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E UNUM PLURIBUS: THE LIMITATIONS ON STATE LAW BECAUSE OF FOREIGN POLICY USES OF STATE LAW AS A GAP FILLER TO MEET THE INTERNATIONAL OBLIGATIONS OF THE UNITED STATES

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ABSTRACT
Unlike many nations where the ratification of a treaty immediately changes its internal laws, in the United States, unless the language of the treaty is self-executing, Congress must affirmatively change domestic laws to conform to the obligations of the treaty. Increasing, it is a modern trend for the United States to represent in international forums that the United States is in conformity with its international obligations because of state statutes or because of common law court decisions. This article looks whether the foreign policy representations of the United States to other countries (in the context of the international intellectual property treaty regime) regarding the nature of state law or common law and its the reliance on non-federal statutory law to meet its treaty obligations imposes any duties on the state legislatures or federal and state courts when developing the common law. This article concludes that because representations made by the United States do not carry a penumbra of federal preemption, much less the weight of actual federal preemption, any body of international obligations by the United States built on state statutory law or federal or state common law is at best a feckless promise. Moreover, states are free to develop their own laws in a manner that best meets their unique needs. However as a matter of sound public policy and a respect for federalism and relevant competencies, states should give these statements or positions extraordinary deference in developing state law so as to avoid causing an unnecessary rift in the foreign relations of the United States.

INTRODUCTION
Unlike many nations where the ratification of a treaty immediately changes its internal domestic laws so that they are congruent with its new international obligations, or at a bare minimum require that their courts interpret national and regional laws in a manner consistent with their new international obligations, in the United States, unless the language of the treaty is self-executing, Congress must affirmatively change domestic laws to conform to the language of the treaty.1 Increasingly, it is a modern trend

* Associate Professor, University of Toledo College of Law. I would like to thank the participants at the (2012) Second Annual Intellectual Property Scholars Roundtable sponsored by the Franklin Pierce Intellectual Property Center at the University of New Hampshire School of Law for their insightful comments, and the faculty and students of the University of New Hampshire School of Law for their gracious hospitality. I would also like to thank my colleagues for permitting me to workshop this article as a half-baked idea and their kind encouragement. I would like to acknowledge the University of Toledo College of Law’s support through a faculty research grant.

for the United States to represent in international forums that the United States is in conformity with its international obligations because of state statutes or because of state common law decisions.\(^2\) There are numerous articles critiquing this policy of the United States of relying on state law in order to meet its treaty obligations rather than expending the necessary political capital to formally change federal law.\(^3\) Many of these articles also comment on whether state law is an adequate basis on which to meet the treaty obligations of the United States.

Although, critically analyzing the foreign relations law of the United States as seriously deficient in so far as it relies on state law to meet its international obligations; ultimately, this article must assume *arguendo* that federal law as supplemented by state law theoretically can meet the international obligations of the United States. Therefore, this article also focuses on the converse question. Whether the foreign policy representations of the United States to other countries (especially in the context of the international intellectual property treaty regime) regarding the nature of state law and reliance on state law to meet its treaty obligations impose any duties on the state legislatures or state courts when developing state law.

This article will first discuss three examples one from Berne Convention and the two from the Paris Convention where in the United States state law is used to supplement federal law in order to provide the minimum level of legal protection required under each treaty. Section II will analyze whether the federal law of preemption or principles of international law require states to develop their law in a manner that is consistent with the representations of the United States. Section III will discuss public policy reasons why a state should if possible develop state law in a manner consistent with the position of the United States in international forums. Section IV will examine the legal effect of a statement made by the United States in international forums and whether these statements are in anyway binding on the development of state law. This article then concludes that a body of international obligations met by the United States while built on state statutory law or state common law is a house built on sand. However, as a matter of sound public policy, especially when a party should be entitled to rights or privileges under a treaty, a state law should provide such protection, if possible otherwise in terms of U.S. foreign policy, the motto will no longer be *e pluribus unum*, “out of many, one” from many one, but rather *e unum pluribus* “out of one, many.”

I. **STATE LAW AS GAP FILLER**
This article will look at three provisions of intellectual property law as a model to better understand the difficulties of using state law to supplement federal treaty obligations. To demonstrate the breadth of the problem, this article will look at an example from copyright, trademark, and trade secret law. First, it will analyze the protection of moral rights in the United States as an obligation of being a member of the Berne Convention; second, it will analyze the protection of well-known marks and trade secrets as an obligation under either Paris Convention for the Protection of Industrial Property (“Paris Convention”) or the Agreement on Trade Related Aspects of Intellectual Property (“TRIPS Agreement”). There are numerous law review articles hotly contesting whether the United States is in conformity with its international obligations and whether the United States actually does rely on state law as a gap filler to federal law in these three areas. This article will not foray into this minefield of conflicting scholarship. Rather, it merely states why state law may be necessary to fill in the lacuna of federal law in the context of moral rights, the protection of well-known marks, and trade secrets. Once the problem is established in this section, the subsequent sections will address the stability of U.S. foreign relations law and whether the states when developing domestic state law are bound by the foreign policy positions taken by the United States.

A. Copyright: Moral Rights

Moral rights are protected under the Berne Convention. As a member of the Berne Convention, the United States is required to protect the moral rights of authors of works protected in other Berne Convention countries. Article 6bis provides that for the life of the author plus 50 years that even after the transfer of the author’s economic rights the author retains the right to “to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation.” Unlike economic rights, which are freely alienable, moral rights are under some interpretations inalienable rights under the Berne Convention.

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4 Berne Convention 6bis.

5 Berne Convention 6bis. Articles 8, 9, 11, 11bis, 11ter, and 12 of the Bern Convention define the author’s economic rights. See id.

6 Berne Convention 6bis. Articles 8, 9, 11, 11bis, 11ter, and 12 of the Bern Convention define the author’s economic rights. See id.

7 See Neil Netanel, Alienability Restrictions And The Enhancement Of Author Autonomy In United States And Continental Copyright Law, 12 Cardozo Arts & Ent. L.J. 1, 3-4 (1994); NIMMER ON COPYRIGHT § 8D.01 (Berne Convention “merely provides that the author’s previous assignment of economic rights does not derogate from subsequent assertion of the attribution and integrity rights; but following transfer of moral rights, nothing in the Berne Convention requires that those rights must nonetheless rest inalienably with their authors.”)
The Berne Convention is not a self-executing treaty.\(^8\) Congress specifically provided in the copyright legislation implementing the Berne Convention that “No right or interest in a work eligible for protection under this title may be claimed by virtue of, or in reliance upon, the provisions of the Berne Convention, or the adherence of the United States thereto.”\(^9\) Moreover arguably, the Berne Convention may not even be used by courts or state legislatures when interpreting copyright laws or in drafting state law. “Any rights in a work eligible for protection under this title that derive from this title, other Federal or State statutes, or the common law, shall not be expanded or reduced by virtue of, or in reliance upon, the provisions of the Berne Convention, or the adherence of the United States thereto.”\(^10\) Finally, Article 6\(\text{bis}\) of the Berne Convention is an exception to the TRIPS Agreement that generally incorporates many of the articles of the Berne Convention.\(^11\)

Whether the United States is in compliance with its obligations under 6\(\text{bis}\) of the Berne Convention is a hotly contested issue. One leading treatise author observed:

The obligation of the United States to provide \textit{droit moral} and the extent to which U.S. law, at the time of our adherence to the Berne Convention (1989), already satisfied the minimum requirements of Article 6\(\text{bis}\) were the single most contentious issues surrounding adherence. Given the opposition of key copyright industries to \textit{droit moral}, adherence to the Berne Convention would not have occurred had the United States complied with Article 6. The solution, which had the blessing of the Director-General of the World Intellectual Property Organization (WIPO), Dr. Arpad Bogsch, was to create a \textit{web of fictional compliance}: the \textit{existing combination of federal and state laws were deemed to satisfy the minimum Berne obligations}.\(^12\)

One leading commentator concluded, “state or common law is more likely to implement Article 6\(\text{bis}\) of the [Berne] Convention than any other feature

\(^9\) 17 U.S.C. § 104(c)
\(^10\) 17 U.S.C. § 104(c).
\(^11\) TRIPS Art. 9(1); 7 Patry on Copyright § 23:62
\(^12\) William F. Patry, 5 Patry on Copyright § 16:3 (2012)(footnotes omitted)(emphasis added).
of Berne . . ..” The authors of the three of the leading copyright treatise agree that state law is necessary to bring the United States into even colorable conformity with its Article 6bis obligation to protect moral rights.  

One court of appeals observed, “Congress initially took the position that domestic law already captured the concept in existing copyright and common-law doctrines and in the statutory law of some states” and one district court judge wrote “[i]t is far from clear exactly how the language of Article 6bis is achieved under the United States’ intellectual property laws.” Moreover, the United States Supreme Court in Dastar Corp. v. Twentieth Century Fox Film Corp. removed both Lanham Act § 43(a) unfair competition and state law analogs provisions as one of the pillars of U.S. protection of moral rights as a “misuse or over-extension of trademark and related protections into areas traditionally occupied by patent or copyright.” The Court in Dastar did not consider the international implications of its decision and whether a case that limited the scope of §43(a)(1)(a) might undermined whatever claim that United States may have had to be Berne compliant. The other pillars of state law that create penumbras that protect the moral rights of authors include: defamation, invasion of privacy, breach of contract, or state laws.

B. Trademark: Well-Known Marks

Well-Known unregistered trademarks are protected under either 6bis of the Paris Convention for the Protection of Industrial Property or Article 16(2) of the Agreement on Trade Related Aspects of Intellectual Property (TRIPS Agreement). Neither the Paris Convention nor the TRIPS Agreement is a self-executing treaty, and Congress has not passed express language to implement these articles—at least a far as the United States’

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13 See 3-8D Nimmer on Copyright § 8D.02[B].
14 See Nimmer, Patry, and Goldstein
15 See Kelley v. Chicago Park Dist., 635 F.3d 290, 297-98 (7th Cir. 2011).
19 See 3-8D NIMMER ON COPYRIGHT § 8D.02[A]. See also 3-8D NIMMER ON COPYRIGHT § 8D.02[D][1] (“Inasmuch as a large part of the moral rights protection canvassed in the sections that follow arises out of doctrines of state law, it is relevant to note that in advertising to U.S. domestic law, Congress intended to include both statutory and common law, at both the federal and state levels.”).
20 5 McCarthy on Trademarks and Unfair Competition § 29:62 (4th ed.).
obligation to protect well-known trademarks without actual trademark use in the United States.\textsuperscript{21}

Arguably, unregistered international well-known marks are protectable under § 43(a), § 44(b), and § 44(h).\textsuperscript{22} Section 43(a) can be read as a broad protection against the use of an international unregistered well-known mark in the United States even absent bona fide domestic use in commerce by the first to use the mark globally, the global senior mark holder.\textsuperscript{23} Section 43(a) does not contain a statutory command that the international mark holder use the mark in commerce in the United States, it merely requires that the alleged infringer use the mark in commerce."\textsuperscript{24} However, existing case law has uniformly read into § 43(a) a requirement that the party claiming to have superior rights in the mark to have actually used it in domestic U.S. commerce.\textsuperscript{25}

Section 44(h) provides the holders of foreign trademarks protection “effective protection against unfair competition” which when interpreted in light of §44(b)’s capacious language which provides that “Benefits of section to persons whose country of origin is party to convention or treaty. Any person whose country of origin is a party to any convention or treaty relating to trademarks . . . or the repression of unfair competition, to which the United States . . . a party . . . shall be entitled to the benefits of this section under the conditions expressed herein to the extent necessary to give effect to any provision of such convention, treaty. . . .\textsuperscript{26} So, there is a statutory basis on which to claim that the United States protects well-known marks that have not yet been used within the United States.

Unfortunately, recently, federal courts have determined that the Paris Convention and the TRIPS Agreement are not self-executing treaties and have also read Lanham Act § 44 very narrowly so that it does not provide federal protection for unregistered well-known marks.\textsuperscript{27} The United States Court of Appeals for the Ninth Circuit in Grupo Gigante S.A. De C.V. v.


\textsuperscript{22} See Lee Ann W. Lockridge, Honoring International Obligations In U.S. Trademark Law: How The Lanham Act Protects Well-Known Foreign Marks (And Why The Second Circuit Was Wrong), 84 ST. JOHN’S L. REV. 1347, 1359-60 (2010); Anne Gilson LaLonde, Don’t I Know You From Somewhere? Protection in the United States of Foreign Trademarks that Are Well Known But Not Used There, 98 TRADEMARK REP. 1379, 1400-03 (2008);

\textsuperscript{23} Lockridge, supra note xx, at 1358 &1379-1391; Lanham Act § 43(a).

\textsuperscript{24} LaLonde, supra note xx, at 1398.

\textsuperscript{25} LaLonde, supra note xx, at 1399.

\textsuperscript{26} See LaLonde, supra note xx, at 1399-1402; Lanham Act § 44(b) & §44(h).

Dallos & Co held that foreign well known marks were protected in the United States in an opinion that was strong on cogent policy and devoid of a statutory analysis basis in the Lanham Act for holding that well known marks were protected.\(^{28}\) Three years later, in *ITC Ltd v. Punchgini, Inc.*, the Second Circuit rejected the holding of the Ninth Circuit and invited Congress to amend the Lanham Act to protect foreign well-known marks, and despite an obvious and significant Circuit split, the Supreme Court denied a petition for a writ of certiorari.\(^{29}\)

In both cases, state law plays an interesting role. The Ninth Circuit found that well known marks are not independently protectable under California trademark or unfair competition law.\(^{30}\) In contrast, the Second Circuit found that under New York State common law, well known marks were potentially protectable and certified the question to the New York Court of Appeals, which answered in the affirmative.\(^{31}\) This article does not undertake to answer the question of which line of cases correctly interprets federal or state law or whether the United States is in compliance with its international obligations to protect well known trademarks from the usurpation of a junior domestic user, it merely observes that the foreign holders of well known trademarks may be subject to inconsistent bodies of law depending on which circuit or state that they choose to litigate in. Further, even within the Second Circuit, whatever rights the senior foreign well-known trademark holder may claim will depend on the law of each individual state.\(^{32}\) This is in conflict with the constitutional principle and the international of federal supremacy in foreign relations and the obligation that the United States speaks with one voice on matters relating to foreign relations and the expectations of its fellow sovereigns that an agreement with the United States in binding on the several states unless otherwise agreed to in the treaty.\(^{33}\)

\(^{28}\) See generally Grupo Gigante S.A. De C.V. v. Dallos & Co., 891 F.3d 1088 (9th Cir. 2004).

\(^{29}\) See ITC Ltd, 482 F.3d at 161 (recognizing disagreement). Further, it is an axiom of the foreign relations law of the United States that “Where fairly possible, a United States statute is to be construed so as not to conflict with international law or with an international agreement of the United States.” RESTATEMENT (THIRD) OF FOREIGN RELATIONS LAW § 114 (1987)(citing cases).

\(^{30}\) See Dallo & Co., 391 F.3d at 1100-01.


\(^{32}\) In ITC Ltd. v. Punchgini, Inc., the federal courts were sitting in their diversity jurisdiction on the question of the protection of an unused well-known under New York State law. See id. at 142 n.3. They could have had as easily applied the law of any other state or had determined that New York’s choice of law or conflict of laws scheme requires the application of the law of a state other than New York to the dispute. See Klaxon Co. v. Stentor Elec. Mfg. Co., 313 U.S. 487, 496–97 (1941).

\(^{33}\) See United States v. Curtiss-Wright Export Corp., 299 U.S. 304, 316-17 (1936); See
C. Unfair Competition: Trade Secret

Trade secret law is largely an outgrowth of state common law protection against misappropriation and unfair business practices. The United States has entered into several treaties that obligate it to protect trade secrets. Yet, there is no civil federal trade secret law. As this section is being written, Congress is considering enacting federal trade secret protection legislation. This section will focus on state trade secret law, but it will also weave into the discussion some analysis of the proposed federal trade secret legislation.

The United States relies on the laws of individual states that protect trade secrets to meet its treaty obligations. While the vast majority of states have adopted the Uniform Trade Secret Act, not all of them have done so. Further, potentially state courts may derogate from the treaty standard of trade secret protection through judicial interpretations of the USTA even if the USTA is treaty compliant. The extent of mandatory trade secret protection under the Paris Convention and TRIPS is unclear because Article 39 of the TRIPS Agreement references back to Article 6bis of the Paris Convention. Accordingly, this Article will focus primarily on the United States’ obligations to protect trade secrets under the North American Free Trade Agreement (NAFTA) to establish the principle that without individual state laws protecting trade secrets the United States is not in
conformity with its NAFTA obligations.

1. Uniform Trade Secret Act

The Uniform Trade Secret Act has been adopted by almost all the states in the United States. However, some states have enacted non-uniform versions of the Uniform Trade Secret Act\(^40\) and of course, state courts have interpreted the Uniform Trade Secret Act in a non-uniform matter.\(^41\) The Uniform Trade Secret Act defines a trade secret as

"Trade secret" means information, including the whole or any portion or phase of any scientific or technical information, design, process, procedure, formula, pattern, compilation, program, device, method, technique, or improvement, or any business information or plans, financial information, or listing of names, addresses, or telephone numbers, that satisfies both of the following:

1. It derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by, other persons who can obtain economic value from its disclosure or use.

2. It is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.\(^42\)

The use of the USTA §1 standard appears to be consistent with minimum treaty obligations and the right of the United States under TRIPS or NAFTA to choose how to implement its treaty obligations through domestic legislation.

The UTSA only imposes liability on third parties when they knew or should have known that the trade secret was acquired by an improper means, \(^43\) and at least one state, Iowa, requires that the third party have

\(^{40}\) See 1 Trade Secrets Law § 3:32 (Massachusetts, New Mexico, and Ohio are examples of states with non-uniform laws.)


\(^{42}\) Melvin F. Jager, 2 Trade Secrets Law § 61:4.

\(^{43}\) The UTSA only protects against third-party use and disclosure if "At the time of disclosure or use, knew or had reason to know that the knowledge of the trade secret that the person acquired was derived from or through a person who had utilized improper means to acquire it, was acquired under circumstances giving rise to a duty to maintain its secrecy or limit its use, or was derived from or through a person who owed a duty to the person seeking relief to maintain its secrecy or limit its use"
actual knowledge of the misappropriation. The standard for imposing third-party liability under NAFTA and the TRIPS Agreement is much lower than that under the UTSA. Even if one can interpret the USTA’s higher mens rea standard as congruent with NAFTA or TRIPS floor for minimum national trade secret protection, at least the law of one state, Iowa is clearly outside the range of permissible interpretations of NAFTA and TRIPS requirements for trade secret protection. So, the United States may be treaty compliant in some states, but not in the entire United States.

2. Trade Secret (Restatement of Torts)

Although, the majority of states have adopted the Uniform Trade Secret Act, three commercially significant states with strong international trade sectors, New Jersey, New York, and Texas, still rely on the Restatement § 757. So, it is worth discussing whether § 757 of the Restatement is fully compliant with NAFTA and TRIPS. Under § 757 of the Restatement of Torts, “A trade secret may consist of any formula, pattern, device or compilation of information which is used in one’s business, and which gives him an opportunity to obtain an advantage over competitors who do not know or use it.”

NAFTA § 1711(1) defines a trade secret as

(a) the information is secret in the sense that it is not, as a body or in the precise configuration and assembly of its components, generally known among or readily accessible to persons that normally deal with the kind of information in question;

(b) the information has actual or potential commercial value because it is secret; and

(c) the person lawfully in control of the information has taken reasonable steps under the circumstances to keep it secret.

While the TRIPS Agreement article 39.2 defines a trade secret as

a) is secret in the sense that it is not, as a body or in the precise configuration and assembly of its components, generally

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44 Pace, supra xx, at 453 & n.84.
45 See 1 INTERNET LAW AND PRACTICE § 18:2 & n. 4.
46 RESTATEMENT OF TORTS § 757 (emphasis added).
47 NAFTA § 1711(1).
known among or readily accessible to persons within the
circles that normally deal with the kind of information in
question;

b) has commercial value because it is secret; and

c) has been subject to reasonable steps under the circumstances,
by the person lawfully in control of the information, to keep
it secret.

Both NAFTA and TRIPS treaties have similar definitions of a trade secret,
and unlike the §757 of the Restatement of Torts, neither of them requires
that the trade secret be used in one’s business. So, to the degree that any
state or a state court requires that a trade secret in order to receive
protection against misappropriation must actually be used in the trade secret
owner’s business, it is imposing an additional obligation that is inconsistent
with the minimum obligations of the United States under NAFTA §1711(1)
and TRIPS article 39.2. However, to continue the theme of a problematic
patchwork of state law protection, although the Texas courts had adopted
the Restatement § 757 requirement of “use in one’s business” test; in
practice, they often ignore the element of “use in one’s business” in a trade
secret misappropriation case.

3. Proposed Civil Federal Trade Secret Protection

The Protecting American Trade Secrets and Innovation Act of 2012 is
designed, if ever enacted, to provide federal court civil jurisdiction only in
the most serious of trade secret misappropriation actions which either
demand nationwide service of process or involve the misappropriation of
U.S. trade secrets to a foreign country. Because of the narrow
jurisdictional limits in the Act, a reasonable reading of the proposed
legislation is that the United States would still have to rely on state trade
secret law as a gap filler in the vast majority of trade secret
misappropriation actions to meet its international obligations. Further even
in those trade secret misappropriation cases that will fall under the proposed
act, as written, the bill is still inconsistent with the international obligations
of the United States to protect trade secrets.

The Protecting American Trade Secrets and Innovation Act of 2012

48 See NAFTA / TRIPS
49 See Pace, supra note xx, at 453-54;
50 Protecting American Trade Secrets and Innovation Act of 2012. S. 3389 proposing
2912607 (July 17, 2012)
incorporate misappropriation either under state trade secret law or under 18 U.S.C. § 1831 (or § 1832) for federal misappropriation of trade secrets.\textsuperscript{51} The language of the bill as structured using a disjunctive “or” as a connector appears to provide for three separate and independent grounds on which to bring a trade secret misappropriation claim. This section will explore the possibilities for civil trade secret protection under the pending The Protecting American Trade Secrets and Innovation Act of 2012.

a. State Misappropriation Based Federal Court Jurisdiction

The Protecting American Trade Secrets and Innovation Act of 2012 provides that the owner of a trade secret may bring an action in federal court under the act for “a misappropriation of a trade secret that is related to or included in a product that is produced for or placed in interstate commerce or foreign commerce.”\textsuperscript{52} This Article already discussed the manifold problems of using state trade secret law as a basis to provide a uniform level of protection that meets the treaty obligations of the United States.\textsuperscript{53} Suffice to say, The Protecting American Trade Secrets and Innovation Act of 2012 merely places a thin shellacking of federal protection of trade secret rights by providing another independent jurisdictional basis on which federal courts may adjudicate these disputes by applying state trade secret misappropriation law. One may speculate that The Protecting American Trade Secrets and Innovation Act of 2012 is more promise that deliverable reality in providing effective federal trade secret protection. Under their diversity jurisdiction, federal courts already hear state law based trade secret misappropriation cases on a regular basis,\textsuperscript{54} and if as the proponents of the bill claim that it is limited to “the most serious of cases” then in practice, it largely should be limited to cases that would meet the amount in controversy and other requirements for federal court diversity jurisdiction.\textsuperscript{55}

Furthermore, to the degree that the basis of these civil suits is a state law based claim of trade secret misappropriation, the proposed act is not a step forward in achieving national uniformity for the protection of trade

\textsuperscript{51} Protecting American Trade Secrets and Innovation Act of 2012, S. 3389, sec. 2(a)(1).
\textsuperscript{52} S. 3389, sec. 2(a)(1)(B). The author queries whether this is a scrivener’s error or that by intention the proposed act does not apply to misappropriated trade secrets used in commerce with Native American tribes.
\textsuperscript{53} See supra sec. XX.
\textsuperscript{54} For example, the search “trade +3 secret /p diversity-jurisdiction” in the Westlaw allfeds database resulted in 199 documents. A slightly broader search “trade +3 secret /p jurisdiction” in the allfeds resulted in 2215 documents roughly one-third of the results of running the same query in allstates (8381 documents).
\textsuperscript{55} 158 Cong. Rec. S5086-01, 2012 WL 2912608
National uniformity requires a national law that preempts state laws that are inconsistent with the national policies of the United States. The Protecting American Trade Secrets and Innovation Act of 2012 fails to achieve a national uniform trade secret law as least in so far as it permits state law based trade secret misappropriation and merely provides an alternative jurisdictional basis on which the federal courts may hear these cases without preemting inconsistent state trade secret law.

b. Federal Trade Secret Law (18 USC § 1831)

Federal criminalizes the theft of trade secrets and the receipt of a stolen trade secret. Currently, there are no federal civil trade secret causes of action. For the purposes, of this article one of the seminal features of even criminal federal trade secret protection is its reliance on state law and state law definitions to create and enforce federal interests (arguably treaty interests) in protecting trade secrets.

Economic Espionage Act (EEA) already criminalizes the theft of, the attempt to steal, and a conspiracy to steal trade secrets. The federal definition of a trade secret parallels the UTSA definition. Sections 1831(a) prohibits the knowing theft of trade secrets to benefit a foreign government or entity, and § 1832(a) prohibits the knowing theft of a trade secret for a product that is produced or placed in interstate or foreign commerce and knowing that the “offense will, injure any owner of that trade secret.” Unlike the Restatement § 757 or the UTSA, federal law narrowly defines what constitutes misappropriation under the criminal statute. Misappropriation under both sections is defined as “steals, or without authorization appropriates, takes, carries away, or conceals, or by fraud, artifice, or deception obtains a trade secret.”

So, arguably examples like legally flying over a competitor’s factory construction site to obtain a trade secret would not be a criminal act of a theft of a trade secret. However, in a civil trade secret misappropriation case under the Restatement, E. I. duPont

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56 S. 3389(d) expressly incorporating 18 U.S.C. § 1838 (“This chapter shall not be construed to preempt or displace any other remedies, whether civil or criminal, provided by United States Federal, State, commonwealth, possession, or territory law for the misappropriation of a trade secret . . . .”) compare, Pace, supra note xx, at 467-68 (discussing the need for federal preemption of state trade secret laws).

57 Compare 18 U.S.C. § 1939(3) (federal trade secret definition) with Uniform Trade Secret Act §1.4 (UTSA trade secret definition). See United States v. Chung, 659 F.3d 815, 824–25 (9th Cir.2011)(noting semantic differences between the two definitions). Federal courts look to state UTSA cases to interpret the federal definition. Id. at 825.

58 See 18 U.S.C. § 1832(a). The EEA appears to be severely underutilized by prosecutors, if the theft of trade is as widespread as is claimed. Although, the EEA is over 15 years old, the author was only able to locate 40 cases on Westlaw involving the EEA.

60 18 U.S.C. § 1831(a)(1) & § 1832(a)(2).
denNemours & Co. v. Christopher, the court interpreted the Restatement element “improper means” in order to prohibit such an skullduggery.\textsuperscript{61} The court gave a robust definition to the term “improper means” and while declining to define improper means in all its possible permutations did state a golden rule that “thou shall not appropriate a trade secret through deviousness under circumstances in which countervailing defenses are not reasonably available.”\textsuperscript{62}

In addition to prohibiting the theft of a trade secret, federal criminal trade secret law also prohibits the knowing receipt of a misappropriated trade secret.\textsuperscript{63} So, under this provision, arguably, although the Christophers are not criminally liable for stealing a trade secret (under the EAA) by flying over the factory; their client may be liable for receiving a stolen trade secret, because the aerial photographs met the EEA’s definition of a trade secret. \textsuperscript{64} As the EEA is a criminal act, it provides for no private cause of action or remedy for the aggrieved trade secret holder,\textsuperscript{65} and of course, the burden of proof is “beyond a reasonable doubt.”\textsuperscript{66} Consequently, the EEA because of a lack of a private cause of action, the narrow criminal definition of theft of a trade secret, and the high beyond a reasonable doubt burden of proof, the EEA is not consistent with either the NAFTA or the TRIPS Agreement floor for trade secret protection.

If enacted The Protecting American Trade Secrets and Innovation Act of 2012 will amend the existing criminal theft of trade secrets provision in the Economic Espionage Act by providing for federal court civil jurisdiction in significant trade secret misappropriation cases. The Protecting American Trade Secrets and Innovation Act of 2012 will amend existing 18 U.S.C. § 1839 to add a definition of the term “misappropriation” which is virtually identical to the definition in the USTA.\textsuperscript{67} Consequently, it

\textsuperscript{61} See E. I. duPont deNemours & Co. v. Christopher, 431 F.2d 1012, 1016 (5th Cir. 1970), cert. denied, 400 U.S. 1024 (1971). In this case, the Christophers flew over a duPont factory and took aerial photographs for an unnamed client. All prior Texas cases involving misappropriation of trade secrets had as one factual element either a criminal law violation or a tort was involved in the misappropriation. Here, the act of flying over the unfinished act was arguably legal as was the taking of the photographs. Id. at 1016.

\textsuperscript{62} Christopher, 431 F.2d at 1017.

\textsuperscript{63} See 18 U.S.C. § 1831(a)(3)(“receives, buys, or possesses a trade secret, knowing the same to have been stolen or appropriated, obtained, or converted without authorization”); & § 1832(a)(3)(same).


\textsuperscript{65} See United States v. Hsu, 155 F3d 189, 203 (3rd Cir. 1998).

has all of the defects of the USTA with the additional major shortcoming of providing only narrow jurisdictional grounds for its application. It does at least however have the marginal advantage of being a federal law and therefore some basis on which to presuppose a national level of uniform protection of trade secrets. In fact, however, the Act may even exacerbate the lack of uniformity, if the federal courts continue their existing practice of looking to state misappropriation of trade secret decisions as guidance when interpreting federal trade secret the EEA.\(^68\) Federal courts may bring into the federal common law developing federal trade secret protection all the inconsistencies and hobgoblins now present in state law.

Currently, the EEA’s criminal provisions do not provide adequate protection of trade secrets nor will it even after the enactment of a civil cause of action in the Protecting American Trade Secrets and Innovation Act of 2012. Consequently, protection of trade secrets in the United States as required by NAFTA and by TRIPS depends crippledly on the laws of each state. As was discussed in earlier in this section, state law either the common law as expressed in the Restatement or by the UTSA as enacted is not compliant with the treaty obligations of the United States. Although, there is proposed legislation pending, it is unclear whether Congress will enact it, and if enacted whether this proposal would place the United States in a substantially better position vis-à-vis its treaty obligations. However, even the enactment of a federal trade secret law that was completely congruent with the international obligations of the United States would not weaken the force of this Article’s contention that the United States does (or if a proper treaty-compliant federal trade secret was enacted did) rely on state law to meet its minimum international obligations to protect trade secrets.

III. PREEMPTION

While the language of the federal statutes may be sufficiently robust to create a colorable statute based argument that the United States is complying with its obligations to protect moral rights, unregistered well known marks, and trade secrets, the actual obligation of the United States is to provide effective protection through its domestic implementation of these treaty obligations.\(^69\) This is may not be the case as these statutes are construed and implemented through inconsistent federal or state court decisions relying on the common law of individual states. In fact, as was discussed earlier, in New York State, there is a cause of action that protects

\(^{68}\) See, e.g., United States v. Chung, 659 F.3d 815 (9th Cir. 2011); United States v. Hanjuan Jin, 833 F. Supp. 2d 977, 1006 (N.D. Ill. 2012).

\(^{69}\) See TRIPS Agreement Art. 41(1) (“ensure that enforcement procedures . . . are available under . . . [national] law so as to permit effective action against any act of infringement of intellectual property rights covered by” the TRIPS Agreement).
well known marks even absent use in the state while the State of California has no analogous provision in state law. So, in California, under state law, as interpreted by the Ninth Circuit, there is no state law remedy, much less an ineffective one. Of course, a party could file an action in federal court and request that the question be certified to the California Supreme Court or commence an action in California state court and thus permit the state courts to develop the organic common law of the state.\textsuperscript{70} California should be the ultimate arbiter of whether state law protects foreign well-known marks that are unregistered and not used by the mark holder in California.

This section will analyze federal preemption doctrines and their applicability to state law with a focus on the preemption doctrines related to the foreign relations of the United States and consider whether these doctrines in any way limit the ability of the states to develop state laws which may be inconsistent with the positions taken by the United States in international forums.

A. Federal Courts

This section will discuss the application of federal preemption doctrines to development of state law in the context of state law serving as statutory gap fillers. Under the Supremacy Clause of the United States Constitution, Congress has the power to preempt state law, and state laws that conflict with federal law are “without effect.”\textsuperscript{71} Federal courts have recognized two general types of federal preemption: express preemption and implied preemption. Implied preemption is often broken down further into conflict preemption and field preemption.\textsuperscript{72} All federal preemption jurisprudence exists against a backdrop that court must indulge in a strong presumption that state law is not preempted and that the preferred interpretation of any purported conflict between federal and state law is the interpretation that disfavors preemption.\textsuperscript{73} If the interpretation that disfavors preemption is the preferred interpretation, then that rule of thumb is built on two jurisprudential posts that "the purpose of Congress is the ultimate touchstone" in every pre-emption case" and when Congress ‘legislated … in a

\textsuperscript{70} See California Rule of Court 29.5. Although extremely rare in actual practice, sister state courts and tribal courts applying the law of another jurisdiction may also certify questions of law to that jurisdiction. See generally Ira P. Robbins, Interstate Certification of Questions of Law: A Valuable Process in Need of Reform, 76 Judicature 125 (Oct/Nov. 1992); Uniform Certification of Questions of Law Act §2.

\textsuperscript{71} Maryland v. Louisiana, 451 U.S. 725, 746 (1981).


field which the States have traditionally occupied,’ … [court must] ‘start with the assumption that the historic police powers of the States were not to be superseded by the Federal Act unless that was the clear and manifest purpose of Congress.”

1. Express Preemption

Express preemption requires that Congress explicitly stated its intention to displace all state regulation from an area that it is constitutionally empowered to regulate. With the narrow exception, the Copyright Act’s §301(f) preemption of state legislation in the context of the Visual Artist’s Rights Act (VARA), federal law is silent on the question of moral rights. Federal law is silent on the questions of well known (but not yet famous marks which are protected from trademark dilution), and trade secret protection. So, there are some narrow grounds on which state law may be preempted.

2. Implied Preemption

Despite the absence of an express statutory command by Congress preemipting state laws, courts may still find state laws preempted, if either the state law conflicts with federal law or if Congress intended federal law to occupy the field and to displace all state regulation. In the case of conflict or field preemption, state law is preempted if either it is impossible to comply with both state and federal law or if “the challenged law stands as an obstacle to the accomplishment and execution of the full purposes and objects of Congress.” If the putative conflict is an area that is historically committed to the state regulation then federal courts will not preempt state law unless “[it] was the clear and manifest purpose of Congress [to preempt state regulation];” further, if there is more than one plausible interpretation of the statute then courts should ordinarily prefer the interpretation that avoids preemption. To the degree that state law moral rights based on claims of unfair competition conflict with Copyright Act, after Dastar, these rights are too preempted.

Absent a conflict between state law and the Constitution, state and federal law, or an express preemption of state regulation by Congress, state regulation may still be preempted by federal law if “[t]he scheme of federal regulation may be so pervasive as to make reasonable the inference that Congress left no room for the States to supplement it”; “the Act of Congress

74 Medtronic, Inv v. Lohr, 518 U.S. 470, 485  
75 See Arizona v. United States, 132 S. Ct. 2492, 2500-01 (2012)  
may touch a field in which the federal interest is so dominant that the federal system will be assumed to preclude enforcement of state laws on the same subject; or “the state policy may produce a result inconsistent with the objective of the federal statute.” 79 Generally, state based protection of moral rights, well-known marks, and trade secret is consistent with principles of federal supremacy. The Constitutional limits on state based regulation of treaty-related subject matter may be when state law comes into conflict with federal treaty obligations.

B. International Law

Breaches of international agreements are generally disputes between sovereigns and the remedy if any is one granted under international law. Rights granted under treaties or obligations that nations undertake rarely percolate down to the level of a private right or a private cause of action. The relationship of the sovereign states and international law is one that is mediated by the federal government. Under U.S. interpretations of its internal domestic (municipal) law, principles of international law are not binding on the states unless and until Congress makes them so bound, by either passing a self-executing treaty or enacting domestic legislation that places some obligation on the states. 80 So for the private parties, who are the putative beneficiaries of the treaty, the question of whether there s a conflict between domestic federal or state law and international law is ultimately reduced to a federal preemption question of whether state law is preempted by domestic federal law, and whether that federal law is a lawful exercise of executive or legislative power of the United States.

C. State Statutes and State Courts

While the focus of scholarly and judicial attention appears to be on the federal governments ability to preempt state laws to assure compliance with national policies, this section will discuss whether the states have state law doctrines that may independently compel them to consider the foreign policy statements of the United States as the develop state law. In Pratt v. Caterpillar Tractor, Co., one justice dissenting from denial of leave to appeal stated that “[c]onsidering both the supremacy clause of the United States Constitution and the plenary authority of the federal government in matters of foreign affair, it is difficult to conceive of a United State foreign policy which is not also the policy of this State and intended for the protection of its citizens.” 81 As a question of statutory interpretation and a prudential principle of the development of the common law, state courts

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81 Pratt v. Caterpillar Tractor Co., 114 Ill.2d 556, 556-57 (Ill. 1987)
have a duty to avoid interpreting a statute or developing state common law in a manner that places the United States in violation of its international obligations.\textsuperscript{82} In the United States, the common law courts at all levels the customary norm is to adjudicate only the issues actually presented by the parties to the court and courts rarely depart from this customary norm.\textsuperscript{83} Courts rarely \textit{sua sponte} raise issues that are not presented to the court by the parties before the court. Therefore, as a practical matter unless the parties before the court actually raise the international implications of the court’s potential holdings, it is unlikely that a state court or federal court sitting in diversity will speculate on the possible implications of its holding. Often, it may not be in the interests of the actual parties before the court to raise international law and treaty issues, and while these issues may be addressed in briefs by amici curiae, the norms of judicial practice limit a court’s use of issues raised by amici curiae in resolving a dispute.\textsuperscript{84}

\textbf{IV. THE LEGAL EFFECT OF A DIPLOMATIC COMMUNICATIONS}

State laws and judicial decisions that are inconsistent with the treaties and other laws of the United States clearly preempted by federal law under the Supremacy Clause of the Constitution.\textsuperscript{85} However, the position of the United States is not always taken in the form of laws and treaties. These lesser acts relating to foreign policy positions of the United States may take place in between executive agreements between the President of the United States and another head of state or internationally recognized juridical entity or in statements made in response to questions posed in a international forum.

\textbf{A. Treaties and Other Statutes}

Treaties are the clearest case. Treaties are a positive enactment of law

\begin{footnotesize}
\begin{enumerate}
\item[83] The rule governing issues not presented by the parties is clear. See, e.g. 9th Cir. R. 28-1(b). However, in practice, some court, if the substantive issues of the underlying case merit it, have departed from this presumptive norm. See generally Adam A. Milani and Michael R. Smith, \textit{Playing God: A Critical Look at Sua Sponte Decisions by Appellate Courts}, 69 TENN. L. REV. 245 (2002); Barry A. Miller, \textit{Sua Sponte Appellate Rulings: When Courts Deprive Litigants of an Opportunity to be Heard}, 39 SAN DIEGO L. REV. 1253 (2002).
\item[85] See U.S. Const. art. VI, cl 2; Hillsborough County, Fla. v. Automated Medical Laboratories, Inc., 471 U.S. 707, 712-13 (1985)
\end{enumerate}
\end{footnotesize}
under an express power granted to the president to negotiate and to the Senate to ratify the treaty.\textsuperscript{86} Treaties preempt inconsistent state law.\textsuperscript{87} However, the treaties that this Article focuses on are not self-executing so they have no domestic effect. In fact, Congress has gone to inordinate lengths to prevent the Berne Convention from even inadvertently being considered a self-executing treaty.\textsuperscript{88} So, while a ratified treaty is a clear expression of federal law, it is one that does not fall within the paradigm analyzed in this article.

B. Executive Agreements

The United States’ preemption jurisprudence regarding the preemptive effect of an executive agreement is consistent. However, its jurisprudence regarding the lawful subject matter of an executive agreement has been remarkably inconsistent in recent years. An executive agreement is “[a]n international agreement entered into by the President, without approval by the Senate, and usually involving routine diplomatic or military matters.”\textsuperscript{89} Even absent an express preemption clause, a valid executive agreement preempts both state statutory and common law.\textsuperscript{90} Consequently, while an executive agreement is not law per se, it has the force of law to displace inconsistent state laws. However, there are limits on the President’s ability to preempt state laws through executive agreements. The executive agreement must comport with federal law and the Constitution of the United States.\textsuperscript{91} In theory, it may be possible for the United States to constrain the development of state law through some form of an executive agreement that creates a binding interpretation of a treaty. However, mere statements by the president or by other high government officials as to their understanding of

\textsuperscript{86} See Restatement (Third) of Foreign Relations of the United States § 303 Reporter's Note 3 (1987). Technically, the president negotiates a treaty, the Senate provides its advice and consent through a resolution of ratification, and then the president ratifies the treaty. See Avero Belgium Ins. v. American Airlines, Inc., 423 F.3d 73, 78-79 (2nd Cir. 2005). However, in common parlance, the U.S. Constitution art. II, sec. 2 para. 2 “advice and consent” requirement is often called a “ratification” of a treaty. \textit{Id}.

\textsuperscript{87} Medellin v. Texas, 552 U.S. 491, 530 (2008).

\textsuperscript{88} 1-1 Nimmer on Copyright §1.12[A]. Almost one-third of the Berne Convention Implementation Act of 1988's sections are designed to “forestall any claim that the Berne Convention is self-executing under United States law. Id. Congress even assured that the BCIA went into effect simultaneously with the Berne Convention to prevent any argument that as later adopted treaty, the Berne Convention modified any aspect of U.S. law Id. at n. 6. See Section XX \textit{supra}

\textsuperscript{89} \textsc{Black's Law Dictionary} (9th ed. 2009), executive agreement


a treaty may be at best the highest form of persuasive authority to state legislature or a court tasked with reconciling state law with the treaty obligations of the United States but in no event are the mere words of the executive branch binding like chains on the development of state law.

C. Statements by Government Officials

Federal and state courts at least in theory “have the final authority to interpret an international agreement for the purposes of applying it as law in the United States, but will give great weight to an interpretation made by the Executive Branch.” 92 This general principle requires two caveats. First, either position or interpretation of the Executive Branch must be clear in citable persuasive authority or the United States must be prepared to file some statement of its interpretative position with the courts. And second, more importantly, while the Constitution and law of the United States grant great authority to the Executive Branch to interpret treaties and to control the foreign relations of the United States, it grants no prerogative to either the Executive, Legislative, or Judicial branches to interpret or to develop the laws of the several states. Assuming that a representation by a representative of the United States’ Executive branch in the course of negotiations or implementation of a treaty would carry less precedential authority in displacing state law than a Memorandum signed by the President of the United States carrying out his constitutional duties and effectuating a judgment by the ICJ then its unlikely that positions taken by the United States assuring foreign governments that it is incompliance with its international obligations because of state laws are in anyway binding on the individual states.

However, there are communications between governments that are significantly less formal than treaties or executive agreements. In *Medellin v. Texas*, the U.S. Supreme Court considered the legal effect of a statement by then President George W. Bush implementing an International Court of Justice decision in the *Case Concerning Avena and Other Mexican Nationals (Mex. v. U.S.)*. 93 The International Court of Justice held that the United States violated the rights of 51 Mexican nationals regarding their Vienna Convention right to be informed about their rights to consular services. 94 The ICJ ruled that based on violations of the Vienna Convention the 51 named Mexican nations were entitled to review and reconsideration of their state court convictions and sentences in the United States regardless of their procedural default under state law for failing to raise these issues.

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92 Restatement (Third) of Foreign Relations of the United States § 326.
93 Medellin, 552 U.S. at 497 citing *In the Case Concerning Avena and Other Mexican Nationals (Mex. v. U.S.)*, 2004 I.C.J. 12 (Judgment of Mar. 31)
earlier in the proceedings.\footnote{Medellin, 552 U.S. at 497.}

President Bush through a Memorandum to the Attorney General declared that the United States would discharge its international obligations by having state courts give effect to the ICJ’s Avena decision.\footnote{Medellin, 552 U.S. at 498.} Relying on the President’s Memorandum, a prisoner petitioned a Texas state court for a writ of habeas corpus, which was denied on the grounds that it was an abuse of the writ under state law because the prisoner had not raised the issue in a timely manner. The Supreme Court granted a writ of certiorari on the issue of whether the President’s Memorandum independently required state courts to provide review and reconsideration without regard to state habeas default rules.

The Supreme Court acknowledged that the Avena judgment constituted an international law obligation of the United States. However, the Court found that the Avena judgment was not a domestic law obligation of the United States or of the individual states. The Court then considered whether there is an inherent power of the President of the United States in the cases where a treat creates an obligation for the United States to find that the treaties “implicitly give the President the authority to implement that treaty-based obligation.”\footnote{Medellin, 552 U.S. at 525-26.} The Court rejected this claim and found that “The responsibility for transforming an international obligation arising from a non-self-executing treaty into domestic law falls to Congress.”\footnote{Medellin, 552 U.S. at 525-26.}

The Court analyzed the scope of the President’s authority using the tripartite scheme first articulated in Youngstown Sheet & Tube Co. v. Sawyer.\footnote{Youngstown Sheet & Tube Co. v. Sawyer, 343 U.S. 579, 610–611 (1952).} The Court recognized that the interests of the United States in protecting relations with foreign governments and demonstrating a commitment to international law were “plainly compelling.”\footnote{Medellin, 552 U.S. at 524.} However, the authority of the President to comply with the international treaty obligations of the United States did not come from either an act of Congress or from the Constitution. Applying, Youngstown, the Court reiterated that when a President acts pursuant to an express or implied authorization of Congress, his authority is at its highest.\footnote{Medellin, 552 U.S. at 528} When the President acts in the absence of an authorization by Congress, but within a zone where both the legislative and executive branch have concurrent authority, presidential authority is derived from “congressional inertia, indifference or quiescence.”\footnote{Medellin, 552 at 524 (quoting Youngtown, 343 U.S. at 637).} Finally, when the President acts against the express or
implied will of Congress, the Court can only sustain his actions by “disabling the Congress from acting upon the subject.” Therefore, “given the absence of congressional legislation, that the non-self-executing treaties at issue here did not “express[ly] or implied[ly]” vest the President with the unilateral authority to make them self-executing.”

In a long unbroken line of U.S. Supreme Court cases, the Supreme Court has upheld the right of the president to settle the civil claims of American citizens against foreign governments or foreign nationals. The court found that the legitimacy of the presidential prerogative was based on its age, an almost 200 year tradition, and Congress’s acquiesce for almost 200 years. But as the Court held “[p]ast practice does not, by itself create power.” The court described, as “unprecedented” President Bush’s exercise of power of executive power, and the Solicitor General was unable to identify a single instance where the President gave or Congress acquiesced to a Presidential directive directed to a state court. Therefore, President Bush’s Memorandum to the Attorney General attempting to meet the international obligations of the United States as a sovereign member of the international community had no legal effect in domestic law and was ultra vires. Of course, Congress could readily correct this deficiency in federal law by expressly granting the president the power to comply with judgments against the United States—obviously subject to some form of Congressional or judicial oversight. For example, Congress could permit the President to authorize the Attorney General to commence an action in federal court to enforce a judgment against the United States and specifically provide for federal court jurisdiction. The President’s decision to commence the action solves the political question and judicial recognition of the President’s constitutional authority in foreign affairs and the judicial review assures that the President’s actions are consistent with the constitution and laws of the United States and that the United States is not inadvertently non-compliant with its treaty obligations.

V. THE LAWS OF 50 STATES PLUS AND BREACH OF TREATY OBLIGATIONS

The language of many intellectual property treaties makes the domestic enforcement of the treaty a matter for domestic legislation. The
Constitution through the Supremacy Clause provides Congress with the explicit power to assure that the domestic implementation of the foreign relations obligations of the United States through either self-executing treaties or legislation that results in national, uniform, and comprehensive laws. However as a concession to domestic politics, Congress (or the executive branch) has on occasion chosen to allow a piecemeal patchwork of state laws to substitute for uniform national laws. This departure is not justified based on international law. Absent appropriate language in the treaty, a nation may not excuse its inability to comply with its treaty obligations based on domestic internal law whether that limitation is based in constitutional, statutory, common law or the inability of the executive branch of government to convince the legislative branch to enact treaty compliant domestic implementation legislation. Merely having something that purports to be colorable law is not sufficient. The basic norm of international law is that a sovereign nation, if it voluntarily chooses to undertake a treaty obligation then it has a duty to comply with the treaty obligations in a good faith manner. The International Court of Justice has consistently interpreted the concept of good faith as more than technical or colorable compliance with a treaty obligation.

Article 26 [of the Vienna Convention on the Law of Treaties] combines two elements, which are of equal importance. It provides that “Every treaty in force is binding upon the parties to it and must be performed by them in good faith.” This latter element, in the Court's view, implies that, in this case, it is the purpose of the Treaty, and the intentions of the parties in concluding it, which should prevail over its literal application. The principle of good faith obliges the Parties to apply it in a reasonable way and in such a manner that its purpose can be realized.

In addition to the general international obligation of a floor of good
faith when implementing a treaty, some international obligations such as those imposed under the TRIPS Agreement require more than mere pro forma linguistic compliance. The TRIPS Agreement requires “effective” domestic implantation of its provisions. Further, the patchwork of potentially inconsistent state laws is inconsistent with Article 41 of the TRIPS Agreement, which requires that “These [enforcement] procedures shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.” Clearly, a tapestry of inconsistent state laws, state based procedures, and circuit splits are quite effective non-tariff barriers to trade.

VI. Material Breach of Treaty

The United States is at a minimum composed of 50 states and the District of Columbia. However, the United States also administers 16 territories as insular territories, for example American Samoa, Guam, Northern Mariana Islands, Puerto Rico, and the United States Virgin Islands and is also responsible for their foreign relations. So, at what geographic, temporal, or economic point, does the United States fall out of its compliance with a treaty obligation is a fascinating question.

The United States’ compliance with its treaty obligations could be measured substantively or qualitatively. Substantively when an economically significant state or a group of smaller states which are collectively economically significant no longer provide state-law protection at a level that a treaty demands of the United States the United States is in breach of its treaty obligations. So, perhaps if any state laws of California, New York, or Texas provide inadequate protection then the United States provides inadequate protection or it could be measured economically, for example a group of smaller states collectively no longer provide treaty

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114 TRIPS art. 41(1)(“Members shall ensure that enforcement procedures as specified in this Part are available under their law so as to permit effective action against any act of infringement of intellectual property rights covered by this Agreement.”).
115 TRIPS art. 41(1).
116 Black’s Law Dictionary (9th ed. 2009)(“United States of America”). Under international law a treaty is binding in the entire territory of its signatories. There is some debate as to whether entire territory means both the metropolitan and non-metropolitan territories and just the metropolitan territories. The territory comprising the fifty states and the District of Columbia is considered the metropolitan territory of the United States; however, the current international norm appears to be that unless a treaty specifically specifies otherwise or there is a clear intention to limit the territorial scope of a treaty that a treaty is binding in all territories where a signatory is sovereign. See generally OLIVER DÖRR AND KIRSTEN SCHMÄLENBACK (eds), VIENNA CONVENTION ON THE LAW OF TREATIES: A COMMENTARY 489-502 (2012).
117 See 48 U.S.C. ch. 4, 7-9, 12, 17-19.
compliant protection then the United States is no longer in compliance with its treaty obligations. Compliance could also be measured qualitatively, the United States signed a treaty as a single entity, and the United States is required to assure that every portion of its sovereign territory is compliant with its international obligations.

**CONCLUSION**

Under current U.S. Supreme Court interpretations of the powers of the President of the United States and of the Executive Branch, statements made by the United States or obligations undertaken by the United States that are part of treaties do not bind individual states or their state courts unless these obligations become part of domestic law. Consequently, statements made by the President or diplomats are merely the promises of kings.\[118\] Congress may make these positions of the United States binding on the states by either ratifying a self-executing treaty or by enacting positive domestic law pursuant to one of its enumerated powers. Unless preempted by the Constitution or by domestic federal law, states are free to grow state domestic law in a manner that is consistent with the international obligations of the United States in the shadow of Congressional inertia. While individual states, absent Congressional action, may be constitutionally free to develop state law free from the constraints of the United States’ international law obligations. Sound policy dictates that state legislatures and state courts carefully consider these positions as highly persuasive authority and only depart from them, if there is a compelling reason. States play their role in foreign policy through the President and Congress. Therefore, state legislatures and courts should avoid injecting themselves into the diplomatic thicket by unnecessarily creating claims that the United States is in violation of its international agreements. No one states choice of domestic law, should impact the foreign relations of the United States nor expose the citizens of other states the withdrawal of reciprocal rights or treaty benefits by an aggrieved treaty-partner.

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\[118\] “God bless our good and gracious King Whose promise none relies on, Who never said a foolish thing Nor ever did a wise one.” -John Wilmot, 2nd Earl of Rochester Of Charles II (published1707).