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The Architecture of the International Intellectual Property System

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THE ARCHITECTURE OF THE INTERNATIONAL INTELLECTUAL PROPERTY SYSTEM

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INTRODUCTION

This Symposium addresses the role of national courts in the construction of international intellectual property law. Each of the primary proposals being considered by the symposiasts[1]—the draft Hague Convention on Jurisdiction and Foreign Judgements in Civil and Commercial Matters (the "Draft Hague Convention")[2] and the Draft Convention on Jurisdiction and Recognition of Judgments in Intellectual Property Matters authored by Rochelle Dreyfuss and Jane Ginsburg (the "Dreyfuss-Ginsburg proposal")[3]—would enhance

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1. In addition to the papers published in this volume of the *Chicago-Kent Law Review*, the on-site Symposium featured remarks from Catherine Kessedjian (University of Paris, formerly Deputy Secretary-General, Hague Conference on Private International Law), Jeff Kovar (Office of the Legal Advisor, US State Department, and Head of the US delegation to the Hague Conference), François Dessemontet (University of Lausanne), Avril Haines (Hague Conference on Private International Law), Jack Goldsmith (University of Chicago Law School), Shira Perlmutter (Associate General Counsel, Intellectual Property Policy, AOL Time Warner, Inc., and former Consultant on Copyright and Electronic Commerce to the World Intellectual Property Organization) and David Gerber (Chicago-Kent College of Law). My thanks to all these speakers and to the other participants at the Symposium for their contributions to a vigorous debate. Additional materials relating to the issues discussed at the Symposium can be found on the dedicated web site, http://www.kentlaw.edu/depts/ipp/intl-courts, which is updated periodically.

2. *See* Hague Conference on Private International Law, Summary of the Outcome of Discussions in Commission II of the First Part of the Diplomatic Conference, 6–20 June 2001, Interim Text, *reprinted in* this issue at 77 CHI.-KENT L. REV. 1015 (2002). The (June 2001) version of the Draft Hague Convention discussed here and reprinted in this volume is referred to where necessary as the "June 2001" draft Hague Convention in order to differentiate this text from the draft proposal published in October 1999. *See* Preliminary Draft Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (adopted October 30, 1999), *at* http://www.hcch.net /e/conventions/ draft36e.html (last visited June 7, 2002).

3. Rochelle C. Dreyfuss and Jane C. Ginsburg, *Draft Convention on Jurisdiction and Recognition of Judgments in Intellectual Property Matters*, 77 CHI.-KENT L. REV. 1065 (2002). The (Fall 2001) version of the Dreyfuss-Ginsburg proposal discussed here and published in this volume is referred to where necessary as the "Chicago-Kent Draft" of the proposal.

the role of national courts in the international intellectual property system. But the suggestion that national courts have *any* role to play in international intellectual property lawmaking appears to run counter to conventional understanding. In this Article, I sketch a vision of the contemporary international intellectual property system that accommodates (and actively seeks to incorporate) national judicial activity, and I seek to situate the proposals being considered in the Symposium within that environment.

Part I describes the classical architecture of the international intellectual property system, and the basic conceptual and institutional pillars on which that system was built. Historically, national courts have played a relatively limited role in that system. Part II discusses some of the ways in which the system of international intellectual property law is changing, and notes that (even without the infrastructure envisaged by the Hague and Dreyfuss-Ginsburg proposals) national courts are becoming more involved in the construction of international intellectual property law. Finally, in Part III, I suggest how the mechanisms that underlie the Draft Hague Convention and the Dreyfuss-Ginsburg proposal might further alter and enhance the emerging role of national courts in the development of the system of international intellectual property law.

I. THE CLASSICAL SYSTEM OF INTERNATIONAL INTELLECTUAL PROPERTY LAW

The beginnings of a developed system of international intellectual property law can be found in the 1880s, with the conclusion of the Paris[4] and Berne Conventions.[5] These treaties were built around two basic propositions.[6] First, signatory states had to provide in their domestic law certain minimum levels of intellectual property protection, so-called substantive minima. Second, as a general rule, a signatory state was obliged to offer protection to nationals of other

4. Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, as last revised at Stockholm, July 14, 1967, art. 28, 21 U.S.T. 1583, 828 U.N.T.S. 305 [hereinafter Paris Convention].

5. *See* Berne Convention for the Protection of Literary and Artistic Works (1971 Paris text), July 24, 1971, 1161 U.N.T.S. 3 [hereinafter Berne Convention]; *see generally* SAM RICKETSON, THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS: 1886–1986 (1987). The first version of the Berne Convention was concluded in 1886.

6. The Paris Convention also contained provisions designed to facilitate the acquisition of national registered rights on a multinational basis. *See* Paris Convention, *supra* note 4, art. 4.

signatory states that matched the protection it afforded its own nationals. This is the principle of national treatment.[7]

This basic structure—national treatment plus substantive minima—has persisted throughout the twentieth century. Although the substantive minima obligations have periodically been revised upwards to require greater and different protection, the conceptual approach has endured. Indeed, it remains the dominant approach in current intellectual property treaties.[8] Some essential characteristics of this system are worth noting. In particular, this approach only barely intruded upon the national sovereignty of signatory nations. This was because of several features. First, the substantive minima were initially quite undemanding.[9] They were in most cases meant to reflect a consensus position, as codifications of existing state practice.[10] Second, many central concepts (such as who is an "author" of a copyrighted work) were left open for signatory states to develop in accordance with their own national policies and values. And this latitude was affirmed in practical terms by the fact that the obligations undertaken by states were not backed up with effective enforcement mechanisms. Although provision was made in later revisions of the Berne and Paris Conventions to refer disputes between states regarding the meaning of those conventions to the International Court of Justice,[11] this was never done.[12]

The international intellectual property system need not have developed in this manner. In the debates leading up to the adoption of the Berne Convention, some delegations advanced the alternative

7. *See* Paris Convention, *supra* note 4, art. 2; Berne Convention, *supra* note 5, art. 5.

8. *See* Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994 [hereinafter the TRIPs Agreement or TRIPs], Marrakesh Agreement Establishing the World Trade Organization [hereinafter WTO Agreement], Annex 1C, LEGAL INSTRUMENTS—RESULTS OF THE URUGUAY ROUND vol. 31, 33 I.L.M. 81 (1994).

9. *See* Graeme B. Dinwoodie, *A New Copyright Order: Why National Courts Should Create Global Norms*, 149 U. PA. L. REV. 469, 491 (2000) (discussing Berne Convention and describing initial standards as "hardly exacting"); GRAEME B. DINWOODIE ET AL., INTERNATIONAL INTELLECTUAL PROPERTY LAW AND POLICY 140 (2001) (describing trademark-related obligations in the Paris Convention as "relatively low-level"); Joanna Schmidt-Szalewski, *The International Protection of Trademarks After the TRIPs Agreement*, 9 DUKE J. COMP. & INT'L L. 189, 199–201 (1998) (discussing the "few trademark rules" provided by the Paris Convention).

10. *See* Dinwoodie, *supra* note 9, at 493 (noting that the traditional Berne Convention revisions "constituted the received wisdom of the participating countries rather than prospective solutions to new problems").

11. *See* Berne Convention, *supra* note 5, art. 33; Paris Convention, *supra* note 4, art. 28.

12. *See* J.H. Reichman, *Enforcing the Enforcement Procedures of the TRIPs Agreement*, 37 VA. J. INT'L L. 335, 339 n.17 (1997).

notion of a universal copyright law. But these attempts were defeated by the pragmatic demands of greater national control over the course of copyright law.[13] Similar tensions, though less starkly presented, can be found in the development of the Paris Convention.[14]

In this scheme, national courts had very little role to play in the construction of international intellectual property law. Public international standards in the treaties found their way into national law largely through legislative implementation in domestic law.[15] This was particularly true in the United States (where many, if not all, of the primary intellectual property treaties are not self-executing).[16] And the treaties did not in any event contain a comprehensive code that could substitute for general domestic legislation. National courts thus interpreted *local* intellectual property *law*, even if the content of that law had in part been influenced by international obligations.

Moreover, the cases that courts were called upon to resolve principally involved national *rights*. Even if international intellectual property treaties were self-executing, intellectual property rights remained national in scope. Territoriality of rights is a fundamental premise of classical international intellectual property law. There is no such thing as an international copyright, or international trademark, or international patent.[17]

Finally, the *disputes* that confronted courts were largely national in nature. National courts did, of course, have some occasion to address issues of private international law where cross-border effects

13. *See* Jane C. Ginsburg, *The Role of National Copyright in an Era of International Copyright Norms*, *in* THE ROLE OF NATIONAL LEGISLATION IN COPYRIGHT LAW 211, 213 (Adolf Deitz ed., 2000).

14. *See* Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce, 223 U.S.P.Q. 909, 918–21 (T.T.A.B. en banc 1984) (discussing negotiation of Article 6 of the Paris Convention); United States–Section 211 Omnibus Appropriations Act of 1998, Report of the Appellate Body, WT/DS176/AB/R (WTO Jan. 2, 2002) [hereinafter United States—Section 211], (noting the legislative discretion retained by national governments under the Paris Convention), *available at* http://www.worldtradelaw.net/reports/wtoab/us-section211(ab).pdf (last visited June 7, 2002).

15. *See* Graeme B. Dinwoodie, *The Development and Incorporation of International Norms in the Formation of Copyright Law*, 62 OHIO ST. L.J. 733, 739 (2001) (discussing copyright law).

16. *See* Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, § 2, 102 Stat. 2853 (Berne Convention not self-executing); Mannington Mills, Inc. v. Congoleum Corp., 595 F.2d 1287, 1299 (3d Cir. 1979) (treating the Paris Convention as not self-executing); *cf.* Vanity Fair Mills, Inc. v. T. Eaton Co., 234 F.2d 633, 640–44 (2d Cir. 1956) (suggesting that the Paris Convention is self-executing, but finding no enlargement of substantive rights under US trademark law). *But see* Laboratorios Roldan v. Tex Int'l, Inc., 902 F. Supp. 1555, 1568 (S.D. Fla. 1995) (recognizing claim under article 10*bis* of the Paris Convention).

17. *See* DINWOODIE ET AL., *supra* note 9, at 1.

occurred.[18] But such events were rarer than today. And matters of private international law were left largely untouched by the intellectual property conventions.[19]

Indeed, in the United States, courts generally have substantial discretion regarding the rules of private international law (such as jurisdiction to adjudicate, choice of law or applicable law, and recognition and enforcement of judgments).[20] Domestically, the United States Constitution, at least as interpreted, imposes greater restraints on the exercise by courts of personal jurisdiction than on the assertion of prescriptive jurisdiction (i.e., the Constitution contributes to the rules of personal jurisdiction but leaves choice of law rules largely unregulated).[21] And, although recognition of foreign judgments is the norm in US law, this flows neither from constitutional mandate—the Full Faith and Credit Clause does not extend to the international context[22]—nor from any international treaty obligations assumed by the United States.[23]

Of course, some private international law rules developed from those international intellectual property disputes that did arise.[24]

18. *See*, *e.g.*, *Vanity Fair Mills*, 234 F.2d at 641 (US-Canadian trademark infringement); Sheldon v. Metro-Goldwyn Pictures Corp., 106 F.2d 45, 52 (2d Cir. 1939) (awarding plaintiff profits from both US and Canadian exhibition of infringing motion picture where a copy of the motion picture had been made in the United States and then shipped to Canada for exhibition), *aff'd*, 309 U.S. 390 (1940).

19. *See* Itar-Tass Russian News Agency v. Russian Kurier, Inc., 153 F.3d 82, 90–91 (2d Cir. 1998) (noting lack of guidance regarding choice of law issues in the Berne Convention); Jane C. Ginsburg, *Private International Law Aspects of the Protection of Works and Objects of Related Rights Transmitted Through Digital Networks*, WIPO Doc. GCPIC/2, at 22, 34 (Nov. 30, 1998) (discussing the extent to which the Berne Convention determines the law applicable to issues of copyright ownership and infringement), *at* http://www.wipo.int/eng/meetings/1998/gcpic/pdf/gcpic_2.pdf (last visited June 7, 2002); Graeme B. Dinwoodie, *Private International Aspects of the Protection of Trademarks*, WIPO Doc. No. WIPO/PIL/01/4, ¶ 14 (Jan. 2001) (discussing the minimal influence of international trademark treaties on choice of law), *available at* http://www.wipo.int/pil-forum/en/documents/doc/pil_01_4.doc (last visited June 7, 2002); *cf.* Fritz Blumer, *Patent Law and International Private Law on Both Sides of the Atlantic*, WIPO Doc. No. WIPO/PIL/01/3, ¶ 2.1 (Jan. 2001) (discussing how far the territoriality principle affects matters of private international law in patent cases), *available at* http://www.wipo.int/pil-forum/en/documents/doc/pil_01_3.doc (last visited June 7, 2002).

20. *See* EUGENE F. SCOLES ET AL., CONFLICT OF LAWS 2 (3d ed. 2000).

21. *Compare* Allstate Ins. Co. v. Hague, 449 U.S. 302, 308 (1981) (choice of law) *with* Asahi Metal Indus. Co. v. Superior Court, 480 U.S. 102, 113 (1987) (personal jurisdiction).

22. *See* U.S. CONST. art. IV, § 1.

23. *See* Hilton v. Guyot, 159 U.S. 113, 163–64 (1895) (resting recognition of foreign judgments on comity).

24. *See supra* note 18 (listing illustrative cases); *see also* Steele v. Bulova Watch Co., 344 U.S. 280, 283–84 (1952) (extraterritorial application of Lanham Act to activities in Mexico with effects on US commerce); Robert Stigwood Group Ltd. v. O'Reilly, 530 F.2d 1096, 1101 (2d Cir. 1976) (declining to apply US copyright law extraterritorially to performances in Canada).

Flowing from the premise that all rights were national, and from the mindset that regarded intellectual property laws as public in nature, courts were reluctant to adjudicate disputes involving foreign intellectual property rights.[25] Thus, although there is an important difference between having jurisdiction to adjudicate a case, and the choice of law or law applicable to the case, courts—both in the United States and elsewhere—would decline to hear a case if their own law was not being applied. The question of applicable law drove the exercise of power to adjudicate.[26]

As a consequence, where infringement did occur in several states, suits typically had to be filed in separate national courts seeking relief for each national infringement.[27] Determining the applicable law was thought to be quite easy: where did the reproduction, the use, the publication, or the sale, occur? The place of such acts would be the place of infringement. The law of that place would thus be the applicable law, which meant that that place would be where the plaintiff sued, and where enforcement occurred. So complex multinational intellectual property litigation appears in practice to have been quite rare.

National courts thus had little trouble with, and did not readily develop, rules of private international law for intellectual property disputes. And they had very little engagement with the rules of public international intellectual property found in treaties because these were not the source of the rules of decision in the cases before them.[28]

25. *See*, *e.g.*, Vanity Fair Mills, Inc. v. T. Eaton Co., 234 F.2d 633 (2d Cir. 1956) (trademark); ITSI T.V. Prods., Inc. v. Cal. Auth. of Racing Fairs Agric., 785 F. Supp. 854, 866 (E.D. Cal., 1992) (copyright), *rev'd on other grounds*, 3 F.3d 1289 (9th Cir. 1993); *see also* Deepsouth Packing Co. v. Laitram Corp., 406 U.S. 518, 537 (1972) (suggesting that a US patent holder seeking protection in foreign markets should avail itself of its foreign patents).

26. In practice, the cause and effect of this relationship may not have been so clear. That is, one could interpret judicial practice as reflecting the sentiment that if the court found jurisdiction to adjudicate, it applied its own law.

27. This remains the norm. *See* Computer Assocs. Int'l, Inc. v. Altai, Inc., 126 F.3d 365, 371–72 (2d Cir. 1997) (refusing to grant antisuit injunction against pursuit of French copyright infringement action notwithstanding that the defendant's program had been held to be noninfringing in parallel US proceedings between the same parties involving the same works). *Compare* Euromarket Designs, Inc. v. Crate & Barrel Ltd., 96 F. Supp .2d 824 (N.D. Ill. 2000) (discussing claim for infringement of US trademark rights in mark CRATE & BARREL) *with* Euromarket Designs, Inc. v. Peters, [2000] E.T.M.R. 1025 (Ch. 2000) (Eng.) (claim for infringement of UK trademark rights in mark CRATE & BARREL); *compare* Improver Corp. and Sicommerce v. Remington Prods., 24 I.I.C. 838 (Dusseldorf Ct. App. 1991) (F.R.G.) (discussing action in Germany for infringement of patent on Epilady shaver) *with* Improver Corp. and Others v. Remington Consumer Prods. Ltd., 1990 F.S.R. 181 (H. Ct. 1989) (UK) (action in the UK for infringement of patent on same invention).

28. *See supra* text accompanying notes 15–17 (discussing implementation in US law).

There was, therefore, very little dynamic between public and private international intellectual property laws.

II. GLOBALIZATION AND CHANGES TO THE ROLE OF NATIONAL COURTS

The last fifteen to twenty years have witnessed some changes to the foregoing description of the international intellectual property system. Some things have not altered, however. The prevailing doctrinal premise is still one of territoriality;[29] rights remain largely national in nature;[30] and the principal intellectual property agreements remain structured around the dual principles of national treatment and substantive minima.[31]

But in that time our social and economic environment has become more global in nature. Intellectual property products, like their creators and users, move through international commerce and international communities with speed and in quantities that we could not previously have imagined. This has prompted demands for intellectual property laws that are more global in reach, and the sometimes inconsistent demand for intellectual property laws that respond more quickly to new problems and new technologies.[32] In this climate, the principles of territoriality and national autonomy over precise rules of domestic intellectual property law have come under pressure.

29. *See Computer Associates*, 126 F.3d at 365 (copyright); Rotec Indus., Inc. v. Mitsubishi Corp., 215 F.3d 1246, 1251 (Fed. Cir. 2000) (requiring that in order to violate the patent holder's exclusive right to offer its patented invention for sale, the allegedly infringing offer must occur within the United States); Johns Hopkins Univ. v. Cellpro, Inc., 152 F.3d 1342 (Fed. Cir. 1998) (patent); Sterling Drug, Inc. v. Bayer AG, 14 F.3d 733, 736, 744–48 (2d Cir. 1994) (taking territorial nature of trademark rights into account when fashioning relief); Subafilms, Ltd. v. MGM-Pathe Communications Co., 24 F.3d 1088, 1089 (9th Cir. 1994) (copyright); Person's Co. Ltd. v. Christman, 900 F.2d 1565, 1569 n.18 (Fed. Cir. 1990) (declining to revise territorial understanding to reflect the "world economy"); Playboy Enters. v. Chuckleberry Publ'g, Inc., 939 F. Supp. 1032, 1036–37 (S.D.N.Y. 1996) (taking territorial nature of trademark rights into account when fashioning relief).

30. Even those exceptional modifications of national rights that exist, such as unitary trademark rights over the entire region of several nations within a free trade agreement (most notably, the European Union, *see* Council Regulation 40/94 of 20 December 1993 on The Community Trademark, 1994 O.J. (L 11), *at* http://oami.eu.int/en/aspects/reg/reg4094.htm (last visited June 7, 2002)), could plausibly still be conceptualized as territorial in nature, albeit with a territory now defined by the regional "superstate" rather than individual nation-states.

31. *See* TRIPs Agreement, *supra* note 8, art. 2(1) (requiring compliance with stated provisions of the Paris Convention), art. 3 (national treatment), and art. 9(1) (requiring compliance with stated provisions of the Berne Convention); *see also* United States–Section 211 Omnibus Appropriations Act of 1998, Report of the Appellate Body, WT/DS176/AB/R (WTO Jan. 2, 2002) (discussing national treatment obligations of TRIPs), *at* http://docsonline.wto.org/gen_home.asp?language=1&_=1 (last visited June 7, 2002).

32. *See* Dinwoodie, *supra* note 9, at 477 (discussing these pressures in copyright law).

As a result of these pressures, international intellectual property lawmaking has undergone substantial change and is now effectively generated by a wide range of different processes. First, there have been efforts to enable international institutions to react more quickly to new social and technological developments. In this category, one might include the structural reorganization of the World Intellectual Property Organization ("WIPO"). WIPO has formed and made use of standing committees to present proposals to the WIPO Assemblies for adoption in the form of non-binding recommendations rather than pursue the same substantive goals through the mechanism of formal treaties adopted after a long negotiation process.[33] This device has been most prevalent in the trademark context, with the 1999 non-binding recommendation on the treatment of well-known marks and the recent adoption of a recommendation on rules governing the concept of "use" on the Internet being notable examples.[34]

The adoption of the Uniform Domain Name Dispute Resolution Policy (the "UDRP")[35] by the Internet Corporation for Assigned Names and Numbers ("ICANN")[36] in late 1999 is another example of speedy (and novel) international intellectual property lawmaking. ICANN requires every registrar offering to register domain names in the most commercially significant generic top-level domains to include in its registration agreement a contractual provision whereby domain name registrants submit to the application of the UDRP. As a result, a certain class of disputes between domain name registrants

33. *See Report of the Director General of WIPO*, WIPO Doc. No. WO/GA/23/1 ¶¶ 1–12 (Sept. 4, 1998) (discussing the proposal to establish standing committees), *at* http://www.wipo.int/eng/document/govbody/wo_gb_ga23_1.htm; *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks*, WIPO Doc. No. A/34/13 at 3 (Aug. 1999) (discussing the nonbinding nature of the recommendation), *at* http://www.wipo.int/eng/document/govbody/wo_gb_ab/pdf/a34_13.pdf [hereinafter Well-Known Marks Joint Recommendation].

34. *See Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks* (Sept. 1999), *at* http://www.wipo.int/about-ip/en/development_iplaw/pdf/pub833.pdf (last visited June 7, 2002); *Joint Recommendation Concerning the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet* (Oct. 2001), *at* http://www.wipo.int/about-ip/en/development_iplaw/pdf/pub845.pdf (last visited June 7, 2002); *see also Joint Recommendation Concerning Trademark Licenses*, (Oct. 2000), *available at* http://www.wipo.int/about-ip/en/development_iplaw/pdf/pub835.pdf (last visited June 7, 2002).

35. *See Uniform Domain Name Dispute Resolution Policy* (Oct. 24, 1999) [hereinafter UDRP], *at* http://www.icann.org/udrp/udrp-policy-24oct99.htm (last visited June 7, 2002); *see also Rules for Uniform Domain Name Dispute Resolution Policy* (Oct. 24, 1999), *at* http://www.icann.org/dndr/udrp/uniform-rules.htm [hereinafter UDRP Rules] (last visited June 7, 2002).

36. ICANN is a not-for-profit corporation that was created by the US government to operate the domain name system, among other things, in accordance with parameters set by the Commerce Department. Management of Internet Names and Addresses, 63 Fed. Reg. 31, 741 (June 10, 1998).

and trademark holders (so-called cybersquatting disputes) is resolved by quasi-arbitral panels appointed by ICANN-authorized dispute settlement providers and according to substantive rules that were developed in an unconventional process of international intellectual property lawmaking.[37]

Without unduly minimizing the ambiguities of that process,[38] in essence the WIPO acted at the request of a single member state (the United States) to produce a report that, by virtue of delegation of de facto control of the domain name registration process from that single government,[39] could be implemented by ICANN as substantive law without the usual airings found in the intergovernmental lawmaking process of which WIPO is a part.[40] And, as the Australian government recognized in a recent submission to the TRIPs Council, the UDRP has indeed become the international standard for resolution of cybersquatting disputes.[41]

To be fair to WIPO, the organization did try to circulate and solicit comments regarding the proposals through alternative channels. Yet, the process was quite different from the classical intergovernmental model to which WIPO formerly adhered (and largely still adheres). Instead, the development of the UDRP occurred outside the traditional intergovernmental process, thus reducing the direct involvement of nation-states and moving at a much brisker pace than found in the treaty revision process.[42]

To be sure, both of these developments are expressly intended to produce only soft law. The recommendations that emanate from the WIPO standing committees and are later adopted by the WIPO Assembly are nonbinding; nations may decide without penalty

37. *See generally* Laurence R. Helfer & Graeme B. Dinwoodie, *Designing Non-National Systems: The Case of the Uniform Domain Name Dispute Resolution Policy*, 43 WM. & MARY L. REV. 141 (2001) (analyzing the development of the UDRP at length); Graeme B. Dinwoodie, *(National) Trademark Laws and the (Non-National) Domain Name System*, 21 U. PA. J. INT'L & ECON. L. 495 (2000) (explaining the clashes between trademark law and the domain name system that gave rise to the non-national solution).

38. For a much fuller account, see Helfer & Dinwoodie, *supra* note 37.

39. *See* Andrew Christie, *The ICANN Domain-Name Dispute Resolution System as a Model for Resolving Other Intellectual Property Disputes on the Internet*, 5 J. WORLD INTELL. PROP. 105, 107–10 (2002).

40. *See* Helfer & Dinwoodie, *supra* note 37 at 167–68.

41. *See* Council for Trade-Related Aspects of Intellectual Prop. Rights, WTO, *Electronic Commerce Work Programme: Submission from Australia*, IP/C/W/233, ¶ 44 (Dec. 7, 2000) (suggesting that the UDRP has "arguably become a de facto international standard" for the resolution of cybersquatting disputes), *at* http://docsonline.wto.org/DDFDocuments/t/IP/C/W233.doc.

42. *See* Helfer & Dinwoodie, *supra* note 37, at 168.

whether to introduce reforms to national law in order to comply with the recommendations.[43] Likewise, the results in UDRP proceedings can be overcome by contrary determinations in national courts and those courts are not obliged to defer (or even refer) in any way to the conclusions of the UDRP panel.[44] Indeed, orders of UDRP panelists may be stayed by nothing more than the losing party filing a complaint in the appropriate national court.[45]

But in practice these new forms of lawmaking may produce harder law. This solidification may happen in different ways. It can occur through traditional public law mechanisms. Consider the recent—very preliminary—draft of an agreement to govern the proposed Free Trade Area of the Americas.[46] The current draft of that agreement would require signatory states to ensure that their trademark laws comply with the WIPO Joint Recommendation on Well-Known Marks.[47] Alternatively, the practical structure of the soft law

43. *See* Well-Known Marks Joint Recommendation, *supra* note 33, at 3 ("[T]his creates no legal obligation for any country, but following such a recommendation would produce practical benefits").

44. *See* UDRP, *supra* note 35, ¶ 4(k) (providing that parties to UDRP disputes are not precluded "from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded"); *see also* Sallen v. Corninthians Licenciamentos LTDA, 273 F.3d 14 (1st Cir. 2001) (noting that UDRP panel decisions are not entitled to any deference in subsequent national court proceedings) (citing cases); *cf.* Holger P. Hestermeyer, *The Invalidity of ICANN's UDRP Under National Law*, 3 MINN. INTELL. PROP. REV. 1 (2002) (suggesting that certain UDRP panel decisions may be vulnerable to attack under French and German law because of the failure of the contractual provision submitting disputes to the UDRP to conform with national consumer protection laws regulating such contractual provisions).

45. *See* UDRP, *supra* note 35, § 4(k) (providing that the filing of a complaint with a court of mutual jurisdiction by a losing respondent within ten business days of the panel's decision will automatically stay the panel's order transferring or canceling the contested domain name). Courts of mutual jurisdiction are determined when the trademark owner files a UDRP complaint. *See*, *e.g.*, UDRP Rules, *supra* note 35, Rule 3(b)(xiii) (requiring that complainant must agree to submit to jurisdiction of a court in at least one specified "mutual jurisdiction" with respect to "challenges to a decision . . . canceling or transferring the domain name"). The trademark owner must select the courts located either where the registrar that issued the domain name registration is located or at the location of the domain-name holder as shown in the registrar's Whois data. *See id.* at Rule 1.

46. *See* Draft Agreement on the Free Trade Area of the Americas, FTAA.TNC/w/133/Rev.1 (July 3, 2001), *at* http://www.ftaa-alca.org/alca_e.asp.

47. *See id.* at 8.3. WIPO has also asked member states to consider whether the different nonbinding trademark recommendations adopted from 1999–2001 should be incorporated in treaties harmonizing trademark law. *See* Proposals for Further Harmonization of Formalities and Procedures in the Field of Marks, WIPO Doc. No. SCT/8/2, ¶ 1 (April 26, 2002) (noting that the WIPO program for 2002–2003 includes consideration by the Standing Committee on Trademarks of the incorporation of the three nonbinding recommendations adopted from 1999–2001 in the framework of harmonization of trademark law), *available at* http://wipo.int/sct/en/documents/session_8/pdf/sct8_2.pdf (last visited June 7, 2002); Suggestions for the Further Development of International Trademark Law, WIPO Doc. No. SCT/8/3, ¶ 1 (April 26, 2002), *available at* http://wipo.int/sct/en/documents/session_8/pdf/sct8_3.pdf (last visited June 7, 2002).

mechanism might cause it to possess more enduring force than would first appear. The soft law character of the UDRP, for example, is arguably belied by the minuscule number of cases in which the losing party has had recourse to national courts. This pre-eminence of the UDRP may in part be attributable to the advantages of UDRP proceedings in comparison to national litigation.[48]

If soft law is so easily hardened, these new lawmaking processes deserve equal care and attention, notwithstanding the advantages that new and faster lawmaking processes offer.[49] As the Argentinean delegation stressed in the 1999 WIPO Assembly meeting, circumspection is appropriate where there is "creation of de facto norms without the permanent transparency of the negotiation and decision-making processes."[50]

A second change that has occurred as a result of the pressure to internationalize intellectual property law is that intellectual property policymaking has been subsumed within the broader apparatus of trade relations. This has occurred unilaterally in the form of annual reviews by the United States Trade Representative under the Special 301 provisions of the Trade Act[51] and the (more recent) equivalent procedure in the European Union under the Trade Barriers Regula-

48. Empirical evidence of challenges in national courts is hard to gather because developing precise data would require coordination among the different registrars to ascertain the number of panel orders that have not been implemented because of the receipt of notice of a court action. One (extremely useful) database of national court challenges to UDRP rulings lists only fifty-one cases (including a mere three non-US cases) out of the more than 4800 UDRP panel decisions to date. *See The UDRP-Court Challenge Database*, *at* http://www.udrplaw.net/UDRPappeals.htm (last modified May 1, 2002). This small number is consistent with anecdotal evidence, although some decisions (of US courts in particular) are beginning to be handed down. *See* Sallen v. Corinthians Licenciamentos, 273 F.3d 14 (1st Cir. 2001) (reversing the dismissal of an action under US law by a US domain name registrant against a Brazilian trademark owner seeking to override a UDRP panel decision in favor of the trademark owner); Barcelona.com, Inc. v. Excelentisimo Ayuntamiento De Barcelona, Civ. Action No. 00-1412-A (E.D. Va. Feb 22, 2002), *available at* http://www.udrplaw.net/Barcelona.pdf (last modified May 1, 2002) (adjudicating a dispute between a Spanish trademark owner and the domain name registrant from whom a UDRP panel had previously ordered transfer of the domain name registration in question).

49. *See* Helfer & Dinwoodie, *supra* note 37, at 245–48 (discussing pace of lawmaking through interpretation of the UDRP).

50. General Report of the Assemblies of the Member States of WIPO, 34th Annual Meeting, Doc. A/34/16, ¶ 178 (Sept. 1999), *at* http://wipo.int/eng/document/govbody/wo_gb_ab/a34_16.htm (last visited June 7, 2002).

51. *See*, *e.g.*, OFFICE OF THE UNITED STATES TRADE REPRESENTATIVE, 2002 SPECIAL 301 REPORT (April 2002), *at* http://www.ustr.gov/reports/2002/special301-report.pdf; *see generally* Kim Newby, *The Effectiveness of Special 301 in Creating Long Term Copyright Protection for U.S. Companies Overseas*, 21 SYRACUSE J. INT'L L. & COM. 29 (1995).

tion.[52] And a parallel shift was effected multilaterally in 1994 by the inclusion of intellectual property provisions (i.e., TRIPs) within the Agreement Establishing the World Trade Organization.[53] The precise ways in which this overarching trade context may transform international intellectual property law remain unclear,[54] but that context surely has altered the *character* of international intellectual property relations. Most directly, the incorporation of intellectual property agreements within trade mechanisms might (if trade concerns become paramount) deprive intellectual property policymaking of the rich palette of human values that historically has influenced its formulation. Considering only the ability to exploit comparative advantage in the ownership of intellectual property rights would appear to make international intellectual property policy less multidimensional. Of course, the outcome of these changes may depend not only upon whether the trade context affects the values underlying nation-to-nation negotiating—"let in my bananas, we'll cut you some slack on CDs" becomes a more ready and explicit form of discussion—but also upon how the binding dispute settlement system of the World Trade Organization (to which the TRIPs obligations are subjected) deals with the trade/intellectual property interface.[55]

The incorporation of intellectual property within the trade arena has, however, already had an interesting institutional effect. Prior to the inclusion of intellectual property within the apparatus of international trade, the primary institutional actor in international intellectual property policy was WIPO.[56] The decision to deploy trade

52. *See* Council Regulation (EC) of 22 Dec. 1994 No. 3286/94 (laying down Community procedures in the field of the common commercial policy in order to ensure the exercise of the Community's rights under international trade rules, in particular those established under the auspices of the World Trade Organization, 1994 O.J. (L 349) 71, as amended by Council Regulation (EC) No. 356/95 of February 20, 1995, 1995 O.J. (L 41) 3); *see generally* David Rose, *The E.U. Trade Barrier Regulation: An Effective Instrument for Promoting Global Harmonisation of Intellectual Property Rights?*, 21 EUR. INTELL. PROP. REV. 313 (1999).

53. The conclusion of TRIPs did not prevent the United States from publishing annual Special 301 reviews of foreign intellectual property protection. Indeed, the Uruguay Round Agreements Act, which implemented the TRIPs Agreement in US law, expressly contemplated that those reviews would continue.

54. *See* Neil W. Netanel, *The Next Round: The Impact of the WIPO Copyright Treaty on TRIPS Dispute Settlement*, 37 VA. J. INT'L L. 441, 451–52 (1997); Dinwoodie, *supra* note 9, at 501–18; David Nimmer, *The End of Copyright*, 48 VAND. L. REV. 1385 (1995).

55. *See generally* Rochelle Cooper Dreyfuss & Andreas F. Lowenfeld, *Two Achievements of the Uruguay Round: Putting TRIPs and Dispute Settlement Together*, 37 VA. J. INT'L L. 275 (1997); *see also* Dinwoodie, *supra* note 15, at 766–69 (discussing the influence of the trade context on the first report issued by a WTO dispute settlement panel regarding a copyright law question).

56. *See* DINWOODIE ET AL., *supra* note 9, at 44.

mechanisms was in part a reflection of fifteen years of little perceived progress at WIPO (at least as viewed by the developed world, and by the United States in particular).[57] But the sudden emergence of the WTO as part of the international intellectual property lawmaking process seemed to energize WIPO, resulting in the conclusion of several new treaties in copyright,[58] patent[59] and trademark law,[60] as well as the reorganization mentioned above that was designed to make WIPO fit for the twenty-first century. This institutional competition may be helpful, as the richer debate that has ensued would suggest.[61]

Relatedly, as noted above, many of the public international obligations undertaken by states are now backed by an effective dispute settlement system (that of the WTO) among states to ensure compliance with the internationally agreed-upon standards.[62] Seven WTO dispute settlement panel reports addressing TRIPs violations have been handed down thus far (three of which also gave rise to reports by the Appellate Body). Although all, bar one, find some transgression of the TRIPs Agreement, these proceedings probably involve the clearest cases of TRIPs noncompliance. Nor should we draw too much significance from the outcomes of these proceedings alone.[63] Indeed, the methodology of panels has been quite strict in tying decisions to the literal language of the TRIPs Agreement; *Webster's Dictionary* has become an essential research tool in WTO TRIPs

57. *See* Susan K. Sell, *Intellectual Property Protection and Antitrust in the Developing World: Crisis, Coercion and Choice*, 49 INT. ORGS. 315, 321 (1995); Peter Drahos, *Global Property Rights in Information: The Story of TRIPs at the GATT*, 13 PROMETHEUS 6, 9 (1995).

58. *See* WIPO Copyright Treaty, WIPO Doc. CRNR/DC/94, Dec. 20, 1996, 36 I.L.M. 65; WIPO Performances and Phonograms Treaty, Dec. 20, 1996, 36 I.L.M. 76.

59. *See* Patent Law Treaty, June 2, 2000 39 I.L.M. 1047.

60. *See* Trademark Law Treaty (Oct. 27 1994), *at* http://clea.wipo.int/lpbin/lpext.dll/clea/LipEN/46e4b/488f4?f=file[document.htm]#JD_74db5.

61. The amount and depth of scholarly writing and speaking on the topic of international intellectual property law has increased exponentially during the past few years, and policymakers from these different institutions have made themselves a ready part of that dialogue.

62. *See* Understanding on Rules and Procedures Governing the Settlement of Disputes, Apr. 15, 1994, WTO Agreement, *supra* note 8, Annex 2, LEGAL INSTRUMENTS—RESULTS OF THE URUGUAY ROUND vol. 31, 33 I.L.M. 112 (1994); *United States–Section 211 Omnibus Appropriations Act of 1998, Report of the Appellate Body*, WTO Doc. No. WT/DS176/AB/R (2002) (reversing Panel Report that offered a narrow interpretation of the scope of TRIPs) *at* http://www.global-trade-law.com/wto.havana%20rum%20case.trademarks(edited)%20(2002).doc (last visited June 7, 2002).

63. *See* Dinwoodie, *supra* note 15, at 765–66 (stressing, in the context of the *United States-Section 110(5)* report, the importance of differentiating the outcome and the reasoning of the panel); Graeme W. Austin, *Valuing "Domestic Self-Determination" in International Intellectual Property Jurisprudence*, 77 CHI.-KENT L. REV. 1155 (2002).

litigation.[64] Moreover, there is evidence that, at least in some respects, WTO panels will not try to alter radically the mix of national autonomy and universal standards embodied in the international intellectual property agreements.[65] But it is also clear that this variable will be a central (if sometimes unexpressed) consideration underlying WTO panel determinations, just as it was in the drafting and revision of the classical conventions.[66] Importantly, however, any recalibration of that balance may now be effected not only by nation-state negotiators but also (and perhaps more easily) by panelists in the WTO dispute settlement body.

The broader process of harmonization, which some of the developments discussed above exemplify, presents many challenges.[67] To the extent that these different lawmaking forces are effecting a convergence around common rules of intellectual property, however, one might suggest that a more intrusive substantive international intellectual property law is growing through public law mechanisms.[68] Yet, rules of similarly de facto global reach may be occurring in private litigation, and they may implicate similar concerns. I have already referenced one such development, namely, the panel decisions issued under the UDRP by ICANN-authorized dispute settlement providers.[69] And any efforts by national courts to adjudicate domain name disputes clearly have an effect beyond national borders; domain name/trademark rules in the generic top-level domains are truly non-national.[70] Or, stated less tendentiously, such decisions by national courts may have substantial effects in a number of countries. The

64. *See* Dinwoodie, *supra* note 15, at 775 (discussing United States-Section 110(5) panel report); J.H. Reichman, *Securing Compliance with the TRIPs Agreement After U.S. v. India*, 1 J. INT'L ECON. L. 585, 594–97 (1998) (discussing India-Pharmaceutical Patents appellate body report); *see also United States-Section 211*, *available at* http://www.worldtradelaw.net/reports/wtoab/us-section211(ab).pdf (last visited June 7, 2002), ¶¶ 137, 172, 187, 215, 219 (citing dictionary definitions of "as is," "derogate," "owner," "available," and "substantiate").

65. *See* Dinwoodie, *supra* note 15, at 764–65 (discussing United States-Section 110(5) panel report); Reichman, *supra* note 64, at 594–97 (discussing India-Pharmaceutical Patents appellate body report).

66. *See* Dinwoodie, *supra* note 15, at 764–66.

67. *See* Graeme B. Dinwoodie, *The Integration of International and Domestic Intellectual Property Lawmaking*, 23 COLOM.-VLA J.L. & ARTS 307, 310 (2000) (discussing EU harmonization of intellectual property laws).

68. *See* Ginsburg, *supra* note 13.

69. *See supra* text accompanying note 37.

70. *See*, *e.g.*, Sallen v. Corinthians Licenciamentos LTDA, 273 F.3d 14 (1st Cir. 2001) (action by US domain name registrant to recover registration from Brazilian trademark owner without equivalent US trademark registration); Heathmount A.E. Corp. v. Technodome.com, 2000 WL 33666935, 60 U.S.P.Q.2d 2018 (E.D. Va. 2000) (applying US law to dispute between Canadian parties because domain name registered with registrar located in the United States).

only means by which this proposition could be altered radically might be through relief mandating the deployment of measures that effect virtual territorialization.[71]

There are many other (apparently more traditional) contexts in which national courts are beginning to tackle cases with broader international ramifications and thus to contribute to the effective creation of international rules. This has occurred most perceptibly and most readily in the copyright context. In the past two years, several courts, with the encouragement of the Second Circuit,[72] have permitted plaintiffs to pursue actions alleging claims under several disparate foreign copyright laws;[73] courts are more consciously separating jurisdiction to adjudicate from questions of applicable law. There is also growing acceptance nationally of a doctrinal device, first used by the Second Circuit, whereby relief will be granted in respect of both domestic and overseas acts of infringement where a predicate act of infringement occurred within the United States and enables further reproduction abroad.[74] In both these ways, courts have provided multinational relief and, in the latter case, have effectively applied a single rule to international conduct.[75] (Even copyright

71. *See Geography and the Net: Putting It in Its Place*, ECONOMIST, Aug. 11, 2001, at 18–20.

72. *See* Boosey & Hawkes Music Publishers, Ltd. v. Walt Disney Co., 145 F.3d 481, 484 (2d Cir. 1998) (reversing district court's dismissal of claims under foreign copyright laws on *forum non coveniens* grounds).

73. *See*, *e.g.*, Carell v. Shubert Org., Inc., 104 F. Supp. 2d 236, 257–59 (S.D.N.Y. 2000) (permitting claims based on foreign copyright laws to proceed notwithstanding the plaintiff's failure to specify in her complaint the particular countries under whose laws the claims were made); Armstrong v. Virgin Records, Ltd., 91 F. Supp. 2d 628, 637–38 (S.D.N.Y. 2000) (entertaining claims based on unspecified foreign copyright laws on the basis of diversity jurisdiction and pendent jurisdiction); Frink Am., Inc. v. Champion Road Mach., Ltd., 961 F. Supp. 398, 404–05 (N.D.N.Y. 1997) (declining to dismiss claim under Canadian copyright law). *But see* ITSI T.V. Prods, Inc. v. Cal. Auth. of Racing Fairs, 785 F. Supp. 854 (E.D. Cal. 1992) (refusing motion to amend complaint to assert claim under Mexican copyright law), *rev'd on other grounds*, 3 F.3d 1289 (9th Cir. 1993).

74. *See* Los Angeles News Serv. v. Reuters T.V. Int'l, Ltd., 149 F.3d 987 (9th Cir. 1998). The device had long been accepted by the Second Circuit. *See* Sheldon v. Metro-Goldwyn Pictures Corp., 106 F.2d 45, 52 (2d Cir. 1939), *aff'd*, 309 U.S. 390 (1940). But the Ninth Circuit had previously expressed some doubt regarding the rule. *See* Subafilms, Ltd. v. MGM-Pathe Comms. Co., 24 F.3d 1088, 1094 (9th Cir. 1994).

75. Although courts applying this theory have applied a single law to the multinational event, it is not inevitable that courts seeking to provide relief for multinational infringement in a single proceeding must apply a single law. Courts could assume jurisdiction over all the related claims but apply different national laws to the different heads of conduct occurring in different jurisdictions, determining liability on a country-by-country basis. *See* Austin, *supra* note 63, at 130–31. Indeed, the new willingness of courts to assume jurisdiction over claims of infringement of foreign copyright law makes this a more plausible alternative. *See supra* text accompanying notes 70–74. For reasons I have explained at length elsewhere, *see* Dinwoodie, *supra* note 9, at 542–79, I favor the application of a single substantive rule (but not *necessarily* one found in the domestic law of a single nation-state, let alone one determined using the vagaries of the

courts that forswear the extraterritorial application of the copyright statute may to some extent be regulating globally when they apply choice of law rules that easily localize any Internet conduct in the United States.[76])

These trends are less evident in patent and trademark cases, where the classical role of national courts has remained more constant. Yet, even here, some US courts have been willing to become embroiled in multinational disputes and apply what in practice is a rule of much more than national scope.[77] Whereas copyright law has formally adhered to a rule proscribing extraterritorial application,[78] US courts have been less restrained in applying the Lanham Act to conduct with a much more tenuous US connection,[79] other than some of the parties involved.[80] And the enactment of the Anti-Cybersquatting Consumer Protection Act in 1999 may prompt even more intrusive US judicial regulation of international domain name space, particularly (though not exclusively) through the capacious *in rem* cause of action granted to trademark owners who cannot obtain jurisdiction *in personam* over a domain name registrant.[81]

predicate act or root copy theory) to copyright disputes that are inherently international. Moreover, in the context of online posting of allegedly infringing material, this possibility of applying different laws *on the question of liability* is very difficult in practical terms. And, although one could award damages in respect only of countries where posting would amount to infringement, injunctive relief is more difficult to fashion absent a willingness to issue orders regulating the nature of online use or imposing technologically grounded obligations. *See infra* note 77 (discussing *Yahoo!* litigation).

76. *See* Dinwoodie, *supra* note 9, at 537 (discussing the ease with which internet copyright-infringing conduct can be localized in the United States).

77. Some courts have, however, sought to be careful in fashioning relief in ways that respect the foreign interests in the dispute before them. *See*, *e.g.*, Playboy Enters., Inc. v. Chuckleberry Publ'g, Inc., 939 F. Supp. 1032 (S.D.N.Y. 1996); Sterling Drug Inc. v. Bayer, 14 F.3d 733 (2d Cir. 1994). Although the use of injunctive relief tailored to accommodate competing interests occurs more frequently (and thus, perhaps, more easily) in trademark cases, *see* Joint Resolution Concerning the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet (Sept. 2001), *available at* http://www.wipo.org/about-ip/en/development_iplaw/pdf/pub845.pdf (suggesting the remedies to be afforded successful plaintiffs in online trademark disputes), it is also possible in copyright cases. *See* Dinwoodie, *supra* note 9, at 558–69 (applying substantive law method to choice of law dilemma in international copyright disputes). This makes somewhat surprising the response of US courts and (most) US commentators (in a non–intellectual property context) to the efforts of the French judge in the well-publicized Yahoo! litigation to find a solution that took account of the values of different affected nation-states. *See* Yahoo! Inc. v. Le Ligue Contre Le Racism et, L'Antismitisme, 145 F. Supp. 2d 1168 (N.D. Cal. 2001).

78. *See* Subafilms, Ltd. v. MGM-Pathe Comms. Co., 24 F.3d 1088 (9th Cir. 1994).

79. *See* Nintendo of Am., Inc. v. Aeropower Co., 34 F.3d 246, 249 n.5 (4th Cir. 1994).

80. *See*, *e.g.*, Ocean Garden, Inc. v. Marktrade Co., 953 F.2d 500 (9th Cir. 1991).

81. *See* 15 U.S.C. § 1125(d)(2); *see also* Heathmount A.E. Corp. v. Technodome.com, 2000 WL 33666935, 60 U.S.P.Q.2d 2018 (E.D. Va. 2000) (exercising *in rem* jurisdiction over a domain name registered with a registrar located in the United States in a dispute between Canadian

As a practical matter, these new private law developments occurring in national courts increasingly may come to comprise and generate the content of international intellectual property law. Moreover, courts have recently expressed some interest in the dynamic between public international intellectual property standards and the role of national courts. One court has found that a plaintiff could, through the vehicle of section 44(b) of the Lanham Act, advance a claim based upon violation of standards found in the Paris Convention rather than being limited to the causes of action expressly delineated in the Lanham Act.[82] The development and content of public international intellectual property law has also informed judicial analysis of *forum non conveniens* issues in several international copyright and trademark cases.[83]

Scholars have also suggested that the choice of law methodologies that US courts have developed in copyright cases, acting free of the constraints of treaty provisions regarding choice of law, might

parties). More all-encompassing US regulation of the domain name space may in the long-term occur through the operation of a complementary, but largely unheralded, provision also introduced by the Anti-Cybersquatting Consumer Protection Act. This provision, codified as section 32(2)(D)(v) of the Lanham Act, permits domain name owners aggrieved at the loss of a UDRP proceeding, and hence of their domain name registration, to bring a claim in US federal court seeking (i) a declaration that their domain name registration does not violate the Lanham Act, and (ii) an order returning the domain name registration. The Court of Appeals for the First Circuit, in the first appellate consideration of this provision, read section 32(2)(D)(v) to offer "disappointed [UDRP] participants with a chance to have *any* unfavorable UDRP decision reviewed in a U.S. court." Sallen v. Corinthians Licenciamentos, 273 F.3d 14, 28 (1st Cir. 2001) (emphasis in original). A textual analysis of section 32(2)(D)(v) suggests that the US court's determination of non-infringement (and hence of the ownership of the domain name registration) would turn on the application of US law. And, under a traditional view of US trademark principles, the ability of the successful UDRP trademark complainant to resist a section 32(2)(D)(v) claim by the domain name registrant would appear to rest upon the trademark owner possessing US rights. *See generally* Graeme B. Dinwoodie, *Ten Years of Trademark Law: Lessons for the Future*, 9 INT'L INTELL. PROP. L. & POL. (Hansen ed., forthcoming 2002). *But see* Barcelona.com, Inc. v. Excelentisimo Ayuntamiento De Barcelona, Civ. Action No. 00-1412-A (E.D. Va. Feb 22, 2002), *available at* http://www.udrplaw.net/Barcelona.pdf (last modified May 1, 2002) (interpreting the Anti-Cybersquatting Consumer Protection Act to protect foreign trademark rights). I am unaware of any similar provision in other countries that might redress this elevation of US courts and US rights. And, in any event, the number of "appeals" of UDRP decisions filed in the US courts, *see supra* note 48, suggests that US law may come essentially to apply to most domain name disputes because of broader social and economic forces. *Cf.* Dinwoodie, *supra* note 9, at 577–79 (discussing copyright law).

82. *See* Gen. Motors Corp. v. Lopez, 948 F. Supp. 684 (E.D. Mich. 1996).

83. *See* Murray v. British Broadcasting Corp., 81 F.3d 287, 290–91 (2d. Cir. 1996) (analyzing the national treatment obligation in international copyright law); Creative Tech., Ltd. v. Aztech Sys., Ltd, 61 F.3d 696, 700–01 (9th Cir. 1995) (giving weight to the principles of national treatment and territoriality); *id.* at 706 (Ferguson J., dissenting) (same); *cf. Heathmount A.E. Corp*., 2000 WL 33666935 (considering the nature of ICANN proceedings); *see also Subafilms*, 24 F.3d at 109–98 (taking into account recent developments in international copyright law in determining the territorial scope of the copyright statute).

include reference to substantive public international copyright law. I refer here not only to my own proposal that well-established international principles contribute to the identification of a substantive governing rule in international copyright cases, but also to suggestions previously made by Jane Ginsburg that provisions in international copyright treaties might serve as a baseline standard to ensure that the foreign law a national court applies complies with international minimum standards. In this fashion, Professor Ginsburg would ensure that the country whose law was applied does not act as a haven for copyright infringers.[84]

In each of these contexts, one finds an echo of the tension underlying the public law debate in the 1880s: the contest remains one that pits notions of universality against those of national autonomy. This is seen in the public international context proper, as might be expected, but also in the development of rules that encourage national courts in private litigation to develop multinational solutions and to engage with public law standards. National courts, it may properly be said, now contribute to the development of international intellectual property law.

III. SITUATING THE HAGUE AND DREYFUSS-GINSBURG PROPOSALS

Where do the proposals discussed during this Symposium—the Draft Hague Convention and the Dreyfuss-Ginsburg proposal—fit within this scheme? Strictly speaking, such treaties might best be described as "public private international law," to borrow Steve Burbank's nomenclature.[85] These treaties are not directly about determining appropriate rules of substantive international intellectual property law, but rather concern the manner in which we determine the appropriate rules. At their most basic, these proposals address the practical problems of litigating national rights in an increasingly non-national world. More systemically, they would establish the basic conditions under which national courts would contribute to and develop a form of international intellectual property law. Thus, these

84. *See* Jane C. Ginsburg, *Private International Law Aspects of the Protection of Works and Objects of Related Rights Transmitted Through Digital Networks*, WIPO Doc. GCPIC/2 (Nov. 30, 1998), *at* http://www.wipo.int/eng/meetings/1998/gcpic/doc/gcpic_2.doc; Jane C. Ginsburg, *Private International Law Aspects of the Protection of Works and Objects of Related Rights Transmitted Through Digital Networks*, *2000 Update*, WIPO Doc. No. PIL/01/02 (2000), *available at* http://wipo.int/pil-forum/en/documents/pdf/pil_01_2.pdf (last visited June 7, 2002).

85. *See* Stephen B. Burbank, *Jurisdictional Equilibration, The Proposed Hague Convention, and Progress in National Law*, 49 AM. J. COMP. L. 203, 204 (2001).

treaties would install the elemental architecture of this (nationally constructed) part of the international intellectual property system, with the precise design to be decided on an ongoing basis by national courts (checked by legislatures) operating within that structure

The development of substantive international rules, and the mediation of the competing values of national autonomy and universal rules, through national court jurisprudence, may possess advantages over public law processes (whether classical or new). When compared with the traditional negotiation of treaties, national court development of "international law" is more responsive to social conditions and hence more dynamic. And it is more readily subject to refinement by a range of national political institutions. Moreover, the articulation of cross-border relief under a single rule by a national court, or (to use the language of my own earlier proposal) the development of a substantive rule of national law applicable to international cases, would not result in the premature entrenchment of such a rule as a higher norm of international law in the way that WTO dispute settlement body rulings in practice might do. At bottom, national court decisions are local law that remains subject to national legislative reversal or modification. And, while courts would be expected to refer to other national court decisions (both domestic and foreign), they would also be formally free to depart from those decisions, retaining the value of national experimentation that is crucial to the classical model of international intellectual property law.[86]

Moreover, this means of developing international intellectual property law is less subject to the political demands that historically have burdened the public international process and that continue to limit its efficacy. To the extent that agreement on substantive harmonized rules (especially forward-looking rules) is fast becoming impossible because of the number of interested parties with disparate agendas in the intellectual property lawmaking process, this alternative form of lawmaking offers a greater prospect of progress. It is uncertain whether the systems of active national court involvement facilitated by the procedural mechanisms discussed during this Symposium would produce rules more favorable to supporters or opponents of expansive intellectual property protection. But one value of these systems as lawmaking instruments may in fact lie in the common *uncertainty* as to the rules that they might produce. Negotiating

86. *See* Austin, *supra* note 63.

for certainty, whether in substantive rules of intellectual property law or in the allocation of prescriptive authority between international and national law, has proven a difficult endeavor of late.

Critics of this purported procedural neutrality might argue that such systems embed quite partisan values, although broader systemic values than those underlying intellectual property policy alone. The Hague Convention, for example, would establish procedural rules that clearly contemplate the possibility of some degree of cross-border relief, of decisions that effect change beyond national borders, or of the universalization of certain values and rules.

This critique is descriptively accurate, but unpersuasive as a rebuttal to the development of the systems contemplated by the draft Hague and Dreyfuss-Ginsburg proposals. Consider the alternative—and this is, I would suggest, a crucial perspective—of cross-border relief being developed on a purely ad hoc basis, in other words of a greater number of decisions by national courts that (without reasoned contemplation) affect conduct beyond their borders. Let us not be naive about the choice: there is no idealized "national" world of hermetically sealed borders within which national courts decide disputes without spillover effects. The choice is between two scenarios, both of which involve a departure from a theorized territorial model: (1) courts providing relief that extends their law beyond their borders, but doing so without considering explicitly the external effects of their application of local law or why to offer cross-border relief; and (2) the development of a system in which courts offer conscious explanations of why cross-border relief is appropriate and why the internal effects of one state outweigh the external effects on another. It is, in effect, the difference between a systematic and transparent development of these rules of international intellectual property law, bounded by outside parameters established by nation states, and a spate of competing decisions with universal effects but unaccompanied by any effort at justifying or explaining the same.

Moreover, I am less troubled than others by the notion that we are moving in some respects toward a different balance of universal and national values—though the precise balance is a point of genuine debate. Proper respect for national values, especially as long as national political structures remain the primary voice for the expression of political viewpoints, is important. But the balance between national and non-national sources of affinity is shifting; legal institutions

that reflect the impulses of the citizenry are more likely to endure than those which resist or counter those impulses.[87]

Having urged a realist perspective on those who find these proposals unsettlingly close to the imposition of global values, let me also suggest a reality check for those who seek to advance enlightened systems of so-called "public private international law." It may be some time before judges in national courts can function in ways that routinely defer to the application of foreign law. But there are signs of progress in judicial awareness of the experience and decisions of other national courts also, as Anne-Marie Slaughter[88] has shown in her work on judicial globalization and as Mark Tushnet and Vicki Jackson have indicated in their analyses of comparative constitutional law.[89]

IV. CONCLUSION

In conclusion, national court decisions may of themselves construct (or at least contribute to) international intellectual property law through the sheer fact of their geographical reach. And this contribution may occur whether effectuated through the ad hoc application and extension of existing doctrinal devices by national courts or through the development and application of a treaty under which such developments are consciously encouraged or appropriately limited.[90]

To some extent, cross-border spillover has always existed. Classic nineteenth century tort actions where conduct in one state caused effects in another state implicated very similar questions: negligence in one state only came home to roost in another state. Courts sought to localize such disputes, which in fact happened in two states, as legally occurring in one state. This is what makes conflicts hard. One might argue that the increased range of such cross-border cases in modern economies can be viewed as merely a difference in degree

87. *See* Dinwoodie, *supra* note 9, at 550–51.

88. *See* Anne-Marie Slaughter, *Judicial Globalization*, 39 VA. J. INT'L L. 1103 (1999).

89. *See* Mark Tushnet, *The Possibilities of Comparative Constitutional Law*, 108 YALE L.J. 1225 (1999); Mark Tushnet, *Returning with Interest: Observations on Some Putative Benefits of Studying Comparative Constitutional Law*, 1 U. PA. J. CONST. L. 325 (1998); Vicki C. Jackson, *Narratives of Federalism: Of Continuities and Comparative Constitutional Experience*, 51 DUKE L.J. 223 (2001).

90. Indeed, those critics who wish to reserve intellectual property issues to the control of national courts might wish to ensure that the Hague Convention includes a broad exclusive jurisdiction provision rather than (as many do) advocating that intellectual property be wholly excluded from the scope of the convention.

from that nineteenth century model. But at some point a difference in *degree* becomes a difference in *kind*. To be sure, there are costs to making changes in legal rules.[91] But at what point do we continue to build our analytical models around fact patterns that represent the exception rather than the rule?

Of course, this question begs a further inquiry: is the multinational or international or cross-border dispute the norm in intellectual property cases? Despite the increasingly large body of scholarship working off this premise, it is not decisively clear that that stage has been reached. An empirical study of the frequency of the types of problems with which this Symposium has grappled would, I think, be a valuable contribution to the debate.

In any event, it is more important to start thinking and talking about the likely challenges of tomorrow than to be confined by present realities. The problems to which the Hague and Dreyfuss-Ginsburg proposals are addressed are, I would suggest, likely to multiply because of broader reasons of societal development. Recent international intellectual property lawmaking, and certainly the ponderous negotiation of the draft Hague Convention, suggests that an informed and inclusive dialogue regarding such proposals will be a long conversation. It is thus an opportune time to begin to discuss the complex issues that they raise.

91. *See* Michael P. Van Alstine, *Treaty Law and Legal Transition Costs*, 77 CHI.-KENT L. REV. 1303 (2002).