum standard for nationals of other Members within the meaning of Article 1.3 of the TRIPS Agreement."

3. In *US – Section 211 Appropriations Act*, the Appellate Body considered the situation in which a requirement of substantive law made it impossible for a court to rule in favour of a claim to a trademark right and found:

\(^{1}\) Appellate Body Report, *US – Section 211 Appropriations Act*, para. 217.
“There is nothing in the procedural obligations of Article 42 that prevents a Member, in such a situation, from legislating whether or not its courts must examine each and every requirement of substantive law at issue before making a ruling.”

4. In US – *Section 211 Appropriations Act*, the Appellate Body applied its findings in respect of Article 42 of the TRIPS Agreement with regard to holders of rights in trademarks and holders of rights in trade names as well.

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