

International Intellectual Property – Selected Topics
CRN 18315/ Fall 2009
ROOM 303
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BASIC INFORMATION, OVERVIEW AND SYLLABUS (VERSION 2)

Class hours:

Wednesdays, 4:00pm – 6:20 pm

Course Materials

All course readings will be posted on ANGEL. A paper course pack with readings for our first two classes will be available at the 5th floor faculty services window for the cost of printing. Depending on student interest, further paper course packs may be printed.

Exam/Evaluation Format:

1. Grading in the course will be based on an open book, 24 hour take-home examination.
2. In addition, class participation may be used to adjust 10+% of the class upward. Professor Hughes also reserves the right to adjust *downward* for lack of class participation.
3. **ABSOLUTELY NO INTERNET USE** is permitted during class. Internet use will be treated as negative participation in class for purposes of grading.

Office hours:

Wednesdays 1:30 – 3:30pm

OVERVIEW

The multilateral, international legal system for the protection of intellectual property began in the late 19th 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 together 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 because the WIPO separately continues to administer several other IP treaties not integrated into WTO, particularly [a] a set of treaties that provide for partially centralized, multilateral registration procedures for patents, trademarks, and appellations of origin as well as [b] 1996 treaties addressing “digital copyright” issues.

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. We will also study the problem of the large economies (US, EU, Japan, and China) pursuing their own IP agendas through bilateral or “plurilateral” arrangements that do not include developing countries as a bloc.

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 materials; everything in black is already on the ANGEL system.

I. 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).

(The Final Act Embodying the Results of the Uruguay Round of the Multilateral Negotiations, Marrakesh Agreement Establishing the World Trade Organization, signed at Marrakesh (Morocco), April 15, 1994, Annex 1C, Agreement on Trade-Related Aspects of Intellectual Property Rights)[TRIPS Agreement.pdf or TRIPS Agreement.doc]

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]

*There is **no** need to look at the Paris Convention yet (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]), but it is in the ANGEL materials in this introductory section.*

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, Annex 2 of the Final Act Embodying the Results of the Uruguay Round of the Multilateral Negotiations, Marrakesh Agreement Establishing the World Trade Organization, signed at Marrakesh (Morocco), April 15, 1994 [Dispute Settlement Understanding.pdf]

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

2. THE DEBATE 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 Lexicografe 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]

PURELY OPTIONAL BACKGROUND READING

Justin Hughes, *How Extra-Copyright Protection of Databases Can be Constitutional*, 43 U. DAYTON L. REV. 159 (2003), available for download at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=468740

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

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 superseded 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].

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]

Frederico Mekis, *Appellations of Origin: Position of Chile's Vineyards in the Concert of the New World*, WIPO-DNPI (URUGUAY) SYMPOSIUM ON THE INTERNATIONAL PROTECTION OF GEOGRAPHICAL INDICATIONS, 28-29 Montevideo 2001 [wipo article chile.pdf]

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]

In re Wisconsin Alumni Research Foundation (WARF), Technical Board of Appeal, European Patent Office, T 137/4/04 – 3.3.08 (15 November 2005) [Excerpt from EPO WARF decision.doc]

Stuart Newman, *My attempt to patent a human-animal chimera*, L'OBSERVATORIE DE LA GÉNÉTIQUE, April-May 2006 [Newman – patenting a human-animal chimera.pdf]

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]

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.)

Summary graph of copyright exceptions in Israeli Copyright Act, 2007, passed by the Knesset on November 19, 2007 [Israel Copyright Act 2007 – exceptions.doc]

[\[MORE ON CURRENT DISCUSSIONS\]](#)

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]

Embrex, Inc. v. Service Engineering Corp., et al, 216 F.3d 1343 (Fed. Cir. 2000) [EMBREX-V-SERVICE_ENGINEERING.doc]

John M.J. Madey v. Duke University, 307 F.3d 1315 (Fed. Cir. 2002)[MADEY-V-DUKE.doc]

[\[MORE ON COMPARATIVE ISSUES\]](#)

7. MULTILATERAL, PLURILATERAL, OR BILATERAL?

[\[MORE TO COME\]](#)

8. INTERNATIONAL NORMS FOR IP LAW ENFORCEMENT

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

WTO Dispute Settlement DS83, *Denmark – Measures Affecting the Enforcement of Intellectual Property Rights*, Request for Consultations by the United States, WT/DS83/1, 21 May 1997 [Denmark – Request for Consultations.doc].

WTO Dispute Settlement DS83, *Denmark – Measures Affecting the Enforcement of Intellectual Property Rights*, Notification of Mutually Agreed Solution, WT/DS83/2, 13 June 2001 [Denmark – Notification of Solution.doc].

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 – Request for Panel.doc] [as well as various Requests to join the consultations – Canada, Mexico, Japan, European Union]

United States Trade Representative, Executive Summary of First Submission in *China – Measures Affecting the Protection and Enforcement of Intellectual Property Rights*, February 8, 2008 [2008-02 USTR Exec Summary of US claims.pdf]

End of syllabus, version 1.0

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