

**Loyola Law School**  
**INTERNATIONAL INTELLECTUAL PROPERTY LAW**  
**Fall 2014**

Basic information, overview, and syllabus  
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**BASIC INFORMATION**

- Class room:** Hall of the 1980s
- Class hours:** Tuesdays, 3:20pm – 5:20pm
- Make-up classes:** *None scheduled at this time, but we will discuss*
- Materials:** All course readings will be posted on TWEN. Depending on interest, paper course packs will be available. **In the past, I had posted both course packs for entire sections of the syllabus AND individual readings.** For now, this is the plan for Fall 2014 as well, so do not be confused by all the materials available on TWEN.
- Email/Internet:** Please send any emails on weekdays. If you don't receive a response within 5 days (or sooner), I recommend sending the message again.

INTERNET USE DURING CLASS IS STRICTLY FORBIDDEN.

- Evaluation:** Grading in the course will be based on a final take home examination. In addition, class participation may be used to adjust grades upward or downward.

As part of class participation, absolutely NO internet use is permitted in the class. ***Students found to be using the internet during class may be referred to the Academic Standing Committee and/or Professor Hughes reserves the option of lowering of the final grade of such a student.***

**OVERVIEW**

The multilateral, international legal system for the protection of intellectual property began in the late 19<sup>th</sup> century with two treaties – the “Berne Convention” for copyright and the “Paris Convention” for patents and trademarks. Each of these treaties had an administrative bureau, which jointly evolved into the World Intellectual Property Organization (WIPO).

But this multilateral system took a quantum leap in importance – and public profile – with the integration of substantive intellectual property standards into the international trading system. The “Trade-Related Aspects of Intellectual Property” Agreement (TRIPS) brought the Berne and Paris Convention standards into the World Trade Organization (WTO) established in the mid-1990s. The WTO provides a binding dispute resolution process when countries do not abide by the standards in TRIPS. The establishment of IP “jurisdiction” in the WTO has also created a bifurcated international intellectual property system in which WIPO separately continues to administer several other IP treaties not integrated into WTO, WTO’s dispute settlement mechanism decides key issues under the Berne and Paris Conventions, and new issues of intellectual property protection are debated in both fora.

We will begin the course with a review of TRIPS, the two dominant multilateral IP treaties on which it is based (the Berne and Paris Conventions), and the dispute resolution process at the WTO. We will then turn to a series of modules studying specific unsettled issues within the international intellectual property system. Some of these issues will involve interpretation and refinement of the TRIPS standards; some will invoke issues intentionally left unresolved in TRIPS.

Below are the topics planned for the course, but Professor Hughes also welcomes recommendations for other topics. [Notations in BLUE indicate places where Professor Hughes plans to add, delete, or adjust materials.](#)

## SYLLABUS

version 01 – 22 July 2014

### **1. THE MULTILATERAL FRAMEWORK FOR IP NORMS**

*Preamble and Article 1-10, 64(1), 65, 66, and 68 of the Trade-Related Aspects of Intellectual Property [TRIPS] Agreement (1994).*

*Articles 2, 7-12 of the Berne Convention for the Protection of Literary and Artistic Works, last revised at Paris on 24 July 1971 and amended on 28 September 1979. [Berne Convention.pdf]*

*Articles 1-3, 4<sup>bis</sup> – 5<sup>quater</sup> of the Paris Convention for the Protection of Industrial Property, last revised at Stockholm on 14 July 1967 and amended on 28 September 1979 [Paris Convention.pdf])*

*Articles 2, 4, 6-8, 10, 12(7-9), 16, 17(1-3), 19, 20, 21(3-5), and 22(1-2) of the Understanding on Rules and Procedures Governing the Settlement of Disputes [Dispute Settlement Understanding.pdf]*

List of WIPO-Administered Treaties, available at <http://www.wipo.int/treaties/en/> [2014 WIPO treaties list.pdf]

### **2. DISAGREEMENTS ABOUT DATABASE PROTECTION**

Review Article 10(2) of the TRIPS Agreement (1994).

*Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340; 111 S. Ct. 1282; 1991 U.S. LEXIS 1856; 113 L.Ed. 2d 358; 59 U.S.L.W. 4251; 18 U.S.P.Q.2D (BNA) 1275 [FEIST2.doc]

*Romme v. Van Dale Lexicografie B.V.*, Supreme Court of the Netherlands, Judgment of 4 January 1991 [Romme v. Lexicografie.pdf]

EUROPEAN UNION DIRECTIVE ON THE LEGAL PROTECTION OF DATABASES (1996), 96/9/EC, March 11, 1996 [DIRECTIVE 96]

Letter from U.S. Department of Commerce to Senator Orrin Hatch on H.R. 2652, the “Collection of Information Antipiracy Act,” August 4, 1998 [1998-08 Hatch Letter.pdf]

H.R. 3872, A BILL TO PROHIBIT THE MISAPPROPRIATION OF DATABASES WHILE ENSURING CONSUMER ACCESS TO FACTUAL INFORMATION, introduced in the U.S. House of Representatives, March 2, 2004 [HR3872asreported.pdf]

*The British Horseracing Board Ltd and Others v. William Hill Organization Ltd*, European Court of Justice, Case C-203/02, 9 November 2004 (1) [EC]bhb-judgment2.doc]

Sections 1 - 4, and 6 [roughly pages 3-22, 25-27] of Commission of the European Communities, First evaluation of Directive 96/9/EC on the legal protection of databases, Brussels, December 12, 2005 [EC DB evaluation\_report\_en.pdf]

### 3. **THE SPIRITED DEBATE ABOUT GEOGRAPHICAL INDICATIONS (GIs)**

Read Articles 22-24 of the TRIPS Agreement (1994).

Justin Hughes, *Champagne, Feta, and Bourbon – the Spirited Debate about Geographical Indications*, 58 HASTINGS LAW JOURNAL 299 (2006). Download from [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=936362](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=936362)

Articles 1 – 8 of the Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration, of October 31, 1958, revised at Stockholm (July 14, 1967) and as amended as of September 28, 1979 [LISBON AGREEMENT.doc]

Excerpts from EU Council Regulation (EEC) No. 2081/92 of 14 July 1992 on the protection of geographical indications. Read Articles 2, 5-8, 12-14. This regulation has been superceded by amendment, but we are reading these articles to understand the Australia/US claim under TRIPS against the EU. [Council Regulation 2081.pdf]

WTO Dispute Settlement DS174, *European Communities – Protection of Trademark and Geographical Indications for Agricultural Products and Foodstuffs*, Panel Report Circulated 15 March 2005 [WTO EU GI case 174R.doc].

*Commission of the European Communities v. Federal Republic of Germany*, European Court of Justice, Case C-132/05, Decision of 26 February 2008 [Decision – ECJ 26 February 2008.doc]

USDA Foreign Agricultural Service, **European Union Trade Policy Monitoring – EU Releases final list of Geographical Indicators for Cancun**, August 28, 2003, GAIN Report Number: E23165 [EUListof41.doc]

James Otieno-Odek, *The Way Ahead – What Future for Geographical Indications?* WIPO – ITALIAN GOVERNMENT, WORLDWIDE SYMPOSIUM ON GEOGRAPHICAL INDICATIONS, Parma, Italy, 27-29 June 2005 [wipo\_geo\_pmf\_05\_otieno-odek.doc]

William A. Kerr, *Enjoying a Good Port with a Clear Conscience: Geographic Indicators, Rent Seeking and Development*, THE ESTEY CENTRE JOURNAL OF INTERNATIONAL LAW AND TRADE POLICY, 7 (1): 1, 8, 2006 [William kerr good port.pdf]

#### 4. **CONFLICTING STANDARDS ON LIFE-FORMS AS PATENTABLE SUBJECT MATTER**

*Diamond v. Chakrabarty*, 447 U.S. 303, 100 S. Ct. 2204 (U.S. Supreme Court, 1980) [Chakrabarty PSM EDIT.doc]

Read Article 27 of the TRIPS Agreement (1994)

*Harvard College v. Canada* (Commissioner of Patents), 2002 Can. Sup. Ct. LEXIS 86; 2002 SCC 76 (Supreme Court of Canada, 2002) [Harvard v Canada PSM EDIT.doc]

*Monsanto Canada v. Schmeiser*, [2004] 1 S.C.R. 902, 2004 SCC 34 (Supreme Court of Canada, 2004) [Monsanto v Schmeiser JH EDIT.doc]

Articles 52 and 53, EUROPEAN PATENT CONVENTION, (1973, as amended by the Act revising the European Patent Convention of 29 November 2000) [Excerpts – European Patent Convention.doc]

Rules 23b, 23c, 23d, and 23e of the IMPLEMENTING REGULATIONS TO THE CONVENTION ON THE GRANT OF EUROPEAN PATENTS, Administrative Council of the European Patent Organisation, December 9, 2004 [EPC Rule 23 series.doc]

*In re President and Fellows of Harvard College (Oncomouse)* Board of Appeal, European Patent Office, T 0315/03 (6 July 2004) [EPO Board of Appeals Oncomouse.doc]

Steve Walsh, *A Short History of the USPTO Position On Not Patenting People*, informal paper prepared for “Patenting People” Conference, Cardozo Law School, November 12 – 13, 2006. NOT FOR CITATION OUTSIDE CLASS [WALSH short history.pdf]

2011 amendment of US Patent Law barring patenting of “human organisms” and background statements in Congress [d- human organism.doc]

#### 5. **LIMITATIONS AND EXCEPTIONS IN COPYRIGHT LAW**

Read Article 13 (as well as Articles 17, 26, and 30) of the TRIPS Agreement (1994)

17 U.S.C. 110(5) [17USC110.doc]

WTO Dispute Settlement DS160, **United States – Section 110(5) of the Copyright Act**, Panel Report Circulated 15 June 2000 [US Music Licensing DS 160 EDIT.doc]

P. Bernt Hugenholtz and Ruth Okediji, *Contours of an International Instrument on Limitations and Exceptions*, Open Society Institute Initiative (2007) [Hugenholtz and Okediji.doc] (Part II.B.4 summarizes DS160 and, if you feel you have a good grasp of that, you might skip II.B.4.)

#### [\[MATERIALS ON THE 2013 MARRAKESH TREATY\]](#)

### 6. THE RESEARCH EXCEPTION IN PATENT LAW

Read Articles 27(1), 30, and 31 of the TRIPS Agreement (1994)

WTO Dispute Settlement DS114, **Canada – Patent Protection of Pharmaceutical Products**, Panel Report Circulated March 17, 2000 [Canada – Pharmaceuticals case.pdf]

35 U.S.C. 271(e) [Section 271.doc]

Article 10(6) of EU Directive 2004/27/EC of March 2004 [Article 10 of Directive 2004-27-EC.pdf]

Article 27 of the Luxembourg Agreement relating to Community patents, 89/695/EEC, Done at Luxembourg on 15 December 1989 [Luxembourg community patent Article 27.doc]

Article 69 of the Japan Patent Act [Article 69 of Japan Patent Act.pdf]

### 7. UNCERTAIN INTERNATIONAL NORMS FOR IP LAW ENFORCEMENT

Read Articles 41, 42-45, 50, and 61 of the TRIPS Agreement (1994)

WTO Dispute Settlement DS125, **Greece – Enforcement of Intellectual Property Rights for Motion Pictures and Television Programs**, Request for Consultations by the United States, WT/DS125/1, 7 May 1998 [Greece – Request for Consultations.doc].

WTO Dispute Settlement DS125, **Greece – Enforcement of Intellectual Property Rights for Motion Pictures and Television Programs**, Notification of Mutually Agreed Solution, WT/DS125/2, 26 March 2001 [Greece – Notification of Solution.doc].

WTO Dispute Settlement DS362, **China – Measures Affecting the Protection and Enforcement of Intellectual Property Rights**, Request for Establishment of a Panel by the United States, WT/DS362/7, 21 August 2007 [[China – – Measures Enforcement of IP.doc](#)]

End of syllabus, version 1.0

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