Advancing IP Policy through Conflict of Laws Rules

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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

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

Preliminary results – do not quote
Substantive IP law

Enforcement power

Conflict of laws rules
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


- 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


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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