INTRODUCTION: CONSTRUCTING INTERNATIONAL INTELLECTUAL PROPERTY LAW: THE ROLE OF NATIONAL COURTS
Graeme B. Dinwoodie

In this Article, Professor Dinwoodie describes the classical architecture of the international intellectual property system, and discusses some of the ways in which that system is changing. In particular, he considers the role of national courts in the international intellectual property system. Conventional understanding suggests that national courts play a relatively limited role, but Professor Dinwoodie notes various developments that have enabled or required national courts to assume greater involvement in the construction of international intellectual property law. The infrastructure envisaged by the proposed Hague Convention, and by Professors Dreyfuss and Ginsburg in their proposal for a standalone convention on jurisdiction and judgments in intellectual property matters, might also enhance the role of such national judicial activity. Professor Dinwoodie concludes by suggesting the ways in which national courts operating within such an infrastructure could make a positive contribution to the construction of international intellectual property law.


Draft Convention on Jurisdiction and Recognition of Judgments in Intellectual Property Matters

This proposal is meant to spur the intellectual property bar to consider whether it would be desirable to create a regime for international enforcement of intellectual
property law judgments. Such a convention could be adopted under the auspices of
the World Intellectual Property Organization ("WIPO") or through the World Trade
Organization ("WTO").

There are several reasons to believe that an instrument drafted specifically for
intellectual property disputes would be particularly advantageous. First, for intellec-
tual property disputes, efficiency should be a principal target. Modern distribution
methods, particularly satellite and Internet transmissions, make it increasingly likely
that intellectual property rights will be exploited simultaneously in more than one
territory. The ability to consolidate claims arising from these usages in one court,
with the expectation that the judgment of that court will be recognized in all conven-
tion States, could reduce costs for all sides, conserve judicial resources on an interna-
tional basis, and promote consistent outcomes.

Second, a convention drafted for intellectual property disputes can take account
of issues uniquely raised by the intangibility of the rights in issue. For example, an
intellectual property agreement can consider the ability of a potential defendant to
gain litigation advantages through the choice of the location of the activities that give
rise to infringement. In certain situations, the propriety of expanding jurisdiction
depends on the possibility of inconsistent outcomes; a convention tailored to intellec-
tual property can specify what that term means in the context of public goods.

An instrument for intellectual property litigation can also deal specifically with
matters of unique concern to the creative community. The strong link between cul-
ture on the one hand, and intellectual production and utilization on the other, means
that the territoriality of these rights is of crucial importance: individual nations must
be able to retain some control over the local conditions under which these products
are created, exploited, and accessed. At the same time, an approach that creates new
avenues for cross-cultural enrichment needs to be considered. For example, the cir-
cumstances where trans-border injunctions are permissible can be specified to in-
clude consideration of cultural, health, and safety issues. Other issues of prime
interest to the information industries can also be considered: provisions on contract
disputes can be tailored to deal with mass-market contracts, which are becoming
prevalent in certain intellectual property transactions; provisions on infringement can
be made sensitive to the interests of the "new media," such as Internet Service
Providers.

Most important, the convention can be confined to rights covered by the intel-
lectual property part of the General Agreement on Tariffs and Trade ("TRIPs
Agreement") and open to signature only to countries that have joined the WTO and
fully implemented the TRIPs Agreement. Since these are countries that have agreed
to enforce intellectual property law and are subject to dispute resolution proceedings
if they fail to do so, these limitations would reduce concerns that forum shopping will
undermine the delicate balance that each nation has struck between the rights of
intellectual property users and owners. And although dispute resolution under the
WTO cannot provide litigants with a substitute for a centralized and authoritative
appellate body (such as the US Supreme Court or the European Court of Justice), it
can provide assurance of transparent and efficient judicial process, along with institu-
tional mechanisms (such as dispute resolution panels, the Dispute Settlement Board,
and the Council for TRIPs) for examining intellectual property law as it develops
through consolidated adjudication of multinational disputes.

Valuing "Domestic Self-Determination" in International Intellectual Property Jurisprudence

In an era of increased globalization of intellectual property law and policy, a key
challenge for domestic and international intellectual property law makers will be the
balancing of domestic and international concerns. In intellectual property law, the
latter are frequently given expression through the principle of territoriality. Profes-
sor Austin's Article examines the continued viability of the territoriality principle
and the value of domestic self-determination in international intellectual property
jurisprudence in both the private and public international law contexts, and discusses
ways that the value of domestic self-determination might be balanced with the need
for international cooperation in the international intellectual property context. This
analysis provides a framework for scrutiny of the Draft Convention on Jurisdiction
and Recognition of Judgments in Intellectual Property Matters proposed by Professors
Dreyfuss and Ginsburg. Professor Austin explores ways in which the draft conven-
tion is and is not consistent with the value of domestic self-determination.
INTERNATIONAL JURISDICTION AND ENFORCEMENT OF JUDGMENTS IN THE ERA OF GLOBAL NETWORKS: IRRELEVANCE OF, GOALS FOR, AND COMMENTS ON THE CURRENT PROPOSALS

Jonathan A. Franklin
and Roberta J. Morris

The Hague Convention attempts to harmonize bases of jurisdiction and make enforcement of foreign judgments routine. At the same time, the diversity in substantive national laws in intellectual property and other areas permits nations to experiment with new and different approaches. A good international legal system will improve transnational litigation without running roughshod over national socio-cultural values, as embodied especially in intellectual property law. This Article ponders disparate factors that could diminish the importance of the whole effort, considers some values that should guide the effort if it is to go forward, and then reviews how selected provisions of the draft Hague Convention and the Dreyfuss-Ginsberg proposal meet these challenges.

COMMENT: NOW THAT WE KNOW "THE WAY FORWARD," LET US STAY THE COURSE

Marc E. Hankin

Mr. Hankin, a partner practicing intellectual property law in the Los Angeles Office of Gordon & Rees, LLP and the Chair of the American Bar Association Section of Intellectual Property Law’s Committee on the Draft Hague Convention, comments on the Dreyfuss-Ginsburg proposal and its tension with current legal procedural norms and the Draft Hague Convention. Hankin argues that intellectual property law should not be treated differently procedurally from other forms of law and, accordingly, should not be subject to a special convention on procedure. Moreover, Hankin disagrees with the Dreyfuss-Ginsburg proposal’s likely exclusion of patent litigation (“hard IP”) from its scope. Such an exclusion is unnecessary and would limit the proposal’s applicability. The Draft Hague Convention benefits from not distinguishing between “hard” and “soft” intellectual property, and while the Hague Convention still faces many challenges, directing our efforts towards improving it is the best way to address the increasingly complex issues affecting international intellectual property law.

TREATY LAW AND LEGAL TRANSITION COSTS

Michael P. Van Alstine

In this Article, Professor Van Alstine examines the costs of legal transition associated with the adoption of multilateral treaties. These “legal transition costs” arise from the need to learn about the content of new legal norms as well as the uncertainty and related costs that flow from the loss of the accrued experience with the old legal regime and from contending with doubts about the new one. Building on earlier work on this phenomenon, Professor Van Alstine analyzes the special implications of transition cost analysis in the context of multilateral treaties such as the one proposed by Professors Dreyfuss and Ginsburg in the field of international intellectual property law.

RETHINKING FORUM SHOPPING IN CYBERSPACE

Kimberly A. Moore
and Francesco Parisi

A game-theoretic analysis of forum shopping reveals how opportunities for strategic choices can influence the behavior of plaintiffs and defendants. If neither party has the opportunity to make strategic choices about participation or forum, we should expect no adverse selection or moral hazard problems. Conversely, if only one of the parties can control both the participation and forum selection choices, then we could expect pervasive adverse selection and moral hazard problems. In this Article, we build on this simple game-theoretic framework to analyze Dreyfuss and Ginsburg’s Draft Convention on Jurisdiction and Recognition of Judgments in Intellectual Property Matters. We suggest that if the parties are faced with a bilateral strategic problem (i.e., if one party has control over one strategic choice and the
other party has control over the other strategic choice), the extent of opportunistic behavior by either party, and the resulting deadweight losses, are likely to be minimized. In this respect, the Dreyfuss-Ginsburg proposal sensibly minimizes the strategic problems of forum shopping and creates an enforcement scheme that leaves intact the innovation incentives underlying intellectual property rights.

STUDENT NOTES

ELIMINATING THE TOTALITY OF THE CIRCUMSTANCES TEST FOR THE PUBLIC USE BAR UNDER SECTION 102(b) OF THE PATENT ACT

Historically, courts have applied a totality of the circumstances test to determine whether a public use or sale of an invention had taken place that would bar patentability under Section 102(b) of the Patent Act. The totality of the circumstances test is burdened by ambiguity and vagueness, which in turn leaves inventors with uncertainty as to which activities trigger the 102(b) bars. In 1998, however, the Supreme Court in Pfaff v. Wells Electronics, Inc., replaced the totality of the circumstances test as applied to the on-sale bar with a clearer, two-part test. In determining whether the on-sale bar applies, courts now use a two-part, ready-for-patenting test. An invention is considered “on sale” within the meaning of 102(b) if: (1) the invention has been the subject of a commercial sale or offer for sale; and (2) the invention is ready for patenting. The Pfaff test gives inventors more clarity by providing more definite guidelines as to what constitutes a sale under 102(b). However, the ambiguous and vague totality of the circumstances test is still applied by courts when determining public use under 102(b). Following the lead of Pfaff, this Note proposes that the totality of the circumstances test as applied to the public use bar be replaced by a clearer, two-part test. Under the proposed test, an invention is in “public use” within the meaning of 102(b) if: (1) there is any nonexperimental use by or visible to someone other than the inventor or those under the inventor’s direction; and (2) the invention has been reduced to practice. The test provides a more definite rule for determining whether an invalidating public use has occurred. This, in turn, allows inventors to conform their activities so as not to be barred from patentability under the 102(b) public use bar. The proposed test also seeks to provide a degree of uniformity in cases dealing with the public use bar.

HAS THE AMERICANS WITH DISABILITIES ACT FALLEN ON DEAF EARS? A POST-SUTTON ANALYSIS OF MITIGATING MEASURES IN THE SEVENTH CIRCUIT

Although the Americans with Disabilities Act was lauded as a statute that would bring long-overdue relief to the disabled, the Supreme Court’s decision in Sutton v. United Airlines has caused many to question the statute’s value. By holding that plaintiffs must be considered in their corrected or mitigated states, Sutton greatly narrowed the group of individuals entitled to relief under the statute. Recent Seventh Circuit holdings have illustrated Sutton’s shortcomings, namely that courts will be required to consider disabled plaintiffs’ corrected states even if their employers discriminate against them by not allowing them to employ their assistive devices or corrective measures while on the job. This Note proposes that under these narrow circumstances, when there is a reasonable probability that the employer is discriminating on the basis of the mitigating measure itself, courts should consider a plaintiff in his or her uncorrected state.
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