

Advancing IP Policy through Conflict of Laws Rules

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IP Scholars Conference
Benjamin N. Cardozo School of Law
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⊙ National IP laws legislated (mostly) for purely domestic cases

• Exceptions:

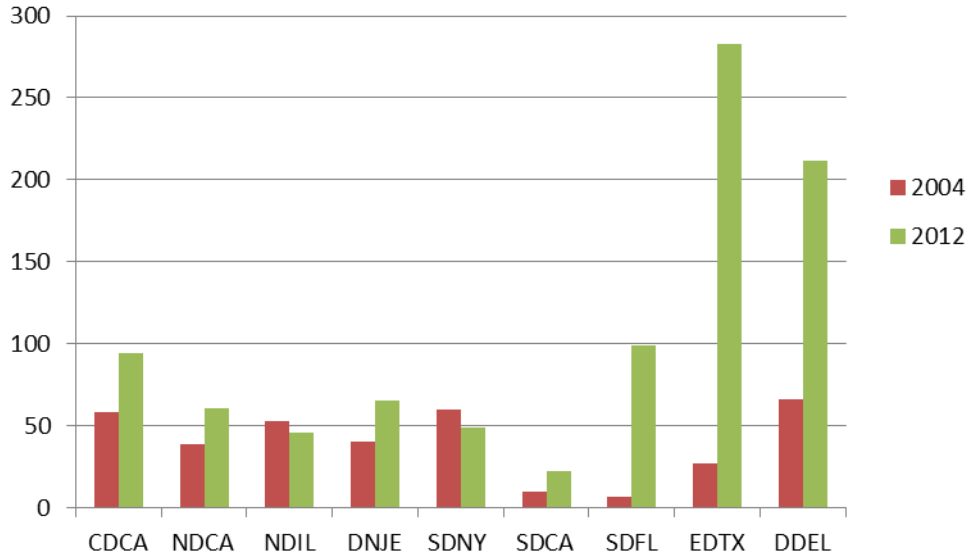
- U.S. Patent Act, 35 U.S.C. §271(f) and (g)
- DMCA, 17 U.S.C. §512(g)(3)(D)

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

• Exceptions:

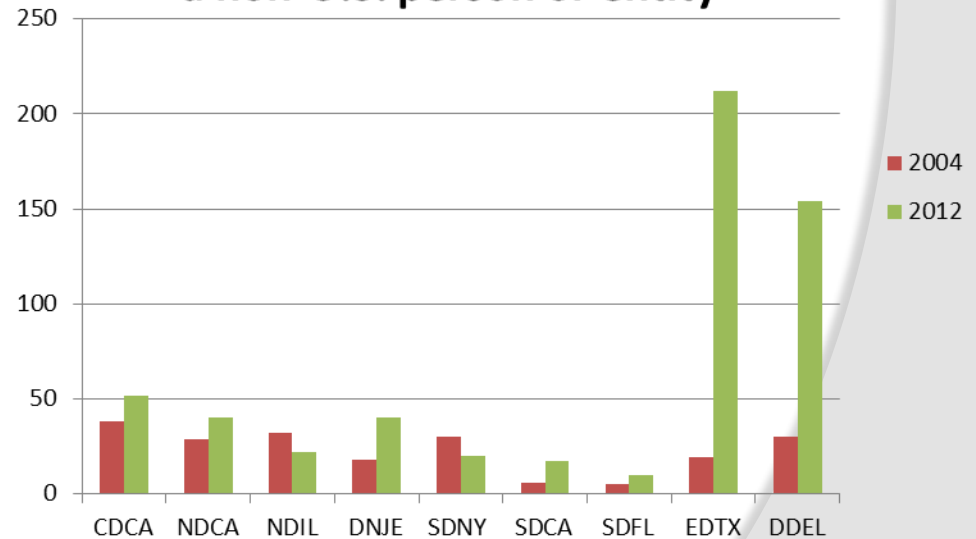
- Berne Convention, Article 5(2)
- WIPO Marrakesh Treaty, Article 5

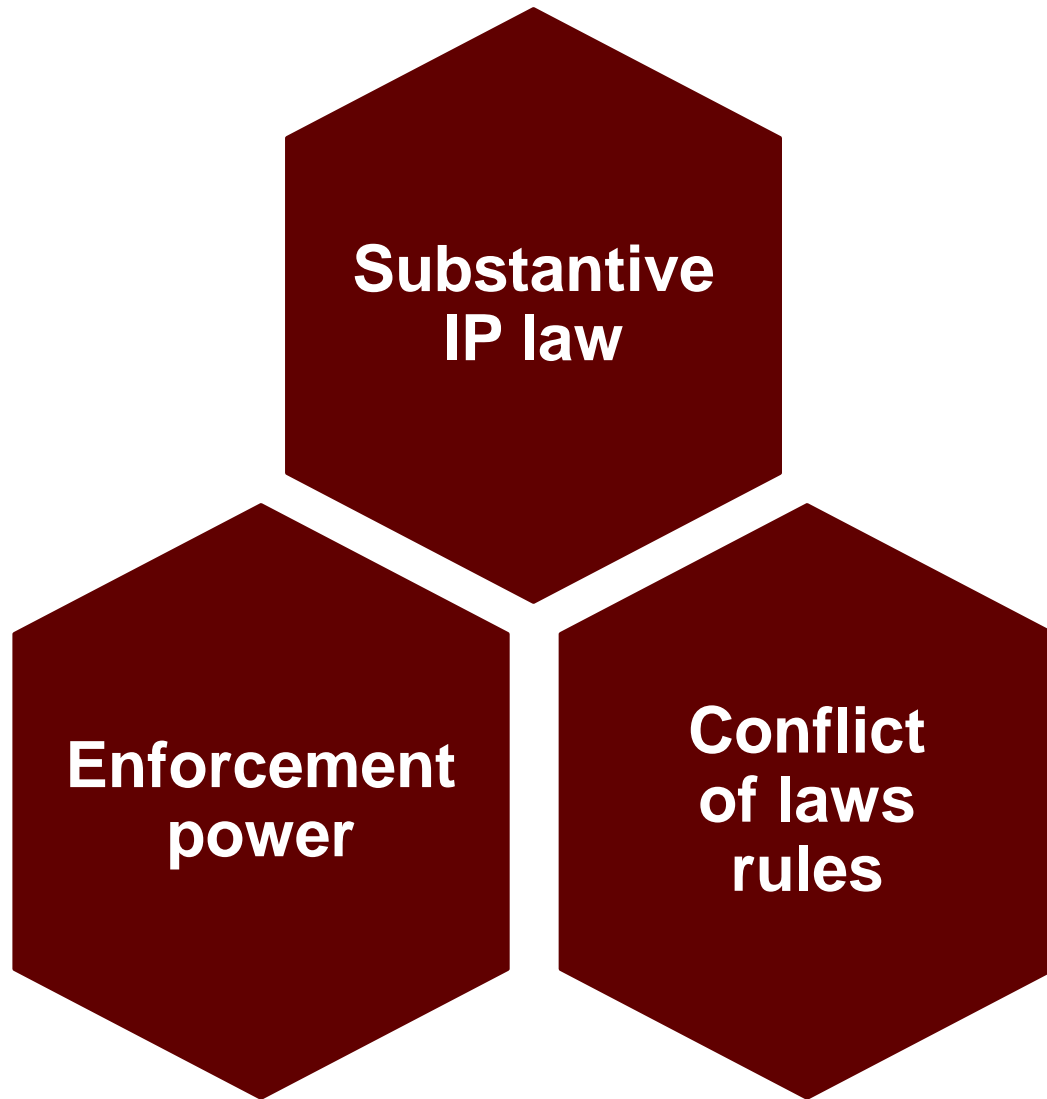
Cases in which at least one party was a non-U.S. person or entity



Preliminary results – do not quote

Cases in which the defendant or at least one of the defendants was a non-U.S. person or entity





Flexibility to shape conflict of laws rules

- ◉ **International treaty obligations**
 - EU: Brussels I Regulation (recast), Rome I and II Regulations
 - The Hague Conference initiative
 - Convention on Choice of Court Agreements (2005)
- ◉ **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**
- ⦿ (Impact of other countries' 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 Laws

- Intl. treaties
 - Berne Convention, Article 5(2)
 - WIPO Marrakesh Treaty, Article 5
- Regional instruments
- National laws

⊙ Conflict of Laws Rules and IP Laws

⊙ Conflict of Laws Rules in IP Laws

⊙ **Non-Conflict of Laws Provisions in Intellectual Property Laws with Effects on Conflict of Laws Rules**

- The principle of territoriality
- The principle of national treatment and the most-favored-nation principle
- Provisions for remedies
 - EU Information Society Directive, Article 8; EU IPR Enforcement Directive
- Mandatory rules of national law
 - German Author's Right Act, Sections 32 – 32B
- Strong public policies
- “Place of the tortious activity”

⊙ Conflict of Laws Rules and IP Laws

⊙ Conflict of Laws Rules in IP Laws

⊙ Non-Conflict of Laws Provisions in Intellectual Property Laws with Effects on Conflict of Laws Rules

⊙ IP-Specific Conflict of Laws Rules

- Jurisdiction:

- EU: Brussels I Regulation (Recast)
- Switzerland, Japan

- Choice of Law:

- Infringement (EU: Rome II Regulation, China, Poland, Switzerland)
- Ownership (China, Portugal, Belgium, Switzerland)

- Recognition and enforcement

- Switzerland

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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