

PRIVATE INTELLECTUAL PROPERTY REGULATION  
IN PUBLIC INTERNATIONAL LAW

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ABSTRACT

*The aim of this article is to show how private rights, as understood within the context of intellectual property are no longer the domain of domestic regulation; rather, they are now within the purview of public international regulation. As such, private rights have now contributed to the “privatization” of public international law, where the interaction of applicable laws under domestic law shapes the interpretation and outcome of how public international law determines global economic relations. The article assesses the international regulatory domain of intellectual property rights under public international law instruments to show how intellectual property rights norms evolved as regulatory tools in the global economic system. The main question that this article addresses is whether contemporary expansion of intellectual property norms has globalised private rights, and if so, what role such developments play in shaping international intellectual property treaties. The article demonstrates that international intellectual property instruments emerged at the end of the nineteenth century and started the privatization revolution of public international law. I first examine the Paris and Berne Conventions in order to understand their role in the globalisation of norms pertaining to contemporary international intellectual property. I then turn to some of the twentieth century treaties and also how the TRIPS Agreement eventually “codified” the privatization of international law. I conclude with some assessment of private rights in international law especially pointing to how some of the critics failed to take into account the “legal process” of the privatization of international law through intellectual property international instruments.*

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I. INTRODUCTION: INTERNATIONAL TREATIES CODIFYING PRIVATE RIGHTS IN INTELLECTUAL PROPERTY

Through public international law, intellectual property has organised itself as guarantor of *private power* on which the international system depends. The field of international intellectual property law, which began with the need to exercise public law-making power at the international level, has always been motivated by private economic interests in matters that are truly of private concern. It is clear from international intellectual property treaties such as the Paris and Berne Conventions that public international law has embraced private influence and expanded private rights beyond the domestic level.<sup>1</sup>

This section of the article focuses on the most important international

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<sup>1</sup> See Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, Preamble (4th recital) [hereinafter TRIPS Agreement] (“intellectual property rights are private rights”). See also Susan K. Sell, *Intellectual Property as a Trade Issue: From the Paris Convention to GATT*, 13 LEGAL STUD. F. 407 (1989) (hereinafter *Intellectual Property as a Trade Issue*); Paul S. Haar, *Revision of the Paris Convention: A Realignment of Private and Public Interests in the International Patent System*, 8 BROOK. J. INT’L L. 77 (1982); CHRISTOPHER MAY, *THE GLOBAL POLITICAL ECONOMY OF INTELLECTUAL PROPERTY RIGHTS* (2<sup>nd</sup> ed., 2015).

treaties that have been codifying private rights in intellectual property for the last hundred years. I will survey the major intellectual property treaties starting with the Paris and Berne Conventions and leading up to the TRIPS Agreement.<sup>2</sup> Moreover, I pay attention particularly to questions pertaining to applicable law and dispute settlement in the Berne Convention before turning to trademark treaties and the globalisation of norms relating to private rights in those treaties.

A full discussion of these treaties is not necessary, nor has such a discussion been the intention or goal of this article. Rather, the article examines the treaties to inform the extensive critical discussion and critique of the international intellectual property system. By turning to the international treaties codifying private rights in intellectual property it is possible to discern how private intellectual property rights at the global level raises public legal problems that are transnational in dimension. Furthermore, some of the underlying principles in international intellectual property law such as national treatment<sup>3</sup> or state doctrine<sup>4</sup> are not new—they are standard principles of public international law. Most international intellectual property rights treaties contain a provision on national treatment, which stipulates that both foreign and local actors in commerce should be afforded the same treatment for their goods and services. At the same time, state doctrine merely ensures that a state exercise sovereignty over its territory and not to intervene in the affairs of another state. In other words, courts have long argued that in the absence of “proper jurisdiction”, they have no right to interfere in the affairs of another country.<sup>5</sup> This was most vivid in the recent *Trader Joe’s* decision between Canada and the United States regarding the infringement of Trader Joe’s Co. trademark.<sup>6</sup> Thus, whether the affairs of state include different forms of property—immovables, intangibles (trademarks, for example), or any form of transitory actions—courts are often aware that it is not their role to “adjudicate” on the domestic laws of other state or apply their own laws extraterritorially.<sup>7</sup> Even as international intellectual

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<sup>2</sup> See TRIPS Agreement, *supra* note 1, art. 1(3) (incorporating the Paris and Berne Conventions).

<sup>3</sup> See TRIPS Agreement, *supra* note 1, art. 3(1); see also Ulrich Loewenheim, *The Principle of National Treatment in the International Conventions Protecting Intellectual Property*, in PATENTS AND TECHNOLOGICAL PROGRESS IN A GLOBALIZED WORLD: LIBER AMICORUM JOSEPH STRAUSS, 593-599 (Wolrad Pymont et al. eds., 2008).

<sup>4</sup> See also Hank M. Goldberg, *A General Theory of Jurisdiction in Trademark Cases*, 8 LOY. L.A. INT’L & COMP. L. J. 611 (1986); for general discussion in public international law, see Michael Zander, *The Act of State Doctrine*, 54 AM. J. INT’L. 826 (1959).

<sup>5</sup> The classic reminder is *Steele v. Bulova Watch Co.*, 344 U.S. 280, 286 (1952).

<sup>6</sup> *Trader Joe’s Co. v. Hallatt*, 835 F. 3d 960 (9th Cir. 2016).

<sup>7</sup> See, e.g., *The British South Africa Co. v. Companhia de Mocambique* [1892] 603 A.C. 607-8 (HL) (“The Court cannot order service of process abroad without statutory authority . . . No Court in this country has direct original jurisdiction with respect to real estate abroad”) (citing *King & Co.’s Trade-Mark* 462, 482). *But see Morrison v National Australia Bank Ltd.*, 130 S. Ct. 2876, at 2877-78 (where the Court held that the presumption against extraterritoriality

property laws began to emerge in the late 1800s courts were still unwilling to rule on matters beyond their jurisdiction. Over the centuries, it was not uncommon for courts in different jurisdictions to hear claims regarding the infringement of their patents, innovation, copyright or technology in another state. However, part of the response by states to the problem was the Paris and Berne Conventions. But even so, courts were still faced with the recurring problem of “trans-border” intellectual property infringement and the “proper” applicable law. Thus, intellectual property rights infringement across borders were increasingly a problem of public international law and domestic laws of nation states, a fact that was acknowledged in the *Mocambique* decision of the era.

The WIPO is the current institutional guardian of all intellectual property

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should not apply).

treaties,<sup>8</sup> including for *global* trademarks<sup>9</sup> or source origin,<sup>10</sup> and even to some extent the TRIPS Agreement due to the WIPO's close collaboration with the WTO via a 1995 cooperation agreement in relation to TRIPS.<sup>11</sup> There are also a number of other treaties directly related to intellectual property that operate

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<sup>8</sup> Some of the WIPO administered intellectual property treaties in addition to the WIPO Convention cover three main categories (a) the classification of intellectual property, (b) intellectual property protection and (c) treaties that offers global protection. The treaties, not necessarily in protection or classification order are: WIPO Performances and Phonograms Treaty (WPPT) (1996); International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations (Rome Convention) (1961); Budapest Treaty on the International Recognition of the Deposit of Micro-Organisms for the Purposes of Patent Procedure (as amended on Sept. 26, 1980); Patent Cooperation Treaty (PCT) (as modified on Oct. 3, 2001); Paris Convention for the Protection of Industrial Property (as amended on Sept. 28, 1979); WIPO Copyright Treaty (WCT) (1996); Beijing Treaty on Audiovisual Performances (2012); Brussels Convention Relating to the Distribution of Programme-Carrying Signals Transmitted by Satellite (1974); Patent Law Treaty (PLT) (2000); Convention for the Protection of Producers of Phonograms Against Unauthorised Duplication of their Phonograms (1971); Washington Treaty on Intellectual Property in Respect of Integrated Circuits (1989); Strasbourg Agreement Concerning the International Patent Classification (as amended on Sept. 28, 1979); Marrakesh Treaty to Facilitate Access to Published Works for Persons Who are Blind, Visually Impaired, or Otherwise Print Disabled (2013); Berne Convention for the Protection of Literary and Artistic Works (as amended on Sept. 28, 1979); Locarno Agreement Establishing an International Classification for Industrial Designs (as amended on Sept. 28, 1979); Hague Agreement Concerning the International Registration of Industrial Designs (1925). Note that this latter treaty has seen various reincarnations such as the London Act (1934); The Hague Act (1960); Protocol to The Hague Act (1960); Additional Act of Monaco (1961); Complementary Act of Stockholm (1967) and the Geneva Act (1999). For a summary of the WIPO administered treaties, see [http://www.wipo.int/edocs/pubdocs/en/intproperty/442/wipo\\_pub\\_442.pdf](http://www.wipo.int/edocs/pubdocs/en/intproperty/442/wipo_pub_442.pdf).

<sup>9</sup> In terms of the trademark treaties, this is for both protection and classification: Singapore Treaty on the Law of Trademarks (2006). The motivation at the heart of the Singapore Treaty is to create a modern and dynamic international framework for the harmonisation of administrative trademark registration procedures. The Singapore Treaty builds upon its forerunner, the Trademark Law Treaty of 1994 (TLT) 2037 U.N.T.S. 35, in that the Singapore Treaty has a wider scope of application and addresses more recent developments in the field of communication technologies. Other global trademark treaties administered at the WIPO include the Madrid Agreement Concerning the International Registration of Marks (as amended on Sept. 29, 1979); Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (as amended on Nov. 12, 2007); Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks (as amended on Oct. 1, 1985); Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (as amended on Sept. 28 1979); Nairobi Treaty on the Protection of the Olympic Symbol (1981) [hereinafter Trademark Treaties].

<sup>10</sup> Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods (1967); Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (as amended on Sept. 28, 1979); Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications (as adopted on May 20, 2015).

<sup>11</sup> See WORLD TRADE ORG., *Agreement Between the World Intellectual Property Organization and the World Trade Organization* (Dec. 22, 1995), [https://www.wto.org/english/tratop\\_e/TRIPS\\_e/wtowip\\_e.htm](https://www.wto.org/english/tratop_e/TRIPS_e/wtowip_e.htm).

outside of the ambit of WIPO which also contribute to the rule and norm-making dimension of international intellectual property law.<sup>12</sup> These treaties, for their part, also contribute to the broader role of intellectual property regulation in international law. Together with bilateral investment treaties and mega-regional free-trade treaties, these treaties have created a somewhat harmonious relationship between domestic intellectual property rights and public international law.

The critical academic discourse on international intellectual property law has had the upper hand over the legal discourse,<sup>13</sup> as Sell and others have actively portrayed. The turn to the *legal content*, that is, an *authoritative legal analysis*, of the international intellectual property treaties could be helpful to the academic discourse, which has been heading in the wrong direction in recent years.

Although the critical discourse on international intellectual property has gained the upper hand, this does not mean that actual general legal discourse on international intellectual property has been lacking. Quite the contrary, the literature is voluminous in that area.<sup>14</sup> However, the legal literature fails to provide a strong and robust defence or portrayal of the international intellectual property system.

The legal literature has been too straitjacket or too practice oriented. One of the more recent and serious pieces of literature to offer a fresh perspective on

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<sup>12</sup> See, e.g., Nagoya Protocol on Access to Genetic Resources and the Fair and Equitable Sharing of Benefits Arising from their Utilization to the Convention on Biological Diversity, (Oct. 29, 2010); Convention on Biological Diversity (June 5, 1992); Convention for the Protection of World Cultural and Natural Heritage (Nov. 16, 1972); 1037 U.N.T.S. 151; International Union for the Protection of New Varieties of Plants (Dec. 2, 1961); Lisbon Agreement for the Protection of Apellation of Origin (Oct. 31, 1958); 93 U.N.T.S. 205; International Treaty on Plant Genetic Resources for Food and Agriculture (Nov. 3, 2001). For an academic assessment of these treaties, see, e.g., JONATHAN CURCI, *THE PROTECTION OF BIODIVERSITY AND TRADITIONAL KNOWLEDGE IN INTERNATIONAL INTELLECTUAL PROPERTY LAW* (2010); TANIA VOON, *CULTURAL PRODUCTS AND THE WORLD TRADE ORGANIZATION* (2007).

<sup>13</sup> See CLAIRE A. CUTLER, *PRIVATE POWER AND GLOBAL AUTHORITY: TRANSNATIONAL MERCHANT LAW IN THE GLOBAL POLITICAL ECONOMY* (2003); SUSAN K. SELL, *PRIVATE POWER, PUBLIC LAW: THE GLOBALIZATION OF INTELLECTUAL PROPERTY RIGHTS* (2003); Laurence R. Helfer, *Regime Shifting in the International Intellectual Property System*, 7 *PERSPECTIVES ON POLITICS* 39 (2009).

<sup>14</sup> Major works on international intellectual property include: DORIS E. LONG & ANTHONY D'AMATO, *INTERNATIONAL INTELLECTUAL PROPERTY LAW*, (Kluwer Law Int'l ed. 1st ed., 1997); FREDERICK ABBOT, THOMAS COTTIER & FRANCIS GURRY, *INTERNATIONAL INTELLECTUAL PROPERTY IN AN INTEGRATED WORLD ECONOMY* (Aspen Publishers 2d ed., 2011). For a more recent work, see *INTERNATIONAL INTELLECTUAL PROPERTY: A HANDBOOK OF CONTEMPORARY RESEARCH* (Daniel J. Gervais ed., 2015). See also Graeme B. Dinwoodie, *The International Intellectual Property System: Treaties, Norms, National Courts, and Private Ordering in INTELLECTUAL PROPERTY, TRADE AND DEVELOPMENTS: STRATEGIES TO OPTIMIZE DEVELOPMENT IN A TRIPS PLUS ERA*, 61-114 (Daniel J. Gervais ed., 2007).

intellectual property in international law has shown that the private rights system of intellectual property protection interacts with the different norm systems of international law.<sup>15</sup> What separates my own contribution in this article from that of Ruse-Khan is my focus on the evolution of intellectual property laws as a result of economic relations, and I limit my discourse to norm relations within private international law and how it relates to the economic constitutionalism of intellectual property rights in public international law.

Given the plethora of international treaties in the intellectual property domain along with the TRIPS Agreement, international intellectual property law is a force to be reckoned with. However, the problem with that reality is that it is not entirely convincing. Or at least, that is what one author seems to have suggested when she queried: “is there an international intellectual property system?”<sup>16</sup> In fact, international intellectual property laws are one of the most coherent and legalistic regimes in the international legal system so much that it falls victim to its own success.

The success of the international intellectual property system of law has triggered a coalition of willing partners to engage in creating a third-tier system of “international” intellectual property laws in specialised trading agreements in different multilateral forums. This is exemplified by super-bilateral trade agreements that directly concern intellectual property and falls into the category of *coalition of the willing* are the new mega-free trade agreements such as the United States Australia Free Trade Agreement (AUSFTA).<sup>17</sup> In this type of agreement—the aim has been to enhance the level of protection in all aspects of intellectual property.<sup>18</sup>

In the first place, private economic actors had turn to international or global intellectual property instruments to realise the economic potential of their innovations: goods, services, and or their copyright-protected books/music/films (intellectual creativity). For most countries that signed up to the TRIPS Agreement there was widespread optimism that some of the most egregious intellectual property infringements that occurs globally (piracy for example) would diminish. Moreover, there was further optimism that the *rule of international law* would eliminate the imbalances between intellectual property laws in the developed countries when compare to other members of the TRIPS Agreement in the global south.<sup>19</sup>

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<sup>15</sup> HENNING G. RUSE-KHAN, *THE PROTECTION OF INTELLECTUAL PROPERTY IN INTERNATIONAL LAW* (2016).

<sup>16</sup> Fiona Rotstein, *Is There an International Intellectual Property System? Is There an Agreement Between States as to What the Objectives of Intellectual Property Laws Should Be?*, 33 EUR. INTELL. PROP. REV. 1 (2011).

<sup>17</sup> United States – Australia Free Trade Agreement (May 18, 2004), 43 I.L.M. 1248 [hereinafter AUSFTA].

<sup>18</sup> AUSFTA, *id.* Chapter 17 (covering intellectual property rights).

<sup>19</sup> See also TRIPS Agreement, *supra* note 1, arts. 7–8.

However, as the global intellectual property system grew crowded and disparities among intellectual property protection in the different countries began to emerge—there were widespread accusations of systemic failure to enforce intellectual property rules or that some nations were coerced into signing up to the TRIPS Agreement.<sup>20</sup> The private economic actors were now realising that the global system either was weak or had been undermined by failure of some states to adopt strong intellectual property rules or enforce the existing rules. Moreover, the larger nations such as the US were warning that they faced an economic disadvantage in relation to piracy, counterfeiting and or failure by some states to enforce intellectual property rules.<sup>21</sup> A new push by likeminded states or formally, by states where the enforcement of intellectual property rules could be achieved became the new wave of post-TRIPS treaty making as nations and regional blocs signed various free-trade agreements with stronger intellectual property protection and enforcement when compared to the TRIPS Agreement.<sup>22</sup> This coalition of the willing states sole purpose was to restore the economic viability of intellectual property protection.

Nevertheless, in some ways, one could make the argument that prior to the emergence of “TRIPS-Plus” types of agreements, the Paris/Berne system, the international trademark agreements and even the TRIPS Agreement, held their ground for some time.

## II. THE PARIS/BERNE SYSTEM AND THE BREAKTHROUGH FOR INTERNATIONAL INTELLECTUAL PROPERTY LAW

The Paris Convention<sup>23</sup> and Berne Convention<sup>24</sup> have always been about international intellectual property law.<sup>25</sup> The two Conventions were the

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<sup>20</sup> See generally CAROLYN DEERE, *THE IMPLEMENTATION GAME: THE TRIPS AGREEMENT AND THE GLOBAL POLITICS OF INTELLECTUAL PROPERTY REFORM IN DEVELOPING COUNTRIES* 151 (2008) (“Importantly, while many developing countries were indeed cajoled or coerced through economic pressures to implement TRIPS-plus reforms, not all countries succumbed.”).

<sup>21</sup> See Benjamin Knaupp, *United States-China Trade Relations: The Intellectual Property Protection Problem*, 3 INT’L TRADE & BUS. L. ANN. 107, 116 (1997): “Chinese piracy robs United States companies of their ability to compete in the Chinese market and costs American firms billions of dollars in lost profits.”

<sup>22</sup> E.g., AUSFTA, *supra* note 17, Chapter 17 (covering intellectual property rights).

<sup>23</sup> Paris Convention for the Protection of Industrial Property (Mar. 20, 1883), 828 U.N.T.S. 305 [hereinafter Paris Convention].

<sup>24</sup> Berne Convention for the Protection of Literary and Artistic Works (July 24, 1971), 828 U.N.T.S. 221 [hereinafter Berne Convention].

<sup>25</sup> See generally Gustavo Bravo, *From Paris Convention to TRIPS: A Brief History*, 12 J. CONTEMP. LEGAL ISSUES 445 (2001); Peter Burger, *The Berne Convention: Its History and its Key Role in the Future*, 3 J. L. & TECH. 1 (1988); William R. Cornish, *The International Relations of Intellectual Property*, 52 CAMBRIDGE L. J. 46 (1993).

culmination of various efforts by European merchants and innovators in the nineteenth century to have their creative *innovations* protected or afforded the same treatment as that given to creative *innovators* in countries that signed up to these two international instruments.<sup>26</sup>

The Paris Convention of 1883, which covers patents, is the older of the two siblings—it was ratified a mere three years before the Berne Convention of 1886, which mostly related to copyrights.<sup>27</sup> By the latter part of the nineteenth century, Europe was fairly industrialised and was concerned about its economic advancement and the protection for industry and commerce in its national economy.<sup>28</sup>

During this particular period, these two intellectual property treaties were largely of a European texture—although supported by a few South American countries as signatories. But, if seen in their European context, the conventions, were in part, I would argue, driven mostly to cover the possibility of *conflicts* that may have arisen in terms of financial damages for the improper use of creative innovations in a different realm of Europe.<sup>29</sup>

Prior to the emergence of the Paris and Berne Conventions in the late nineteenth century, an intricate system relying on private international law addressed different areas of legal conflicts in Europe.<sup>30</sup> Thus, on the one hand copyrighted works that were sold in other countries were subjected to a number of treaties that offered protection for authors.<sup>31</sup> On the other, conflict of laws questions were dealt with mostly on the basis of some form of connecting factor or largely *lex protectionis* rule linking copyright owners to the territory in which they were seeking protection.<sup>32</sup> During the same period, things were different in the United States because prior to 1891, foreign works were not protected under the US Copyright Act.<sup>33</sup>

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<sup>26</sup> For example, early English efforts to protect intellectual property in exhibitions resulted in a new law. See Protection of Inventions and Designs Amendment Act (25 & 26 Vict. C. 12) 1862.

<sup>27</sup> Berne Convention, *supra* note 24, art. 2 (applying the convention to “literary and artistic works”).

<sup>28</sup> See also TOM KEMP, INDUSTRIALIZATION IN NINETEENTH-CENTURY EUROPE (2d ed., 2014).

<sup>29</sup> See, e.g., *Jeffreys v. Boosey* (1854) 10 Eng. Rep. 681, 4 H.L.C. 815 (regarding the copyright of a foreigner on works published in England).

<sup>30</sup> See generally Ralf Michaels, *The New European Choice-of-Law Revolution*, 82 TUL. L. REV. 1607 (2008).

<sup>31</sup> See generally SAM RICKETSON & JANE C. GINSBURG, INTERNATIONAL COPYRIGHT AND NEIGHBOURING RIGHTS: THE BERNE CONVENTION AND BEYOND (2d ed., 2006); MIREILLE VAN EECHOU, CHOICE OF LAW IN COPYRIGHT AND RELATED RIGHTS: ALTERNATIVES TO THE LEX PROTECTIONIS (2003).

<sup>32</sup> See generally *id.*

<sup>33</sup> See generally *Golan v. Holder*, 132 S. Ct. 873 (2012).

The Berne and Paris Conventions articulate an essential principle: national treatment. *Creative innovators* get the same treatment they would get in a state participating in the treaties as they would in their own state, so long as such treatment was provided without regard to the innovators' nationality. As a result, the creative industries in Europe flourished and the economic rewards of creative innovation and technological progress were great.<sup>34</sup>

For the Europeans, through the prism of the Paris/Berne system, the world was small. Europe, her empires and far-flung colonies formed a single *entity* in the global sphere of things.<sup>35</sup> Countries that were not part of this entity were either (1) un-civilised<sup>36</sup> or (2) as I would prefer to label the non-European nations such as Liberia and Haiti that signed the Paris and Berne Conventions in the 1880s: *exotic occurrences*. With the outbreak of WWI in 1914, the world changed, and by the end of 1919—new countries were born as empires collapsed and borders were redrawn. This meant that additional new nations could accede to the Paris and Berne Conventions.

Although, few countries acceded to the Paris/Berne system during the interwar years, i.e. between 1918–1945, it was not until after 1945 that a new era of economic liberalism began. In this new era, the Paris/Berne system was fully opened up to those countries that were once part of the *entity* of Europe.<sup>37</sup> It was after 1945 that the Paris/Berne system transformed from an international law regime between European countries to *global* international law as it is understood in the present day context.<sup>38</sup>

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<sup>34</sup> See also Joel Mokyr, *Intellectual Property Rights, The Industrial Revolution, and the Beginnings of Modern Economic Growth*, 99 AM. ECON. REV. 349 (2009), 352 (discussing incentives for patent inventions); KEMP, *supra* note 28.

<sup>35</sup> E.g., the colonial clause of Article 19 of the Berne Convention empowers European states to accede to the convention on behalf of their colonies: “the provisions of this convention shall not preclude the making of a claim to the benefit of any greater protection which may be granted by legislation in a country of the Union.” See Berne Convention, *supra* note 24, art. 19. See also Ruth L. Okediji, *The International Relations of Intellectual Property: Narratives of Developing Country Participation in the Global Intellectual Property System*, 7 SING. J. INT’L. & COMP. L. 315 (2003); WILLIAM BRIGGS, *THE LAW OF INTERNATIONAL COPYRIGHT: WITH SPECIAL SECTIONS ON THE COLONIES AND THE UNITED STATES OF AMERICA* (Stevens & Haynes ed., 1906), <https://archive.org/details/lawinternational01briggs/page/n12>.

<sup>36</sup> See, e.g., Amin Forji, *International Law, the Civilizing Mission and the Ambivalence of Development in Africa: Conceptual Underpinnings*, 6 J. AFRICAN AND INT’L L. 191, 198 (2013) (discussing the concept of uncivilised in international law).

<sup>37</sup> For example, Kenya signed the Paris Convention in May 1965, but technically, as a former British colony, the argument can be made that Kenya was bound to international treaties signed by Britain through state obligation. See also SH Frishauf and P. Bassard, *Industrial Property in the Former French Overseas Territories*, 44 J. PAT. OFF. SOC’Y. 754 (1962); Irwin A. Olian, *International Copyright and the Needs of Developing Countries: The Awakening at Stockholm and Paris*, 7 CORNELL INT’L L. J. 81 (1981).

<sup>38</sup> See also Eva Hemmungs Wirtén, *Colonial Copyright, Postcolonial Publics: The Berne Convention and the 1967 Stockholm Diplomatic Conference Revisited*, 7 SCRIPTed 532 (2010).

A. *THE PARIS CONVENTION AS THE FIRST GLOBALISATION OF INTELLECTUAL PROPERTY*

Treaty-making in the late nineteenth century was a rather peculiar development for international law—*thou shall not interfere with sovereignty*—and it began the first wave of globalisation.<sup>39</sup> These treaty negotiations, including those relating to intellectual property rights, had modest goals, such as: to “secure recognition of the entitlement of authors to protection.”<sup>40</sup> Once this goal was achieved, it was up to the domestic laws of each state as parties to those treaties to provide the legal protection for intellectual property and remedies for infringing those rights.<sup>41</sup> But in the context of nineteenth century treaty-making, the Paris Convention has to be seen as the first instrument of globalisation in intellectual property. It emerged from the raucous nature of various bilateral intellectual property treaties and various congresses in the industrial and literary spheres, which was a reaction to the rise of what we could in modern times call intellectual property infringement.<sup>42</sup>

It is reasonable to argue that the post-TRIPS era of globalisation came about as a result of this first wave of globalisation in the latter part of the nineteenth century, which was driven in part by a need to protect intellectual property.<sup>43</sup>

Indeed, private intellectual property rights have been and continue to be responsible for globalisation.<sup>44</sup> The main instrument that brought about the globalisation of intellectual property was the Paris Convention of 1883 that extended international law<sup>45</sup> to *all things intellectual property* under the unambiguous term of “industrial property” (an anglicised version of the French “*propriete industrielle*”).<sup>46</sup> In a sense, this victory for the Paris Convention was

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<sup>39</sup> Cobden-Chevalier Treaty, Fr.-U.K. (Jan. 23, 1860). See also STEPHEN BROADBERRY & KEVIN H. O’ROURKE, *THE CAMBRIDGE ECONOMIC HISTORY OF MODERN EUROPE: 1870 TO THE PRESENT* 5-29 (2d vol., 2010); LEONARD GOMES, *THE ECONOMICS AND IDEOLOGY OF FREE TRADE: AN HISTORICAL REVIEW* 249-300 (2003).

<sup>40</sup> See SAM RICKETSON & JANE C. GINSBURG, *INTERNATIONAL AND NEIGHBOURING RIGHTS: THE BERNE CONVENTION AND BEYOND* 138 (2d ed., 2006).

<sup>41</sup> See also Alfredo C. Robles, *History of the Paris Convention*, 15 *WORLD BULL.* 1 (1999).

<sup>42</sup> *Id.* at 2.

<sup>43</sup> See also Ituku Botoy Elangi, *From the Paris Convention to the TRIPS Agreement: A One-Hundred-and-Twelve-Year Transitional Period for the Industrialized Country*, 7 *J. WORLD INTELL. PROP.* 115, 118 (2004) (discussing the emergence of the Paris Convention).

<sup>44</sup> See generally PRIVATE POWER, PUBLIC LAW, *supra* note 13.

<sup>45</sup> See also G.H.C. BODENHAUSEN, *GUIDE TO THE APPLICATION OF THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY, AS REVISED IN STOCKHOLM, IN 1967*, at 10 (WIPO 1968) (“The Convention contains provisions of *international public law* regulating *rights and obligations of the member States*.”).

<sup>46</sup> Paris Convention, *supra* note 23, art. 1 (on the scope of industrial property as set out in 1(2): “The protection of industrial property has as its object patents, utility models, industrial designs, trademarks, service marks, trade names, indications of source or appellations of origin,

a *Mancinian* victory as opposed to *Savignian* approach to reason, where the latter approached private law matters from the perspective of public international law.<sup>47</sup>

To use a parallel with the British royal family, like Queen Victoria (1819–1901), the Paris Convention is the *grandmother* of all international intellectual property treaties. In other words, I am positing that the basic foundation of all contemporary international intellectual property treaties and conventions is the Paris Convention. To put the analogy in perspective, let's imagine that late nineteenth century royal courts in Europe to the early twentieth century had a fair amount of connection to Queen Victoria. It is the same for international intellectual property law. There is also a fair amount of connection to the Paris Convention (and also the Berne Convention) as the first truly international intellectual property instruments.<sup>48</sup> The Paris Convention set standards for international intellectual property law with some amount of uniformity and lasting power.<sup>49</sup> The success of other instruments in international intellectual property law such as the Berne Convention and the modern TRIPS Agreement is a product of their roots in the Paris Convention.

Prior to the Paris Convention, the *royal prerogative* of intellectual property in the various European states were colliding and tensions were being created across borders.<sup>50</sup> Order was necessary for a stable foundation. Furthermore, the non-existence of national intellectual property rules raised a number of concerns for the protection of foreign inventions especially in the Austro-Hungarian Empire. At the Vienna International Exhibition of Inventions in 1873, the Emperor-King unveiled a law specifically designed to protect whatever inventions were on display on its territory.<sup>51</sup> The first legal thread of the Paris Convention had sewn albeit on a temporary basis.<sup>52</sup>

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and the repression of unfair competition.”).

<sup>47</sup> See also Michaels, *supra* note 30. See also P. Sean Morris, *The Private Foundations of International Law: Intellectual Property Rights and Pashukanis*, 5 *JUS GENTIUM: J. INT'L LEGAL HIST.* 37,123, 87-88 (2020) (discussing Mancini).

<sup>48</sup> See also SAM RICKETSON, *BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS: 1886–1896* (1987).

<sup>49</sup> See also Bravo, *supra* note 25.

<sup>50</sup> Paris Convention, *supra* note 23, art. 11(1) (recognising international exhibitions); Elangi, *supra* note 43, at 117-118; see also Charles E. Townsend, *Protection of Intellectual Property at International Expositions*, 2 *CALIF. L. REV.* 291 (1913) (discussing early twentieth century developments in the United States).

<sup>51</sup> See Susan K. Sell, *Intellectual Property and Public Policy in Historical Perspective: Contestation and Settlement*, 38 *LOY. L.A. L. REV.* 267, 292 (2004) [hereinafter *Intellectual Property and Public Policy in Historical Perspective*] (discussing how the Austro-Hungarian Empire unveiled a new law during the World Exhibition); GRAHAM DUTFIELD, *INTELLECTUAL PROPERTY RIGHTS AND THE LIFE SCIENCES INDUSTRIES: A TWENTIETH CENTURY HISTORY* 55 (2003).

<sup>52</sup> WIPO, *INTRODUCTION TO INTELLECTUAL PROPERTY: THEORY AND PRACTICE* 359

The Paris Convention contained provisions on national treatment, which would become standardized in international treaties concerning economic relations.<sup>53</sup> Furthermore, rights on priority,<sup>54</sup> patents, trademarks, industrial designs,<sup>55</sup> trade names, appellations of origin, indication of source, and unfair competition were seen as part of the rubric of industrial property.<sup>56</sup> This broad array of rights that the Paris Convention set forth, touching most of the economic relations of states at both the domestic and international level, is, in my view, perhaps the most significant contribution of the Convention.

Attaching a form of hierarchy to this system of intellectual property under the Paris Convention would be futile, yet one cannot escape the fact that such a hierarchical system exists. Certainly, one could argue that patents and trademarks are stronger intellectual property per se when compared to industrial designs or geographical indications. From my personal position, I find trademarks to sit on the top of a hypothetical hierarchal pyramid due to their infinite use as opposed to other forms of intellectual property, which last for specific period.

For example, trademark rights under the Paris Convention are extended to a variety of “marks” ranging from collective marks, service marks, and well-

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(1997) (“The Congress for Patent Reform passed several resolutions, setting out forth a number of principles on which an effective and useful patent system should be based, and urging governments ‘to bring an international understanding upon patent protection as soon as possible.’”). Other crucial events that lead to the Paris Convention include an International Congress on Industrial Property in Paris in 1878, with a follow-up Congress in 1880 where a draft proposal was prepared. *Id.* at 59-60. Another source attributed the most crucial period of the Paris Convention to the period between 1872–1881, claiming that it was the U.S. and not Austria-Hungary that made the first move. *See* Heinrich Kronstein & Irene Till, *A Re-evaluation of the International Patent Convention*, 12 L. CONTEMP. PROBS. 765, 766 (1947) (“[T]he creative period of the Union was between 1872 and 1881. During this period the negotiations of the international patent convention were the battlefield for three opposing philosophies: (1) the anti-patent movement, aimed at the destruction of the patent system; (2) the recognition of patents as private property; (3) the recognition of patents as an instrument of public policy....[T]he initial invitation for an international conference on patent rights came from the Austrian Government in 1872. The invitation specifically states, however, that the suggestion came from the United States.”) (citation and quotations omitted); *Id.* at 767 (“The proposal for international patent protection did not come from the semi-feudal country of Austria, conspicuously lacking in industrial development; it came from the United States, already at the forefront industrially and with the strongest patent system in the world.”). *See also* STEPHEN LADAS, PATENTS TRADEMARKS, AND RELATED RIGHTS: NATIONAL AND INTERNATIONAL PROTECTION, at 59-68 (Harv. U. Press 1975).

<sup>53</sup> *See* TRIPS Agreement; *supra* note 1, art. 3(1).

<sup>54</sup> Paris Convention, *supra* note 23, art. 4I(1), (explaining that the right of priority concerns the filing and application of trademark registrations and also patents: one year for the latter and six months for the former).

<sup>55</sup> *Id.* art. 5quinquies.

<sup>56</sup> *See also* Thomas G. Fields, *Intellectual and Industrial Property in a Nutshell*, 77 W. VA. L. REV. 525 (1974).

known marks, among others.<sup>57</sup> As previously mentioned, marks are not the only form of intellectual property that the Paris Convention covers, and moreover, the protection that is afforded under the Paris Convention is based on the principle of national treatment<sup>58</sup> and priority of rights covering six months regarding the application and registration of a mark in a Member State.<sup>59</sup>

The national treatment principle of the Paris Convention is one of the cornerstone basic principles of international law found in the convention.<sup>60</sup> In addition to national treatment and the right of priority, the other substantive provisions of the Paris Convention are definitions of common rules in the field of substantive law and also provisions dealing with an administrative framework.<sup>61</sup>

Moreover, complementing the national treatment principle in terms of significance is the principle of independence of rights: no two trademarks are the same regardless if they are covered for the same subject in different countries.<sup>62</sup> Thus a trademark owner may own one or more trademarks for the same goods and services in different member states of the Union.<sup>63</sup> However, the provision of Article 6(3) of the Paris Convention has been criticised for extending the national treatment principle to the extreme.<sup>64</sup>

The move towards establishing a global system of intellectual property in the late nineteenth century through the Paris Convention made sense then, and it still makes sense today. The Paris Convention, along with the Berne Convention, is part of the modern intellectual property regime that centres on the TRIPS Agreement.

For nineteenth century Europeans (and the few outside *realms* that signed

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<sup>57</sup> Paris Convention, *supra* note 23, arts. 5–11.

<sup>58</sup> *Id.* art. 2(1) (“[N]ationals of any country of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to all nationals; all without prejudice to the rights specifically provided for by this Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with.”). *See also id.* arts. 2–3; Amy M. Au, *National Treatment and the International Recognition and Treatment of Trademarks*, 12 J. CONTEMP. LEGAL ISSUES 450 (2000).

<sup>59</sup> Paris Convention, *supra* note 23, art. 4I(1).

<sup>60</sup> *Id.* art. 2. *See also id.* art. 6(1-2) (dealing specifically with national treatment from a trademark perspective).

<sup>61</sup> Paris Convention, *supra* note 23, art. 12.

<sup>62</sup> Paris Convention, *supra* note 23, art. 6(3) (“A mark duly registered in a country of the Union shall be regarded as independent of marks registered in the other countries of the Union, including the country of origin.”).

<sup>63</sup> *Id.*

<sup>64</sup> Joanna Schmidt-Szalewski, *The International Protection of Trademarks After the TRIPS Agreement*, 9 DUKE J. COMP. INT’L L. 189, 194 (1998) (“This rule extends the national treatment principle to an extreme because the trademark owner is subject exclusively to the national law of each country.”).

on to the intellectual property conventions in the 1880s) the path to economic prosperity could realise itself only through a uniform set of rules on the governance of intellectual property. The same logic was applied to the TRIPS. A global intellectual property system that is uniform and with inherent common rules in all countries—what the Paris Convention set out to achieve—would culminate more than 110 years later in the second wave of globalisation spurred by intellectual property governance in the TRIPS Agreement.<sup>65</sup>

The sister to the Paris Convention, the Berne Convention, although developed during the time of the events leading up to the Paris Convention, had a late birth. By the time it was adopted, it was the first intellectual property convention to focus on a singular issue—copyright.<sup>66</sup> If the Paris Convention was the grandmother of international intellectual property law, then the Berne Convention became the matriarch of international copyright law.

#### B. THE BERNE CONVENTION: APPLICABLE LAW IN INTERNATIONAL LAW

The Berne Convention has a chequered history and in one sense it can be described similarly to the way Sell described the emergence of the TRIPS as a product of the American intellectual property owners or the so-called council of twelve.<sup>67</sup>

Berne, for its part, was also driven by European intellectual property owners through the International Literary Association (& Artists). The Association was founded in 1878 at the Paris Universal Exposition (Paris Congress) as a vehicle with the express goal of defending ‘the principles of intellectual property in all countries.’<sup>68</sup> Like the TRIPS Agreement, the Berne Convention was all about protecting and defending the intellectual property rights of private economic actors in domestic economies, even if such rights were being infringed outside

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<sup>65</sup> See TRIPS Agreement, *supra* note 1.

<sup>66</sup> See Berne Convention, *supra* note 24, art. 1.

<sup>67</sup> PRIVATE POWER, PUBLIC LAW, *supra* note 13, at 13.

<sup>68</sup> CATHERINE SEVILLE, THE INTERNATIONALISATION OF COPYRIGHT LAW: BOOKS, BUCCANEERS AND THE BLACK FLAG IN THE NINETEENTH CENTURY 24 (Cambridge U. Press 1st ed., 2006) (explaining that the Berne Convention has been revised on several occasions including in 1908 (the Berlin Revision), 1928 (the Rome revision), 1948 (the Brussels revision) and the 1971 (Paris revision), and that, since then, the Berne Convention has been incorporated into the TRIPS Agreement, but technically exists also as separate international treaty). See generally SAM RICKETSON, BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS: 1886–1896 (1987). One of the advantages of the Berne Convention is that it extends full protection of copyright works in all Member countries without any formality, merely because they have created a work. Furthermore, the Berne Convention acts a vehicle for “international relations in the field of copyright by dealing with international situations, i.e. situations the laws of more than one country as opposed to national situations which are dealt with according to the law of the land.” STEPHEN M. STEWART. & HAMISH SANDISON, INTERNATIONAL COPYRIGHT AND NEIGHBOURING RIGHTS 99 (2d ed., 1989).

of domestic territory.<sup>69</sup> A system of *international law* was in place to defend those rights.

Also like the TRIPS Agreement, the Berne Convention would eventually be championed by national governments, even though behind the scenes, the main drivers were non state-actors such as the International Literary Association (Berne) or the Council of Twelve (TRIPS).<sup>70</sup> But even with the ratification of those instruments, majority negotiating states, or at least the advanced states at the table, believed that those instruments did not go far enough. In the end they were watered down in the form of “minimum standards”—a euphemistic phrase, in my view, for failure or compromise. And, such failures would, in contemporary times, generally bring about new rounds of negotiations for similar treaties by like-minded states in the form of a coalition of the willing. The recently concluded agreements on the Regional Comprehensive Economic Partnership Agreement (RCEP)<sup>71</sup> and CETA<sup>72</sup> are examples.

Although, I have mentioned the national treatment principle as one of the pillars of the Paris/Berne system, it is not the national treatment that I want to discuss further with regards to the Berne Convention. Rather, I would like to address two issues that are linked to private international law and public international law (1) the dispute settlement system and (2) the country of origin principle. The former’s significance lies mostly prior to the incorporation of Berne into the TRIPS, and the latter, is actually tied to national treatment as Article 5(1) of the Berne Convention sets out the national treatment principle.<sup>73</sup>

Focusing on the Berne dispute settlement system for instance, evokes the very theme of this article—interaction of private and public international law. The Berne dispute settlement system by all accounts belonged to the system of public international law, as evidenced by its treaty status.<sup>74</sup> On the other hand, that dispute settlement system was meant to be a response to the very private litigations of private economic actors who are owners of copyrights.<sup>75</sup>

The country of origin principle, like the dispute settlement system, forms a dividing line between public and private international law. According to Article 5(1) of the Berne Convention:

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<sup>69</sup> See PAUL GOLDSTEIN, *INTERNATIONAL COPYRIGHT: PRINCIPLES, LAW, AND PRACTICE* 14, 27 (2001).

<sup>70</sup> See PRIVATE POWER, PUBLIC LAW, *supra* note 13.

<sup>71</sup> For commentary and comparison to similar agreements, see Peter Yu, *The RCEP and Trans-Pacific Intellectual Property Norms*, 50 *VAND. J. TRANSNAT’L L.* 673 (2017).

<sup>72</sup> See also Comprehensive Economic and Trade Agreement, CAN-EU, Oct. 30 2016, OJ (L/11) 23 [hereinafter CETA].

<sup>73</sup> Berne Convention, *supra* note 24, art. 5(1).

<sup>74</sup> See also GOLDSTEIN, *supra* note 69.

<sup>75</sup> Although states may be owners of “literary and artistic works”—the literary and artistic world has been primarily made up of authors, publishers and other private copyright holders.

Authors shall enjoy, in respect of works for which they are protected under this Convention, in countries of the Union other than the country of origin, the rights which their respective laws do now or may hereafter grant to their nationals, as well as the rights specially granted by this Convention.<sup>76</sup>

This reference to country of origin in the Convention raises many questions, all of which cannot be determined here. I will, however, address one specifically: what determines the country of origin and which law is applicable—domestic law or international law?

### III. COUNTRY OF ORIGIN IN THE BERNE CONVENTION AND APPLICABLE LAW

When the Court of Justice of the European Union (CJEU) was confronted with the principle of country of origin and the applicable law for copyright infringement in *Tod's v. Heyraud* it held that no “distinguishing criterion based on the country of origin of the work”<sup>77</sup> should be applied.<sup>78</sup> In other words, the CJEU held that discrimination based on nationality should not be a factor for copyright owners seeking to claim copyright protection in a member state of the EU. In a similar case, the US Supreme Court in *Golan v. Holder* also acknowledged the importance of the country of origin principle.<sup>79</sup>

Similarly, in Europe, the CJEU also acknowledged that the country of origin principle is an established one in international law as per the Berne Convention. According to *Tod's*, the country of origin principle applies to the EU as a whole and as such allows an “author to claim in a Member State the copyright protection afforded by the law of that State.”<sup>80</sup> In other words, as a principle of international copyright law, the country of origin principle, was equally transportable in the internal legal market of the EU.

In addition to Article 5 of the Berne Convention, Articles 18<sup>81</sup> and 30 also supplement the country of origin rule.<sup>82</sup> In terms of determining the country of

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<sup>76</sup> Berne Convention, *supra* note 24, art. 5(1).

<sup>77</sup> Case C-28/04, *Tod's SpA and Tod's France SARL v. Heyraud SA*, 2005 E.C.R. I – 05781 [hereinafter *Tod's*].

<sup>78</sup> *Id.* For a general discussion that include the country of origin principle in a different context see *European Commission Study, Economic Analysis of the Territoriality of the Making Available Right in the EU* (Mar. 2014); *European Commission Study on the Making Available Right and Its Relationship with the Reproduction Right in Cross-Border Digital Transmissions* (Dec. 2014) [hereinafter *Reproduction Right*]. This latter study addressed the principle of country of origin in EU copyright more extensively.

<sup>79</sup> *Golan v. Holder*, 132 S. Ct. 873, 878 (2012).

<sup>80</sup> *Tod's*, *supra* note 77, ¶ 36.

<sup>81</sup> Berne Convention, *supra* note 24, arts. 18, 30.

<sup>82</sup> See Axel Nordemann, *Berne and Beyond: Understanding International Conventions*

origin, the Berne Convention actually gives a straightforward answer: it all depends on whether the work is (1) published, (2) published simultaneously, or (3) unpublished.<sup>83</sup> According to Article 5(4), the country of origin is to be considered based on those three grounds.<sup>84</sup> In other words, the country of origin principle establishes that copyright ownership is determined by the laws of the country in which the work was first published.<sup>85</sup> Furthermore, Article 18(1) states that the convention also “appl[ies] to all works which, at the moment of its coming into force, have not yet fallen into the public domain in the country of origin through the expiry of the term of protection.”<sup>86</sup> These two provisions of the Berne Convention are the underlying rules for determining the country of origin principles in copyright protection.<sup>87</sup>

Why is the country of origin principle a concern for private international law and public international law? Because the principle connects and confronts the copyright laws of different countries, thereby creating conflict of laws in the literal sense. Furthermore, in addressing that conflict, recourse to public international law is also necessary given that the Berne Convention is an instrument in public international law. In a conflict situation that depends on (a) private international law (conflict of laws), such as domestic copyright law, and (b) public international law, such as for example, the Berne Convention. The country of origin principle is essential for the applicability of those two systems of laws.<sup>88</sup> Moreover, because Article 7(8) of the Berne Convention stipulates that copyright protection “shall not exceed the term fixed in the country of origin of

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*Relating to Copyright Law*, 59 J. COPYRIGHT SOC’Y. U.S.A. 263, 268 (2012) (“[The country of origin principle] denotes whether a national of a non-member state can claim protection under the international convention . . . The country of origin principle further means that in the context of international copyright law any author or right holder can benefit from the rights granted by an international convention even if he is not a national of a member state to the international convention.”).

<sup>83</sup> Berne Convention, *supra* note 24, art. 5.

<sup>84</sup> *Id.* art. 5(4).

<sup>85</sup> *Id.* art. 5(4) (“The country of origin shall be considered to be: (a) in the case of works first published in a country of the Union, that country; in the case of works published simultaneously in several countries of the Union which grant different terms of protection, the country whose legislations grants the shortest term of protection; (b) in the case of works published simultaneously in a country outside the Union and in a country of the Union, the latter country; (c) in the case of unpublished works or of works first published in a country outside the Union, without simultaneous publication in a country of the Union, the country of the Union of which the author is a national, provided that: (i) when these are cinematographic works the maker of which has his headquarters or his habitual residence in a country of the Union, the country of origin shall be that country, and (ii) when these are works of architecture erected in a country of the Union or other artistic works incorporated in a building or other structure located in a country of the Union, the country of origin shall be that country.”).

<sup>86</sup> *Id.* art. 18(1).

<sup>87</sup> See also GOLDSTEIN, *supra* note 69, at 19-23.

<sup>88</sup> *Id.*

the work,” it is plausible to argue that the country of origin principle in a contemporary sense allows for “measuring the duration of protection”<sup>89</sup> in copyright.<sup>90</sup>

In terms of other conflict principles in private international law such as *lex fori* (the law of the forum), the country of origin principle does not in any way affect how the *lex fori* may be determined. This is because the sole function of the country of origin principle is to establish first ownership, that is, to determine, where a copyright work was first published.<sup>91</sup> The *lex fori*, on the other hand, establishes the forum in case of doubts with regard to copyright infringement.<sup>92</sup>

The country of origin in the Berne Convention requires the applicability of two forms of law: domestic law and public international law. With respect to domestic law, domestic copyright law, and to an extent private international law, is the applicable law in determining the protection afforded to the copyright work.<sup>93</sup> On the other hand, given that the Berne Convention is an international treaty, the possibility of excluding public international law can be discounted.

The treatment of international law as such had some shortcomings in *Tod’s v. Heyraud*. The CJEU merely argued that it was not its prerogative to rule on matters concerning international law: “it is not for the [CJEU] to rule on the applicability of provisions of . . . international law.”<sup>94</sup> Although the CJEU endorsed issues that primarily concerned international law in the case, such as nationality, the Court avoided using the language of international law to directly rule on an international law matter: national treatment. Thus, by framing the matter in a different way—“distinguishing criterion”—the CJEU was able to address national treatment.

The main concern in *Tod’s v. Heyraud* was overt discrimination through intellectual property rights such as trademarks, copyright and design rights regarding infringement of registered designs of shoes.<sup>95</sup> *Tod’s* brought an action against Heyraud for infringement of design rights and Heyraud argued that such a claim was not valid under international intellectual property law, that is, under

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<sup>89</sup> See STEWART & SANDISON, *supra* note 68, at 45-46.

<sup>90</sup> *Id.*

<sup>91</sup> Berne Convention, *supra* note 24, art. 5(3) (“Protection in the country of origin is governed by domestic law. However, when the author is not a national of the country of origin of the work for which he is protected under this Convention, he shall enjoy in that country the same rights as national authors”).

<sup>92</sup> *Id.* art. 5(2).

<sup>93</sup> See also GOLDSTEIN, *supra* note 69, at 19-23.

<sup>94</sup> *Tod’s*, *supra* note 77, ¶ 14.

<sup>95</sup> *Id.* ¶ 19 (“[T]he rules regarding the equality of treatment between nationals and non-nationals prohibit not only overt discrimination by reason of nationality but also all covert forms of discrimination.”).

Article 2(7) of the Berne Convention.<sup>96</sup> According to Heyraud, under international intellectual property law, “Tod’s is not entitled to claim copyright protection in France for designs that do not qualify for such protection in Italy.”<sup>97</sup> On the other hand, Tod’s objected and claimed that applying international intellectual property law to the dispute “constitutes discrimination within the meaning of Article 12 EC.”<sup>98</sup> That provision says that any discrimination on the grounds of nationality are prohibited.<sup>99</sup>

Thus, international law was invoked from the beginning between two EU member states: France and Italy. Tod’s business is incorporated under Italian law, with Tod’s France as the company’s shoe distributor in France. Heyraud, a French company, sold similar shoes to Tod’s by essentially copying “or at least imitate[ing] the principal characteristics of the Tod’s and Hogan designs.”<sup>100</sup> The CJEU, aware of the international law implications,<sup>101</sup> steered its analysis into only EU law per Article 12 EC and held that there are no grounds for discrimination.<sup>102</sup>

The *Tod’s* judgment is not the most important case to have been addressed by the CJEU on matters relating to international law.<sup>103</sup> However, the judgement is important in that it has touched upon the divide between private international law and public international law from an intellectual property perspective; namely, copyright. The CJEU has in place certain procedures to address matters relating to the internal effect of international law in the EU, that is, the principle of *effet utile*, or internal effect (direct effect). It has been confirmed in *Racke v. Mainz* that the “rules of customary international law ... are binding upon the

<sup>96</sup> Berne Convention, *supra* note 24, art. 2(7) (“[I]t shall be a matter for legislation in the countries of the Union to determine the extent of the application of their laws to works of applied art and industrial designs and models, as well as the conditions under which such works, designs and models shall be protected. Works protected in the country of origin solely as designs and models shall be entitled in another country of the Union only to such special protection as is granted in that country to designs and models; however, if no such special protection is granted in that country, such works shall be protected as artistic works.”).

<sup>97</sup> *Tod’s*, *supra* note 77, ¶ 8.

<sup>98</sup> *Id.* ¶ 9.

<sup>99</sup> *Id.* ¶ 37.

<sup>100</sup> *Id.* ¶ 7.

<sup>101</sup> *Id.* ¶ 24 (“The existence of a link between the country of origin of a work within the meaning of the Berne Convention, on the one hand, and the nationality of the author of that work, on the other, cannot be denied.”). *See also id.* ¶¶ 33–34.

<sup>102</sup> *Id.* ¶ 36 (“Article 12 EC, which lays down the general principle of non-discrimination on grounds of nationality, must be interpreted as meaning that the right of an author to claim in a Member State the copyright protection afforded by the law of that State may not be subject to a distinguishing criterion based on the country of origin of the work.”).

<sup>103</sup> *See, e.g.*, Joined Cases C-402 & 415/05P, *Kadi & Al Barakaat International Foundation v. Council & Commission*, 2008 E.C.R. I – 6351 at ¶ 372 [hereinafter *Kadi & Al Barakaat*] (finding that EU Regulations implementing UN Sec Council Resolutions are void if incompatible with fundamental principles of the European constitutional order).

Community institutions and form part of the Community legal order.”<sup>104</sup> This, therefore, confirms that international law is directly applicable in the EU.<sup>105</sup> But when it comes to interpreting international law in the EU legal order, in general, the CJEU gives EU law the same equal footing as international law as per the *Hageman* decision.<sup>106</sup>

However, in *Tods v. Heyraud*, there was a certain ambivalence towards public international law by the CJEU, because the court, skirted the relevance of international law as much as possible in deciding the case. First, international law was being invoked to address matters of applicable law (private international law) in two EU Member States. Second, the question of intellectual property rights—as broad as such term is—came full circle regarding meaning and interpretation. That frontal attack on intellectual property in *Tod's*, from the multitude of intellectual property protection questions that were covered (trademarks, copyrights, design rights) and the response of different sets of intellectual property law (international intellectual property law; national intellectual property law and EU intellectual property law—the latter through the designs directive) illustrates that the divide between public and private international law has some limitations. Those limitations are necessarily dependent on the degree of applicability of EU law (private international law) or applicable public international law.

It was not the first time that the CJEU has been ambivalent in its interpretation of international law in the EU legal order, as it has done so on other occasions that generally involve issues of trade and commerce. For instance, *Intertako*,<sup>107</sup> *Mox Plant*<sup>108</sup> and *Bogiatzi*<sup>109</sup> saw the CJEU being ambivalent or almost denying the effect of international law on the EU legal order. And outside of the trade and commerce regime, in *Kadi*, the CJEU drew a cautious line in the sand.<sup>110</sup>

In *Tod's v. Heyraud*, the CJEU appeared to see no reason to address international law.<sup>111</sup> Instead, the CJEU merely ignored the direct effect of

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<sup>104</sup> A. Racke GmbH & Co v Hauptzollamt Mainz, ECLI: EU:C:1998:293, at ¶ 46. *See also* Case 104/81, Hauptzollamt Mainz v. C.A. Kupferberg & Cie KG, 1982 E.C.R. I – 3641.

<sup>105</sup> *See* Nicolas A.J. Croquet, *Import of International Customary Law into the EU Legal Order: The Adequacy of a Direct Effect Analysis*, 15 CAMBRIDGE Y.B. EUR. LEGAL STUD. 47 (2012).

<sup>106</sup> *E.g.*, Case 181/73, R & V Haegeman v. Belgian State, 1974 E.C.R. I – 00449.

<sup>107</sup> Case C-308/06, International Association of Independent Tanker Owners (Intertanko) and Others v. Secretary of State for Transport, 2008 E.C.R. I – 04057.

<sup>108</sup> Case C-459/03, Commission of the European Communities v. Ireland, 2006 E.C.R. I – 04635.

<sup>109</sup> Case C -301/08, Irene Bogiatzi v. Deutscher Luftpool and Others, 2009 ECR I -10185.

<sup>110</sup> *See* *Kadi & Al Barakaat*, *supra* note 103.

<sup>111</sup> *Tod's*, *supra* note 77, ¶ 14 (“it is not for the Court of Justice to rule on the applicability of provisions of ... international law”).

international law, and the matter slowly withered away without any form of concrete legal solution.<sup>112</sup> Had the CJEU addressed international law, it would have given a clearer picture on the relationship of public and private international law in relation to intellectual property.

Earlier, I posed a question regarding the Berne Convention: what determines the country of origin and which law is applicable, domestic law or international law? One form of answer can be gleaned from *Tod's v. Heyraud*, when the CJEU noted that the applicable law would be the domestic (copyright) law that provides for national treatment of protected works.<sup>113</sup> Thus, based on this interpretation, it is the national law where the copyright is protected that governs the country of origin principle.<sup>114</sup> But this leaves the matter of international law per the Berne Convention out of the equation and in a rather unsettling way.

It is unsettling because it is difficult to glean from the Berne Convention whether it provides for the application of domestic copyright law or international copyright law.<sup>115</sup> In order to remedy that situation, and giving equal force to both domestic law and international law, the issue of jurisdiction can find credible answers in the Berne Convention when applying it to disputes such as *Tod's v. Heyraud* or general disputes that raise questions of applicable law.<sup>116</sup> As such, the “close link” factor under the jurisdiction clause of Brussels I Regulation, Article 5(3) (recast Article 7(2) could be used as a threshold to create a connection in determining the country of origin for (physical or online) publication in copyright infringement cases.<sup>117</sup>

Another relevant question that the country of origin principle raises is how to determine the country of first publishing for online publications. That issue has been given a considerable amount of attention in various domestic courts in relation to online copyright infringement.<sup>118</sup> In other words, how do we

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<sup>112</sup> *But see* Croquet, *supra* note 105.

<sup>113</sup> *See* *Tod's*, *supra* note 77, ¶ 32 (“As is apparent from Article 5(1) of the Berne Convention, the purpose of that convention is not to determine the applicable law on the protection of literary and artistic works, but to establish, as a general rule, a system of national treatment of the rights appertaining to such works.”).

<sup>114</sup> *But see* Berne Convention, *supra* note 24, art. 5(3) (“Protection in the country of origin is governed by domestic law.”).

<sup>115</sup> *See* Croquet, *supra* note 105.

<sup>116</sup> *See* GOLDSTEIN, *supra* note 69, at 136-138.

<sup>117</sup> I later learnt of a similar proposal, albeit one made in a different context discussing US case law. *See* Fitzgerald, *infra* note 118, at 44-45.

<sup>118</sup> *See generally* Brian Fitzgerald et al., *Country of Origin and Internet Publication: Applying the Berne Convention in the Digital Age*, in *COPYRIGHT PERSPECTIVES: PAST, PRESENT AND PROSPECT* (2015); Chris Dombkowski, *Simultaneous Internet Publication and the Berne Convention*, 29 SANTA CLARA HIGH TECH. L. J. 643 (2012). A recent study that also discussed the country of origin in the context of digital transmission in the EU noted that the country of origin of the work under the Berne Convention is controversial when it comes to

determine whether works published on the internet are domestic or international for the purposes of the country of origin principle in the Berne Convention? Some domestic courts such as those in the United States, often subscribes to the “international” view, or the simultaneous publication rule under the Berne Convention.<sup>119</sup>

The publication of works online in the era of the internet is an acute problem in the context of the Berne Convention and its country of origin principle. The close link factor or other connecting elements the work has with the output country are more suitable to determine country of origin within the context of Berne. Given that the internet is worldwide, works published online, in that sense, also move in a global paradigm, and to contain such works and determine the legal criteria of country of origin under Berne, the close link factor should be sufficient for connecting to a single country of origin.

#### IV. DISPUTE SETTLEMENT IN THE BERNE CONVENTION AS PUBLIC INTERNATIONAL LAW

The dispute settlement system of the Berne Convention is set out in Article 33 and as recently there were plans by the Caribbean Island of Dominica to invoke the system’s provisions against Brazil for breach of moral rights by a Brazilian singer for her use of a popular song by a Dominican artist.<sup>120</sup> Given that the Berne Convention is incorporated into TRIPS and forms part of the broader dispute settlement system of the WTO as such, the intention in this short discussion, is to frame the Berne dispute settlement system in the broader context of public international law. A further intention is to ascertain the nature of the Berne dispute settlement system prior to the entry into force of the TRIPS Agreement.

The dispute settlement system of the Berne Convention is set out in a rather

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audio-visual or cinematographic works. *See Reproduction Right, supra* note 78, at 16 (“If authorship and initial ownership are determined in accordance with the *lex loci originis* of the work, the authorship or initial ownership of the work is invariable. This would remove the legal uncertainty that results from different national rules. The Berne Convention provides which country is the country of origin of the work ... This option is however controversial and seems excluded, at least for audio-visual or cinematographic works.”).

<sup>119</sup> *E.g.*, *Kernal Records Oy v. Timothy Mosely et al.*, 794 F. Supp 2d 1355 (S.D. Fla. 2011) (noting that online publication includes publication “around the world.”). *See also* ALAI, DETERMINATION OF COUNTRY OF ORIGIN WHEN A WORK IS FIRST PUBLICLY DISCLOSED OVER THE INTERNET: REPORT BY THE COUNTRY OF ORIGIN STUDY GROUP OF THE INTERNATIONAL LITERARY AND ARTISTIC ASSOCIATION (ALAI) (2012), <http://www.alai.org/assets/files/resolutions/country-of-origin.pdf> (suggesting that the nationality of author should determine the country of origin of works by multiple authors).

<sup>120</sup> *See* Press Release, Dominica News Online, Dominica claims millions from Brazil in Berne Convention Dispute, (Mar. 15, 2016), <http://dominicanewsonline.com/news/homepage/news/general/dominica-claims-millions-from-brazil-in-berne-convention-dispute/>

typical way that befitted the later amendments.<sup>121</sup> Disputes are to be referred to the International Court of Justice (ICJ).<sup>122</sup> According to Article 33:

Any dispute between two or more countries of the Union concerning the interpretation or application of this Convention, not settled by negotiation, may, by any one of the countries concerned, be brought before the International Court of Justice by application in conformity with the Statue of the Court, unless the countries concerned agree on some other method of settlement.<sup>123</sup>

Thus, in the event of any misunderstandings, it is the ICJ that interprets and determines the scope of disputes that fall under the Berne Convention if no other methods can be found. A mere recognition of the jurisdiction of the ICJ is sufficient to bring disputes before it and the Berne Convention similarly to other international treaties, recognised the compulsory jurisdiction of the ICJ.<sup>124</sup> If the Dominica/Brazil dispute had been initiated, history would have been made, as it would be the first time that the Berne Convention initiated the ICJ dispute settlement system.

According to Article 33(1) of the Berne Convention, disputes are to be referred to the ICJ.<sup>125</sup> However, and in defiance of logic, the second clause of the Article allows states to ignore the rulings of the ICJ if such a case were to be brought. According to Article 33(2) a country may “declare that it does not consider itself bound by the provisions of paragraph (1).”<sup>126</sup> It is perhaps because of this provision that the ICJ has never heard a dispute in relation to international intellectual property rights. The TRIPS Agreement itself would change all of that, albeit rather disappointingly from a litigation point of view.

International intellectual property rights went from *unenforceable* under Berne (and other IP conventions) to enforceable under the TRIPS. This dramatic shift also contributed to the general criticisms TRIPS received (and is still receiving) in the legal literature (and the wider society at large), partly because

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<sup>121</sup> The reference to the ICJ for Berne disputes was made during the Brussels Amendments of 1948 whilst the Stockholm Conference of 1967 made it optional for countries that do not recognise the jurisdiction of the ICJ. *See also* Jerome Reichman, *Design Protection in Domestic and Foreign Copyright Law: From Berne Revision of 1948 to the Copyright Act of 1976*, 1983 DUKE L. J. 1143; Arthur Fisher, *The 1948 Revision of the Berne Convention*, 10 FED. COMM. B.J. 53, 58 (1949) (noting: “By a new Article 27-bis it is provided that any dispute between two or more countries of the Union as to interpretation or application of the Convention not settled by negotiation may be brought before the International Court of Justice.”).

<sup>122</sup> Fisher, *supra* note 121.

<sup>123</sup> Berne Convention, *supra* note 24, art. 33(1).

<sup>124</sup> *See* Silke von Lewinski, *The WTO/TRIPS Dispute Settlement Mechanism: Experiences and Perspectives*, in *TRIPS PLUS 20: FROM TRADE RULES TO MARKET PRINCIPLES* 604 (H. Ulrich et al. eds., 2016).

<sup>125</sup> Berne Convention, *supra* note 24, art. 33(1):

<sup>126</sup> Berne Convention, *supra* note 24, art. 33(2).

of the difficulty of amending the TRIPS Agreement.<sup>127</sup> And to complicate matters, the rise of “TRIPS-Plus” agreements has made TRIPS obligations somewhat minor in comparison to some of those in TRIPS-plus agreements.<sup>128</sup>

Although during the Berne era international intellectual property rights were unenforceable, the mere use or reference to the ICJ in the Berne Convention was a sort of appreciation of (and a fall-back on) public international law. This was necessary on two grounds. First, the Berne Convention, itself being a treaty within the context of public international law, had to have a means for settling dispute. Although such a means was only recognised in a subsequent revision of the Berne Convention, states were satisfied with the status quo that their national sovereignty would not be lost to a system of international intellectual property enforcement.<sup>129</sup>

The second reason for the necessity of a fall-back on international law for intellectual property enforcement during the Berne era was the need to maintain a uniform definition of intellectual property. What does this mean? The definition of intellectual property prior to the Berne/Paris system, and, even after that, meant different things in different countries. For most continental countries, the notion of “industrial property” was all-encompassing to also include technological innovations or patents. The fact that the language of the Paris Convention referred to “industrial property” is one such example on the lack of a consensus on the scope of intellectual property rights.<sup>130</sup> In any case, various national policy objectives and laws relating to intellectual property meant that what was defined and protected as intellectual property in one state did not necessarily receive the same treatment in another state.<sup>131</sup>

As such, while there was a common understating of what really constituted intellectual property, there was no legal consensus on the definition of scope of intellectual property as a term when compared to industrial property. Therefore, a system of international dispute settlement could determine the meaning and what constitutes intellectual property where there were any doubts.<sup>132</sup> Thus, if Country X had challenged the intellectual property laws of Country Y in relation to the meaning and protection of intellectual property under the Berne

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<sup>127</sup> See Henning Grosse Ruse-Khan, *The International Law Relation Between TRIPS and Subsequent TRIPS-Plus Free Trade Agreements: Towards Safeguarding TRIPS Flexibilities*, 18 J. INTELL. PROP. L. 325, 329 (2010) (note 11 discussing how IP rights are sacrosanct in international conventions and thereby proving difficult to amend).

<sup>128</sup> *Id.* at 328. See also AUSFTA, *supra* note 17, Chapter 17.

<sup>129</sup> See also GOLDSTEIN, *supra* note 69, at 23-28 (discussing the revision of the Berne Convention).

<sup>130</sup> See, e.g., Jermome H. Reichman, *Legal Hybrids Between the Patent and Copyright Paradigms*, 94 COLUM. L. REV. 2432 (1994).

<sup>131</sup> See also Kronstein & Till, *supra* note 52 (discussing variations of public policy and intellectual property in late nineteenth century that lead to the Paris and Berne Conventions).

<sup>132</sup> See Berne Convention, *supra* note 24, art. 33.

Convention, such a matter would have been settled within an international forum of adjudication, as opposed to applying one country's intellectual property laws extraterritorially. The inclusion of the dispute settlement system in the Berne Convention was therefore meant to retain international intellectual property as part and parcel of the system of civilised states, that participates in public international law.

A final link to public international law of the Berne Convention is the issue of interpretation. As Article 33 stipulates, the convention must be applied when "any dispute between two or more countries of the Union concerning the interpretation" within the international intellectual property system.<sup>133</sup> This provision in the Berne Convention does not mean it is a treaty interpretation provision.<sup>134</sup> As a matter of fact, the Berne Convention (and the Paris Convention) lacked provisions in relation to treaty interpretation. Therefore, from a treaty law perspective, the rules on treaty interpretation are fairly modern when the Vienna Convention on the Laws of Treaties (VCLT) is factored into the equation.<sup>135</sup> And in this modern sense, when the Berne Convention has to be interpreted as part of the TRIPS system, the rules for doing so are set out in Articles 30-34 of the VCLT.<sup>136</sup> As such, disputes per Berne via TRIPS are referred to the dispute settlement body (DSB) of the WTO, in which case the Vienna rules are invoked.<sup>137</sup> But prior to TRIPS, the interpretation of the Berne Convention was to be done in accordance with customary rules of public international law (also a factor behind the Doha Declaration of 2001, which endorsed the view that TRIPS should be interpreted in light of customary international law).<sup>138</sup> Thus, in intellectual property cases such as *India – Patent*

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<sup>133</sup> *Id.* art. 33(1).

<sup>134</sup> *But see* The Vienna Convention on the Law of Treaties (May 23, 1969), 1155 U.N.T.S. 331 (entered into force 27 January 1980), arts. 31–33 [hereinafter VCLT].

<sup>135</sup> *Id.* Thus, when the VCLT is compared to the international treaties of the late nineteenth century – one could make the argument that the VCLT is a "modern" treaty especially with its rules on treaty interpretation in Articles 31–33.

<sup>136</sup> *See, e.g.*, VCLT, art. 30(2) (setting out the relationship between successive treaties on the same subject matter).

<sup>137</sup> *See* Appellate Body Report, *India – Patent Protection for Pharmaceutical and Agricultural Chemical Products*, ¶46 WT/DS50/AB/ (adopted Dec. 19, 1997) [hereinafter *India – Patent Protection* (1997)].

<sup>138</sup> World Trade Organization, Declaration on the TRIPS Agreement and Public Health of (Nov. 20 2001), WTO Doc. WT/MIN (01) DEC/2, 41 ILM 755 (2002). *See also* James T. Gathii, *The Legal Status of the Doha Declaration on TRIPS and Public Health under the Vienna Convention on the Law of Treaties*, 15 HARV. J. L. & TECH. 292, 292-93 (2002).

*Protection*<sup>139</sup> and for the purposes of relevant rules of international law,<sup>140</sup> the WTO dispute settlement body confirmed that the VCLT forms part of customary international law.

But given that the international protection of intellectual property was unenforceable during the Berne era and the fact that no dispute or complaint ever reached the ICJ, which had jurisdiction to interpret the Berne Convention, it was only during the interpretation of TRIPS that the provisions of the Berne Convention were called into question. In cases such as *US Section 211 Omnibus*,<sup>141</sup> the WTO dispute settlement body confirmed that Berne Provisions were an integral part of TRIPS and thus the WTO. What was remarkable about *US Section 211 Omnibus* was that for the first time, the Berne Convention was put into sharp focus and interpreted within the context of a public international law dispute settlement body on trade and intellectual property rights.<sup>142</sup> This allowed the WTO to effectively side-line the jurisdictional role that the ICJ plays in the Berne Convention.<sup>143</sup> Another case in the WTO that touched upon trademarks within the context of interpreting the Berne Convention was *EC Trademarks and Geographical Indications*,<sup>144</sup> which was equally important and also raised more questions about the status of international trademarks agreements in general. The next section discusses those agreements.

#### V. TRADEMARK TREATIES AND THE GLOBALISATION OF TRADEMARK NORMS

This section introduces a discussion on trademarks, that is, it frames trademark protection within the context of international law by looking at the roles that trademark protection and trademark treaties play in the global system of intellectual property. As a cautionary note, the trademarks discussion in this section is only a mere overview.

Three primary questions are addressed that link trademarks to privatization

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<sup>139</sup> *India – Patent Protection* (1997), *supra* note 137, ¶ 46. (“These rules must be respected and applied in interpreting the TRIPS Agreement or any other covered agreements. ... Both panels and the Appellate Body must be guided by the rules of treaty interpretation set out in the Vienna Convention, and must not add to or diminish rights and obligations provided in the WTO Agreement.”).

<sup>140</sup> *E.g.*, Appellate Body Report, *United States—Definitive Antidumping and Countervailing Duties on Certain Products from China*, WT/DS379/AB/R (adopted Mar. 11, 2011), ¶¶ 312 – 313.

<sup>141</sup> Panel Report, *United States—Section 211 of Omnibus Appropriations Act of 1998*, WTO Doc. WT/DS176/AB (adopted Jan. 2, 2002) [hereinafter *Section 211*].

<sup>142</sup> *But see* Panel Report, *United States – Section 110(5) of US Copyright Act*, WTO Doc. WT/DS160/R (adopted June 15, 2000) [hereinafter *Section 110(5)*].

<sup>143</sup> There are no known cases at the ICJ that addressed/interpreted the Berne Convention.

<sup>144</sup> Panel Report, *European Communities—Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs*, WTO Doc. WT/DS290/R (adopted 2006).

narrative in this article and also frame trademark protection as part of the systematic globalisation of intellectual property rights that began in the 1880s with *proper* intellectual property treaties such as the Paris/Berne system on “industrial property” and copyright, but which excluded a proper trademark convention.<sup>145</sup> Of course, the Paris Convention addressed trademarks, but trademarks at the time lacked *preferential treatment* via a convention. Since then, however, a myriad of international treaties governing various aspects of trademarks came into existence, with the pre-TRIPS trademark treaties all bearing the Eurocentric names of the capitals where they were concluded.<sup>146</sup> The major pre-TRIPS trademark treaties and conventions are: the Paris Convention (1883) (selected parts); the Madrid Agreement (1891); the Nice Agreement (1957); the Vienna Agreement (1973); the Madrid Protocol (1989) and the Trademark Law Treaty (1994).<sup>147</sup> The Madrid Agreement belonged to the era of the Paris/Berne system, and if *royal* titles were to be bestowed upon it—the Madrid Agreement is in one sense the grand-duke of international trademark law.

Although the Madrid Agreement was enacted as a separate piece of international legislation in the late 1880s, it too has a similar history to the Paris/Berne system: European “industrial proprietors” were in search of international legal solutions that were plaguing the “counterfeiting” of their goods.<sup>148</sup> There was also a similar concern in the United States<sup>149</sup>—even the American Trademark Act of 1870 had an international focus.<sup>150</sup> Furthermore, due to the first wave of globalisation, European countries were busy enacting a number of domestic laws regulating various economic activities in their jurisdictions.<sup>151</sup> Laws relating to the domestic regulation of trademarks were one such set of laws enacted in various European states in the latter part of the

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<sup>145</sup> Paris Convention, *supra* note 23, art. 1(2). The Paris Convention was much more about trademarks, but “industrial property”, which concerns “patents, utility models, industrial designs, trademarks, service marks, trade names, and indications of source or appellations of origin, and the repression of unfair competition.”

<sup>146</sup> See Trademark Treaties, *supra* note 9. The only major challenge to build an international intellectual property structure that could challenge or mimic those in Europe came from Latin America, where some members were also signatories to the “global” intellectual property initiatives led by Europe. See, e.g., Horatio Rangel-Ortiz, Regional Trade Agreements in Latin American and Intellectual Property, Address at the Annual Meeting of the International Association of Teachers and Researchers in Intellectual Property (July 11-13, 2005).

<sup>147</sup> See Trademark Treaties, *supra* note 9.

<sup>148</sup> Madrid Agreement Concerning the International Registration of Marks of Apr. 14, 1891 (as amended on Sept. 28, 1979), 828 U.N.T.S. 39, art. 2, *9ter* [hereinafter Madrid Agreement].

<sup>149</sup> See Paul DuGuid, *French Connections: The International Propagation of Trademarks in the Nineteenth Century*, 10 ENTERPRISE & SOC’Y. 3 (2009).

<sup>150</sup> See *In re Trade-Mark Cases*, 100 U.S. 82, 88 (1879), (“The act is a regulation of foreign commerce.”).

<sup>151</sup> See, e.g., The Trade Marks Registration Act 1875 (38 & 39 Vict. c. 91).

nineteenth century.<sup>152</sup>

Some European states such as Germany and Belgium were initially sceptical about trademark protection, but when the U.S. took steps and signed bilateral treaties with countries such as Russia and France,<sup>153</sup> frantic efforts were made to enact domestic laws regarding trademark protection in different European states.<sup>154</sup> Those efforts would later lead to the trademark provisions of the Paris Convention and also the Madrid Agreement.

The Madrid Agreement is in principle based on the Paris Convention given that Article 19 of the Paris Convention allows members “the right to make separately between themselves special agreements for the protection of industrial property.”<sup>155</sup> However, what separates the Madrid Agreement (and indeed the other trademark treaties) from the Paris Convention is that the former deals mostly with registration and the procedural aspects of trademarks.<sup>156</sup> The exception to this is the Trademark Law Treaty. The main characteristic of the Madrid Agreement is its global registration system and single payment system.<sup>157</sup> Because of its largely procedural role, the Madrid Agreement has to be seen as part of the Paris *system*, and as such, it excludes domestic laws on trademark protection but uphold the principle of territoriality.<sup>158</sup>

The other treaty in the international system of trademark registration was the Trademark Registration Treaty, which sought to offer an alternative international trademark registration for states which were not satisfied with the Madrid Agreement.<sup>159</sup> Unfortunately, that treaty only created more self-inflicted problems for the international trademark system as it did not gain many signatories.<sup>160</sup> The Madrid Protocol<sup>161</sup> made a similar attempt to enhance the international registration of trademarks and offer more procedural languages

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<sup>152</sup> *Id.*

<sup>153</sup> See Zvi S. Rosen, *In Search of the Trade-Mark Cases: The Nascent Treaty Power and the Turbulent Origins of Trademark Law*, 83 ST. JOHN’S L. REV. 827, 835 (2018) (“The first [U.S.] trademark treaty was signed with Russia in 1868, followed shortly thereafter by treaties with Belgium and France.”).

<sup>154</sup> *Id.* at 834 (discussing Belgium and Germany).

<sup>155</sup> Paris Convention, *supra* note 23, art. 19.

<sup>156</sup> Madrid Agreement, *supra* note 148, arts. 1, 3.

<sup>157</sup> *Id.* art. 8.

<sup>158</sup> See Schmidt-Szalewski, *supra* note 64, at 203.

<sup>159</sup> *Id.*

<sup>160</sup> See David Allen, *The Trademark Registration Treaty: Its Implementing Legislation*, 21 IDEA 161 (1980).

<sup>161</sup> The Madrid Protocol is not to be confused with the Madrid Agreement as these are two distinct “international trademark agreements.” See Thorsten Klein, *Madrid Trademark Agreement vs. Madrid Protocol*, 12 J. CONTEMP. LEGAL ISSUES 484 (2001). What separates the Madrid Protocol from the Madrid Agreement is the application for an international trademark based on the basic application in the home country, and also extends the opposition period to 18 months. *Id.* at 486. Other distinctions also exist. *Id.*

such as English, national application and extended notification procedures, but it too has largely initially suffered due to the lack of a number of a significant amount of signatories.<sup>162</sup>

The only international treaty outside of the trademark registration system is the Trademark Law Treaty designed to harmonise and simplify national registration of trademarks. However, given that the Trademark Law Treaty was ratified in 1994, it too would suffer a fate similar to TRIPS in some respect, and in some respects it has had not the desired effect.<sup>163</sup> The latest version—the Singapore Trademark Law Treaty—has a few advantages over its predecessor in that it is the first international treaty to recognise non-traditional marks.<sup>164</sup>

The impact of the harmonisation and “uniformification” process that the trademark treaties covered and attempted prior to the existence of TRIPS actually singled out one major problem that was and still remains a sticking point in international trademark law: territoriality.<sup>165</sup> Trademarks are not *exactly* territorial despite the existence of domestic laws regulating trademarks in domestic jurisdictions only.<sup>166</sup> Trademarks are symbols of global economic commerce and relegating trademarks to a single territory does not fit the modern needs of global economic commerce. The existence of territoriality for the

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<sup>162</sup> As of October 2019, some 100 countries acceded to the Madrid Protocol, *see* [https://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid\\_marks.pdf](https://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf).

<sup>163</sup> *See also* Richard Cheng, *Pros and Cons of the Trademark Law Treaty*, 12 J. CONTEMP. LEGAL ISSUES 480 (2001).

<sup>164</sup> Singapore Treaty on the Law of Trademarks (Mar. 27 2006), Rule 3(10) on non-visible trademarks. *See also* Qian Zhan, *The International Registration of Non-Traditional Trademarks: Compliance with the TRIPS Agreement and the Paris Convention*, 16 WORLD TRADE REV. 111, 122-124 (2017); Constance R. Lindman, *Trademark Boundaries: The Geography of Non-Conventional Marks*, 20 SMU. SCI. & TECH. L. REV. 213 (2017); Samay Gheewala, *Singapore Sling: WIPO Passes the Buck on Meaningful Reform of International Trademark Law*, 17 DEPAUL-LCA J. ART & ENT. L. 305, 313 (2006).

<sup>165</sup> *See also* Kenneth L. Port, *Trademark Harmonization: Norms, Names and Nonsense*, 2 MARQ. INTELL. PROP. L. REV. 33 (1998) (“The old territorial understandings of jurisdiction need to be reconsidered when attempting to arrive at an international standard for trademark protection. Because goods flow in a market, which has become truly international, the laws that protect the indications of source or origin used on or in connection with the sale of these goods and services is also international. Truly, as long as the world community slavishly adheres to territorial justifications for sovereignty and jurisdiction, “harmonization” of trademark laws will be impossible. In fact, the universality of markets for trademark bearing goods was one of the original objectives relied upon in the creation of the Lanham Act.”) (citations omitted). Although, speaking purely in a domestic context, Port’s arguments truly apply in the international context, and they also capture the elements of this article. *See, e.g., id.* at 36 (“The territorial theories of sovereignty severely restrict the notion of one global system of trademark law to mirror the one global market place.”).

<sup>166</sup> Trademark laws are territorial, however, trademarks such as Coco-Cola can be found in almost every country and as such, it is the domestic laws of each country that regulates the use of trademark on its territory. *But see* *Trader Joe’s Co. v. Hallatt*, 835 F.3d 960 (9th Cir. 2016).

purposes of trademark use in the global economic structure of commerce, in which trademarks are the lead signals of transactions, only diminishes the scope and appeal of extraterritoriality of intellectual property laws relating to trademark use. This reduction in the ability to apply intellectual property laws extraterritorially in turn, on the one hand prevents sovereign intervention in a state but also creates negative effects for global economic progress.<sup>167</sup>

The alternative, which the Trademark Law Treaty attempted to achieve, was harmonisation<sup>168</sup> of the global registration procedures for trademarks, and it was a credible attempt. The death knell of the Trademark Law Treaty was the TRIPS Agreement, as it went further than the Trademark Law Treaty and previous treaties in two ways.

First, TRIPS was able to offer “greater minimum standards” of protection than what the previous intellectual property treaties could afford.<sup>169</sup> That is, the TRIPS was more advanced than the Paris Convention and the other trademark treaties. Second, due to some overlapping functions of the TRIPS Agreement and previous treaties involving trademarks, states were more impressed with the dispute settlement system of the TRIPS.<sup>170</sup> In addition, TRIPS achieved what the Paris and other intellectual property treaties failed to achieve: a global system for the protection of intellectual property and a modern international intellectual property legal system. Crucial to this modern era of international intellectual property law was the most-favoured nation (MFN) principle, which is one of the pillars of international law.<sup>171</sup> Thus, what the Paris/Berne system and other intellectual property regimes of a global nature lacked, the TRIPS crystallised with minimum standards.

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<sup>167</sup> The arguments on this subject matter are complex, *but see* Graeme Dinwoodie, *Trademarks and Territory: Detaching Trademark Law from the Nation State*, 41 HOUS. L. REV. 885 (2004).

<sup>168</sup> For a useful discussion from the point of view of international intellectual property treaties in relation to trademarks, *see* Timothy W. Blakely, *Beyond the International Harmonization of Trademark Law: The Community Trade Mark as a Model of Unitary Transnational Trademark Protection*, 149 U. PA. L. REV. 309. *See also id.* at 322 (“Despite its initial goals of providing for comprehensive and substantive harmonization of all aspects of international trademark law, in the end, the [Trademark Law Treaty] has provided little more than a greater system of procedural harmonization for the registration and maintenance of trademark rights.”).

<sup>169</sup> *See, e.g.*, Jerome Reichman, *Universal Minimum Standards of Intellectual Property Protection under the TRIPS Component of the WTO Agreement*, 29 INT’L LAWYER 345 (1995); Alison Slade, *The Objectives and Principles of the WTO TRIPS Agreement: A Detailed Anatomy*, 53 OSGOODE HALL L.J. 948 (2015).

<sup>170</sup> *See, e.g.*, Jose Felgueroso, *TRIPS and the Dispute Settlement Understanding: The First Six Years*, 30 AIPLA Q. J. 165 (2002); Rochelle Cooper Dreyfuss and Andreas Lowenfeld, *Two Achievements of the Uruguay Round: Putting TRIPS and Dispute Settlement Together*, 37 VA. J. INT’L L. 275 (1996).

<sup>171</sup> TRIPS Agreement, *supra* note 1, arts. 3–4.

However, there is one crucial question to answer given the existence of trademark treaties and/or treaties with significant trademark provisions in the pre-TRIPS era: was there such a thing as international trademark law? Relying on the Paris Convention, the Madrid Agreement, the Trademark Law Treaty, and various other trademark related treaties, the answer is “no.” There were international acceptable standards for trademarks, but that did not mean that there was in fact international trademark law.<sup>172</sup> Furthermore, the lack of a dispute settlement system relating to problems and the creation of norms in international trademarks in the pre-TRIPS era further complicated the task of creating a system of international trademark law. But given that the situation changed after TRIPS, is there international trademark law today?

#### VI. TRIPS, INTERNATIONAL TRADEMARK LAW AND THE PRIVATE DIMENSION OF INTELLECTUAL PROPERTY

This section is concerned with two related questions. The first, (1) is there international trademark law, (2) and if so, how much does the private dimension of trademarks influence the creation of “international trademark law”? The answers to these two questions lie in an examination of the post-TRIPS era. This is because it is the post-TRIPS era have produced most of the international case law in the WTO dealing with intellectual property where broadly trademarks can reveal the dimension of international trademark law.<sup>173</sup> Pre-TRIPS Agreements, such as those discussed in the previous section, did in fact generate norms on international trademark law.<sup>174</sup> However, they never fully created a *system* of international trademark law.

If my earlier characterisation of the Paris Convention as the *grandmother* of international intellectual property treaties, and the Madrid Agreement as the *grand-duke* of international trademark law touched upon any nerves, then a similar characterisation of TRIPS should not be surprising. In fact, in international intellectual property law in the modern sense, all roads lead to the TRIPS Agreement. The TRIPS Agreement is the epicenter of the international intellectual property system that has formed a grand dynasty comprised of the Paris/Berne system of industrial property and copyright and to some extent the

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<sup>172</sup> But see Marshall A. Leaffer, *The New World of International Trademark Law*, 2 MARQ. INTELL. PROP. L. REV. 1 (1998).

<sup>173</sup> Section 211, *supra* note 141.

<sup>174</sup> But see Tai-Heng Cheng, *Power, Norms and International Intellectual Property Law*, 28 MICH. J. INT'L L. 109 (2006); Marshall A. Leaffer, *The New World of International Trademark Law*, 2 MARQ. INTELL. PROP. L. REV. 1 (1998); Linda B. Samuels and Jeffrey M. Samuels, *The Changing Landscape of International Trademark Law*, 27 GEO. WASH. J. INT'L L. & ECON. 433 (1993); James R. Holbein, and Laurinda L. Hicks, *Convergence of National Intellectual Property Norms in International Trading Agreements*, 12 AM. U. J. INT'L L. & POL'Y. 769 (1997).

Madrid system of trademark registration.<sup>175</sup> As the epicenter, the TRIPS is more akin to the Vatican-like *system royale*.

This grand dynasty which the TRIPS created is of biblical proportion—it was the genesis of a new era that defines the scope and content of international intellectual property law for some time now. But despite the *holy* and *royal* foundation of the TRIPS Agreement, its dynastic and *religious-like influence* has been under attack from the very beginning, though such criticisms fail to take into account the similar history of the Paris/Berne system.<sup>176</sup> Those criticisms, coming from various wings in the global *diocese* of the Vatican-like TRIPS *system royale*, who have influence or can direct influence, such as *opus dei* left political splinter groups (calling for the reform of the TRIPS) or arch conservatives *eucharist* legal commentators (embracing TRIPS-plus types of agreement), have caused a general divisiveness in the holy realm of global intellectual property.<sup>177</sup>

Those who oppose the TRIPS Agreement, do so because they see TRIPS as representing only the commercial interests of corporations.<sup>178</sup> On the other hand, the few TRIPS enthusiasts see the agreement as a tool of (legal) globalization.<sup>179</sup>

The TRIPS Agreement incorporates the principle of national treatment, requiring members to accord the treatment provided for in the agreement to the nationals of other members.<sup>180</sup> Furthermore, the most favoured nation principle of the TRIPS Agreement provides that any advantage, favour, privilege or immunity granted by a Member to the nationals of any country shall be equally applied to all nationals of the other Member countries.<sup>181</sup> From the point of view of the TRIPS negotiators, the agreement provided minimum standards as a blanket agreement, meaning one size fits all.<sup>182</sup>

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<sup>175</sup> See TRIPS Agreement, *supra* note 1, art. 1(3) (referring to a host of intellectual property treaties incorporated into the TRIPS Agreement).

<sup>176</sup> See, e.g., Daya Shanker, *Legitimacy and the TRIPS Agreement*, 6 J. WORLD INTELL. PROP. 155 (2003); M.A. Hamilton, *The TRIPS Agreement: Imperialistic, Outdated, and Overprotective*, 29 VAND. J. TRANS. L. 613 (1996).

<sup>177</sup> One commentator perhaps captures the various bargaining of TRIPS simply as “discontents”, see Peter Yu, *TRIPS and its Discontents*, 10 MARQ. INTELL. PROP. L. REV. 369, 410 (2006) (noting that the various contentious narratives on the TRIPS fails to “fully explains the development of the Agreement”).

<sup>178</sup> See generally *Intellectual Property and Public Policy in Historical Perspective*, *supra* note 51.

<sup>179</sup> See generally Bobak Razavi and Alan M. Anderson, *The Globalization of Intellectual Property Rights: TRIPs, BITs, and the Search for Uniform Protection*, 38 GA. J. INTL’ & COMP. L. 265 (2010).

<sup>180</sup> See generally WOLTERS KLUWER, INTRODUCTION TO INTELLECTUAL PROPERTY: THEORY AND PRACTICE (WIPO eds., 2d ed., 1997).

<sup>181</sup> *Id.* at 478.

<sup>182</sup> See THE STRUCTURE OF INTELLECTUAL PROPERTY LAW—CAN ONE SIZE FIT ALL? (Annette Kur and Vytautas Mizaras eds., 2011).

Intellectual property in the broadest scope is “universal” and reaches all corners of the globe. According to this reasoning, the universal nature of intellectual property and the goods and services that carry this legal gatekeeper of private economic operators should not be diluted on a country by country basis. In other words, territorial sovereignty is a threat to the system of global intellectual property regulation. The “benefits of intellectual property protection globally outweigh the harm, whatever the stage of a country’s development. Thus, a uniform intellectual property system makes sense for the world.”<sup>183</sup> When this view is weighed in addition to matters concerning global investment, the implication is that investments would flow or increase as a result of a uniform intellectual property system, technology would be more accessible to lesser developed countries, and vaguely descriptive concerns about “competitiveness and innovation” would increase.<sup>184</sup>

Indeed, these issues were the main arguments advanced in favour of a global intellectual property system.<sup>185</sup> But those arguments were not sufficiently debated, or at least, those who opposed that line of reasoning never made their positions quite forcefully.<sup>186</sup> Yet, as time came to pass, it was revealed that a uniform intellectual property system did not make sense for the world. Or, at least, that is what the continued evolution of the global intellectual property system demonstrated in the fight over public health, legal obligations, level of development, and the rights of global corporations.<sup>187</sup>

Sell portrays that divisiveness rather powerfully in *Private Power, Public Law*, detailing the open efforts of American intellectual property corporate owners to shape the global intellectual property system: “[i]n effect, twelve corporations made public law for the world. The combination of the increasing openness of the US system to private influence and the changing structural position of the United States in the world economy provided an opening for corporate influence.”<sup>188</sup> In a similar vein, and writing at the same time, Clair Cutler provides an equally bleak assessment of how private actors shape the global economic system through law, creating a legitimacy crisis due to the role of a global corporate elite or “mercatorcracy.”<sup>189</sup> The global intellectual property

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<sup>183</sup> Robert M. Sherwood, *Why a Uniform Intellectual Property System Makes Sense*, GLOBAL INTELLECTUAL PROPERTY RIGHTS IN SCIENCE AND TECHNOLOGY 68 (Mitchel B. Wallerstein et al. eds., 1993).

<sup>184</sup> See TRIPS Agreement, *supra* note 1, arts. 7–8 which are widely seen as “balancing provisions” to meet the needs of the developing world.

<sup>185</sup> But see Gerald J. Mossinghoff, *The Importance of Intellectual Property Protection in International Trade*, 7 B.C. INT’L & COMP. L. REV. 235 (1984).

<sup>186</sup> See Peter M. Gerhart, *The Tragedy of the TRIPS*, 2007 MICH. ST. L. REV. 143 (2007).

<sup>187</sup> *Id.*

<sup>188</sup> PRIVATE POWER, PUBLIC LAW, *supra* note 13, at 96-97.

<sup>189</sup> CLAIRE CUTLER, PRIVATE POWER AND GLOBAL AUTHORITY: TRANSNATIONAL MERCHANT LAW IN THE GLOBAL POLITICAL ECONOMY 4-5 (2003) (“The mercatorcracy

system can be described using Cutler's mercatorcracy, as it is the essential element that maintains global capitalism and how the law permeates and reinforces such mercatorcracy.<sup>190</sup> What is however, important is that these early works have led the assault on global intellectual property regulation, at least in the post-TRIPS era.<sup>191</sup> Moreover, these works combine law and politics to demonstrate that one size does not fit all.

The critical response from most of the legal literature on the TRIPS Agreement has been somewhat positive, with relatively few dissenters.<sup>192</sup> The reasons for the positive response to the TRIPS Agreement by legal scholars, including myself, are varied. However, what most of those responses lacked was a contextual defence of the global intellectual property system in light of works such as those of Cutler and Sell.

The TRIPS Agreement in its current form is the principal instrument of international intellectual property law.<sup>193</sup> It has mobilised most other international intellectual property instruments, such as the Paris and Berne Conventions under its corpus.<sup>194</sup> Furthermore, all other international intellectual property instruments are generally compatible with TRIPS or ensure that obligations have the minimum standard requirements set out in TRIPS. This also applies to bilateral and regional intellectual property instruments. What separates the TRIPS Agreement from previous international intellectual property instruments is the dispute settlement provision, which provides for recourse to the WTO DSB.

Thus, as was demonstrated in *India—Patents*, TRIPS provide a robust enforcement mechanism for disputes in international law. What this means is that states that are found to be in violation of the TRIPS Agreement (and WTO rules more broadly) are required to bring their laws into compliance with TRIPS.<sup>195</sup> However, given the trajectory of disputes relating to the TRIPS Agreement in the WTO, it has been mostly a David versus Goliath situation,

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operates globally and locally to develop new merchant laws governing international commerce and the settlement of international commercial disputes and to universalise the laws through the unification and harmonisation of national commercial legal orders. As a complex mix of public and private authority, the mercatorcracy blurs the distinction between public and private commercial actors, activities and law.”)

<sup>190</sup> *But see id.*

<sup>191</sup> *See, e.g., PRIVATE POWER, PUBLIC LAW, supra note 13.*

<sup>192</sup> The dissenting opinions on the TRIPS Agreement in the legal literature are more prevalent in legal journals as opposed to monographs or edited collections. *See, e.g.,* Marci A. Hamilton, *The TRIPS Agreement: Imperialistic, Outdated, and Overprotective*, 29 VAND. J. TRANSNAT'L L. 613 (1996); DUNCAN MATTHEWS, *GLOBALISING INTELLECTUAL PROPERTY RIGHTS: THE TRIPS AGREEMENT* (Shaun Breslin et al. eds., 1st ed., 2002); JAYASHREE WATAL, *INTELLECTUAL PROPERTY RIGHTS IN THE WTO AND DEVELOPING COUNTRIES* (1st ed., 2001).

<sup>193</sup> *See TRIPS Agreement, supra note 1.*

<sup>194</sup> *Id.* art. 1(3).

<sup>195</sup> *See India – Patent Protection* (1997), *supra note 137.*

where the U.S. or the proverbial David has been predominantly a complainant about TRIPS compliance. Furthermore, the U.S., when faced with adverse rulings by the WTO such as in the *United States – Section 110(5) of US Copyright Act*,<sup>196</sup> generally fails to amend its laws to be TRIPS compliant.<sup>197</sup>

The TRIPS Agreement is divided into seven parts consisting of seventy-three articles.<sup>198</sup> Articles 1–8 contains the basic provisions and the general provisions in general. Articles 9–40 contains the substantive provisions of the TRIPS Agreement, whilst Articles 41–61 set out the comprehensive rules regarding the enforcement of rights. Article 62 regulates the acquisition and maintenance of intellectual property, whilst Articles 63–64 covers dispute settlement. Articles 65–67 contains the transitional rules and Articles 68–73 covers the institutional arrangement of the TRIPS.<sup>199</sup>

For instance, the protection of trademarks under the TRIPS Agreement is contained in Articles 15–21.<sup>200</sup> Article 15(1) gives what is considered to be an international definition of trademarks.<sup>201</sup> The provisions on trademarks in the TRIPS Agreement are modelled off of the E.U. trademark law as contained in the Trademark Directive of 1989.<sup>202</sup> According to Article 16(1) of TRIPS, trademark rights are those conferred exclusively to the owner of registered trademarks.<sup>203</sup> The TRIPS trademark rights provision also echoes the other international intellectual property treaties, such as the Paris Convention, on trademark rights (although a trademark is not defined in the Paris Convention).<sup>204</sup> This is essential, especially in relation to well-known trademarks where “the

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<sup>196</sup> *Section 110(5)*, *supra* note 142.

<sup>197</sup> As of November 2019, the US informed the WTO that “The US Administration will work closely with the US Congress and will contribute to confer with the European Union in order to reach a mutually satisfactory resolution of this matter.” *See* Status Report by the United States (Nov. 12, 2019), Doc No. 19-7707, [https://www.wto.org/english/tratop\\_e/dispu\\_e/cases\\_e/ds160\\_e.htm](https://www.wto.org/english/tratop_e/dispu_e/cases_e/ds160_e.htm).

<sup>198</sup> TRIPS Agreement, *supra* note 1; *see generally* 7 WTO: TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS - MAX PLANCK COMMENTARIES ON WORLD TRADE LAW 1 (Peter Tobias Stoll et al. eds., 1st ed., 2009) [hereinafter TRADE-RELATED ASPECTS].

<sup>199</sup> TRIPS Agreement, *supra* note 1, arts. 65–67, 68–73.

<sup>200</sup> *Id.* arts. 15–21.

<sup>201</sup> *Id.* art. 15(1).

<sup>202</sup> Council Directive 89/104/EEC, 1998 O.J. (L 040) 1, 1-7 (EC). *See also* Draft Agreement on Trade-Related Aspects of Intellectual Property Rights MTN.GNG/NG11/W/68, (1990).

<sup>203</sup> TRIPS Agreement, *supra* note 1, art. 16(1).

<sup>204</sup> From a trademark perspective, it can be argued that, given the various scattered provisions in the convention relating to trademarks, the Paris Convention is the first international trademark agreement. *See* TRADE-RELATED ASPECTS, *supra* note 198, at 118; *id.* at 304 (reiterating that prior to the TRIPS, the Paris Convention was the only international law instrument containing provisions on international trademark rights).

knowledge of the trademark in the relevant sector of the public” is important.<sup>205</sup> Because of these developments in TRIPS, the nature of international trademark law has since been transformed. It is a reminder that the once abandoned principle of universality of trademark rights<sup>206</sup> is resurrecting through international norms for trademark protection.

But what makes TRIPS (or broadly WTO law) a special vehicle for the unification of international law is its recourse to dispute settlement. Although the Paris/Berne System has recourse to dispute settlement via the ICJ, that mechanism has never been invoked. The TRIPS recourse to dispute settlement system is via the WTO DSB, and it has actually been invoked on several occasions in a number of TRIPS cases.<sup>207</sup> Disputes are to be referred to the DSB as set out in Article 64 in order for “the settlement of disputes under this Agreement.”<sup>208</sup> The intellectual property disputes that have made their way to the DSB of the WTO are small in number when compared to other trade-related disputes. At the end of December 2015, there were only ten intellectual property disputes were brought before the WTO.<sup>209</sup> Of those ten, only three that were decided were related to trademarks (and another six mostly relating to the plain packaging sagas),<sup>210</sup> with the most notable being the *Section 211 Omnibus*

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<sup>205</sup> TRIPS Agreement, *supra* note 1, art. 16(2); Paris Convention, *supra* note 23.

<sup>206</sup> See Walter J. Derenberg, *Territorial Scope of Situs of Trademarks and Good Will*, 47 VA. L. REV. 733, 734 (1961).

<sup>207</sup> See *Section 110(5)*, *supra* note 142; Panel Report, *Canada – Term of Patent Protection*, WTO Doc. WT/DS170/AB (adopted Oct. 12, 2000); Panel Report, *Canada – Patent Protection of Pharmaceutical Products*, WTO Doc. WT/DS114/R (adopted Apr. 7, 2000); Appellate Body Report, *India – Patent Protection for Pharmaceutical and Agricultural Chemical Products*, WTO Doc. WT/DS50/AB/ (adopted Jan. 16, 1998) [hereinafter *India – Patent Protection* (Jan. 1998)]; Panel Report, *India – Patent Protection for Pharmaceutical and Agricultural Chemical Products*, WTO Doc. WT/DS79/R/ (adopted Sept. 22, 1998) [hereinafter *India – Patent Protection* (Sept. 1998)]; Panel Report, *European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs*, WTO Doc. WT/DS290/R (adopted Apr. 20, 2005).

<sup>208</sup> TRIPS Agreement, *supra* note 1, art. 64(1).

<sup>209</sup> A representative sample includes: *Section 110(5)*, *supra* note 142; Panel Report, *Canada – Term of Patent Protection*, WTO Doc. WT/DS170/AB (adopted Oct. 12, 2000); Panel Report, *Canada – Patent Protection of Pharmaceutical Products*, WTO Doc. WT/DS114/R (adopted Apr. 7, 2000); *India – Patent Protection* (Jan. 1998), *supra* note 206; *India – Patent Protection* (Sept. 1998), *supra* note 207; Panel Report, *European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs*, WTO Doc. WT/DS290/R (adopted Apr. 20, 2005).

<sup>210</sup> Panel Report, *Indonesia – Certain Measures Affecting the Automobile Industry*, WTO Doc. WT/DS59/R (adopted July 2, 1998); Panel Report, *European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs*, WTO Doc. WT/DS174/R (adopted Mar. 15, 2005); *Section 211*, *supra* note 141; Panel Report, *China – Measures Affecting the Protection and Enforcement of Intellectual Property Rights*, WTO Doc. WT/DS362/P (adopted Jan. 26, 2009); Panel Report, *Australia – Certain Measures Concerning Trademarks and Other Plain Packaging Requirements Applicable to Tobacco*

case.<sup>211</sup>

In the *Section 211 Omnibus* dispute, the WTO found that U.S. intellectual property rules pertaining to trademarks were violating the TRIPS Agreement. The dispute was largely whether the U.S. had the right to prevent the registration of a trademark that was confiscated in Cuba by “American” entrepreneurs, even when such entrepreneurs were not physically in the U.S. The WTO said they had no such right. What was interesting about the *Section 211 Omnibus* dispute was the fact that private property was at its centre of gravity: capitalism versus communism. Furthermore, it was the role of international law, or the rules of the WTO, to play peacemaker. The U.S. had introduced rules that were in the spirit of free market, whilst the opposite was taking place in Havana, the *right* to confiscate private property. But in doing so, the U.S. fell short of its international law obligations in the TRIPS Agreement, hence, the WTO said the U.S. rules were a direct violation of international law.<sup>212</sup> The WTO, on this occasion, asserted the omnipotence of the TRIPS Agreement in international law.<sup>213</sup>

One of the more far-reaching effects of TRIPS in relation to trademark laws worldwide is that the subject matter that trademark covers has been continuously expanding, covering even “unorthodox indicia of origin.”<sup>214</sup> Furthermore, TRIPS has more than ever harmonised international trademark laws to the extent that “harmonising trends point to diminishment of territoriality as the organising principle of trademark law, as well as for other breaches of intellectual property law.”<sup>215</sup> It is this demise of territoriality by intellectual property law, or at least in this context, trademark law that presents the complex sets of problems; namely, (1) harmonising at the global level, and (2) the existence of national intellectual property laws and the conflict that each set of laws produces. Furthermore, (3) what is the appropriate response of national laws to conflicts brought about by international intellectual property laws? Some of these questions are best approached through substantive private international law.<sup>216</sup>

At this stage, however, it could be submitted that TRIPS does not significantly depart from national decisions that are decided under domestic private international law. This is because, TRIPS requires the minimum standard

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*Products and Packaging*, WTO Doc. WT/DS434, WT/DS435, WT/DS441, WT/DS458, WT/DS467 (2012–2013).

<sup>211</sup> *Section 211*, *supra* note 141.

<sup>212</sup> *Id.*

<sup>213</sup> *Id.*

<sup>214</sup> Marshall Leaffer, *The New World of International Trademark Law*, 2 MARQ. INTELL. PROP. L. REV. 1, 8 (1998); *see also* Qian, *supra* note 164, at 122 (discussing non-traditional trademarks).

<sup>215</sup> Leaffer, *supra* note 214, at 9 (“Dogmatic territoriality, when applied to intellectual property, ignores basic reality because informational products cannot be located at a particular spot on the globe.”).

<sup>216</sup> *But see* Morris, *supra* note \*, where the full discussions have been carried out.

in protection and at the national level. Domestic intellectual property rules are in fact rules reflecting their international character.<sup>217</sup> Local intellectual property rules afford national treatment to foreign private owners based on the state's obligations under international law (TRIPS or Berne).<sup>218</sup>

Further, under the WTO, panels are tasked with interpreting laws related to intellectual property in domestic jurisdictions that are compatible with the TRIPS Agreement. And in *Havana Rum* for instance, the Appellate Body noted that that a textual approach is always the starting point for interpreting treaties and as codified in the VCLT.<sup>219</sup> This is in line with the mandate of the DSB as outlined in Article 3.2 of the WTO Dispute Settlement Understanding (DSU) that panels are to clarify the covered agreements in line with rules of interpretation under international law. Thus, a TRIPS panel, when interpreting the compatibility of domestic law with TRIPS, must also take into account the state and shape of domestic intellectual property rules and how far they are in conflict with their international counterparts.<sup>220</sup>

## VII. THE CREATION OF PRIVATE RIGHTS UNDER INTERNATIONAL INTELLECTUAL PROPERTY LAW

One of the hallmarks of the first international intellectual property treaty, the Paris Convention, is that it recognises patents, trademarks and other “industrial property” as private property.<sup>221</sup> This is significant, because, it was the first time that an international treaty negotiated by states thrust into the limelight domestic economic matters that are private in nature as an important part of the international economic system. Moreover, even though industrial properties were private in nature, they were intertwined with public policy and, as such, they became either “public goods”, (i.e. for the general public) or they form part of a state's public policy.<sup>222</sup>

But the relevance and potency of intellectual property rights as private rights did not end with the Paris Convention. The Paris Convention was incorporated into the TRIPS Agreement, and so too was its recognition of the relevance of intellectual property rights as private rights. Under the TRIPS Agreement

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<sup>217</sup> TRIPS Agreement, *supra* note 1, art. 1(1): (“Members may, but shall not be obliged to, implement in their law more extensive protection than is required by this Agreement...”).

<sup>218</sup> See TRIPS Agreement, *supra* note 1, art. 3(1).

<sup>219</sup> Section 211, *supra* note 141, ¶ 4.32

<sup>220</sup> See also Patrick L. Wojahn, *A Conflict of Rights: Intellectual Property Under TRIPS, The Right to Health and AIDS Drugs*, 6 UCLA J. INT'L L. & FOR. AFF. 463, 491-496 (2001).

<sup>221</sup> Article 1(2) of the Paris Convention provides for a broad approach to “industrial property” especially as it relates to “industry and commerce proper”, and my interpretation of this is that it reflects private property ownership, *but see* TRIPS Agreement, *supra* note 1, Preamble (4th recital).

<sup>222</sup> See also Kronstein & Till, *supra* note 52.

however, intellectual property rights are explicitly recognised as private rights. This recognition came in the form of a terse statement in recital 4 of the TRIPS Agreement preamble, where members acknowledge that “intellectual property rights are private rights.”<sup>223</sup> This provision of the recitals has significance in a number of ways, but most importantly, it makes clear that “[m]embers are not required to proceed *ex officio* against infringements of intellectual property rights, but that this task is primarily assigned to the dominant claimant, who bears the burden of exercising and defending his or her rights.”<sup>224</sup> It is through this provision in the recitals that the TRIPS imposes its intervention in the domestic trajectory of national law making, because it “deeply interferes with national discretion in establishing rights that can be claimed by private parties in national jurisdictions.”<sup>225</sup> The recognition of intellectual property rights as private rights in the TRIPS Agreement is also a logical acknowledgment that the state is the enabler and guarantor of the private interests of domestic rights owners at the international level.

The recognition by the TRIPS Agreement that intellectual property rights are private rights should not be a surprise. This is so given that, as similarly observed by Seckelmann,<sup>226</sup> the propertisation and legal creation of property has been the hallmark of law and economic relations for over a century.<sup>227</sup> In this context, “the history of the formation of the international system protecting intellectual property rights can be seen as a history of propertisation.”<sup>228</sup> What TRIPS did was to simply endorse the customary norms that have been present in the economic expansion of societies and the ways in which those societies guaranteed creative innovation. Furthermore, when the history of law-making is fully considered, economic relations have always been at the heart of how law develops; and private property remains at the center of such legal and economic relations.<sup>229</sup>

The very emergence of international law, especially from the seventeenth century, has been predominantly related to natural resources and ownership of property,<sup>230</sup> and how the law of nations responded via various treaties. States were either being colonised with a view to owning colonial property or accessing

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<sup>223</sup> TRIPS Agreement, *supra* note 1, at 4th recital.

<sup>224</sup> See TRADE-RELATED ASPECTS, *supra* note 198, at 71.

<sup>225</sup> *Id.*

<sup>226</sup> See Margrit Seckelmann, *From the Paris Convention (1883) to the TRIPS Agreement (1994): The History of the International Patent Agreements as a History of Propertisation*, 14 JOURNAL DER JURISTISCHEN ZEITGESCHICHTE 38, 46 (2013).

<sup>227</sup> *Id.*

<sup>228</sup> See Seckelmann, *supra* note 226.

<sup>229</sup> See, e.g., Stanley D. Metzger, *Property in International Law*, 50 VA. L. REV. 594 (1964).

<sup>230</sup> See, e.g., ANDREW FITZMAURICE, *SOVEREIGNTY, PROPERTY AND EMPIRE, 1500–2000* (2014).

colonial resources, to rephrase the early twentieth century Soviet legal scholar Evgeny Pashukanis, creating inequality in the property system of international law.<sup>231</sup> On the other hand, property ownership was part of the peace settlements relating to various conflicts.<sup>232</sup> Most of the settlements regarding ownership of properties over the centuries related to private economic operators that were actively engaged in trade, commerce, and conflicts.<sup>233</sup>

Moreover, the emergence of international law in relation to private rights such as those in property or other economic assets goes to show how the two branches of law, public international law and private international law, were also drawn to each other. Private (property) rights were attached to sovereign state domestic laws, and that sovereign state could in turn use the norms of public international law to settle conflicts regarding private property rights at the international level.<sup>234</sup> A significant case, *Barcelona Traction* dispute at the ICJ, highly reflects the complicated relationship between private rights in property and that of international law.<sup>235</sup>

But what is significant about property rights in the international context is that as a method of legal control of acquired rights, such private rights as sanctioned by law are able to do two things: (1) commodify resources that are endemic to a sovereign state and (2) commodify the intellectual creations of private citizens beyond sovereign state boundaries.<sup>236</sup> The latter, private rights in intellectual property, has since the 1880s enjoyed great amount of leverage under international law through various treaties from the Paris/Berne System through the TRIPS Agreement.

International intellectual property treaties cover the various private rights of intellectual creations such as copyrights, patents, and trademarks.<sup>237</sup> In the process, the treaties enshrine those rights as *property* rights in sovereign states, which have obligations under international law to ensure compliance with those rights.<sup>238</sup> What differentiates the private rights of intellectual property from other

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<sup>231</sup> EVGENY B. PASHUKANIS, *THE GENERAL THEORY OF LAW AND MARXISM: LAW, CULTURE, AND SOCIETY*-NEW INTRODUCTION BY DRAGAN MILOVANOVIC 40 (2001).

<sup>232</sup> *Id.* at 170.

<sup>233</sup> See generally FITZMAURICE, *supra* note 230.

<sup>234</sup> See generally Stanislaw Wielgus, *The Genesis and History of "Ius Gentium" in the Ancient World and the Middle Ages*, 47 *PHILOSOPHY OF MORALS* 335 (1999); Genc Transavci, *The Meaning and Scope of the Law of Nations in the Context of the Alien Tort Claims Act and International Law*, 26 *U. PA. J. INT'L. ECON. LAW.* 193 (2005); Morris, *supra* note 47, at 123.

<sup>235</sup> *Barcelona Traction, Light and Power Ltd (Belg. v. Spain)*, Judgment, 1970 I.C.J. 3 (Feb. 5, 1970); *Barcelona Traction, Light and Power Ltd (Belg. v. Spain)*, Judgment, 1964 I.C.J. 6 (July 24, 1964). See also Morris Cohen, *Property and Sovereignty*, 13 *CORNELL L. REV.* 8 (1927).

<sup>236</sup> See Morris, *supra* note 234; see also Thomas W. Merrill, *Property and Sovereignty, Information Audience*, 18 *THEORETICAL INQUIRES IN LAW* 417 (2017).

<sup>237</sup> See TRIPS Agreement, *supra* note 1, Pt II, § 1–7.

<sup>238</sup> See also Keith Aoki, *(Intellectual) Property and Sovereignty: Notes toward a Cultural*

private property rights in the international system is the legal sophistication in which intellectual property rights are governed. International intellectual property rights created domestic private international law, which means intellectual property has a *public* origin and force in public international law, through treaty obligations.

Real property such as land or other natural resources are already in abundance and private individuals typically enter into some form of contractual arrangement with a sovereign state to exercise ownership over such property.<sup>239</sup> However, intellectual property rights are different in that they are the legal creation of a sovereign state (via the enactment of intellectual property laws) and part of that legal creation is a recognition of rights as a result of commodification such as the copyright in books or the patent for a medicine.

For example, in the case of the private right as a result of an intellectual creation for a sign representing the commodification result of a medicinal drug, its trademarks is not limited purely to the territorial domain of the sovereign state; it extends beyond state boundaries (even if registration is not sought).<sup>240</sup> Thus, private rights under international intellectual property law came about as a result of a public origin (legislated) in domestic private international law whose property rights are “good against the entire world. They impose duties on everyone else to respect those rights.”<sup>241</sup> It is that legal authority of intellectual property that also makes them attractive beyond the sovereign state that originally created them that allows for their universal appeal in the international legal system even though they are the private rights that does not belong to the state.

It is for that reason that international intellectual property law has been able to respond to the private rights of intellectual property within the international legal system for over a century.<sup>242</sup> Public international law, when viewed through the sub-branch of international intellectual property law, is then tasked with the promotion of private rights of intellectual property through stringent obligations

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*Geography of Authorship*, 48 STAN. L. REV. 1293 (1996).

<sup>239</sup> But see Michael Lehmann, *The Theory of Property Rights and the Protection of Intellectual and Industrial Property*, 16 INT. REV. OF IND. PROP. & COPYRIGHT L. 523 (1985); Duncan Kennedy and Frank Michelman, *Are Property and Contract Efficient?*, 8 HOFSTRA L. REV. 711 (1980).

<sup>240</sup> The ubiquitous “pink” color of PEPTO-BISMOL is a good example that goes beyond the shores of the United States, and even if rivals would want to claim a similar pink trademark item, a court could not prevent them from doing so, see *Norwich Pharmacal Co. v. Sterling Drug, Inc.*, 271 F. 2d 569 (1959); see also Hannah Brennan, *The Cost of Confusion: The Paradox of Trademarked Pharmaceuticals*, 22 MICH. TELECOMM. & TECH. L. REV. 1 (2015); Jeremy Green, *The Materiality of the Brand: Form, Function, and the Pharmaceutical Trademark*, 29 HISTORY AND TECHNOLOGY 210 (2013).

<sup>241</sup> Greg Alexander & Eduardo Penalver, AN INTRODUCTION TO PROPERTY THEORY 2 (2012).

<sup>242</sup> See Paris Convention, *supra* note 23; Berne Convention, *supra* note 24.

on states.<sup>243</sup> The result of this promotion of private rights is the global economic constitutionalisation of intellectual property in which the private rights of domestic economic operators fuses with the public law of states at the global level.<sup>244</sup>

The TRIPS Agreement, fiercely criticised by Sell and others, is in my view, actually the result of a sort of harmonisation of private rights in intellectual property and public international law that in one sense seeks to avoid some of the problems regarding applicable law. For the purposes of private rights in intellectual property, the TRIPS for its part reflects domestic private international law and public international law, because the latter recognises that domestic intellectual property law governs the private rights in intellectual property.<sup>245</sup>

But despite the emergence of private rights in intellectual property in the international legal system, and through their enforcement via TRIPS, international law has not been effective in relation to intellectual property litigation concerning infringement.<sup>246</sup> It is the domestic intellectual property laws that are still being relied on to address issues of intellectual property infringement that occur in more than one jurisdiction.<sup>247</sup> What should have been the domain of international law is still the domain of private international law. This is telling, as it suggests that private rights under international intellectual property law are only a matter of convenience and not the norm for enforcement or infringement.

This creates a striking distinction and relevance of private international law and public international law: domestic private international law is always applicable to the private rights of intellectual property regardless of whether infringement occurs within the parameters of public international law where international intellectual property treaties are recognised. Taken in this context, there is an aura about the nature of domestic private international law that if fully submitted to by its international counterpart will weaken the very nature of the territoriality in intellectual property rights.

There is something contradictory about the very nature of private rights in international intellectual property law. That contradiction stems from the very divide between the nature of “private law” “public law” and it might be possible that the actual interpretation of private rights under public international (intellectual property) law may resolve such contradiction.

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<sup>243</sup> See also Ruse-Khan, *supra* note 15.

<sup>244</sup> See, e.g., *Intellectual Property as a Trade Issue*, *supra* note 1.

<sup>245</sup> For similar discussion regarding international investment, see N.M. Perrone, *The International Investment Regime and Foreign Investors' Rights: Another View of a Popular Story* (Unpublished PhD Dissertation: London School of Economics, 2013) 93-94 (discussing the TRIPS Agreement).

<sup>246</sup> See also Joost Pauwelyn, *The Dog that Barked But Didn't Bite: 15 Years of Intellectual Property Disputes at the WTO*, 1 J. INT'L DISP. SETTLEMENT 389 (2010).

<sup>247</sup> See, e.g., *Trader Joe's Co. v. Hallatt*, 835 F. 3d 960, 975 (9th Cir. 2016) (noting that “the Lanham Act reaches Hallatt’s allegedly infringing activity”).

## VIII. CONCLUSION

In summary, what this article demonstrates is that the public international law system of intellectual property rights has always been about how private rights are regulated and how effectively the owners of private rights are able to navigate the public international law system. The article suggests that the public international law system has been a convenient cover for the global promotion of private rights—whether in the form of property rights proper or iterations of intellectual property. Moreover, the article demonstrates how private rights situate in the international legal systems through a historical and legal analysis and that the focus of criticisms by different community of scholars sometimes fail to paint an accurate legal picture of how private rights immerse themselves into the legal process and system of public international law.