Advancing National Intellectual Property Policies in a Transnational Context

Marketa Trimble
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

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- 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.”

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
Substantive IP law

Enforcement power

Conflict of laws rules
“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**

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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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