

# **Advancing National Intellectual Property Policies in a Transnational Context**

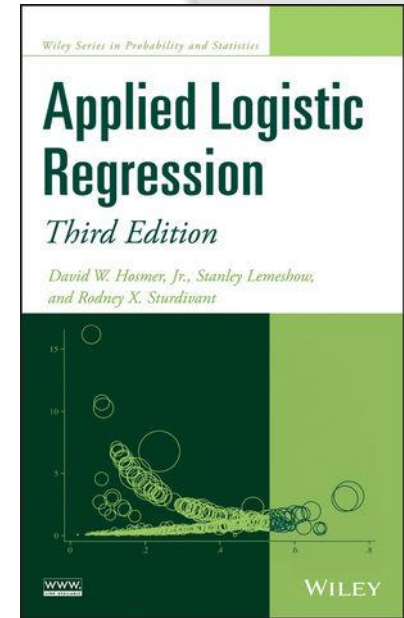
**Marketa Trimble**

International Intellectual Property Scholars Roundtable  
May 1, 2014

Clarity in the *reach* of national laws is ...  
no less important for legal certainty than is  
clarity in the *substance* of national laws.

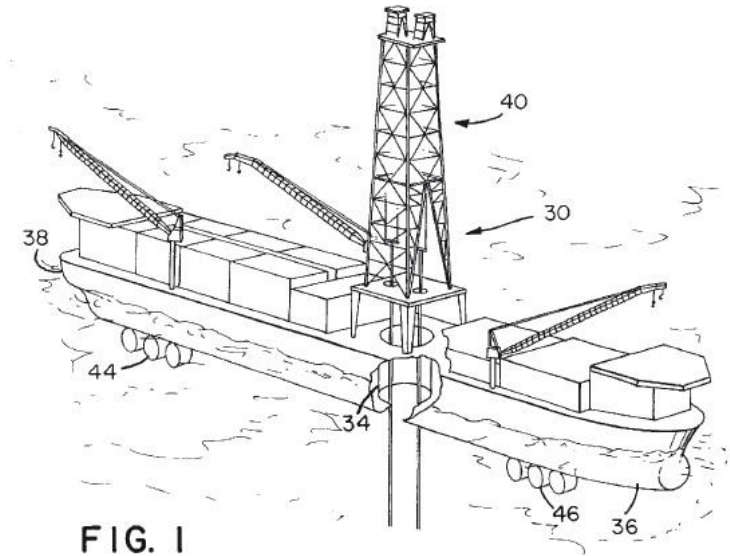
# Territorial Scope of IP Laws

- ◉ Kirtsaeng v. John Wiley & Sons, Inc., 133 S.Ct. 1351 (2013)



# Territorial Scope of IP Laws

- ◉ *Kirtsaeng v. John Wiley & Sons, Inc.*, 133 S.Ct. 1351 (2013)
- ◉ *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Contractors USA, Inc.*, 617 F.3d 1296 (Fed. Cir. 2010) (cert. pending)



“Both historical and contemporary statutory context indicate that **Congress**, when writing the present version of § 109(a), **did not have geography in mind.**”

Supap Kirtsaeng, dba Bluechristine99 v. John Wiley & Sons, Inc.,  
133 S.Ct. 1351 (2012) (J. Breyer)

⊙ National IP laws legislated (mostly) for purely domestic cases

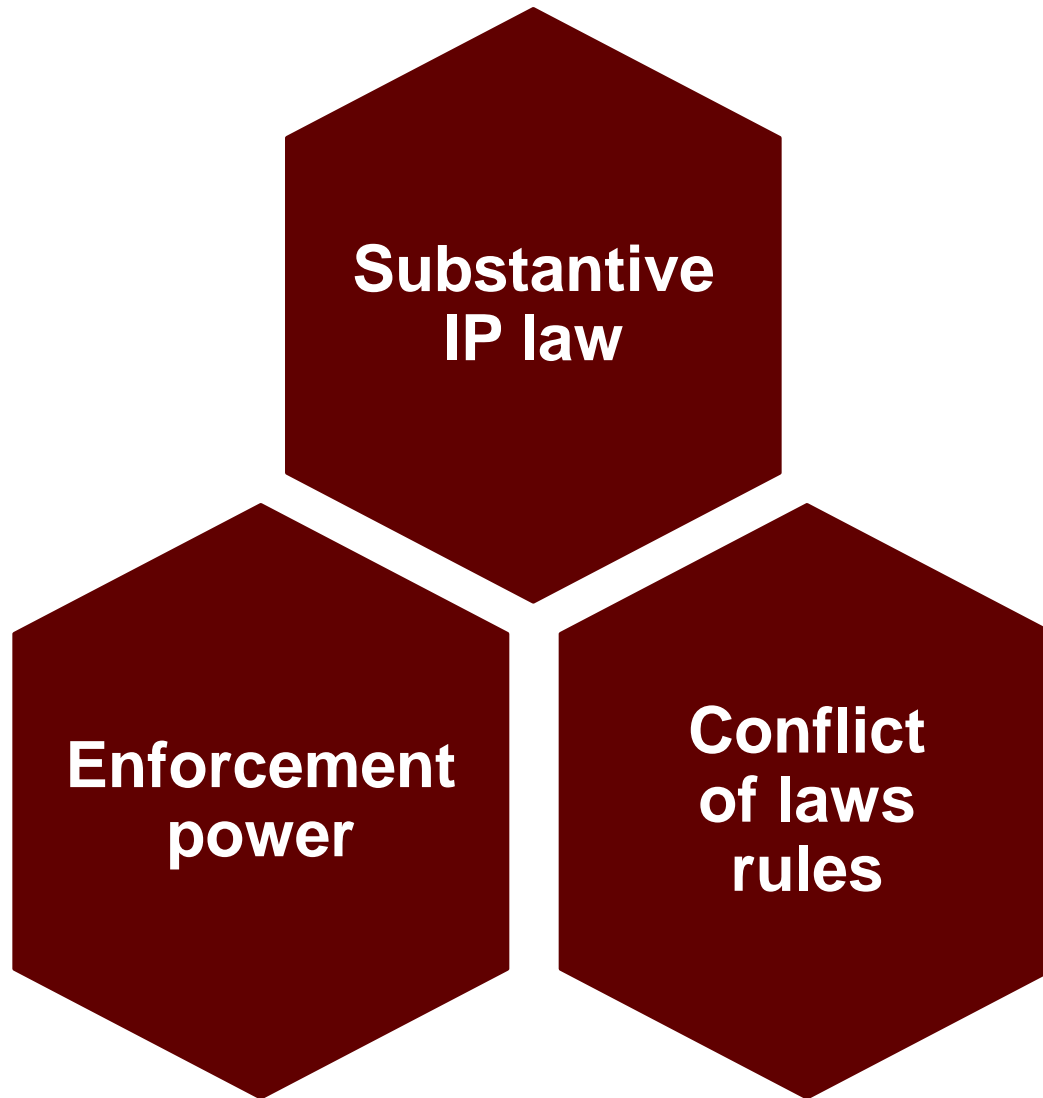
• Exceptions:

- U.S. Patent Act, 35 U.S.C. §271(f) and (g)
- DMCA, 17 U.S.C. §512(g)(3)(D)

⊙ International treaties negotiated (mostly) for single-nation cases

• Exceptions:

- Berne Convention, Article 5(2)
- WIPO Marrakesh Treaty, Article 5



# “Instrumental” Use of Conflict of Laws Rules

- ◉ **Interaction of policies and conflict of laws rules**
- ◉ **Conflict of laws rules design**
  - Design calling for consideration of substantive policies
  - Design influenced by substantive policies
- ◉ **Proliferation of conflict of laws rules**
  - Legislated rules
  - Approaches developed by courts



# Flexibility to Shape Conflict of Laws Rules

- ⊙ **International treaty obligations**
  - The Hague Conference initiative
  - Convention on Choice of Court Agreements (2005)
  - EU: Brussels I Regulation (recast), Rome I and II Regulations
- ⊙ **Comity**
- ⊙ **Inter-country cooperation**
- ⊙ **Higher laws in a country's national hierarchy of laws**

# Flexibility to Shape the Territorial Scope of IP Laws

- ⦿ **International treaties, internationally recognized principles, and laws that stand higher in a country's hierarchy of laws than IP laws**
- ⦿ **National treatment and the most-favored-nation principles**
- ⦿ **Territoriality principle**
- ⦿ **Minimum standards**
  - flexibilities
- ⦿ **Reciprocity (other countries' IP laws)**

# Conflict of Laws Rules and IP Laws

## Conflict of Laws Rules in IP Statutes

- International treaties
- Regional instruments
- National law

## Non-Conflict of Laws Rules in IP Statutes

- Territoriality principle, national treatment principle, MFN principle
- Provisions for remedies
- Mandatory rules of national law
- Strong public policies
- “Place of the tortious activity”

## IP-Specific Conflict of Laws Rules

- Jurisdiction
- Choice of law
- Recognition and enforcement of foreign judgments
- National law
- Proposals (e.g., ALI Principles, CLIP principles)

# Examples

- French rule for initial ownership of copyright in software
- U.S. trademark infringement by a non-resident alleged infringer
- U.S. patent-infringing offer to sell

# Conclusions

- ◉ Need to **synchronize** national IP laws and conflict of laws rules
- ◉ Need to be aware of the **effective territorial scope** of national IP laws
- ◉ Need to recognize differences between the intended territorial scope of national IP laws and their effective territorial scope, and identify **proper tools** for remedying any gaps

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