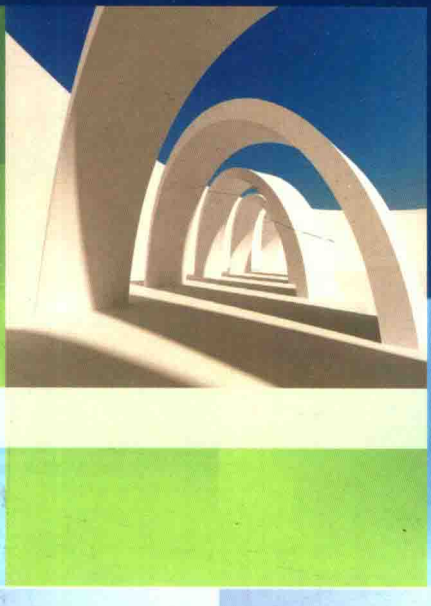
Edited by
GRAEME B. DINWOODIE

Methods and Perspectives in Intellectual Property



ATRIP Intellectual Property Series

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Methods and Perspectives in Intellectual Property

ATRIP INTELLECTUAL PROPERTY SERIES

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Edited by Graeme B. Dinwoodie

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Contents

PART I

Comparative law

1. The role of comparative legal analysis in intellectual property law: From good to great?

Irene Calboli*

1. INTRODUCTION

It is certainly old news that we live in a globally interconnected world where we can reach friends and colleagues around the planet with the touch of a computer key. We can access all types of information, including legislation, case law, and academic scholarship from anywhere and in multiple formats. This ability to interconnect, or more precisely to "Internet-connect," has reached unprecedented levels in recent years. We can now participate in meetings and conferences remotely, and watch events that we could not attend in person at our convenience. Scholars can easily share their scholarship and works-in-progress with colleagues all over the world, and the possibility to follow and participate in academic, or any other type of debate has dramatically increased with the proliferation of blogs, virtual symposia, and other forms of multimedia.

Because of this increasing globalization and Internet connectivity, it would seem logical that comparative law would take an even more crucial role as part of the legal debate. The possibility to access relevant information via legal databases, research networks, and open access

* This Chapter was originally presented at the 31st Annual ATRIP Congress "Methods and Perspectives in Intellectual Property Law," Chicago-Kent College of Law, Chicago, United States, July 29–August 1, 2012. I thank the Congress organizers for the opportunity to address the topic of comparative legal methodology in intellectual property law as comparative legal analysis has been part of my professional journey since I was a law student at the University of Bologna. I also thank the Congress participants for useful conversation, comments, and suggestions before and after the presentation of this Chapter. Additional thanks are due to Heather Stutz for editorial and research assistance. The views expressed, and any mistakes, remain my own.

platforms, along with the increased ability to directly or virtually meet academics and legal experts around the world, undoubtedly facilitates the gathering of data and information about any specific topic in multiple jurisdictions. Somewhat surprisingly, however, the role of comparative law remains unclear, and the importance attributed to comparative legal analysis seems to vary across different countries and among legal scholars. For example, comparative legal analysis undoubtedly plays a relevant role as a research methodology in the majority of the Member States of the European Union – likely the result of the process of European integration – as well as in several other countries. Comparative legal analysis seems, however, a somewhat less frequently adopted research methodology in the United States.[1]

In this Chapter, I attempt to briefly analyze the role of comparative law and comparative legal analysis in the area of intellectual property law. Because the protection of intellectual property rights is inextricably connected to international trade, intellectual property law is one of the most internationally and regionally harmonized fields of law, and has been so since the late nineteenth century.[2] Comparative legal analysis has undoubtedly played an important role in this process of harmonization. Intellectual property scholars have traditionally engaged in comparative legal analysis in the areas related to intellectual property law across a variety of jurisdictions. Throughout their comparative scholarship, intellectual property scholars have facilitated the process of international and regional harmonization by clarifying the respective status of national laws, and at times by criticizing the desirability of the proposed international standards. Scholars have additionally engaged in comparative legal analysis to assess the consequences of the adoption of international standards into national laws. Still, despite the existing considerable tomes of comparative legal scholarship, the perceived importance attributed to comparative legal analysis seems to vary among legal scholars also in the area of intellectual property law similar to mainstream comparative law. This may be attributable to cultural or institutional differences among scholars in different countries, with scholars in the United States, for

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[1] *See* Colin B. Picker, *Comparative Legal Methodology and American Legal Culture: Obstacles and Opportunities*, 16 ROGER WILLIAMS U.L. REV. 86 (2011). *See also* David S. Clark, *The Modern Development of American Comparative Law: 1904–1945*, 55 AM. J. COMP. L. 587, 587–88, 613–14 (2007); Vivian Grosswald Curran, *Cultural Immersion, Difference and Categories in U.S. Comparative Law*, 46 AM. J. COMP. L. 43 (1998).

[2] *See infra* Part 3.

example, appearing to be less frequently engaged in legal comparison than scholars in other countries.[3]

This Chapter proceeds as follows. In Part 2, I provide a general overview of comparative law and of the methodology (or rather the controversy surrounding the methodologies) of comparative legal analysis. Such an overview is in order, as comparative law has traditionally been an area of controversy where debates range from the very recognition of comparative law as an independent legal discipline to the type of methodology that comparative legal analysis should follow. Based upon this premise, I elaborate, in Part 3, on the current role of comparative legal analysis in the specific area of intellectual property law. Due to the limited scope of this Chapter, my analysis is not exhaustive. Notably, I emphasize that comparative legal analysis seems to be already a research technique widely used by scholars in this field consistent with the long tradition of international harmonization of intellectual property law. I also note, however, that variation exists among intellectual property law scholars with respect to the importance of the role of comparative law and comparative legal analysis. More generally, I highlight the challenges that intellectual property law scholars face while conducting comparative legal analysis. These obstacles are the same obstacles that typically face comparative scholars in any field of legal study, and range from different theoretical frameworks to language barriers, cultural differences, and different national interests. Despite these recognized differences, however, I argue that such obstacles should not diminish the general benefits that comparative legal analysis can bring to the advancement of the study of intellectual property law (or any field of law) in *every* country. These benefits include a better understanding of foreign law, which can lead to more effective international harmonization, as well as a better understanding of national law, which can result in a more effective legal practice domestically.

In light of these benefits, I conclude the Chapter in Part 4 with a call to strengthen the role and perceived importance of comparative legal analysis in intellectual property law in those countries and by those

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[3] Scholars in the United States have nonetheless pioneered a variety of research methodologies, from law and economics to empirical studies, semiotic analysis of the law, etc. *See, e.g.*, WILLIAM M. LANDES & RICHARD A. POSNER, THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW (2003); William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265 (1987); Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 95 CAL. L. REV. 1581 (2006); Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621 (2004).

scholars that do not seem to engage in comparative legal analysis as frequently as they engage in other research methodologies. Although I advocate for a greater scholarly engagement in comparative legal analysis in this area, I do not advocate, however, for a compelled convergence in the scholarly interpretation of national intellectual property laws and policies. Rather, my intention is simply to emphasize the importance of the awareness of foreign legal systems, cases, and scholarship for all those who are conducting research in similar areas in their respective national jurisdictions. Such awareness is a desirable aspect of contemporary legal scholarship in any field because "[n]eglecting ... international and comparative law could vitiate the vitality, nimbleness, and effectiveness of [national] law or simply leave us without the best tools and insights as we design and run institutions, pass legislation, and work to govern ourselves."[4] With respect to intellectual property law, a field wherein concerns over international trade and control of intellectual property rights in cyberspace dominate national and international legal developments, such awareness has become a necessary skill for scholars and other legal actors worldwide.

2. (A BRIEF) OVERVIEW OF COMPARATIVE LAW AND COMPARATIVE LEGAL ANALYSIS

Comparative law is, broadly defined, "the comparison of different legal systems of the world."[5] Generally, scholars or other legal actors (judges, lawyers, law-makers) who conduct comparative legal analysis compare the law of two or more legal systems with respect to a specific topic in any area of law – topics can range from constitutional law to criminal law, employment law, intellectual property law, and so forth. Often, the starting point of the comparison is the analysis of one or more foreign legal systems juxtaposed against the national legal systems of the

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[4] Martha Minow, *The Controversial Status of International and Comparative Law in the United States*, 52 HARV. INT'L L.J. ONLINE 1, 18 (2010), http://www.harvardilj.org/2010/08/online_52_minow/.

[5] KONRAD ZWEIGERT & HEIN KOTZ, AN INTRODUCTION TO COMPARATIVE LAW: THE FRAMEWORK 7 (1977). For a general overview and the academic debate in this area, *see* VIVIAN GROSSVALD CURRAN, COMPARATIVE LAW: AN INTRODUCTION (2002); THE OXFORD HANDBOOK OF COMPARATIVE LAW (Mathias Reimann & Reinhard Zimmermann eds., 2006).

scholars or legal actors conducting the comparison.[6] In some instances, the comparison exclusively involves the analysis and juxtaposition of two or more foreign systems without reference to the national jurisdiction of the comparative law scholars.[7] With respect to those areas of the world that, like the European Union, have undergone a considerable process of regional integration resulting in the creation of a supranational legal system, legal comparison frequently entails the analysis and juxtaposition of the legal system of one or more of the members of the region with the supranational legal system[8] – for example, comparing Italian or French law with European Union law on a certain topic.

While comparative legal analysis is routinely used in a large variety of contexts, scholars disagree, however, over whether comparative law has developed into an independent substantive field of law or whether it merely constitutes a "method" for comparing the laws of different countries.[9] As critics have pointed out, the main academic objection against the categorization of comparative law as an independent field of law rests on the fact that comparative law requires objects of comparison – different legal systems, legislation, cases, etc. – and does not directly rely on its own sets of written rules such as the equivalent of an internal code or a statute.[10] This criticism originates, in particular, from the civilian approach that generally "legitimizes legal discourse mostly through codes"[11] – compilations of written norms that prescribe a positive conduct and sanction the violators of this conduct. Still, even in the absence of an independent set of written norms, the study of

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[6] Edward J. Eberle, *The Methodology of Comparative Law*, 16 ROGER WILLIAMS U.L. REV. 51, 52 (2011).

[7] *Id.*

[8] Generally on the application of comparative legal analysis in the area of European law, *see* MARKKU KIIKERI, COMPARATIVE LEGAL REASONING AND EUROPEAN LAW (2001).

[9] *See, e.g.*, James Gordley, *Is Comparative Law a Distinct Discipline?*, 46 AM. J. COMP. L. 607, 611 (1998); Matthias Reimann, *The Progress and Failure of Comparative Law in the Second Half of the Twentieth Century*, 50 AM. J. COMP. L. 671 (2002).

[10] *See* Fabio Morosini, *Globalization and Law: Beyond Traditional Methodology of Comparative Legal Studies and an Example from Private International Law*, 13 CARDOZO J. INT'L & COMP. L. 541, 543–44 (2005), *citing* Rene David, LES GRANDS SYSTEMES DU DROIT CONTEPORAINS (DROIT COMPARÉ) 1 (1964).

[11] *Id.* at 544. For a comprehensive introduction to the civilian tradition, *see* JOHN HENRY MERRYMAN & ROGELIO PEREZ-PERDOMO, THE CIVIL LAW TRADITION (2007); REINHARD ZIMMERMAN, ROMAN LAW, CONTEMPORARY LAW, EUROPEAN LAW: THE CIVILIAN TRADITION TODAY (2001).

comparative law has generated much epistemological debate among scholars engaged in comparing different legal systems,[12] and this seems sufficient to define comparative law, at a minimum, as a legitimate and scientifically based model for comparative legal studies.[13]

Even though scholars disagree on the nature of comparative law – independent field of law or primarily a method for legal analysis – they nonetheless seem to agree on the main objectives of comparative law. Such objectives are: to investigate historical, philosophical, economic, social or other issues related to the law; to use this information to further understand scholars' respective legal systems (or additional systems); and to better understand both national law and foreign law, which may ultimately benefit the development of international law and international relations.[14] Scholars' positions on how to achieve these objectives, however, vary considerably[15] and much controversy has dominated the debate over what represents the appropriate technique to be followed while conducting comparative legal analysis. As some scholars have highlighted, this controversy essentially involves identifying "how high the cognitive bar [for an appropriate legal comparison should be] set."[16] Notably, it involves identifying whether the role of comparative law should be limited to comparing existing legal systems or whether comparative law ought to play a larger role in understanding public policy issues within national legal systems. In this respect, for example, scholars frequently disagree on whether comparative legal analysis should primarily (or exclusively) consider the written law of the countries

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[12] *See generally* EPISTEMOLOGY AND METHODOLOGY OF COMPARATIVE LAW (Mark Van Hoecke ed., 2004).

[13] Morosini, *supra* note 10, at 544.

[14] *See, e.g.,* Edward J. Eberle, *The Methodology of Comparative Law*, 16 ROGER WILLIAMS U.L. REV. 51, 53 (2011). *See also,* Nora V. Demleitner, *Combating Legal Ethnocentrism: Comparative Law Sets Boundaries*, 31 ARIZ. ST. L.J. 737 (1999).

[15] For a critical review of some of these objectives, *see* Vernon Valentine Palmer, *From Lerotholi to Lando: Some Examples of Comparative Law Methodology*, 53 AM. J. COMP. L. 261 (2005) [hereinafter *From Lerotholi to Lando*] (advocating against a single methodology for comparative law and for a sliding scale of options depending on the specific research). "Mainstream comparative lawyers … seem to be caught in the pincers of three developments, each pulling in a different direction." *Id.* at 263.

[16] *Id.* at 264. *See also* Hiram E. Chodosh, *Comparing Comparisons: In Search of Methodology*, 84 IOWA L. REV. 1025, 1066 (1999).