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Intellectual property lawyers and intellectual property scholars have on the whole had little to say about conflicts matters.¹ And, reciprocating the affectation of nonchalance,² conflicts scholars have had very little to say about intellectual property law.³ If one scans the principal intellectual property treatises and casebooks, one largely finds passing discussion of the traditional trinity of private international law (jurisdiction, choice of law, and recognition and enforcement of judgments). The same has been true until recently with conflicts treatises and casebooks; intellectual property is given short shrift (if any mention at all).

This essay begins by canvassing some reasons for this lack of engagement between intellectual property and conflicts scholars in the United States. In Part II of the essay, I discuss developments that suggest an evolving *détente*, if one largely grounded in practical necessity.⁴ In

*Professor of Law, Chicago-Kent College of Law. Copyright 2001, Graeme B. Dinwoodie. This essay is based upon a presentation at the Annual Meeting of the Association of American Law Schools, Section on Conflict of Laws, in San Francisco in January 2001. My thanks to my fellow panelists, Bénédicte Fauvarque-Cosson, Mathias Reimann, and Michael Traynor, for the positive effect that their contributions have undoubtedly had on the development of many of the thoughts articulated herein. Thanks also to Brian Havel for helpful comments on an earlier draft of this essay. The late Fritz Juenger forced me to consider many of these issues anew, both through personal urging and through the power of his scholarship. I will always be grateful. The views expressed in this essay are, however, mine alone.

¹See *Itar-Tass Russian News Agency v. Russian Kurier, Inc.*, 153 F.3d 82, 88 (2d Cir. 1998) (noting that “choice of law issues in international copyright cases have been largely ignored in the reported decisions and dealt with rather cursorily by most commentators.”).

²The apparent nonchalance may in fact reflect an unfamiliarity by one group of scholars with the methodologies and structures of the discipline of the other. See JAMES J. FAWCETT AND PAUL TORREMANS, *INTELLECTUAL PROPERTY AND PRIVATE INTERNATIONAL LAW* 4 (1998) (“Many problems have been created by the fact that intellectual property lawyers are not entirely familiar with the methodology of private international law. Conflicts lawyers, on the other hand, tend to be baffled by the complexity of the national and international intellectual property law.”).

³See P.B. Carter, General Editor’s Preface, in FAWCETT AND TORREMANS, *supra* note 2 (“Historically the impact of private international law upon intellectual property issues was slight”); FAWCETT AND TORREMANS, *supra* note 2, at vii (“Private international lawyers have largely ignored [intellectual property law]”).

⁴See Carter, *supra* note 3 (commenting that “whatever the explanation of the past failure of private international law to meet the need to accommodate problems in the area of intellectual property, that need is compelling” and noting that the need “has become even

particular, I analyze two aspects of recent international intellectual property litigation: (i) responses, actual and proposed, to the difficulties of litigating cases of international copyright infringement under the prevailing premise of territoriality, and (ii) the development of autonomous (non-national) substantive trademark law through the use of dispute resolution panels convened under the rules of the Internet Corporation for Assigned Names and Numbers (ICANN). I conclude in Part III by discussing briefly how the changing nature of international intellectual property litigation implicates the comparative method, both in general and as regards conflict of laws in particular, and suggest that these changes may herald a greater role for comparative thought than intellectual property litigation would heretofore have provided.

I. THE LACK OF ENGAGEMENT BETWEEN CONFLICTS AND INTELLECTUAL PROPERTY SCHOLARS

From the perspective of U.S. conflicts scholars, the lack of attention to issues presented by intellectual property law stems in part from a preoccupation with internal, domestic, multistate disputes.⁵ In some respects, this domestic focus might appear unsurprising. The United States is a large and diverse country comprising many autonomous political sub-units that enjoy adjudicatory and prescriptive authority. As commerce, culture, and communication became more national in nature, conflicts between different states within the United States were sufficiently plentiful to provide grist for

more pressing” as a result of advances in technology).

⁵The intangible nature of intellectual property rights may also be responsible for difficulties in addressing conflicts issues in intellectual property law. See J.H. Reichman and Pamela Samuelson, *Intellectual Property Rights in Data?*, 50 VAND. L. REV. 51, 112 n.279 (1997) (“From a legal perspective, these developments [in database protection] raise daunting problems of conflicts of law, a field that has never found it easy to accommodate intangible property”); Carter, *supra* note 3 (discussing the lack of attention to conflicts issues in intellectual property law and noting that “the physical location of non-physical phenomena presented difficulty”). Intangible property has no obvious *situs* that would facilitate the process of localization typically effected by choice of law rules. Indeed, in the digital environment, its intangibility leads to ubiquity, which wholly undermines the project of localization. If the intangible nature of intellectual property were the cause of a lack of scholarly interest, the lack of attention could not be solved merely by reorienting the focus of conflicts and intellectual property scholarship. But one might have expected such intellectual challenges to attract, rather than to repel, scholars. And, perhaps more significantly, conflicts rules have been applied, albeit with some difficulty, to (intangible) intellectual property rights conferred by state law. See *infra* note 16 (citing cases involving trade secret rights and publicity rights). The federal nature of the primary rights, rather than their intangible nature, thus appears the principal cause of the historical lack of scholarly or judicial attention within the United States.

the mills of both courts and conflicts scholars.

Of course, even in this climate, international disputes confronted courts in the United States. Indeed, some of the leading cases through which courts developed modern approaches to choice of law, and which fed scholarly debate in the latter half of the twentieth century, involved disputes that extended beyond U.S. borders.⁶ Yet, courts and scholars treated such cases in the same manner as they did domestic disputes. This assimilation of international disputes to the domestic model may have been because many of these disputes involved neighborly conflicts with the adjacent provinces of Canada and Mexico. It may also have been because the methodological framework within which courts addressed numerous and more prevalent domestic conflicts was simply too dominant to warrant jettisoning for the exceptional and less frequent international case. In any event, the domestic multistate dispute has prevailed as the model for primary judicial and scholarly attention to conflicts issues in the United States.⁷

Protection of the three principal forms of intellectual property in the United States is accorded under federal law. Patent protection is exclusively federal;⁸ the 1976 Copyright Revision Act federalized the entire corpus of

⁶*See, e.g.*, *Babcock v. Jackson*, 12 N.Y.2d 473 (1963) (adopting full-blown policy-based analysis in the course of deciding a conflict between the laws of New York and Ontario); *Neumeier v. Kuehner*, 31 N.Y.2d 121 (1972) (endorsing the need to articulate certain general rules in guest statute cases in the course of deciding a conflict between the law of New York and Ontario); *Hurtado v. Superior Court*, 11 Cal.3d 574 (1974) (conflict between the laws of Mexico and California); *Auten v. Auten*, 308 N.Y. 155 (1954) (moving away from the traditional approach to choice of law in deciding a conflict between the laws of New York and England); *O'Connor v. O'Connor*, 201 Conn. 632 (1986) (abandoning the *lex loci delicti* in course of deciding a conflict between the laws of Connecticut and Quebec); *Milkovich v. Saari*, 295 Minn. 155 (1973) (a leading case on the use of Professor Leflar's choice-influencing considerations involving a conflict between the laws of Minnesota and Ontario).

⁷Most of this discussion relates to choice of law, which has consumed the greatest part of scholarly attention in the conflicts field. But some of the leading decisions of the United States Supreme Court on personal jurisdiction have also involved foreign parties. *See, e.g.*, *Asahi Metal Indus. Co. v. Superior Court*, 480 U.S. 102 (1987); *Helicopteros Nacionales de Colombia v. Hall*, 466 U.S. 408 (1984). In that context, the international nature of the dispute – or, more precisely, the foreign citizenship of the non-resident defendant – might affect whether it is reasonable to exercise jurisdiction and thus whether to do so would offend traditional notions of fair play and substantial justice. *See Asahi*, 480 U.S. at 116 (discussing and placing weight on the “international context”). Similarly, the international nature of a dispute regarding recognition and enforcement of judgments should be relevant because the Full Faith and Credit Clause, *see* U.S. CONST., art. IV, § 1, which regulates many of such matters in the domestic multistate context, is inapplicable in the international setting.

⁸*See Bonito Boats Inc. v. Thunder Craft Boats Inc.*, 489 U.S. 141 (1989) (preempting state law that granted patent-like rights to boat hulls).

copyright law, bringing unpublished works as well as published works within its reach;⁹ and disputes over trademarks, which may nominally be protected under both state and federal law, are typically litigated under federal law such that state standards have converged around the federal.¹⁰ Thus a focus on internal multistate disputes will necessarily avoid conflicts questions raised by the primary intellectual property regimes.

To be sure, international intellectual property cases have presented themselves and the courts have developed methodologies to address, for example, whether U.S. law should be applied to conduct occurring outside the United States. But these methodologies have typically been more rigid and mechanical.¹¹ Because courts were disinclined to apply foreign intellectual property laws, regarding them as part of the “public law taboo,” courts largely avoided consideration of the competing interests of different states.¹²

Interestingly, many of the leading international copyright and

⁹See 17 U.S.C. § 301 (preempting state causes of actions that grants right equivalent to copyright to subject matter within the scope of copyright); H.R. Rep. No. 1476, 94th Cong. 129 (1976) (noting the shift from a dual copyright system, split between state and federal law depending upon the published or unpublished status of a work, to a unified form of federal protection). Prior to the 1976 Act, unpublished works were protected under state law. See *Forward v. Thorogood*, 985 F.2d 604 (1st Cir. 1993).

¹⁰See *Maternally Yours v. Your Maternity Shop*, 234 F.2d 538, 545 (2d Cir. 1956) (Clark J. concurring) (noting that “a more academic issue [than the choice between state and federal trademark law] can hardly be conceived”). State trademark and unfair competition laws may vary from the federal model on occasion. And state forms of protection may offer protection to local interests insufficiently national to warrant federal protection. In particular, state dilution laws may offer regionally famous marks protection; federal trademark dilution legislation, see 15 U.S.C. § 1125(c), offers less certain protection to marks with such geographically limited fame. See *Greenpoint Financial Corp. v. The Sperry & Hutchison Co., Inc.*, 116 F. Supp.2d 405, 413 (S.D.N.Y. 2000) (rejecting federal dilution claim where mark was famous only in the New York city tri-state area); see also H.R. Rep. No. 374, 104th Cong., 1st Sess., 1996 U.S.C.C.A.N. 1029, 1030-31 (noting that to be protected by the federal legislation the geographic fame of the mark must extend through a substantial portion of the United States”).

¹¹See *Vanity Fair Mills v. T. Eaton & Co.*, 234 F.2d 633 (2d Cir. 1956) (considering the extraterritorial application of the trademark statute); *Robert Stigwood Group Ltd. v. O’Reilly*, 530 F.2d 1096 (2d Cir. 1976) (considering the extraterritorial application of the Copyright Act).

¹²See *Vanity Fair*, 234 F.2d at 633 (dismissing trademark case involving foreign trademark law); *Subafilms, Ltd. v. MGM-Pathe Comms. Co.*, 24 F.3d 1088 (9th Cir. 1994) (dismissing copyright case where allegedly infringing conduct occurred abroad). While such tests have attracted *some* (insightful) scholarly attention, see, e.g., Curtis A. Bradley, *Territorial Intellectual Property Rights in an Age of Globalism*, 37 VA. J. INT’L L. 505 (1997), this has been on the periphery of conflicts scholarship, and has occurred primarily in the last few years.

trademark disputes also involve Canada or Mexico.¹³ And, although globalization has expanded the range of recent disputes beyond North America,¹⁴ a steady flow of Canadian and Mexican intellectual property conflicts continues to generate U.S. litigation.¹⁵ Yet, courts addressing conflicts in the leading intellectual property cases have not treated the Canadian or Mexican disputes as akin to domestic conflicts. Instead, because those cases involved uniform federal law conflicting with the laws of a foreign country, the contrast with domestic disputes was painted starkly. In intellectual property cases involving federal law, therefore, the international dispute represents the conflicts paradigm rather than the exception, instantly separating such disputes from the principal focus of scholarly attention.

The suspicion that the federal nature of the primary intellectual property rights (and thus the inevitably international nature of any conflicts) is a significant cause of the lack of attention by conflicts scholars is confirmed by two observations. First, courts have issued detailed opinions dealing with conflicts involving the remaining state law-based forms of intellectual property, such as publicity rights or trade secret protection.¹⁶ The analysis in such cases more closely approximates that found in the cases over which scholars and courts have pored for the last half-century, and thus finds

¹³See, e.g., *Steele v. Bulova Watch Co.*, 344 U.S. 280 (1952) (Mexico); *Vanity Fair Mills v. T. Eaton & Co.*, 234 F.2d 633 (2d Cir. 1956) (Canada); *Robert Stigwood Group Ltd. v. O'Reilly*, 530 F.2d 1096, 1101 (2d Cir. 1976) (Canada).

¹⁴See, e.g., *Itar-Tass Russian News Agency v. Russian Kurier, Inc.*, 153 F.3d 82, 88 (2d Cir. 1998) (Russian law); *Sterling Drug Inc. v. Bayer*, 14 F.3d 733 (2d Cir. 1994) (worldwide rights held by a German company); *Creative Technology, Ltd. v. Aztech System, Ltd.*, 61 F.3d 696 (9th Cir. 1995) (Singapore law); *Bridgeman Art Library Ltd. v. Corel Corp.*, 25 F.Supp.2d 421 (S.D.N.Y. 1998), *aff'd on reconsideration*, 36 F.Supp.2d 191 (S.D.N.Y. 1999) (U.K. law); *Boosey & Hawkes Music Pubs. v. The Walt Disney Co.*, 145 F.3d 481 (2d Cir. 1998) (rights in 18 countries),

¹⁵See, e.g., *Aerogroup v. Marlboro Footworks*, 955 F. Supp. 220 (S.D.N.Y. 1997), *aff'd*, 152 F.3d 948 (Fed. Cir. 1998) (Canada); *National Football League v. TVRadioNow Corp.*, 53 U.S.P.Q.2d 1831, 1834-35 (E.D. Pa. 2000) (Canada); *Allarcom Pay TV Ltd. v. General Instrument Corp.*, 69 F.3d 381 (9th Cir. 1995) (Canada); *ITSI T.V. Prods, Inc. v. California Authority of Racing Fairs*, 3 F.3d 1289 (9th Cir. 1993) (Mexico).

¹⁶See *Cairns v. Franklin Mint Co.*, 24 F. Supp.2d 1013 (C.D. Cal. 1998) (publicity rights); *BP Chemicals Ltd. v. Formosa Chemical & Fibre Corp.*, 229 F.3d 254, 264 (3d Cir. 2000) (trade secret protection). The federalization of trade secret law originated in 1996 with the Economic Espionage Act, 18 U.S.C. § 1831-39 (West Supp. 1998), and there have been moves afoot for a while to federalize publicity rights. See Marci Hamilton et al., *Rights of Publicity: An In-Depth Analysis of the New Legislative Proposals to Congress*, 16 CARD. ARTS & ENT. L.J. 209, 209-211 (1998) (comments by Steven M. Getzoff) (discussing status of proposals for federal publicity statute). Thus, those domestic multistate conflicts issues that remain in intellectual property litigation may soon go the way of the primary forms of intellectual property.

itself a more ready part of the scholarly debate (notwithstanding its relatively minor significance in the intellectual property scheme).¹⁷

Second, a comparison with Europe shows a (slightly) more long-standing interest abroad in the private international law of intellectual property.¹⁸ Europe does not have the luxury of a common intellectual property law, even with continuing legislative efforts at harmonization of national laws.¹⁹ Intellectual property rights are (with the one recent exception of a unitary supranational trademark that covers the entire territory of the EU)²⁰ established by national laws operating within a federal free trade area.

¹⁷Even treatise authors who are beginning to recognize more explicitly the growing international dimensions of the discipline and the increased importance of intellectual property issues continue to treat the state-based forms of protection more centrally than the (economically more significant) federal patent, copyright and trademark rights. For example, in the recently published fourth edition of his *Commentary on the Conflict of Laws*, Russell Weintraub has added a chapter on international issues. See RUSSELL J. WEINTRAUB, COMMENTARY ON THE CONFLICTS OF LAWS Ch. 12 (4th ed. 2001). But intellectual property issues still receive little prominence as part of that discussion. Copyright and trademark laws merit two sentences six pages from the conclusion of the book. See *id.* at § 12.4. In contrast, Professor Weintraub separately addresses the problems presented by “multiple state torts” such as invasion of privacy, libel and the infringement of the right of publicity as part of the heart of his analysis of choice of law in tort cases. See RUSSELL J. WEINTRAUB, COMMENTARY ON THE CONFLICTS OF LAWS § 6.32 (4th ed. 2001). The right of publicity represents an extremely small part of U.S. intellectual property law. Similarly, another leading treatise has added a short but instructive section on jurisdiction in cases of intellectual property infringement, see EUGENE F. SCOLES, PETER HAY, PATRICK J. BORCHERS AND SYMEON C. SYMEONIDES, CONFLICT OF LAWS § 9.3 (3d ed. 2000), and addresses the interstate aspects of choice of law in unfair competition cases in some detail. See *id.* at § 17.53. But the same section simply notes in a footnote that “this section deals with the interstate aspects of unfair competition. A wide diversity of opinion has been expressed in the international context.” *Id.* at n.1.

¹⁸Even within Europe, the development of a private international law of intellectual property law is recent. See Carter, *supra* note 3 (noting “some, albeit piecemeal, progress” since 1990 in the development of a private international law of intellectual property).

¹⁹See Graeme B. Dinwoodie, *A New Copyright Order: Why National Courts Should Create Global Norms*, 149 U. PA. L. REV. 469, 495-97 (2000) (explaining the nature of the harmonization of copyright law in the European Union); Timothy W. Blakely, Comment, *Beyond the International Harmonization of Trademark Law: The Community Trademark as a Model of Unitary Transnational Trademark Protection*, 149 U. PA. L. REV. 309, 323-330 (2000) (explaining the nature of the harmonization of trademark law in the European Union); *Coin Controls Ltd. v. Suzo International (UK) Ltd.*, [1997] 3 All ER 45 (Ch. D. 1997) (Eng) (emphasizing that an application under the European Patent Convention still results in the grant of national patent rights).

²⁰See Council Regulation 40/94 of 20 December 1993 on The Community Trademark, 1994 O.J. (L 11); see generally EUROPEAN COMMUNITY TRADEMARK: COMMENTARY TO THE EUROPEAN COMMUNITY REGULATION (Mario Franzosi ed. 1997); GRAEME B. DINWOODIE, WILLIAM HENNESSEY AND SHIRA PERLMUTTER, INTERNATIONAL

In the EU, there is relatively more interest in the private international aspects of intellectual property law.²¹ The output is still hardly overwhelming, but one finds studies by Professor Ulmer commissioned by the European Commission as far back as 1970,²² there are now monographs on the private international aspects of intellectual property law published in the last decade,²³ and one copyright directive has included a harmonized choice of law rule.²⁴

This analysis may explain why intellectual property law has not been at the center of conflicts scholarship. But why have intellectual property scholars not placed conflicts issues high on their agenda? In large part, this lack of engagement can be attributed to the looming presence of public international intellectual property law. Intellectual property is the subject of extensive public international agreements by states seeking to ensure a certain level of international protection for their authors and producers. As far back as the 1880s, multilateral treaties were concluded articulating international standards of copyright, patent and trademark protection.²⁵ These treaties (the Berne Convention and the Paris Convention) also provided for the equal treatment of foreign authors, inventors, and producers in signatory countries

INTELLECTUAL PROPERTY LAW AND POLICY 1034-59 (Matthew Bender 2001). Parallel legislation creating a unitary Community Design Right and a unitary Community Patent is pending. See Amended Proposal for a Council Regulation on Community Design, COM(2000) 660 final/2 (Nov. 23, 2000), available at http://www.europa.eu.int/comm/internal_market/en/intprop/indprop/com660en.pdf (last visited Jan. 27, 2001); Proposal for a Council Regulation on a Community Patent, COM(2000) 412 final (Aug. 1, 2000), available at: http://www.europa.eu.int/comm/internal_market/en/intprop/indprop/412en.pdf (last visited Jan. 27, 2001).

²¹This attention is heavily focused on intra-European conflicts, and thus in this respect mirrors the U.S. experience. But in the European context, by virtue of the different stage of federal development in the European Union and the role of more heterogeneous nation-states as constituent parts of the inchoate federal union, this similarly introspective focus is “international” in a way that U.S. analysis has never been.

²²See EUGEN ULMER, *INTELLECTUAL PROPERTY RIGHTS AND THE CONFLICT OF LAWS* (trans. ed. 1976).

²³See, e.g., FAWCETT AND TORREMANS, *supra* note 2.

²⁴See Council Directive 93/83/EEC of 27 September 1993 on The Coordination of Certain Rules Concerning Copyright and Rights Related to Copyright Applicable to Satellite Broadcasting and Cable Retransmission, 1993 O.J. (L 248), art. 1(2)(b) (defining the act of communication to the public).

²⁵See Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, as last revised at Stockholm, July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305; Berne Convention for The Protection of Literary and Artistic Works (1971 Paris text), 1161 U.N.T.S. 3 (first concluded in 1886).

(the principle of national treatment).²⁶ Public international lawmaking has become even more pronounced during the past decade; the body of public international intellectual property law is now quite vast. And many of these treaties are subsumed within the dispute settlement mechanisms of the World Trade Organization such that they now are effectively enforceable against all the states parties to the WTO Agreement.²⁷

Treatment by public international law has the capacity to reduce the importance of private international law. Indeed, the Court of Appeals for the Ninth Circuit has in recent years used the frenetic public international lawmaking by the U.S. government to explain the court's reluctance to become involved in international intellectual property litigation.²⁸ And, to be sure, if the content of national intellectual property laws comes to approximate a set of common standards enshrined in international agreements, then fewer conflicts questions should arise.²⁹

Yet, this surface tranquility may be misleading. The standards found in international agreements typically are *minimum* standards; states are free to grant higher levels of protection.³⁰ Thus, notwithstanding international minimum standards, differences in national laws persist. Moreover, in certain crucial areas, the treaties allow member states significant latitude to adopt rules that are tailored to their own social and economic priorities and philosophies. For example, states signatory to international copyright conventions may generally define the central concept of "author" in different

²⁶See Paris Convention, *supra* note 25, arts. 2, 6(2); Berne Convention, *supra* note 25, art. 5(1).

²⁷See Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments—Results of the Uruguay Round, vol. 31, 33 I.L.M. 81 (1994); Understanding on Rules and Procedures Governing the Settlement of Disputes, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 2, Legal Instruments—Results of the Uruguay Round vol. 31, 33 I.L.M. 112 (1994).

²⁸See *Subafilms, Ltd. v. MGM-Pathe Comms. Co.*, 24 F.3d 1088, 1095-98 (9th Cir. 1994).

²⁹International intellectual property agreements do not address jurisdiction, and thus disputes may still arise as to whether a particular court had authority to hear a case. But because the applicable laws would be similar, choice of law questions would be reduced, and (subject to jurisdictional concerns) recognition of foreign judgments would present fewer problems of the rules upon which the judgment was based offending the public policy of the enforcing state.

³⁰See TRIPS Agreement, *supra* note 27, art. 1(1). The harmonization efforts of the EU seek to effect more tightly-controlled commonality, sometimes imposing ceilings on the degree of variation that member states may permit. See Dinwoodie, *supra* note 19, at 497 (discussing copyright directives); DINWOODIE ET AL., *supra* note 20, at 222 (discussing the limited room for variation permitted by the trademark harmonisation directive).

ways that reflect quite divergent philosophical groundings of copyright (and which thus identify different authors of a work).³¹ This conscious, and valuable, concession to national autonomy and the value of diversity creates potential conflicts issues. Finally, even identical rules of law may lead to different results when applied in different social contexts by different tribunals. National laws -- including harmonized national laws -- are normally applied by reference to national market conditions. Factual differences in social practices, competitive conditions or consumer attitudes will lead to different legal conclusions (even under the same legal standard) that rest on those factual findings. For example, the meaning of a word or other symbol claimed as a trademark may vary from one country to another because of both linguistic denotation and social connotation, and thus the application of the same trademark rule may generate a different result because the word or symbol operates as a trademark in only some of those countries.³² Numerous intellectual property concepts reflect underlying determinations of the appropriate balance between ensuring competition and stimulating innovation;³³ but different competitive climates may subsist in different national markets, warranting a different balance and thus divergent interpretation of the (supposedly harmonized) concept in question. Whether an unauthorized use of a copyrighted work is fair use may in part depend upon whether a market for such uses is “traditional, reasonable, or likely to develop,” which in turn may hinge on nationally distinct social practices and technological capabilities.³⁴ Consumers in different national markets, subjected to different marketing practices, may be confused by the use of an allegedly similar trademark in different circumstances.

Aspects of international treaties other than substantive minimum

³¹See Dinwoodie, *supra* note 19, at 491.

³²See *Playboy Enters. v. Chuckleberry Pub. Inc.*, 939 F. Supp. 1032 (S.D.N.Y. 1996).

³³See Jane C. Ginsburg, *No “Sweat?” Copyright and Other Protection of Works of Information After Feist v. Rural Telephone*, 92 COLUM. L. REV. 338, 346 (1992) (suggesting that the idea/expression distinction in copyright law reflects notions of appropriate competition); Graeme B. Dinwoodie, *The Death of Ontology: A Teleological Approach to Trademark Law*, 84 IOWA L. REV. 611, 652 (1999) (noting the explicit grounding of the trademark functionality doctrine in judicial concern that broad trade dress protection not give rise to anticompetitive consequences).

³⁴This formulation of how market analysis affects permissible unauthorized uses is taken from U.S. copyright law, but is not unlike the approach recently developed by a WTO dispute settlement panel in interpreting Article 13 of TRIPS; Article 13 sets out the conditions under which WTO members may create any exceptions to copyright. See Graeme B. Dinwoodie, *The Development and Incorporation of International Norms in the Formation of Copyright Law*, 62 OHIO STATE L.J. 733, 754-59 (2001).

standards may, however, also have restricted attention by intellectual property scholars to conflicts issues. The adoption of the principle of national treatment as the primary means of ensuring broader international protection was in fact the corollary of another principle, namely, territoriality.³⁵ Intellectual property rights are resolutely territorial in nature. There is no such thing, properly speaking, as an international copyright, even under international copyright law. The creation of a single motion picture gives rise to a French copyright, an American copyright, a British copyright, and so on. Similarly, the first use in commerce of a source-identifying term in the United States will secure trademark rights only in the United States.³⁶ If a competing producer registers the same term for the same goods in France, the second producer will own the rights to the trademark in France. Indeed, even if the same person owns the rights in different countries, the rights remain conceptually separate, to be sued upon and enforced separately (typically) in separate proceedings.³⁷ International intellectual property agreements simply grant authors and producers the right to receive in foreign countries a guaranteed minimum level of protection, and to receive protection on the same terms as local authors and producers.³⁸

³⁵See Carter, *supra* note 3 (attributing the lack of attention to conflicts matters in intellectual property law in part to the “territorial approach” of private international lawyers but noting that the situation had barely improved in the era of policy-based conflicts methodologies); *see also* Vanity Fair Mills v. T. Eaton & Co., 234 F.2d 633, 640-41 (2d Cir. 1956) (linking national treatment principle and territoriality).

³⁶Strictly, the use will secure rights only in the areas of use and related “zones of expansion.” *See* United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90 (1918) (discussing geographic scope of use-based rights). To ensure national rights, the producer must either use the mark nationally or register the mark with the Patent and Trademark Office. *See* 15 U.S.C. § 1057(c) (registration application constitutes constructive nationwide use); § 1072 (registration constitutes constructive notice).

³⁷*See* Computer Associates Int’l, Inc. v. Altai, Inc., 126 F.3d 365 (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 U.S. proceedings between the same parties involving the same works); *see also* Euromarket Designs, Inc. v. Crate and Barrel Limited and Miriam Peters, 96 F. Supp.2d 824 (N. D. Ill. 2000) (claim for infringement of U.S. trademark rights in mark CRATE & BARREL); *Euromarket Designs Inc. v. Peters*, [2000] E.T.M.R. 1025 (Ch. D. 2000) (Eng.) (claim for infringement of U.K. trademark rights in mark CRATE & BARREL).

³⁸The principle of national treatment found in the Berne and Paris Conventions has been elevated to a general principle of international intellectual property law by the TRIPS Agreement. *See* TRIPS Agreement, *supra* note 27, art. 3. The demise of the alternative principle of reciprocity may reduce the need for comparative work because the recognition of rights becomes independent of foreign legal systems. As demonstrated by recent EU directives that, relying on claimed exceptions to Article 3 of TRIPS, condition protection on reciprocity, the comparative work necessitated by the use of reciprocity as a condition for

The principle of territoriality led naturally, at least in the crucial matter of determining infringement, to the proposition that the *lex loci delicti* was the applicable law, meaning in copyright cases that the propriety of a defendant's conduct in copying a work would be determined by where the allegedly unauthorized copying or publication occurred. And in trademark cases, the defendant's conduct in using a particular mark was adjudged by the law of the place where the alleged passing off occurred, and in respect of which, therefore, the plaintiff was claiming rights.³⁹ The principle of territoriality, with the delictual act consisting of clearly defined acts, was seen as a simple and universal choice of law rule. Intellectual property conflicts were simple to resolve.⁴⁰

II. RECENT DEVELOPMENTS IN INTERNATIONAL INTELLECTUAL PROPERTY LITIGATION

Increased global exploitation of copyrighted works and trademarked products has, however, forced courts and scholars to reconsider the apparent simplicity of choice of law issues in intellectual property cases. Notions of conceptually defined places of conduct governing an infringement action become problematic when works are distributed, and allegedly infringing trademarks are used, on the internet. Where does "publication" of a work occur when it is made available online? Everywhere? If a work can be accessed from the United States, has publication occurred in the United States? If a person uses an allegedly infringing mark without authorization on a web site in France, but that site is accessible from the United States, where has the mark been used? These are vexing questions.⁴¹ The shift in

intellectual property protection will most likely be performed in the legislative or executive branches. See Directive 96/9/EC of The European Parliament and of The Council of 11 March, 1996, on the Legal Protection of Databases, 1996 O.J. (L 77), art. 11(3) (extending protection to non-EU database makers only upon agreement concluded by the Council and Commission, which in turn is dependent upon determinations of reciprocity by the third country in question).

³⁹See *Vanity Fair Mills, Inc. v. T. Eaton Co.*, 234 F.2d 633, 639 (2d Cir. 1956) (noting that "passing off occurs . . . where the deceived customer buys the defendant's product in the belief that he is buying the plaintiff's").

⁴⁰In *Itar-Tass Russian News Agency v. Russian Kurier, Inc.*, the Court of Appeals for the Second Circuit noted that one of the leading "treatises briefly (and perhaps optimistically) suggests that conflicts issues 'have rarely proved troublesome in the law of copyright.'" *Itar-Tass Russian News Agency v. Russian Kurier, Inc.*, 153 F.3d 82, 89 (2d Cir. 1998).

⁴¹See generally Graeme B. Dinwoodie, *Private International Aspects of the Protection of Trademarks*, WIPO Doc. No. WIPO/PIL/01/4 (Jan. 2001), available at http://wipo.int/pil-forum/en/documents/pdf/pil_01_4.pdf; Jane C. Ginsburg, *Private*

the attitude of intellectual property law to conflicts questions is perhaps best captured by the title of a recent review of U.S. case law published in a European journal: in conflicts matters, intellectual property law has gone “from dodging the bullet to biting it.”⁴² In this Part, I will outline some recent developments in international intellectual property litigation, first in copyright law, and second in trademark law, that reflect this sentiment.

A. *International Copyright Litigation*

In 1998, in *Itar-Tass Russian News Agency v. Russian Kurier, Inc.*, the Court of Appeals for the Second Circuit offered one of the most detailed choice of law analyses seen in modern copyright cases. The court commented that “choice of law issues in international copyright cases have been largely ignored in the reported decisions and dealt with rather cursorily by most commentators,”⁴³ and noted (with some irony) that this dearth of treatment could be attributed to a perception among scholars that conflicts issues were “rarely troublesome” in copyright law. The Second Circuit thought otherwise and sought to develop a federal rule on choice of law in copyright cases.

The court rejected the conventional wisdom that public international law (and in particular, the national treatment principle) compelled any particular choice of law rule.⁴⁴ After reviewing various options, the court

International Law Aspects of the Protection of Works and Objects of Related Rights Transmitted Through Digital Networks, WIPO Doc. GCPIC/2 (Nov. 30, 1998); 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.

⁴²Paul Torremans, *Jurisdiction and Choice of Law Issues in United States Intellectual Property Cases: From Dodging the Bullet to Biting It*, 3 INTELL. PROP. Q. 372 (1999).

⁴³*See Itar-Tass Russian News Agency v. Russian Kurier, Inc.*, 153 F.3d 82, 88 (2d Cir. 1998).

⁴⁴*See id.* at 89. Neither the Berne Convention nor the TRIPS Agreement, which confirms the principle of national treatment in copyright cases, is self-executing in the United States. *See Berne Convention Implementation Act of 1988*, Pub. L. No. 100-568, 102 Stat. 2853, § 2 (1988); S. Rep. No. 103-412, at 13 (1994); Uruguay Round Agreements Act, Pub. L. 103-465, § 102(a). Thus, even if national treatment did suggest a particular choice of law rule, such a rule would not be binding on the U.S. courts, although canons of interpretation would counsel in favor of filling gaps with international law-compliant rules. *Cf.* Case C-149/96, *Portugal v. Council*, 1999 E.C.R. I-8395 (E.C.J. 1999); Case C-300/98, *Parfums Christian Dior v. Tuk Consultancy*, 2001 E.T.M.R. 276, 289 (E.C.J. 2000) (although TRIPS was not self-executing under Community law, national courts should in a field where the Community has legislated, interpret national law, where possible, in a manner consistent with

applied a variation on the approach of the Second Restatement of Conflicts, but gave primary weight in infringement matters to the *lex loci delicti*.⁴⁵ I have serious doubts about the cogency of the Second Circuit's approach, especially when pushed to the limits by digital uses, and have elsewhere advocated an approach using the development of substantive rules applicable to international copyright cases.⁴⁶ Where a work is made available online, and courts treat accessibility in their country as publication, the *lex loci delicti* rule localizes the unitary act of uploading in too many disparate *loci delicti*.⁴⁷ But, putting aside for present purposes the debate concerning the best copyright choice of law rule, the sudden recognition by courts that choice of law analysis in copyright litigation might require more substantial development than heretofore is noteworthy.

Before addressing the significance of increased attention to choice of law in copyright cases, however, a second development in recent international copyright litigation merits brief mention. As noted above, until recently, U.S. courts were extremely reluctant to adjudicate claims of infringement arising under foreign intellectual property laws.⁴⁸ If U.S. law did not apply, the complaint was dismissed. Many other countries adopted a similar approach to the (non-)application of foreign law.⁴⁹

This approach – using the binary switch of justiciability -- precludes the development of a nuanced methodology designed to reconcile the competing claims of different national laws.⁵⁰ Such a rule of self-abnegation also forces intellectual property owners to pursue infringers serially in a large number of countries.⁵¹ Digital use of marks and copyrighted works has

TRIPS).

⁴⁵See *Itar-Tass*, 153 F.3d at 90-91.

⁴⁶See Dinwoodie, *supra* note 19, at 533-69.

⁴⁷See *id.* at 537.

⁴⁸Foreign law had been applied in a few copyright cases to other issues, such as the scope of rights under a license, or the identity of the owner of the copyright, although even more frequently courts had minimized conflicts on such issues by simply applying U.S. law or assuming foreign law to be the same as U.S. law. See *Itar-Tass*, 153 F.3d at 88-90. Detailed analysis of the choice of law issue never occurred. See *id.*

⁴⁹See G.W. Austin, *The Infringement of Foreign Intellectual Property Rights*, 113 LAW QUART. REV. 321 (1997).

⁵⁰See P.B. Carter, *Decisions of British Courts During 1990: Private International Law*, 61 BRITS. YBK. OF INT'L L. 395, 402 (1991) (criticizing the "rigid rule" applied by the English court in *Tyburn Productions v. Conan Doyle*, [1990] 3 W.L.R. 167 (Ch. D.) (Eng) in declining to hear an action for infringement of foreign copyright law).

⁵¹See, e.g., *Computer Associates Int'l, Inc. v. Altai, Inc.*, 126 F.3d 365 (2d Cir. 1997) (permitting the pursuit of separate actions in the French and U.S. courts for the infringement of French and U.S. copyright, respectively, in the same work by the same

highlighted this inefficiency.⁵² It is not surprising therefore that in the past two years several courts, with the encouragement of the Second Circuit, have permitted actions alleging claims under several foreign copyright laws to proceed,⁵³ although none of these cases has gone to trial.⁵⁴ British courts have also reversed their historical reluctance and indicated a similar willingness.⁵⁵

At its most uncontroversial, the mere fact that national courts are now engaging in serious copyright choice of law analysis and that they are contemplating the application of foreign law requires us to know foreign law more intimately and thus enhances the need for comparative work. This is a relatively low-intensity kind of comparative work that arises from the mere willingness to accept the possibility of applying some law other than the *lex*

competing work). The U.S. courts have developed some doctrinal devices to mitigate these inefficiencies. For example, U.S. courts have granted relief in respect of both domestic acts and acts of overseas infringement where a predicate act of infringement occurring within the United States enabled further reproduction abroad. *See, e.g.*, *Los Angeles News Serv. v. Reuters T.V. Int'l Limited*, 149 F.3d 987 (9th Cir. 1998); *Update Art, Inc. v. Modiin Publishing, Ltd.*, 843 F. 2d 67, 72-73 (2d Cir. 1988); *Sheldon v. Metro-Goldwyn Pictures Corp.*, 106 F.2d 45, 52 (2d Cir.1939), *aff'd*, 309 U.S. 390 (1940).

⁵² *Euromarket Designs, Inc. v. Crate & Barrel Ltd.*, 96 F. Supp.2d 824, 843 (N.D. Ill. 2000) (noting that the U.S. plaintiff was pursuing an Irish-based web site alleged to have infringed its trademarks in separate proceedings in Ireland, the United Kingdom and the United States).

⁵³ *See, e.g.*, *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 conveniens grounds); *Carell v. Shubert Org.*, 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*, 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 America, Inc. v. Champion Road Machinery, Ltd.*, 961 F. Supp. 398, 404 (N.D.N.Y. 1997) (declining to dismiss claim under Canadian copyright law). Courts outside the Second Circuit have been somewhat more reluctant to discard the historical reluctance. *See, e.g.*, *ITSI T.V. Prods, Inc. v. California Authority of Racing Fairs*, 785 F.Supp. 854 (N.D. Cal. 1992), *rev'd on other grounds*, 3 F.3d 1289 (9th Cir. 1993) (declining to enter the "bramble bush" of foreign copyright law). There is one older case in which a U.S. court permitted an action alleging infringement of foreign copyright laws to proceed. *See London Film Prods. v. Intercontinental Comms.*, 580 F. Supp. 47 (S.D.N.Y. 1984).

⁵⁴ *See Disney to Pay for Copyright Breach*, Infogate Entertainment News, Jan. 24, 2001, available at http://main2.infogate.com/content/content.php?feed=reuters&catkey=sm_musicnews&uniqueID=980323864471960&bid=1 (reporting settlement of *Boosey & Hawkes Music Pubs. v. The Walt Disney Co.*).

⁵⁵ *See, e.g.*, *Pearce v. Ove Arup P'ship*, [1999] 1 All E.R. 769, 784-804 (C.A. 1999) (claim for infringement of Dutch copyright).

fori. It thus seems remarkably untaxing. Indeed, the task is not inherently comparative; it involves the mere supply of information to the courts. But translating information into knowledge, and thence into understanding, such that the information is properly understood and applied, is facilitated by exposure to comparative scholarship. Understanding foreign substantive law often requires a more generalized appreciation of foreign systems and methods that does not neatly correlate to the specialized division of substantive law.

To be sure, the routine application of foreign law itself arguably does not *require* such comparativist immersion (although the quality of the process by which lawyers supply, and courts apply, foreign law, would surely benefit).⁵⁶ From a conflicts perspective, courts and scholars will now have to develop choice of law rules for copyright as they have done in the past for all sorts of torts. And those who think that the internet merely requires the further application of traditional techniques devised for domestic problems can find ready analogies to the problem of digital publication, for example, in the single publication rule of defamation law.

In fact, however, the possible analogy to multistate defamation merely highlights the difference between conflicts in the domestic multistate and transnational context, a difference that the internet brings into sharp focus and to which we need to attend. While state defamation law in the United States has substantial commonality, and has been given a unifying federal overlay by virtue of the constitutionalization of some aspects of the tort, there is a gulf between the defamation laws of such apparently similar societies as the United Kingdom and the United States. (Or at least U.S. courts who refuse to enforce U.K. libel judgments appear to think so.⁵⁷) And any unifying overlay could only be international in nature, where no supreme adjudicative body exists. The ongoing tribulations of Yahoo before the French courts confirms that countries of similar economic development, but quite different historical circumstance, might reach fundamentally different conclusions on the appropriate balance between free speech rights and ensuring a climate of equality for its citizens.⁵⁸ Transnational answers may more often require a

⁵⁶Such comparative exposure might thus be regarded as a luxury, *see* Mathias Reimann, *Parochialism in American Conflicts Law*, 49 AM. J. COMP. L. 379-80 (2001) (drawing distinction between types of comparative work that might be regarded as necessities and luxuries), although at some point activities that affect the quality of legal work may lose their luxury status. *See id.* at 14 (discussing teaching of comparative conflicts).

⁵⁷*See, e.g.*, *Bachchan v. India Abroad Publications Inc.*, 154 Misc.2d 228 (Sup. Ct. N.Y. 1992); *Matusevitch v. Telnikoff*, 877 F. Supp. 1, 4 (D.D.C. 1995).

⁵⁸*See generally* Association Union des Étudiants Juifs de France, la Ligue Contre le Racisme et l'Antisémitisme v. Yahoo! Inc. et Yahoo France, T.G.I. Paris, Ordonnance de référé du 22 mai 2000, http://www.legalis.net/jnet/decisions/responsabilite/ord_tgi-

much harder analytical tussle, and the reconciliation of competing values may need to be pursued in a quite different way.

These divides exist throughout the field of copyright, and not simply through the free speech concerns that are often implicated.⁵⁹ There are fundamental philosophical differences on central matters of copyright protection throughout the world.⁶⁰ Reconciling instrumentalist economic philosophies with personality-based notions of rights, for example, requires a real grasp of these different philosophies. Such reconciliations are not impossible, however, especially when attempted in the setting of concrete litigated disputes.⁶¹ And there are also some legislative arenas (a classical locus for the use of comparative scholarship)⁶² in which these efforts at compromise have borne fruit, including, most notably, in the EU (which includes countries with laws reflecting each of these different philosophies).⁶³

Although U.S. courts are largely resorting to existing choice of law

aris_220500.htm.; *see also* Yahoo! Inc. v. Le Ligue Contre Le Racism et L'Antisemitisme, 145H.F. Supp.2d 1168, 2001 WL 640418 (N.D. Cal. June 7, 2001); Michael Traynor, *Conflict of Laws, Comparative Law and the American Law Institute*, 49 AM. J. COMP. L. 391 (2001).

⁵⁹Because intellectual property laws implicate questions of cultural and information policies, and values of free expression, such issues are likely to be raised by international intellectual property litigation. To be sure, the internet may pose substantial dilemmas for many bodies of law other than intellectual property law, but intellectual property law is at its center. From the content of web pages, almost all of which are protected by copyright, to online advertising and sales of trademarked goods and services, to the digital distribution of copyrighted products, intellectual property issues abound on the internet.

⁶⁰*See generally* PAUL GOLDSTEIN, *INTERNATIONAL COPYRIGHT* (2001).

⁶¹*See, e.g.*, Gilliam v. American Broadcasting Co., 538 F.2d 14, 24 (2d Cir. 1976) (reconciling the effective protection of plaintiff's moral rights of paternity and integrity -- not available as such under U.S. law -- with the instrumentalist premises of U.S. copyright protection).

⁶²*See* Bénédicte Fauvarque-Cosson, *Comparative Law and Conflicts of Laws – Allies or Enemies? New Perspectives From Europe on an Old Couple*, 49 AM. J. COMP. L. 407(2001). Although the process of negotiating treaties among nations of disparate traditions has classically been regarded as a prototypical use of comparative knowledge, several scholars have noted that in recent years the negotiation process has increasingly become dominated by political compromise rather than intellectual convergence. This may be particularly true in the context of the harmonization process underway in the EU. *See* Reimann, *supra* note 36, at [19] n.71 (discussing unification of private international law in Europe through “bureaucratic fiat”); Fauvarque-Cosson, *supra*, at [13] (discussing increased use of EU regulations rather than negotiated treaties); Graeme B. Dinwoodie, *The Integration of International and Domestic Intellectual Property Lawmaking*, 23 COLUM.-V.L.A. J. L. & ARTS 307, 310 (2000) (discussing EU harmonization of intellectual property laws). The causes of such a development are beyond the scope of this essay.

⁶³*See generally* Gillian Davies, *The Convergence of Copyright and Authors' Rights – Reality or Chimera?*, 26 I.I.C. 964 (1995).

methodologies to resolve international copyright conflicts, by either refining traditional connecting factors or suggesting variations on the Second Restatement,⁶⁴ scholars have been more inventive.⁶⁵ In addition to my own efforts to advocate substantive rules generated from an amalgam of national sources and international standards,⁶⁶ Jane Ginsburg has argued for a more traditional waterfall of connecting factors, but all undergirded by the substantive standards found in international treaties.⁶⁷ And cyber-enthusiasts have floated the notion of autonomous standards governing internet conduct.⁶⁸

What each of these proposals has in common is a commitment to comparative analysis as part of the solution to (certain)⁶⁹ copyright conflicts. The substantive law method that I have advocated in international copyright cases would require courts to consider international agreements and practices, national and regional laws, the norms of developing post-national groupings, and systemic conflicts values in fashioning an applicable substantive rule.⁷⁰ Professor Ginsburg would require courts to determine whether the potentially applicable national copyright law is consistent with the norms found in the Berne Convention, the TRIPS Agreement and the WIPO Copyright Treaty.⁷¹

⁶⁴See Dinwoodie, *supra* note 19, at 535-36 (discussing *Itar-Tass*).

⁶⁵It is to be hoped that, if confronted with having to apply numerous copyright laws to a single act involving the same parties, courts will be willing to consider these alternatives. The *Itar-Tass* court emphasized that the federal courts remained free to develop a federal choice of law approach for copyright cases. See *Itar-Tass*, 153 F.3d at 89-90.

⁶⁶See Dinwoodie, *supra* note 19, at 542-69.

⁶⁷See Ginsburg, *2000 Update*, *supra* note 41, at 11-12.

⁶⁸See David R. Johnson and David Post, *Law and Borders—The Rise of Law in Cyberspace*, 48 STAN. L. REV. 1367, 1378 (1996).

⁶⁹Professor Ginsburg's proposal is confined to the internet context, as are those advanced by proponents of cyber-autonomy. My proposal seeks to draw a line instead between domestic and international (rather than online and offline) disputes. See Dinwoodie, *supra* note 19, at 542-43.

⁷⁰See Dinwoodie, *supra* note 19, at 552-57.

⁷¹See Ginsburg, *2000 Update*, *supra* note 41, at 11-12. As Mathias Reimann has noted, the failure to attend to the international dimensions of a subject reflects a parallel parochialism to that seen in the failure to consider comparative dimensions. See Reimann, *supra* note 56, at 369-70. But direct reference to international treaty standards can help to remedy both shortcomings, because (ideally) international rules will embody the fruits of comparativist thought. *But see supra* note 62 (discussing the changing nature of harmonization activities). By their direct reference to treaty standards, these two approaches seek to use ready-made, hopefully comparativist-driven accommodations of national approaches. Cf. Reimann, *supra* note 56, at 388 (suggesting that “if we want to overcome the remaining insularity of American conflicts laws, we need to tackle both kinds of deficits – the comparative and the international – in tandem”).

At first blush, the notion of universal autonomous standards would in contrast appear to conclude, rather than re-energize, the comparativist task.⁷² This appearance is deceptive. The initial development of such rules should, of course, ideally proceed from detailed comparative analysis. But, even after the unified rules are formulated, the practical reality of current international relations is that certain matters will be reserved to, or dependent upon, national laws or rights. The supranational Community Trade Mark system operating within the EU, as well as the ICANN domain name dispute resolution policy discussed below, confirm this suspicion.⁷³ Mediating between the unified non-national rules and the relevant remaining national rules – vertical choice of law analysis – will benefit greatly from comparativist insight.

These recent developments in international copyright litigation thus suggest the need for greater comparative thought. The adoption of proposals for reform currently pending would bolster this need. The similar willingness to adjudicate foreign copyright claims in Europe⁷⁴ is partly a result of the provisions of the Brussels Convention on Jurisdiction and Enforcement of Judgments in Civil and Commercial Matters.⁷⁵ The Brussels Convention is similar (but not identical) to the proposed Hague Convention on Jurisdiction and Judgments that is being considered by the Hague Conference on Private International Law.⁷⁶ Some copyright owners would like to see the Brussels system extended more broadly in the belief that this would streamline international enforcement of national copyrights. It has thus attracted the attention of international intellectual property policymakers.⁷⁷ The provisions

⁷²See Fauvarque-Cosson, *supra* note 62, at 415 (“complete unification would be a bitter victory, for it would doom comparative law by depriving it of its main *raison d’être*”).

⁷³See DINWOODIE ET AL, *supra* note 20, at 1047-56; Dinwoodie, *supra* note 41, at 52 (discussing the role of national rights in applying the UDRP).

⁷⁴See *supra* note 55.

⁷⁵See Convention on Jurisdiction and Enforcement of Judgments in Civil and Commercial Matters, Sept. 27, 1968, 1978 O.J. (L 304) 77, 78-83, *amended by* 1990 O.J. (C 189) 2, 3-9 (1990); *see also* Council Regulation No. 44/2001 of 22 December 2000 on Jurisdiction and the Recognition and Enforcement of Judgments in Civil and Commercial Matters, 2001 O.J. (L 12) 1.

⁷⁶In June 2001, delegates to a Diplomatic Conference organized by the Hague Conference met to discuss the latest draft of the proposed Convention. The June conference was intended as the first half of a two-part process designed to conclude with the adoption of a convention at a second Diplomatic Conference in early 2002. After two weeks of intensive negotiations, participating delegations agreed to convene again in January 2002, and to decide then on the final scope of the project.

⁷⁷See, e.g., Memorandum on the Provisions of the Preliminary Draft Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters, WIPO Doc. No. SCT 4/3 (Dec. 20, 1999) (Prepared by the WIPO International Bureau for the Standing Committee

addressing intellectual property have, however, proved controversial and some delegates to the Hague Conference would like to exclude intellectual property from the scope of the new convention.

Copyright claims appear likely to be governed by any Hague (or Hague-like) regime that ensues. The greatest opposition to the inclusion of intellectual property claims within the Hague system has arisen with respect to registered rights such as accorded under patent and trademark laws; many countries remain unwilling to permit foreign courts to review the administrative determinations made by their patent and trademark officials.⁷⁸ Moreover, even if all intellectual property rights (including copyright) are excluded from the Hague Convention as it emerges from the negotiations, or no such treaty is concluded, scholars and international intellectual property organizations have been considering the possibility of a standalone treaty on jurisdiction and recognition of judgments in intellectual property cases.⁷⁹

This last proposal, a standalone treaty authored by Professors Rochelle Dreyfuss and Jane Ginsburg, was first discussed at a two-day forum organized by the World Intellectual Property Organization in Geneva in January 2001, immediately preceding a meeting of the delegates to the Hague Conference. The draft of the Dreyfuss/Ginsburg proposal debated in Geneva would arguably implicate comparative work (and, in particular, comparative analysis of conflicts) even more extensively than the current draft of the Hague Convention. The negotiation process itself (and the process of preparing for possible implementation) forces participants to engage in comparative analysis of the content and merits of different approaches to jurisdiction and recognition and enforcement.⁸⁰ But the draft of the Dreyfuss/Ginsburg proposal would include a ground for non-recognition of judgments not found in the Hague proposal, namely, the application by the rendering court of a law that is arbitrary or unreasonable.⁸¹ Of itself, this provision would require courts to engage in comparative assessment of the conflicts analysis of foreign courts. And this salutary effect is heightened by the inclusion of a standard for that assessment that includes the choice of law rule suggested by Professor Ginsburg (which may require reference to

on Trademarks).

⁷⁸See Dinwoodie, *supra* note 41, at 22.

⁷⁹See Rochelle C. Dreyfuss and Jane C. Ginsburg, Draft Convention on Jurisdiction and Recognition of Judgments in Intellectual Property Matters, WIPO Doc. No. PIL/01/07 (2000), available at http://wipo.int/pil-forum/en/documents/pdf/pil_01_7.pdf. A revised version of the proposed treaty is available at <http://www.kentlaw.edu/depts/ipp/intl-courts/>.

⁸⁰But see *supra* note 62 (discussing whether contemporary treaty negotiation involves genuine comparative analysis or mere political bargaining).

⁸¹See Dreyfuss/Ginsburg Treaty, Geneva Draft, *supra* note 79, art. 25(1)(g).

international treaties).⁸²

Indeed, either treaty will increase the need for comparative expertise in conflicts. Although, unlike the Brussels Convention, the Hague and Dreyfuss/Ginsburg systems would operate without any court with supreme jurisdiction over questions raised by the Convention, both seek to achieve uniformity by requiring national courts to interpret the Convention in light of its international character, the need for uniformity, and the case law of other contracting states.⁸³ This appeal to what might be called “interpretive comity” establishes a bare set of “conflicts-influencing” considerations that, situated within a conflicts treaty, constitute a direct invitation to comparative analysis of conflicts methodology. The Hague Convention, or the Dreyfuss/Ginsburg proposal, would thus increase the already-developing need for comparative analysis of copyright law, of conflicts, and of legal systems generally, that recent developments in international copyright litigation have generated.

B. *International Trademark Litigation*

In the trademark context, the internet has caused immense problems of private international law.⁸⁴ Because trademark rights are territorial in nature, different producers may own rights in the same mark for the same class of goods in different countries. Producer X may use the mark APPLE for a particular good in State A, and that mark may be separately used (and owned and registered) by Producer Y for the same goods in State B. Both parties may have legitimate, discrete national trademark rights that conflict only when one or both seek to operate in the international marketplace. Which of the different owners of legitimate national trademark rights in the word APPLE is entitled to ownership of the domain name registration apple.com (of which there can, under the current configuration of the internet, only be one registration)?⁸⁵ And what remedies might either of these mark owners have against a third person, with no trademark rights in the mark APPLE, who in bad faith secures the domain name registration apple.com as a result of the first-come first-served philosophy underlying current domain name registration processes?

These problems have thus far been addressed largely through existing

⁸²See Dreyfuss and Ginsburg, *supra* note 79, at 34-35.

⁸³See Proposed Hague Convention, art. 38.

⁸⁴See Dinwoodie, *supra* note 41, at 5-7.

⁸⁵See generally Graeme B. Dinwoodie, *(National) Trademark Laws and the (Non-National) Domain Name System*, 21 U. PA. J. INT'L ECON. L. 495 (2000).

devices of trademark law and conflict of laws.⁸⁶ An alternative solution has been developed to address a particular problem, namely the question of cybersquatting, which is loosely defined as the bad faith registration and use of a domain name consisting of or including a trademark of another in which the domain name registrant has no rights. When ICANN approved registrars to allocate domain names in the leading generic top level domain names (such as .com, or .net), it imposed certain conditions. One was that the registrar require domain name registrants to agree in their registration application to resolve any complaints brought by a trademark owner before an ICANN approved dispute settlement provider. These complaints are resolved according to the Uniform Domain Name Dispute Resolution Policy (UDRP) promulgated by ICANN.⁸⁷ The UDRP articulates the elements that a trademark owner must show in order to make out a claim.⁸⁸ If the claim is sustained, the dispute settlement panelist may order that the domain name registration be transferred to the trademark owner.

Trademark owners, well pleased with this non-national form of resolving the conflict between their national rights and domain name registrants whose rights are not nationally rooted, would like to see the system expanded. And suggestions that the UDRP system might be adopted for other internet-based disputes can be found both in congressional hearings and in aspirational recitals in a recent EU Directive.⁸⁹ The potential, and perhaps appropriate limits on the use, of UDRP-like systems as a means of resolving conflicts issues on the internet is worth sustained analysis.⁹⁰ For

⁸⁶In particular, the World Intellectual Property Organization has drafted model trademark law provisions that, when implemented by member countries, would restrict the extraterritorial effect of national trademark laws online, *see* Proposed Joint Recommendation Concerning the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet, WIPO Doc. No. SCT/6/7 (March 30, 2001), and trademark cases constitute a substantial proportion of case law applying existing jurisdictional rules online. *See* Dinwoodie, *supra* note 41, at 15-18 (discussing U.S. and European jurisdiction jurisprudence).

⁸⁷*See* Uniform Domain Name Dispute Resolution Policy, available at <http://www.icann.org/udrp/udrp-policy-24oct99.htm>.

⁸⁸*See id.* § 4(a).

⁸⁹*See* Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market, arts. 12-14, and recitals 40-46, O.J. L 178, 1, 6, 12-13; Subcommittee Tackles Jurisdiction Issues on Internet, 60 PAT. TRAD. COPR. J. (BNA) 214, 215 (July 14, 2000) (reporting testimony before House Judiciary Committee's Subcommittee on Courts and Intellectual Property).

⁹⁰*See* Laurence R. Helfer and Graeme B. Dinwoodie, *Designing Non-National Systems: The Case of the Uniform Domain Name Dispute Resolution Policy*, 43 WM. &

present purposes, however, I focus only on the approach of the UDRP to applicable law. The Rules promulgated by ICANN to accompany the UDRP instruct dispute resolution panels to “decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”⁹¹ The Policy and the Rules are skeletal. To where should panels look when additional guidance is required? This choice of law rule invites comparative analysis in at least three important respects.⁹²

The first opportunity for comparative analysis is presented by the need to develop or select an appropriate substantive rule. Some scholars have argued that the UDRP choice of law provision should not be regarded as an instruction to develop *lex-mercatoria*-like, substantive rules applicable to certain international disputes. And, to be sure, language in the *travaux préparatoires* to the UDRP suggests that in certain cases where a particular national interest predominates, national sources may be the appropriate basis for finding interpretive guidance. But nothing appears to preclude the development and application of autonomous standards drawn from any number of sources, national, international or any other, in appropriate circumstances. Indeed, the entire UDRP project is premised upon the development of substantive non-national rules so as to obviate the problems of disparate national laws and national rights operating in the context of a ubiquitous online environment.

A second role for comparative thought in the UDRP system is more closely linked to comparative conflicts scholarship. In an era when international or non-national rules assume greater importance, determining when to develop or apply a substantive international rule, and when to insist instead on the predominant claim of one prescriptive national source, will become crucial. This is a vertical choice of law, and is an analysis that will be greatly aided by comparative and historical analysis. Guidance on the question of balancing centralized order and local autonomous rights can be found in numerous federal systems, including the increasingly developed jurisprudence of the European Court of Justice, and parallels the tension

MARY L. REV. 141 (2001).

⁹¹See Rules for the Uniform Domain Name Dispute Resolution Policy (approved by ICANN, Oct. 24, 1999), R.15, available at <http://www.icann.org/udrp/udrp-rules-24oct99.htm>.

⁹²Many of the panelists in ICANN UDRP proceedings are academics, perhaps the most likely to advance the comparatavist project. See Reimann, *supra* note 56, at 377. But the short time frame in which decisions must be rendered (within 45 days of filing) does not always provide the opportunity for the deliberation that would facilitate comparative work.

found in every international intellectual property agreement.⁹³

Comparison must always be informed, of course. Structurally, one might regard the contest between national and international norms and institutions as the natural successor to the contest between state and federal authority that occurred in federal systems when regional activity became more national in nature. But the current competition between national and international norms deviates from the most obvious examples of this parallel in one important way. How to resolve these new “local-federal” disputes will be determined without any federal political or legal structure, whether established by constitutional document or by treaty. The extent to which the applicable norms will derive from the broader community and institutions and the scope of their application will be determined in large part by the local institutions and local rules.⁹⁴

Finally, comparative awareness of other systems in which the

⁹³Jurisprudence in the United States demarcating the respective lines of state and federal authority can be conceived of as implicating questions of vertical choice of law. Some of the allocations of power flow derivatively, albeit by virtue of the Supremacy Clause of the federal constitution, from actions (or inaction) of the federal government that preempt state legislation. *See* 17 U.S.C. § 301. But other allocations are grounded in more independent aspects of constitutional structure. In this latter regard, some present members of the U.S. Supreme Court have been willing to examine the allocation of power in foreign federal structures, *see, e.g.*, *Printz v. United States*, 117 S.Ct. 2365, 2405 (1997) (Breyer J., dissenting), contrary to the general non-comparativist attitudes of the U.S. courts. *Cf.* Reimann, *supra* note 36, at 16 (discussing comparative conflicts analysis).

⁹⁴*But see* Robert Wright, *Clinton's One Big Idea*, N.Y. Times, Jan. 16, 2001 at A27 (describing the WTO as “arguably the most effective body of world governance in the history of the planet.”). Where broader supranational institutions and laws arise, their legitimacy will be conferred and viability will be determined by national institutions. To be sure, the viability and legitimacy of the United States and the European Union clearly depended upon state endorsement (in the case of the United States) and national endorsement (in the case of the European Union). But such prospective transfer of power to supranational political bodies, and the consequent establishment of dual sovereignties in a vertical political structure, is unlikely to occur at present. Some scholars have, however, considered whether (and how) a worldwide directly-elected lawmaking body mimicking some of the features of current national political systems might be achieved. *See* Richard Falk and Andrews Strauss, *On The Creation of a Global Peoples Assembly: Legitimacy and the Power of Popular Sovereignty*, 36 STAN. J. INT'L L. 191 (2000) (discussing the extension of democratic procedures and institutions from the setting of the nation-state to the global context). Although Falk and Strauss suggest that “the time for establishment of a global [popularly-elected legislative] assembly is ripening,” *id.* at 191, progress toward such a goal has been halting even among the more homogenous component states of the European Union. In the EU, federal-level political structures remain inchoate and the most likely enhancement of EU-level legitimacy involves something short of the popular sovereignty prevailing in nation-states of the EU. *See* Larry Siedentop, *A Crisis of Legitimacy*, FIN. TIMES Oct. 24, 2000 at 23 (noting the advocacy of “intergovernmentalism” within the EU as an alternative to a federal union).

substantive law method has been applied will also assist in the UDRP context.⁹⁵ Should a panelist apply the best substantive rule? Are there still systemic or conflicts concerns that might over-ride preferred substantive results? But, here again, our inclination to compare must be informed. For example, the modern *lex mercatoria* found in international commercial arbitration may be only of limited use in the UDRP setting because it operates in a quite different context. In particular, it exists within a system where there is genuine party consent to the panels' terms of reference, and there is only a limited publication of opinions. In this regard, the UDRP is closer to a judicial system; involvement is not optional on the part of domain name registrants, and every decision is published, creating a systemic value of precedent and expectation that might not be present in other contexts.

III. CONCLUDING THOUGHTS

As seen in Part II, recent developments in international intellectual property litigation demand an intensified commitment to comparative work. This takes many forms. The recent recognition that conflicts in intellectual property law are not straightforward, but require a more sophisticated approach, has finally engaged conflicts and intellectual property scholars. Many of the approaches being considered by scholars, if not yet by courts, would elevate the role of comparative analysis, whether in developing substantive private international copyright law or interpreting the provisions of international treaties as baseline elements of choice of law analysis. Moreover, the acceptance that courts might apply foreign copyright law introduces the potential for comparative analysis to play its most practical role of supplying information about foreign law. Although this role is often seen as purely informational (and arguably non-comparative) the informed application of foreign law requires broader comparative exposure, especially if that foreign law in any way references or incorporates international treaty standards.

The growing liberal attitude toward the procedural structure of international intellectual property litigation, of which the developments discussed above are illustrative, has vastly multiplied the number of cases pursued in ways that challenge the traditional model of serial national litigation. This development of itself generates a number of issues that require comparative analysis, including not only application of foreign law,

⁹⁵The comparative understanding demanded of UDRP panelists will not be restricted to initial questions of applicable law. If any substantive law methodology is used, later panels (and national courts who have to address panel decisions) will have to understand the etymology of such rules in order to interpret and understand them.

but consideration of foreign law as part of *forum non conveniens* analysis⁹⁶ and in assessing requests for antisuit injunctions.⁹⁷

The proposed Hague Convention, which some of the intellectual property community view as a vehicle for the more effective enforcement of rights on an international basis, would establish a multinational judicial network requiring constant comparative analysis of conflicts thought. The Dreyfuss/Ginsburg proposal would heighten this need by its choice of law-based ground for non-recognition of judgments, although even the grounds for non-recognition in the current Hague proposal (e.g., lack of jurisdiction in the rendering court) would require comparative analysis that is sufficiently informed to understand the different conceptual approach to jurisdiction outside the United States.⁹⁸

Developments in international trademark law, and the ICANN UDRP in particular, also illustrate the ways in which a re-orientation of choice of law analysis might occur in a more globalized world. Choice of law analysis is about the allocation of prescriptive power, and that contest is increasingly waged between national and international (or non-national) institutions rather than merely national ones. It will involve not only the horizontal choice between laws of competing nation-states, but also the question of whether national prescriptive authority should accede to international or non-national standards. Which aspects of society should be treated in law according to national norms rather than regional or international or non-national norms? Upon which issues can universal solutions be developed at the expense of local values? As noted above, the first question suggests a re-orientation toward vertical choice of law issues. The second presents a more fundamental political debate about the competing (and perhaps complementary) values of universality and diversity.

Professor Fauvarque-Cosson characterizes this second question as the battle between comparativism (or internationalism) and conflictualism.⁹⁹ But one can strive for greater uniformity on certain matters without wholly

⁹⁶See *Creative Technology, Ltd. v. Aztech System, Ltd.*, 61 F.3d 696, 704 (9th Cir. 1995) (finding Singapore adequate alternative forum for copyright litigation); *Murray v. British Broadcasting Corp.*, 81 F.3d 287 (1996) (finding the United Kingdom adequate alternative forum for copyright litigation); *Heathmount A.E. Corp. v. Technodome.com*, Case No. CA-00-00714-A (E.D. Va. Dec. 29, 2000) (finding that neither Canada nor an ICANN UDRP panel was an adequate alternative forum in trademark/domain name litigation).

⁹⁷See *Computer Associates Int'l, Inc. v. Altai, Inc.*, 126 F.3d 365 (2d Cir. 1997); see also Peter Nicolas, Comment, *The Use of Preclusion Doctrine, Antisuit Injunctions, and Forum Non Conveniens Dismissals in Transnational Intellectual Property Litigation*, 40 VA. J. INT'L L. 331 (1999).

⁹⁸See Reimann, *supra* note 56, at 377-79.

⁹⁹See Fauvarque-Cosson, *supra* note 62.

undermining the local values that conflictual methodology sustains. Comparative knowledge and comparative method will contribute to a better understanding of when, and how, each of these sometimes competing values should be given greater weight. The project of comparativists therefore is not to reveal universal truths, nor merely destructively to declare that the individuality of perspective renders the discipline an irrelevance and common values a fraud.¹⁰⁰ Instead, the goal of contemporary comparative work has to be to facilitate a dialogue about when and in what ways these values are at work.¹⁰¹ It is to build a bridge between unity and diversity, between internationalism and conflictualism.¹⁰² The complexities of international intellectual property litigation, stemming from the need to reconcile territorialist legal structures with inherently non-territorial activity, may serve as a vehicle for the pursuit of that task. Comparative thought will be central to achieving that goal with any degree of success.

Finally, the developments discussed above will require lawyers and judges to cross borders in a number of different ways that comparative analysis can assist. These include not only the provision of information about other vertical allocations of authority and how to understand international laws that are (ideally) the amalgamated product of comparative analysis. But also, involving more conceptual borders, this will encompass how to apply public international laws in the private international context; and, correlatively, whether and how to extend privately generated bodies of law, such as the modern *lex mercatoria*, in settings that are substantively less private in nature (such as ICANN panels).¹⁰³ A comparativist perspective will always aid appreciation of laws. But the increasingly multidimensional nature of international intellectual property litigation may mean that only a comparativist can fully appreciate these dimensions and accord them the proper weight.¹⁰⁴

¹⁰⁰*Cf. id.* at 414 n.96 (suggesting that “comparatists’ task for tomorrow” include the use of international lawmaking processes, such as harmonization, that leave more room for diversity).

¹⁰¹*See* Fauvarque-Cosson, *supra* note 62, at 414-15 (citing various works of Fritz Juenger).

¹⁰²For a discussion of these dichotomies, see Fauvarque-Cosson, *supra* note 62.

¹⁰³*Cf.* Fauvarque-Cosson, *supra* note 62, at 420-26 (discussing similar challenge in the context of fundamental human rights).

¹⁰⁴Of course, these developments in private international intellectual property law are occurring simultaneously with greater public international lawmaking, and an increased commonality of intellectual property standards. These efforts are aided, in part, by comparativist thought. But is the success of that work the cause of the demise of its role? As discussed above, the surfeit of harmonization or international lawmaking will not reduce the need for comparative work. *See supra* text accompanying notes 30-34 & 69. It will

likely only change its orientation.