A vertical graphic on the left side of the cover. It features a blue-toned image of a globe made of puzzle pieces at the bottom. Above the globe are two large, metallic, 3D circular objects. The top one has the letters 'TM' and the bottom one has a large 'R', representing the trademark symbol.

Trademark Protection and Territoriality Challenges in a Global Economy

**EDITED BY
Irene Calboli
and Edward Lee**

ELGAR INTELLECTUAL PROPERTY AND GLOBAL DEVELOPMENT

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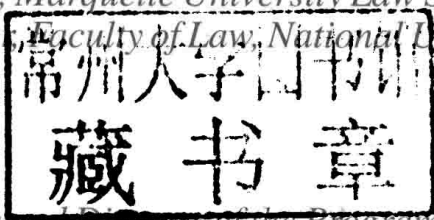
Edited by

Irene Calboli

*Professor of Law, Marquette University Law School, USA and
Visiting Professor, Faculty of Law, National University of
Singapore*

Edward Lee

*Professor of Law and Director of the Program in Intellectual
Property Law, IIT Chicago-Kent College of Law, USA*



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Trademark Protection and Territoriality Challenges in a Global Economy

ELGAR INTELLECTUAL PROPERTY AND GLOBAL DEVELOPMENT

Series Editor: Peter K. Yu, *Kern Family Chair in Intellectual Property Law and Director, Intellectual Property Law Center, Drake University, USA*

Rapid global economic integration and the increasing importance of technology and information goods have created the need for a broader, deeper and more critical understanding of intellectual property laws and policies. This uniquely-designed book series provides an interdisciplinary forum for advancing the debate on the global intellectual property system and related issues that intersect with transnational politics, international governance, and global economic, social, cultural and technological development. The series features the works of established experts and emerging voices in the academy as well as those practising on the frontlines. The series' high-quality, informed and accessible volumes include a wide range of materials such as historical narratives, theoretical explanations, substantive discussions, critical evaluations, empirical analyses, comparative studies, and formulations of practical solutions and best practices. The series will appeal to academics, policy makers, judges, practitioners, transnational lawyers and civil society groups as well as students of law, politics, culture, political economy, international relations and development studies.

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Trademark Protection and Territoriality Challenges in a Global Economy
Edited by Irene Calboli and Edward Lee

Editors and contributors

Graeme W. Austin is Chair in Private Law at Victoria University of Wellington (New Zealand) and Professor of Law at Melbourne University (Australia). With first degrees from Victoria University, Professor Austin graduated J.S.D. and LL.M. from Columbia University, where he held the Burton Fellowship in Intellectual Property Law. Before returning to Australasia in 2010, he was the J. Byron McCormick Professor of Law at the University of Arizona. He is an elected member of the American Law Institute. Professor Austin's most recent book (co-authored with Prof. Larry Helfer (Duke)) is *Human Rights and Intellectual Property Law: Mapping the Global Interface* (Cambridge University Press).

Irene Calboli is a Professor of Law at Marquette University Law School, a Visiting Professor at the Faculty of Law of the National University of Singapore, and a Transatlantic Technology Law Forum Fellow at Stanford Law School. She started her academic career at the Faculty of Law of the University of Bologna and held visiting positions at DePaul University College of Law, King's College London, the University of California Berkeley, the University Complutense, and the Max-Planck-Institute for Intellectual Property Law. Dr Calboli's research interests focus on trademark law and policy, overlapping intellectual property rights, and the protection of geographical indications of origin. She is an active member of the Academic Committee of the International Trademark Association (INTA), the International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP), the Association Littéraire et Artistique Internationale USA (ALAI-USA), and the Executive Committee of the Section on Law and Arts of the Association of American Law Schools.

Margaret Chon is the Donald & Lynda Horowitz Professor for the Pursuit of Justice, and formerly Associate Dean for Research at Seattle University School of Law. She is an active scholar and teacher of intellectual property and critical theory. Her current research explores the global governance dimensions of intellectual property, especially their distributional consequences and social justice implications. Professor Chon is the author of over 40 articles, book chapters and review essays

on both intellectual property and on race. She has been affiliated with numerous institutions, including most recently New York University School of Law, where she was a 2011–12 Senior Global Emile Noël Research Fellow at the Jean Monnet Center for International and Regional Economic Law & Justice. In addition, she has been a Visiting Law Professor at George Washington University Law School, University of Hawaii School of Law, University of Michigan Law School, Notre Dame Law School, University of Washington School of Law and elsewhere. Throughout her professional career, she has been and continues to be active in various community and professional organizations, both nationally and internationally. She received her A.B. from Cornell University and her J.D. from University of Michigan.

Daniel C.K. Chow is the Associate Dean for International and Graduate Programs and the Joseph S. Platt-Porter, Wright, Morris & Arthur Professor of Law at the Ohio State University Michael E. Moritz College of Law. He writes and teaches in the areas of international business and trade, international intellectual property, and the law of China. He has written numerous books and articles in all of these areas. He is a frequent speaker at academic conferences and has testified before Congress several times and also before the International Trade Commission on intellectual property issues. He received his B.A. and J.D. from Yale University.

Graeme B. Dinwoodie is the Professor of Intellectual Property and Information Technology Law at the University of Oxford, Director of the Oxford Intellectual Property Research Centre, and a Professorial Fellow of St. Peter's College. Prior to his appointment to the IP Chair at Oxford in 2009, Professor Dinwoodie was a Professor of Law at the Chicago-Kent College of Law. He has also previously taught at the University of Cincinnati College of Law and the University of Pennsylvania School of Law, and from 2005–2009 held a Chair in Intellectual Property Law at Queen Mary College, University of London. He is the author of several casebooks and numerous articles on various aspects of intellectual property law. Professor Dinwoodie holds an LL.B. degree from the University of Glasgow, an LL.M. from Harvard Law School (where he was a Kennedy Scholar), and a J.S.D. from Columbia Law School (where he was a Burton Fellow). He was elected to membership in the American Law Institute in 2003, and is currently the President of the International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP). In 2008, the International Trademark Association awarded Professor Dinwoodie the Pattishall Medal for Teaching Excellence in Trademark Law.

Christine Haight Farley is a Professor of Law at American University Washington College of Law, where she teaches Intellectual Property Law, Trademark Law, International and Comparative Trademark Law, International Intellectual Property Law and Art Law. Professor Farley served as Associate Dean for Faculty and Academic Affairs from 2007 to 2011 and as Co-Director of the Program on Information Justice and Intellectual Property from 2005 to 2009. Professor Farley has taught at the University of Puerto Rico, the University of Paris Ouest, and at Monash University in Prato, Italy. In addition, she has lectured on intellectual property law in Australia, Canada, Columbia, Cuba, France, Italy, Jordan, Korea, Mongolia, Namibia, Panama, Peru, Portugal, Russia, Scotland, Switzerland and Turkey. Before teaching, Professor Farley was an associate specializing in intellectual property litigation with Rabinowitz, Boudin, Standard, Krinsky & Lieberman in New York. She received a B.A. from Binghamton University, a J.D. from University at Buffalo Law School, and an LL.M. and J.S.D. from Columbia Law School.

Leah Chan Grinvald is an Associate Professor of Law at Suffolk University Law School. She received her B.A. in East Asian Studies, *summa cum laude*, from the George Washington University. She later obtained a J.D. from the New York University School of Law, where she served as the Articles and Notes Editor for the *Journal of International Law & Politics*. She served as a law clerk for the Honorable Frank Sullivan, Jr. in the Indiana State Supreme Court. Before joining the faculty at Suffolk Law School, Professor Grinvald was an Assistant Professor at Saint Louis University School of Law. Professor Grinvald teaches courses in Contracts, Secured Transactions, Intellectual Property Survey, Trademark, and International Intellectual Property. Her research focuses on domestic and international enforcement of intellectual property laws. Prior to entering academia, Professor Grinvald served as global corporate counsel at Taylor Made Golf Company, Inc. She advised on a variety of legal issues including trademark, copyright, contract and employment law arising within Taylor Made and its affiliated entities located outside of the United States. Before Taylor Made, Professor Grinvald was a corporate associate with Latham & Watkins LLP and Clifford Chance US LLP.

Mary LaFrance is the IGT Professor of Intellectual Property Law at the William S. Boyd School of Law, University of Nevada, Las Vegas, where she has taught since 1999. She previously taught at Florida State University, in both the College of Law and the School of Motion Pictures, Television, and Recording Arts. Professor LaFrance is a *summa cum laude* graduate of Bryn Mawr College. She received her J.D. with

High Honors from the Duke University School of Law, where she served as Executive Editor of the *Duke Law Journal*. She simultaneously earned her M.A. in Philosophy from the Duke University School of Graduate Studies. Prior to teaching, she clerked for Judge Harry T. Edwards of the United States Court of Appeals for the D.C. Circuit, and practiced law for three years with the Washington, D.C. office of Fried, Frank, Harris, Shriver & Jacobson. Professor LaFrance has authored or co-authored five books, including *Intellectual Property Cases and Materials*, *Understanding Trademark Law*, *Understanding Intellectual Property Law*, *Global Issues in Copyright Law*, and *Copyright Law in a Nutshell*. Her articles have been published in numerous law reviews, including the *Southern California Law Review*, the *Vanderbilt Law Review*, and the *Emory Law Journal*.

Marshall A. Leaffer is Distinguished Scholar in Intellectual Property Law and University Fellow, Indiana University Maurer School of Law. He received his J.D. at the University of Texas and his LL.M. in Trade Regulation at New York University Law School. Leaffer teaches Copyright Law, Trademark Law, Intellectual Property Survey, and International Intellectual Property. He is the author of three books and numerous articles, including the best-selling treatise *Understanding Copyright Law*, now in its fifth edition. Leaffer is also the author of *Copyright Law: Cases and Materials*, 9th edition and *International Treaties on Intellectual Property*, 2nd edition. His current research focuses on the interplay of intellectual property law in a global marketplace. Before becoming a full-time teacher, he practiced trademark law with American Home Products Corp. and the firm of Haseltine Lake & Waters in New York. He also has served as attorney-advisor to the U.S. Patent and Trademark Office and the U.S. Copyright Office. He currently serves on the international executive committee of the Association Littéraire et Artistique Internationale, a non-governmental institution based in Paris that promotes the rights of authors worldwide.

Edward Lee is a Professor of Law and the Director of the Program in Intellectual Property Law at IIT Chicago-Kent College of Law. Professor Lee's research focuses on the ways in which the Internet, technological development, and globalization challenge existing legal paradigms. He also writes extensively about the intersection between free speech and intellectual property law, including the Framers' understanding of the Free Press Clause as a limit on using the Copyright Clause to restrict technologies. In addition to numerous articles, he co-authored a leading casebook with Daniel Chow titled *International Intellectual Property: Problems, Cases, and Materials* (West Group). Professor Lee is a *cum*

laude graduate of Harvard Law School, where he was an editor and co-chair of the books and commentaries office of the *Harvard Law Review*. In 1992, he graduated Phi Beta Kappa and *summa cum laude* from Williams College with a bachelor's degree in philosophy (highest honors) and classics.

Jacqueline Lipton is the Baker Botts Professor of Law and Co-Director of the Institute for Intellectual Property and Information Law at the University of Houston Law Center. Prior to her academic work, she practiced as an attorney in the banking and finance area in several Australian commercial law firms as well as a brief stint as a member of the in-house counsel team at a major Australian bank. Her scholarship focuses on law and digital technology, as well as law and the creative arts, each with an international/comparative slant. She is the co-author of multiple editions of a leading cyberspace casebook *Cyberspace Law: Cases and Materials* (with Professor Raymond S.R. Ku) as well as sole author of *Internet Domain Names, Trademarks and Free Speech* (Edward Elgar, 2010) and *Security Over Intangible Property* (LBC Thompson, 2000). She has published in leading law reviews in the United States, Europe and Australia, including the *Northwestern University Law Review*, *Boston College Law Review*, *Washington University Law Review*, *Hastings Law Journal*, *UC Davis Law Review*, *Washington and Lee Law Review*, *Iowa Law Review*, *Harvard Journal of Law and Technology*, and *Berkeley Technology Law Journal*.

Lee Ann W. Lockridge teaches and writes in the area of intellectual property. Her courses include Introduction to Intellectual Property, International Intellectual Property, Advanced Trademark and Unfair Competition Law, Advanced Copyright Law, and Advertising Law. She is the co-author of a West casebook, *Intellectual Property: Cases and Materials* (4th edition 2012), and has authored law review articles on U.S. and international trademark and copyright law and on the intersection of both copyright and trademark rights with the First Amendment right of free speech. Professor Lockridge was elected to membership in the American Law Institute in 2012. Professor Lockridge graduated *summa cum laude* from Southwestern University, earning a B.A. in chemistry. She is a *magna cum laude* graduate of the Duke University School of Law, where she was a member of the Order of the Coif. She served as a judicial clerk to the Honorable Eugene E. Siler, Jr., of the United States Court of Appeals for the Sixth Circuit. Professor Lockridge is admitted to practice before the United States Patent and Trademark Office as well as in the state of Texas.

Doris Estelle Long is a Professor of Law and Director of the Center for Intellectual Property Law at the John Marshall Law School in Chicago, Illinois. She specializes in international intellectual property law, lecturing throughout the United States and in over 30 countries on five continents. She has taught in nine countries, including serving as a Fulbright Professor at Jiao Tung University in Shanghai, and as a Visiting Professor at Michigan State University School of Law. In 2000, she served as an attorney advisor in the Office of Legislative and International Affairs of the U.S. Patent and Trademark Office. She is the author of numerous books and articles and a monthly columnist on international intellectual property law for the *Chicago Daily Law Bulletin*. Before joining the John Marshall Law School, Professor Long was an attorney with the Washington, D.C. law firms of Arent Fox Kintner Plotkin & Kahn, and Howrey and Simon, specializing in the areas of intellectual property, unfair competition, and antitrust law. She is a graduate of Ithaca College, B.A. *summa cum laude*, Cornell Law School, J.D., *cum laude*, and holds an Executive Education Certificate from the Kennedy School of Government/Harvard University in Science, Technology and Innovation Policy.

Pierre-Emmanuel Moyse is an Intellectual Property Law Professor at the Faculty of Law at McGill University and the Director of the Center for Intellectual Property Policy. He is also responsible for the joint MBA-Law program in partnership with the Desautels Faculty of Management. Professor Moyse wrote his doctoral thesis on the law of distribution in copyright law (University of Montréal, published 2007) under the direction of Professor Ysolde Gendreau. Prior to joining McGill in 2007, he taught at both the University of Montréal and HEC Montréal. He is frequently called as an expert in litigation. He successfully argued the case of *Euro-Excellence v. Kraft Canada* in front of the Supreme Court of Canada in 2007, one of the most important recent intellectual property decisions. Professor Moyse currently directs research and conferences on the theme of “Competition Law and Innovation,” an initiative which he launched in 2007. A prolific author, he is the director of publication of the Innovation and Competition series published by Les Éditions Thémis, and also the editorial consultant and one of the authors for the encyclopaedic work on Intellectual Property by JurisClasseur Québec/LexisNexis (2013).

Mary Wong joined the Internet Corporation for Assigned Names & Numbers (ICANN) in July 2013 as a Senior Policy Director. Up to June 2013 she was a Professor of Law and the Faculty Chair for Global

Intellectual Property (IP) Partnerships at the University of New Hampshire School of Law. She was also the founding Director of the law school's flagship applied research center, the Franklin Pierce Center for IP, and has been Special Counsel to a major international law firm in its New York and Brussels offices. As an academic, Mary was already involved in policy development work at ICANN, including on its new gTLD program, serving two terms as an elected member of ICANN's GNSO Council, which approved and manages the policies that apply to the new gTLD program. She was also appointed by ICANN's Nominating Committee to the ccNSO Council, which manages domain name policies in the country code namespace. Her research interests center on the international policy aspects of IP, in particular, the challenges posed by Internet and digital technology.

Peter K. Yu holds the Kern Family Chair in Intellectual Property Law and is the founding director of the Intellectual Property Law Center at Drake University Law School. He has served as Wenlan Scholar Chair Professor at Zhongnan University of Economics and Law in Wuhan, China and a visiting Professor of Law at the University of Haifa, the University of Hong Kong, the University of Strasbourg, and Washington and Lee University. Born and raised in Hong Kong, Professor Yu is a leading expert in international intellectual property and communications law. A prolific scholar and an award-winning teacher, he is the author or editor of five books and more than 100 law review articles and book chapters. He serves as the general editor of *The WIPO Journal* published by the World Intellectual Property Organization (WIPO). Professor Yu has spoken at events organized by WIPO, the International Telecommunication Union, the U.N. Conference on Trade and Development (UNCTAD), the U.N. Educational, Scientific and Cultural Organization (UNESCO), the Chinese, U.S. and EU governments and at leading research institutions from around the world. His lectures and presentations have spanned more than 25 countries on six continents, and his publications have appeared in Chinese and English and have been translated into Arabic, French, Japanese, Persian, Portuguese, Spanish, and Vietnamese.

Daphne Zografos Johnsson is a Legal Officer in the Traditional Knowledge Division at the World Intellectual Property Organization (WIPO). Prior to joining WIPO, she was a Lecturer and Course Director in Intellectual Property Law at the University of Reading, a Visiting Lecturer at Queen Mary, University of London, and a Visiting Research Fellow at King's College, University of London. Daphne holds a Ph.D. from Queen Mary, and an LL.M. in Intellectual Property Law from

University College London. Her research interests lie in the fields of intellectual property, traditional knowledge and genetic resources, as well as the use of intellectual property rights to support socio-economic development.

Foreword

When I teach courses in international intellectual property law, I often start by suggesting that much of the content that we will cover can be understood as an attempt to solve the problem of territoriality – both territoriality as a legal (political) concept, and territoriality as the dominant defining unit of social and commercial ordering. Understanding why *international* intellectual property law (apparently) paradoxically embraces a commitment to this foundational principle is crucial to an appreciation of the proper roles of international and local systems in regulating the creative and commercial environment. As the social power of territoriality comes under pressure from global trade and online activity, it might be tempting to jettison the legal principle entirely rather than to work out how to harness its enduring benefits in a contemporary context. But casting territoriality aside would be too simplistic a solution. Many of the contributions to the volume illustrate nicely the continuing importance of national autonomy, of difference and differentiation, of elevating local values in an increasingly global time. And others demonstrate the practical and political difficulties of substituting universal norms in place of what we now have. But that does not make this a conservative tome. It is very far from that. All the contributions recognise, and grapple with, the reality that intellectual property scholars must reconsider the normative and practical claims of territoriality in light of changing circumstances. But that reconsideration might sometimes lead us to reaffirm historical commitments and redouble efforts to preserve what powerful social and political forces might imperil. On other occasions, it results in acknowledgment that new institutions or new rules must be shaped to make it possible for intellectual property law to serve its core purposes. This is a subtlety that can be found throughout this volume; it is what makes international intellectual property law complex, and work like this vital.

The volume takes trademark law as its particular focus. The questions raised by territoriality pervade intellectual property law, but they are especially acute in the field of trademarks. Trademarks, as vessels for consumer understanding, have an inherently spatial dimension that reflects patterns of social and commercial exchange. Yet, the online world

that renders borders porous and physical place less dominant is trademark-intensive. Thus, as the title to this book suggests, the global economy is a huge challenge to territoriality of marks. The magnitude of that challenge, however, may only inspire harder thought and greater readiness for innovation. The editors are to be commended for bringing together such a varied and thoughtful collection of contributions, all of which vigorously accept the challenge that this environment presents. The result is a thoroughly informative and thought-provoking read.

Graeme B. Dinwoodie
June 2013, Oxford

Acknowledgments

We would like to thank the many people who have participated in the realization of this volume with their academic prowess and in many other ways. In particular, we want to express our gratitude to our colleagues, all distinguished scholars, who contributed to the volume. We are honoured by their contributions and generosity in accepting our invitation to participate in this project despite their busy schedules and many competing commitments. Without exception, all contributors met the production deadlines promptly and ensured that the materials addressed in the chapters were both timely and followed the general theme of the volume. We have learned a tremendous amount from all our contributors, and we hope that this volume, now in print, makes them as proud as we are to have had the privilege of coordinating this project.

Special thanks are due to Graeme Austin for writing an introductory chapter and comprehensively setting the stage for the other distinguished contributions to this project. Likewise, we are sincerely indebted to Graeme Dinwoodie for writing the foreword and, more generally, for inspiring us in pursuing the idea of a collective volume on this topic. We also thank our publisher Edward Elgar, and Peter Yu, the editor of the *Intellectual Property and Global Development Series*, for believing in this project and agreeing to publish it. Chloe Mitchell, Tara Gorvine, Alison Hornbeck, and the editing team of Elgar worked hard and with unquestionable professionalism in order to make this volume a reality. Additional thanks go to Heather Stutz and Kevin Wleklinski, who provided excellent assistance during the editing process of the manuscript before the submission of the final draft to the publisher.

We dedicate this volume to our contributors and to all other colleagues in the intellectual property world who conduct research in the area of international intellectual property. Regardless of their “territoriality” – nationalities, languages, and academic affiliations – these scholars have long recognized the need to address transnational, comparative, and ultimately global issues in their works. Almost without exception, these scholars are open minded and very generous in sharing their ideas and insights with other academics, and in general. They have undoubtedly made this field very welcoming and exciting. We thank them for their

generosity, and we refer to them as a guiding example for all academics researching and teaching in the area of intellectual property law.

Irene Calboli and Edward Lee
June 2013, Singapore and Chicago