

AMERICAN
CASEBOOK
SERIES

INTERNATIONAL INTELLECTUAL PROPERTY

PROBLEMS, CASES, AND MATERIALS

Second Edition



Daniel C.K. Chow
Edward Lee

WEST

INTERNATIONAL INTELLECTUAL PROPERTY

PROBLEMS, CASES, AND MATERIALS

Second Edition

■ ■ ■

By

Daniel C.K. Chow

Joseph S. Platt-Porter, Wright, Morris & Arthur

Professor of Law

The Ohio State University Michael E. Moritz College of Law

Edward Lee

Professor of Law

Illinois Institute of Technology, Chicago-Kent College of Law



AMERICAN CASEBOOK SERIES®

WEST®

A Thomson Reuters business

Thomson Reuters created this publication to provide you with accurate and authoritative information concerning the subject matter covered. However, this publication was not necessarily prepared by persons licensed to practice law in a particular jurisdiction. Thomson Reuters does not render legal or other professional advice, and this publication is not a substitute for the advice of an attorney. If you require legal or other expert advice, you should seek the services of a competent attorney or other professional.

American Casebook Series is a trademark registered in the U.S. Patent and Trademark Office.

© 2006 West, a Thomson business

© 2012 Thomson Reuters

610 Opperman Drive

St. Paul, MN 55123

1-800-313-9378

Printed in the United States of America

ISBN: 978-0-314-20762-3

To my wife Ching and our son Alan

—DC

To my parents, Douglas and Catalina Lee

—EL

PREFACE TO THE SECOND EDITION

We are gratified by the warm reception given to the first edition of this book by our students and colleagues. *International Intellectual Property: Problems, Cases, and Materials* grew out of our belief that international intellectual property had emerged as a vital field of study for any serious student of intellectual property and that there was a need for a student friendly casebook on this growing subject.

The second edition retains the organization and approach of the first. Each chapter has been substantially updated with new cases and developments, some in replacement of existing materials. We continue to provide ample author-written explanatory text, examples, and short problems all in a concise format that can be covered in a 2 or 3 credit class. The one major structural change is that the second edition now introduces the topic of exhaustion in the Introduction and discusses the topic in depth in Chapter 6, comparing the different approaches for copyrights, trademarks, and patents.

As in the first edition, the second edition contains many short problems. We have found the problems to be an excellent pedagogical tool and have received enthusiastic feedback about their effectiveness as a tool to stimulate class discussion. Many of the problems have been updated and new ones have been added.

We have avoided the tendency to produce a second edition that is substantially longer than the first. To that end, we have assiduously pruned outdated materials from the first edition. We have designed a book of a manageable length that can be covered in its entirety in a 3 credit course. Of course, covering the entire book will require going at a fast pace and many professors may wish to emphasize certain topics. The book is designed for flexibility of use and can accommodate many different approaches. Each chapter begins with materials on core concepts that are then followed by a series of “special discussion” topics. Professors can pick and choose among these topics as a focus of extended study or can choose to cover all or the bulk of them in a survey class.

This edition, like the first, can be used by students with many different levels of background in intellectual property, including students with no previous study. We have used this book ourselves with students for whom this is the first course in intellectual property.

Many thanks to Colleen Chien, Margaret Chon, Donald Harris, Paul Heald, Tomas Gomez-Arostegui, Shubha Ghosh, Manuel Kleinemenke, Janice Mueller, John Rothchild, and John Thomas for their generous comments and suggestions related to our casebook. We also recognize the generous support of our deans, Alan Michaels and Harold Krent.

We could not have completed this edition without the incredible and untiring assistance of Matt Cooper of the Moritz Law Library and Tom Gaylord of the IIT Chicago–Kent College of Law Library and Claire Alfus.

James Baldwin, Adam Colgrove, Alan Devries, and Michael Johnson provided excellent research assistance. James Baldwin, Daniel Bujas, Adam Colgrove, Daniel D’Addario, Amy Harvey, Karen Hwang, Melanie Kibbler, Kacy King, Roberto Martell Jr., Richard Martin, Renae Resch, Alex Sklut, Smita Sarkar, Laurence Tooth, James Vergara and Filip Zucek provided invaluable help in proofreading drafts of this casebook.

DANIEL CHOW

chow.1@osu.edu

EDWARD LEE

elee@kentlaw.edu

PREFACE TO THE FIRST EDITION

Just a decade ago, only a few law schools in the United States offered courses on International Intellectual Property (IP). Today, this has changed. Courses on International IP are now part of the mainstream law school curriculum, and the study of International IP has become essential for any serious student of IP. We have written this casebook in response to the growing need for teaching materials in this emerging area.

Our casebook is designed for use by law students of all different backgrounds, including students with no prior background in IP or in international law. The casebook contains ample amounts of our own introductory and explanatory material for these students. At the same time, students who have had prior courses in IP or in international law will find our background materials and textual explanations to be useful in helping to refresh or reinforce their previous studies. Indeed, we have successfully tested the casebook in our own classes with students of all backgrounds, including in an entire class of students who had just completed their first year. Based on our own experience, we believe that professors can use this casebook in a course on International IP without requiring any prior courses in IP or international law as prerequisites.

We have made special efforts to listen to the feedback of our students, in order to make the materials on this complicated subject more “student friendly.” To that end, as noted above, we have included our own explanatory text to introduce most topics we cover in the casebook. We have also added simple examples—called “Illustrations” in the casebook—to elucidate basic principles and treaty provisions, which can often be quite abstract in this area. In addition, we have included numerous problems—each of relatively short length—throughout the casebook as we have found that the use of problems works well to stimulate classroom discussion and also requires students to read the materials much as a lawyer would, with an eye to answering a legal question. We have found that having the students analyze relatively straightforward problems by applying treaty provisions, laws, and cases from the reading helps the students to obtain a much deeper understanding of these materials. Often, we have placed the problems *before* the reading materials to which they relate. Although some students and even professors may be unaccustomed to this practice, the overwhelmingly positive reaction of our students has confirmed to us the benefits of including problems before the relevant reading as a way to give students greater purpose in their reading and to hone their skills of applying legal rules and doctrines.

The casebook is designed for use in a three- or four-hour course. In a four-hour course, it should be possible to cover the bulk of the entire book at a

reasonable pace of 15 to 20 pages per class for a 50-minute class. In a three-hour course, professors should be able to cover most of the casebook at a pace that should not overly burden their students. However, it is unlikely that professors using the casebook for a three-hour course will be able to cover the entire text, so some decisions on coverage will likely need to be made. To assist professors in making decisions on coverage, we have designed the casebook to provide teaching flexibility. With the exception of Chapter 1, the introductory chapter, all of the chapters in the casebook are organized as follows: the chapters begin with basic topics that most professors will want to cover. Following and interspersed with these basic topics, we often include a number of optional topics under the heading of “Special Discussion.” These “Special Discussion” topics provide an in-depth treatment of current, cutting-edge topics that professors can pick and choose from in accordance with their interests and the interests of their students. We have designed the book so that professors can choose to cover or omit any of the “Special Discussion” topics without compromising on coverage of the fundamentals.

For ease of reading, we have *not* included, in most instances, any ellipses to indicate portions of text we omitted from our excerpts of articles and cases. We also have omitted most footnotes from the original sources; footnotes that we did include are numbered as they are in the original. For the most part, we have kept the spelling of words and the punctuation in foreign cases and materials as they are in the original, even though they may be different from standard U.S. conventions.

We hope that you find these materials as stimulating and as challenging as we do. We welcome your thoughts and suggestions for future editions.

DANIEL C.K. CHOW

EDWARD LEE

June, 2006
Columbus, Ohio

ACKNOWLEDGEMENTS TO THE FIRST EDITION

We are grateful for the support of Dean Nancy H. Rogers, Associate Dean Sharon L. Davies, Professor Albert L. Clovis, and Professor David Goldberger of The Ohio State University Michael E. Moritz College of Law. Without their support, the completion of this project would not have been possible.

We also received many insightful and useful comments on these materials from Cory M. Amron, Lionel Bently, Thomas T. Moga, John Okuley, Douglas L. Rogers, and Timothy P. Trainer.

Our students in our international intellectual property classes at the Moritz College of Law have, by their responses and suggestions, helped us to write and rewrite this book in a more student-friendly way. Christopher Thiemann provided us with the photograph of the Neem tree that he took while in India. Also, the following students provided us with excellent research assistance at different stages of this book's production: Matthew Allinson, Patrick Berarducci, Erin Barker Brown, William Browne, Nicholas Kamphaus, John Hui Li, Edward Olszewski, Ajay Patel, Joseph Popp, Steven Roach, Michelle Robinson, and Derek Somogy. We would like to single out Ronald Wadlinger, who provided outstanding research assistance from start to finish.

We could not have written this book without the extraordinary help of the reference librarians at the Michael E. Moritz Law Library. We would like to thank especially Katherine Hall and Rachael Smith for their invaluable and continual assistance throughout the entire process. Finally, we are indebted to our assistant, Jennifer Pursell, for her tireless help in the production of this casebook.

D.C.

E.L.

TABLE OF CASES

The principal cases are in bold type. Cases cited or discussed in the text are in roman type. References are to pages. Cases cited in principal cases and within other quoted materials are not included.

- Administration des Douanes et Droits Indirects v. Rioglass SA, Transremar SL**, [2003], ECR 00000, Case C-115/02 (October 23, 2003), **722**
- Alappat, In re, 33 F.3d 1526 (Fed.Cir.1994), 347
- American Ins. Ass'n v. Garamendi, 539 U.S. 396, 123 S.Ct. 2374, 156 L.Ed.2d 376 (2003), 76
- Asahi Metal Industry Co., Ltd. v. Superior Court of California, Solano County, 480 U.S. 102, 107 S.Ct. 1026, 94 L.Ed.2d 92 (1987), 728
- Association for Molecular Pathology v. United States Patent and Trademark Office**, 653 F.3d 1329 (Fed.Cir.2011), **325**
- Automobili Lamborghini Holding SpA's Community Trade Mark Application (R772/2001-1)**, 2003 WL 23841538 (OHIM (1st Bd App) 2003), **509**
- Babbitt Electronics, Inc. v. Dynascan Corp., 38 F.3d 1161 (11th Cir.1994), 450
- Barnes v. Miner, 122 F. 480 (C.C.S.D.N.Y. 1903), 180
- Bezpečnostní Software Asociace - Svaz Software Ochrany v. Ministerstvo Kultury (C-393/09), 2010 WL 5184929 (ECJ 2010), 132
- Bilski, In re, 545 F.3d 943 (Fed.Cir.2008), 336
- Bilski v. Kappos**, ___ U.S. ___, 130 S.Ct. 3218, 177 L.Ed.2d 792 (2010), **337**
- British Horseracing Board Ltd v. William Hill Organisation Ltd (C-203/02)**, 2004 WL 2709083 (ECJ 2004), **150**
- Bronco Wine Co. v. Jolly, 17 Cal.Rptr.3d 180, 95 P.3d 422 (Cal.2004), 593
- Bruce Springsteen v. Jeff Burgar and Bruce Springsteen Club**, Case No. D2000-1532 (January 25, 2001), **616**
- Bruce Springsteen and His Band**, Case No. I ZR 205/95 (Apr. 23, 1998), **122**
- Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 114 S.Ct. 1164, 127 L.Ed.2d 500 (1994), 186
- Canada-Patent Protection of Pharmaceutical Products**, WT/DS 114/R (March 17, 2000), **407**
- CCH Canadian Ltd. v. Law Society of Upper Canada (S.C.C.2004), 137
- Collins v. Imtrat Handelsgesellschaft mbH (C-92/92), 1993 WL 965326 (ECJ 1993), 210
- Collins v. Imtrat Handelsgesellschaft mbH (C-92/92)**, 1993 WL 1298249 (ECJ 1993), **32**
- Compagnie Generale Maritime, In re, 993 F.2d 841 (Fed.Cir.1993), 458
- Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234, 84 S.Ct. 779, 11 L.Ed.2d 669 (1964), 634
- Consorzio del Prosciutto di Parma v. Asda Stores Ltd (C-108/01)**, 2003 WL 100986 (ECJ 2003), **577**
- Costco Wholesale Corp. v. Omega, S.A., ___ U.S. ___, 131 S.Ct. 565, 178 L.Ed.2d 470 (2010), 759
- Crocker National Bank v. Canadian Imperial Bank of Commerce, 1984 WL 63595 (Trademark Tr. & App. Bd.1984), 458
- CyberSource Corp. v. Retail Decisions, Inc., 654 F.3d 1366 (Fed.Cir.2011), 348
- Dam Things from Denmark, a/k/a Troll Company ApS, v. Russ Berrie & Company, Inc.**, 290 F.3d 548 (3rd Cir.2002), **107**
- Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23, 123 S.Ct. 2041, 156 L.Ed.2d 18 (2003), 230
- Dawn Donut Co. v. Hart's Food Stores, Inc., 267 F.2d 358 (2nd Cir.1959), 492
- Devils Films, Inc. v. Nectar Video, 29 F.Supp.2d 174 (S.D.N.Y.1998), 180
- DHL Express France SAS v. Chronopost SA (C-235/09)**, 2011 WL 1363807 (ECJ 2011), **482**
- Diamond v. Chakrabarty, 447 U.S. 303, 100 S.Ct. 2204, 65 L.Ed.2d 144 (1980), 79, 321
- Diamond v. Diehr, 450 U.S. 175, 101 S.Ct. 1048, 67 L.Ed.2d 155 (1981), 336, 347
- Eli Lilly & Co. v. Natural Answers, Inc., 233 F.3d 456 (7th Cir.2000), 570
- Empresa Cubana del Tabaco v. Culbro Corp.**, 399 F.3d 462 (2nd Cir.2005), **535**
- Empresa Cubana del Tabaco v. Culbro Corp., 2004 WL 602295 (S.D.N.Y.2004), 540

- Empresa Cubana Exportadora de Alimentos y Productos Varios v. United States Dept. of Treasury, 638 F.3d 794, 395 U.S.App.D.C. 19 (D.C.Cir.2011), 41
- Enzo Biochem, Inc. v. Gen-Probe Inc., 323 F.3d 956 (Fed.Cir.2002), 388
- Ex Parte (see name of party)**
- Federal Republic of Germany and the Kingdom of Denmark v. Commission of the European Communities**, [2005] ECR I-9178, C-465/02 (October 25, 2005), 584
- Feist Publications, Inc. v. Rural Telephone Service Co., Inc.**, 499 U.S. 340, 111 S.Ct. 1282, 113 L.Ed.2d 358 (1991), 78, 133
- Foster v. Neilson, 27 U.S. 253, 2 Pet. 253, 7 L.Ed. 415 (1829), 29
- Fox Film Corp. v. Doyal, 286 U.S. 123, 52 S.Ct. 546, 76 L.Ed. 1010 (1932), 90
- Frazer v. Schlegel**, 498 F.3d 1283 (Fed.Cir. 2007), 293
- Fuji Photo Film Co., Ltd. v. Jazz Photo Corp., 394 F.3d 1368 (Fed.Cir.2005), 775
- General Motors Corp. v. Lopez de Arrior-tua**, 948 F.Supp. 684 (E.D.Mich.1996), 638
- General Motors Corp v. Yplon SA (C-375/97), 1999 WL 1071290 (ECJ 1999), 549
- Gesellschaft für Antriebstechnik mbH & Co KG (GAT) v. Lamellen und Kupplungsbau Beteiligungs KG (LuK) (C-4/03), 2006 WL 1911374 (ECJ 2006), 736
- Gilliam v. American Broadcasting Companies, Inc.**, 538 F.2d 14 (2nd Cir.1976), 223
- Golan v. Gonzales, 501 F.3d 1179 (10th Cir. 2007), 113
- Golan v. Holder, — U.S. —, 132 S.Ct. 873, 181 L.Ed.2d 835 (2012), 114
- Golan v. Holder, 611 F.Supp.2d 1165 (D.Colo. 2009), 114
- Google France Sarl v. Louis Vuitton Malletier SA (C-236/08)**, 2010 WL 1030379 (ECJ 2010), 244, 551
- Grupo Gigante SA De CV v. Dallo & Co., Inc., 391 F.3d 1088 (9th Cir.2004), 540
- Hall, In re, 781 F.2d 897 (Fed.Cir.1986), 360
- Hanson v. Denckla, 357 U.S. 235, 78 S.Ct. 1228, 2 L.Ed.2d 1283 (1958), 728
- Harvard College v. Canada (Commissioner of Patents)**, S.C.C.2002, 315
- Hitachi, Ltd.**, T 0258/03-3.5.1 (Apr. 21, 2004), 342
- Huston v. Société Turner Entertainment**, 1991 Bull. Civ. I, No. 172 (May 28, 1991), 214
- IHT Internationale Heiztechnik GmbH v. Ideal Standard GmbH**, [1994] ECR I-2789, Case C-9/93 (June 22, 1994), 746
- Infopaq International A/S v. Danske Dagblades Forening**, Case C-302/10 (2010/C 221/49), 180
- In re (see name of party)**
- Intel Corp. Inc. v. CPM United Kingdom Ltd (C-252/07), 2008 WL 2519763 (ECJ 2008), 549
- Interflora Inc. v. Marks & Spencer Plc (C-323/09)**, 2011 WL 4388782 (ECJ 2011), 557
- International Cafe, S.A.L. v. Hard Rock Cafe Intern. (U.S.A.), Inc., 252 F.3d 1274 (11th Cir.2001), 644
- International Shoe Co. v. State of Wash., Office of Unemployment Compensation and Placement, 326 U.S. 310, 66 S.Ct. 154, 90 L.Ed. 95 (1945), 728
- Itar-Tass Russian News Agency v. Russian Kurier, 1997 WL 109481 (S.D.N.Y.1997), 49
- Itar-Tass Russian News Agency v. Russian Kurier, Inc.**, 153 F.3d 82 (2nd Cir. 1998), 43
- Jartech, Inc. v. Clancy, 666 F.2d 403 (9th Cir. 1982), 180
- Jazz Photo Corp. v. International Trade Com'n**, 264 F.3d 1094 (Fed.Cir.2001), 772
- J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred Intern., Inc., 534 U.S. 124, 122 S.Ct. 593, 151 L.Ed.2d 508 (2001), 323
- John Wiley & Sons, Inc. v. Kirtsaeng, 654 F.3d 210 (2nd Cir.2011), 767
- Kelly v. Arriba Soft Corp., 336 F.3d 811 (9th Cir.2003), 174, 186
- Kemart Corp. v. Printing Arts Research Lab., Inc., 269 F.2d 375 (9th Cir.1959), 643
- K Mart Corp. v. Cartier, Inc.**, 486 U.S. 281, 108 S.Ct. 1811, 100 L.Ed.2d 313 (1988), 751
- Koninklijke Philips Electronics NV v. Remington Consumer Products Ltd (C-299/99)**, ECJ 2002, 498
- KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.**, 543 U.S. 111, 125 S.Ct. 542, 160 L.Ed.2d 440 (2004), 566
- KSR Intern. Co. v. Teleflex Inc.**, 550 U.S. 398, 127 S.Ct. 1727, 167 L.Ed.2d 705 (2007), 377
- L'Aiglon Apparel v. Lana Lobell, Inc., 214 F.2d 649 (3rd Cir.1954), 644
- Laserdisken APS v. Kulturministeriet, Case C-479/04 (Sept. 12, 2006), 759
- Lever Bros. Co. v. United States**, 981 F.2d 1330, 299 U.S.App.D.C. 128 (D.C.Cir.1993), 755
- Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.**, 633 F.3d 1158 (9th Cir.2011), 544
- Libertel Groep BV v. Benelux-Merkenbureau (C-104/01), 2003 WL 100846 (ECJ 2003), 507
- London Film Productions Ltd. v. International Communications, Inc.**, 580 F.Supp. 47 (S.D.N.Y.1984), 729
- Loral Fairchild Corp. v. Matsushita Elec., 266 F.3d 1358 (Fed.Cir.2001), 297
- L'Oreal SA v. Bellure NV**, 2010 WL 1990595 (CA (Civ Div) 2010), 629
- L'Oreal SA v. Bellure NV (C-487/07), 2009 WL 321141 (ECJ 2009), 549

- Los Angeles News Service v. Reuters Television Intern. (USA) Ltd., 340 F.3d 926 (9th Cir.2003), 406
- Madey v. Duke University, 307 F.3d 1351 (Fed. Cir.2002), 417
- Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"**, WIPO Case No. D2000-0847 October 12, 2000), 611
- Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894 (9th Cir.2002), 570
- McDonald's Corp. v. Joburgers Drive-Inn Restaurant (Pty) Ltd.**, 1997 South African Reports 1, Appellate Division, Case No. 547/95 1996, 529
- Merck & Co Inc v. Primecrown Ltd (C267/95)**, 1996 WL 1571754 (ECJ 1996), 769
- Microsoft Corp. v. AT & T Corp., 550 U.S. 437, 127 S.Ct. 1746, 167 L.Ed.2d 737 (2007), 406
- Milpururru v. Indofurn Pty Ltd**, 1994 WL 1658894 (FCA 1994), 158
- Mitchell Bros. Film Group v. Cinema Adult Theater, 604 F.2d 852 (5th Cir.1979), 180
- Moba, B.V. v. Diamond Automation, Inc., 325 F.3d 1306 (Fed.Cir.2003), 388
- Monsanto Canada Inc. v. Schmeiser (S.C.C. 2004), 322
- Monsanto Technology LLC v. Cefetra BV (C-428/08)**, 2010 WL 2667396 (ECJ 2010), 331
- Nakamura v. Nichia Kagaku Kōgyō K.K.**, Toyko District Court (Jan. 30, 2004), 306
- Network Automation, Inc. v. Advanced Systems Concepts, Inc., 638 F.3d 1137 (9th Cir.2011), 556
- New Kids on the Block v. News America Pub., Inc., 971 F.2d 302 (9th Cir.1992), 570
- Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v. BORCO-Marken-Import Matthiesen GmbH & Co KG (C-265/09 P)**, 2010 WL 3501989 (ECJ 2010), 493
- Omega S.A. v. Costco Wholesale Corp.**, 541 F.3d 982 (9th Cir.2008), 26, 764
- Otokoyama Co. Ltd. v. Wine of Japan Import, Inc.**, 175 F.3d 266 (2nd Cir.1999), 515
- Padawan SL v. Sociedad General de Autores y Editores de Espana (SGAE) (C-467/08)**, 2010 WL 4116866 (ECJ 2010), 199
- Parfums Givenchy, Inc. v. Drug Emporium, Inc., 38 F.3d 477 (9th Cir.1994), 768
- Pellegrini v. Analog Devices, Inc.**, 375 F.3d 1113 (Fed.Cir.2004), 402
- Pernod Ricard USA, LLC v. Bacardi U.S.A., Inc., 653 F.3d 241 (3rd Cir.2011), 41
- Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492 (2nd Cir.1961), 527
- Prouder, Ex Parte, 2010 WL 2727840 (Bd.Pat. App. & Interf.2010), 348
- Qualitex Co. v. Jacobson Products Co., Inc., 514 U.S. 159, 115 S.Ct. 1300, 131 L.Ed.2d 248 (1995), 507, 509
- Quality King Distributors, Inc. v. L'anza Research Intern., Inc.**, 523 U.S. 135, 118 S.Ct. 1125, 140 L.Ed.2d 254 (1998), 760
- Quanta Computer, Inc. v. LG Electronics, Inc., 553 U.S. 617, 128 S.Ct. 2109, 170 L.Ed.2d 996 (2008), 776
- Regents of the University of California v. Eli Lilly & Co., 119 F.3d 1559 (Fed.Cir.1997), 388
- Rescuecom Corp. v. Google Inc., 562 F.3d 123 (2nd Cir.2009), 556
- Roadshow Films Pty Ltd and Others v. iiNet Ltd**, 2011 WL 2003366 (FCA 2011), 244
- Rosetta Stone Ltd. v. Google, Inc., 730 F.Supp.2d 531 (E.D.Va.2010), 556
- Ross Cosmetics Distribution Centers, Inc. v. United States**, 18 C.I.T. 979 (CIT 1994), 714
- Rotec Industries, Inc. v. Mitsubishi Corp., 215 F.3d 1246 (Fed.Cir.2000), 406
- Sabel BV v. Puma AG (C-251/95)**, 1997 WL 1105081 (ECJ 1997), 522
- Sandoz GmbH v. Roche Diagnostics (formerly Boehringer Mannheim GmbH)**, 2004 WL 1640390 (Ch D 2004), 381
- Sarl Louis Feraud Intern. v. Viewfinder, Inc.**, 489 F.3d 474 (2nd Cir.2007), 738
- SCM Corp. v. Langis Foods Ltd.**, 539 F.2d 196, 176 U.S.App.D.C. 194 (D.C.Cir.1976), 453
- Scotch Whisky Ass'n v. Majestic Distilling Co., Inc., 958 F.2d 594 (4th Cir.1992), 643
- Sega Enterprises Ltd. v. Accolade, Inc., 977 F.2d 1510 (9th Cir.1992), 186
- Shaw v. Cooper, 32 U.S. 292, 7 Pet. 292, 8 L.Ed. 689 (1833), 360
- Sheldon v. Metro-Goldwyn Pictures Corp., 106 F.2d 45 (2nd Cir.1939), 406
- Shield Mark BV v. Kist (t/a Memex) (C-283/01), 2003 WL 100628 (ECJ 2003), 508
- Sieckmann v. Deutsches Patent- und Markenamt (C-273/00) (ECJ 2002), 508
- Silhouette International Schmied GmbH & Co KG v. Hartlauer Handelsgesellschaft mbH (C-355/96), 1998 WL 1042949 (ECJ 1998), 751
- Sony Corp. of America v. Universal City Studios, Inc., 464 U.S. 417, 104 S.Ct. 774, 78 L.Ed.2d 574 (1984), 90, 186
- Star Industries, Inc. v. Bacardi & Co. Ltd., 412 F.3d 373 (2nd Cir.2005), 496
- State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368 (Fed. Cir.1998), 336
- Steele v. Bulova Watch Co., 344 U.S. 280, 73 S.Ct. 252, 97 L.Ed. 319 (1952), 23, 729
- Stichting de Thuiskopie v. Opus Supplies Deutschland GmbH (C-462/09), 2011 WL 2368177 (ECJ 2011), 202

- Storus Corp. v. Aroa Marketing, Inc., 2008 WL 449835 (N.D.Cal.2008), 556
- Studiengesellschaft Kohle mbH v. Eastman Kodak Co.**, 616 F.2d 1315 (5th Cir. 1980), **363**
- Subafilms, Ltd. v. MGM-Pathe Communications Co.**, 24 F.3d 1088 (9th Cir.1994), **18**
- Teets v. Chromalloy Gas Turbine Corp.**, 83 F.3d 403 (Fed.Cir.1996), **303**
- The Paquete Habana, 175 U.S. 677, 20 S.Ct. 290, 44 L.Ed. 320 (1900), 29
- 3M Company v. LMS Corp., 2010 Hu 2698 (2011), 386
- TianRui Group Co. Ltd. v. International Trade Com'n**, 661 F.3d 1322 (Fed.Cir. 2011), **657**
- Toho Co., Ltd. v. Sears, Roebuck & Co., 645 F.2d 788 (9th Cir.1981), 644
- TraFFix Devices, Inc. v. Marketing Displays, Inc.**, 532 U.S. 23, 121 S.Ct. 1255, 149 L.Ed.2d 164 (2001), **502**
- Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 95 S.Ct. 2040, 45 L.Ed.2d 84 (1975), 196
- Ultramercial, LLC v. Hulu, LLC, 657 F.3d 1323 (Fed.Cir.2011), 348
- United States v. _____ (see opposing party)**
- Universal City Studios, Inc. v. Corley**, 273 F.3d 429 (2nd Cir.2001), **233**
- Universal City Studios, Inc. v. Reimerdes, 111 F.Supp.2d 294 (S.D.N.Y.2000), 239
- University Of Rochester v. G.D. Searle & Co., Inc., 358 F.3d 916 (Fed.Cir.2004), 388
- Vanity Fair Mills, Inc. v. T. Eaton Co., 234 F.2d 633 (2nd Cir.1956), 643
- Vaudable v. Montmartre, Inc., 193 N.Y.S.2d 332 (N.Y.Sup.1959), 540
- Veeck v. Southern Bldg. Code Congress Intern., Inc., 293 F.3d 791 (5th Cir.2002), 144
- Vittoria North America, L.L.C. v. Euro-Asia Imports Inc.**, 278 F.3d 1076 (10th Cir.2001), **488**, 751
- Voda v. Cordis Corp.**, 476 F.3d 887 (Fed.Cir. 2007), **731**
- Watches, Watch Parts, Calculators & Misc. Parts, United States v., 692 F.Supp. 1317 (S.D.Fla.1988), 727
- Wheaton v. Peters, 33 U.S. 591, 8 Pet. 591, 8 L.Ed. 1055 (1834), 144
- Zatarains, Inc. v. Oak Grove Smokehouse, Inc., 698 F.2d 786 (5th Cir.1983), 569
- Zyla v. Wadsworth, Div. of Thomson Corp., 360 F.3d 243 (1st Cir.2004), 231

**INTERNATIONAL
INTELLECTUAL
PROPERTY
PROBLEMS, CASES, AND MATERIALS**

Second Edition

SUMMARY OF CONTENTS

	Page
PREFACE TO THE SECOND EDITION	v
PREFACE TO THE FIRST EDITION	vii
ACKNOWLEDGEMENTS TO THE FIRST EDITION	ix
TABLE OF CASES	xxv
 Chapter 1. Introduction	 1
A. Scope and Approach of Our Casebook	2
B. Why Has Intellectual Property Gone “International”?	4
C. The “System” of International Intellectual Property	16
D. International Legal Institutions	49
E. Recent Developments in International Intellectual Property	66
F. Brief Overview of U.S. Intellectual Property Laws	77
 Chapter 2. Copyright and Neighboring Rights	 84
A. Introduction	84
B. Foreign Nationals Acquiring Copyrights and Neighboring Rights	93
C. Subject Matter	129
D. Exclusive Rights of Copyright (Economic)	165
E. Exceptions to Exclusive Rights	184
F. Copyright Term and Neighboring Right Term	203
G. Moral Rights	213
H. Special Discussion: Anti-Circumvention Rights in the Digital Age	232
I. Special Discussion: ISP Duties, Safe Harbors, and Secondary Liability	241
 Chapter 3. Patents	 252
A. Introduction	252
B. Ownership and Formalities: Obtaining Domestic and Foreign Patents	275
C. Patent Requirements	313
D. Exclusive Rights	400
 Chapter 4. Trademarks and Geographical Indications	 441
A. Introduction	441
B. Trademarks	447
C. Geographical Indications	573
D. The Relationship Between Trademarks and Geographical Indications	601
E. Special Discussion: Internet Domain Names and Trademark Disputes	609

	Page
Chapter 5. Unfair Competition and Trade Secrets	623
A. Unfair Competition.....	623
B. Protection for Undisclosed Test Data for Pharmaceuticals and Agricultural Chemical Products	646
C. Transnational Lawsuits: Protecting Trade Secrets Internationally.....	656
Chapter 6. International Enforcement of Intellectual Property Rights	660
A. Introduction	660
B. Commercial Piracy.....	661
C. Enforcement Obligations Under TRIPS	694
D. Private Enforcement—Procedural and Substantive Concerns	727
E. Exhaustion of Rights and Gray Market Goods	742
INDEX.....	777

TABLE OF CONTENTS

	Page
PREFACE TO THE SECOND EDITION	v
PREFACE TO THE FIRST EDITION	vii
ACKNOWLEDGEMENTS TO THE FIRST EDITION	ix
TABLE OF CASES	xxv
Chapter 1. Introduction	1
A. Scope and Approach of Our Casebook	2
B. Why Has Intellectual Property Gone “International”?	4
1. Globalization, International Trade, and Multi-National Enterprises	4
2. Intellectual Property, Developing Countries, and Economic Development	11
<i>Problem 1-1</i>	11
<i>Notes and Questions</i>	15
C. The “System” of International Intellectual Property	16
1. The Principle of Territoriality in a TRIPS World	16
a. National IP Laws—Territorial in Scope	16
<i>Problem 1-2</i>	18
<i>Subafilms, Ltd. v. MGM-Pathe Communications Co.</i>	18
<i>Notes and Questions</i>	23
b. Territoriality and Exhaustion of Intellectual Property Rights	23
<i>Notes and Questions</i>	26
c. IP Treaties and the World of TRIPS	26
<i>Problem 1-3</i>	27
<i>Notes and Questions</i>	28
2. The Principle of National Treatment	30
<i>Problem 1-4</i>	30
<i>Phil Collins v. Imtrat Handelsgesellschaft GmbH</i>	32
<i>Notes and Questions</i>	35
3. The Most Favored Nation Principle	36
<i>Problem 1-5</i>	36
<i>United States—Section 211 Omnibus Appropriations Act of 1998</i>	37
<i>Notes and Questions</i>	40
4. Choice of Law in Transnational Disputes	42
<i>Itar-Tass Russian News Agency v. Russian Kurier, Inc.</i>	43
<i>Notes and Questions</i>	49
D. International Legal Institutions	49
1. The World Trade Organization	50
a. History and Evolution of the WTO From GATT	50
b. The General Structure of the WTO	53
<i>The World Trade Organization: Law, Practice and Policy</i>	53
c. WTO Monitoring and Enforcement of TRIPS	54