

INTERNATIONAL
INTELLECTUAL
PROPERTY LAW
CASES AND MATERIALS

THIRD EDITION

PAUL GOLDSTEIN
MARKETA TRIMBLE

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by

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To Jan and Lizzy

To Gary

PREFACE

Increasingly, the practice of intellectual property law has an international reach. A U.S. pharmaceutical company will time its patent disclosures with not only American grace periods in mind, but also foreign statutory bars. A French book publisher, if well-counselled, will accommodate its licensing arrangements to the different rules on rights and ownership that may obtain under foreign law. Trademark ownership acquired by use in the United States may lose out to trademark ownership acquired by registration abroad. Legislators must be alert to intellectual property treaty obligations, particularly since the 1994 TRIPs Agreement gave teeth to many of these obligations.

This book has two objectives. One is to equip law students with the tools they will need to engage in international intellectual property practice, whether transactional or litigation. The second is to expose the social, economic and cultural considerations that underpin intellectual property laws around the world. The division between developed and developing economies is doubtless the most salient source of conflict in contemporary policy discussions, but this book also explores the division between common law and civil law approaches to intellectual property protection.

Part I considers the private and public international law topics—territoriality, national treatment, choice of forum, choice of law, treaties and trade—that frame the substantive rules of intellectual property law. Part II considers the substantive rules themselves—copyright, patent, trademark, unfair competition, trade secrets and design protection—from the perspective of comparative law. Throughout, the text offers the viewpoint not only of the practitioner whose domestic client wants to obtain, license or enforce intellectual property rights abroad, but also the practitioner whose foreign client wants to obtain, license or enforce intellectual property rights in the practitioner's home country.

It would of course be impossible to capture the relevant details of all national intellectual property laws in a single volume. Nonetheless, a book this size can convey more than just the flavor of national practice around the world. The great bulk of intellectual property norms are in fact strikingly similar from country to country. (Even after the TRIPs Agreement, the United States continues to be the most notable maverick.) Applicable treaties and trade agreements have gone far toward establishing universal norms and, at least across developed economies, legislators have struck pretty much the same balances between the interests of producers and consumers of intellectual goods. Also, regional institutions such as the European Union have adopted common rules for large areas; EU directives and regulations, several of which are considered in these pages, have played

an important role in establishing intellectual property norms not only inside the European Union, but outside as well.

Academic perspective and practical insight animate international intellectual property law, and we are grateful for the guidance of friends and colleagues. John Duffy, Amalia Kessler, Mary LaFrance, Péter Mezei, Neil Netanel, Tyler Ochoa, Piet Jan Slot and Toshiko Takenaka provided helpful comments on all or portions of the book. Research assistants at Stanford Law School and the William S. Boyd School of Law at the University of Nevada, Las Vegas, devoted long hours to compiling bibliographies, checking references and proofreading manuscript. At Stanford we are grateful to Rey Barcelò, Simona Kiritsov Jankowski, Julia Martin, Corynne McSherry, Laura Nowell, Phil Poirier and David Walker. A bequest from the Clare and Michael Brown Estate supported their work. At the University of Nevada, Las Vegas, Melissa L. Flatley provided valuable research support. The book also benefited greatly from the services of the superb Stanford Law Library Information Services staff, especially Paul Lomio, Sonia Moss, Rachael Samberg, Sergio Stone and George Wilson, and of the University of Nevada Wiener–Rogers Law Library faculty, especially Jeanne Price and Jennifer Anderson.

Finally, we are indebted to Lynne Anderson for coordinating and typing the manuscript through its several drafts and for keeping the project on track with her incomparable energy, wit and good humor.

P.G.
M.T.

Stanford, California
Las Vegas, Nevada
February, 2012

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