

Intellectual Property and Private International Law: Heading for the Future. Edited by Josef Drexler and Annette Kur. International Review of Industrial Property and Copyright (IIC) - Studies in Industrial Property and Copyright Law, Vol.24. Oxford: Hart Publishing, 2005. Pp. 371. \$90.00.

Reviewed by Laurence Seidenberg, Esq., Reference Librarian, Syracuse University College of Law, Syracuse, NY, USA

Intellectual Property and Private International Law vol. 24 (hereinafter 'IIC') presents a compendium of 16 articles resulting from a July 2003 meeting organized by the Max Planck Institute for Intellectual Property, Competition and Tax Law held at Frauenchiemsee, Bavaria, Germany entitled "A Symposium on Jurisdiction and Choice of Law in Intellectual Property Matters- Perspectives for the Future".

The resulting text comprehensively covers a distinctly European view of developments leading up to, but not including, the June 2005 approval of the Hague Choice of Court Agreement by Member states.¹ Despite this text being published several months before this significant event, it provides valuable insights and perspectives on the elements, omissions and to some extent the politics of issues and clauses of this timely and important international collaboration that may lead to further standardization in international and domestic choice of law and jurisdiction in I.P.

The text, in its focus on intellectual property and private international law, is highly relevant and worth acquiring due to the proliferation of transborder disputes resulting from increasing borderless communication structures such as internet based commerce that present challenges to antiquated legal systems rooted in traditional notions of jurisdiction, sovereignty and conflicts of laws. Intellectual property rights are still territorial and national in nature and major international conventions reflect this respect of the sovereign nature of I.P. right grants.² Further, while acquisition, transfer and exploitation of intellectual property rights are mostly a matter of private law, a single act of infringement across multiple borders can have a significant impact on politics, culture, values and economics beyond the intention of the parties and a multitude of consequences over jurisdictions with divergent standards of I.P. protection.

National courts have attempted to apply various legal maxims like *lex protectionis* (law of the country of protection), *lex fori* (law of the forum), *locus delicti commissi* (law of the place where the tort was committed), all concepts that reflect territorial based systems. Globalization and the spread of transborder communication technologies have posed a strong challenge to territorial notions of I.P. Two articles are illustrative of the depth and range of these challenges to traditional I.P. notions. The article in the text on the Proposed Rome II Regulation³: European Choice of law in I.P. by a Director of the Max

¹ available at http://www.hcch.net/index_en.php?act=conventions.text&cid=98; also see generally <http://www.hcch.net>

² see Art. 4 bis Paris Convention. for the Protection of Industrial Property; Art 5 Berne Convention for the Protection of Literary and Artistic Works

³ proposed Rome II Regulation, see http://europa.eu.int/eur-lex/en/com/pdf/2003/com2003_0427en01.pdf

Planck Institute, Josef Drexl, touches on these ideas and he provides an excellent overview of EC Choice of Law rules and the pros and cons of inclusion and exclusion of intellectual property rights (hereinafter 'IPRs') to subsequent drafts of Rome II. In doing so, he provides a comprehensive picture of the regulatory backdrop of I.P. regulation in the EC in pointing out relevant WIPO, TRIPS and community I.P. treaties (Amsterdam and Retransmission Treaties) as well as current case law. Author Dorothee Thum explores the difficulty of determining copyright ownership in colorized films in the context of global acts of infringement and in the process demonstrates how principles of universality challenge territorial notions of copyright in applying a country of origin rule⁴ for initial ownership, but which is in itself layered with unpredictable guides like 'connecting factors'.

The IIC anthology, presents, in comprehensive fashion, a detailed analysis of major efforts to harmonize choice of law rules in the international context in the area of Intellectual Property Rights with an emphasis on European law and it reaches in to the traditional I.P. areas of Patents, Trademarks and Copyrights as well as Design, with some mention of neighboring rights among other topics. Some of the major efforts discussed include :

- 1) The Joint Recommendation Concerning Provisions on the Protection of Marks and Other Industrial Property Rights in Signs on the Internet (The WIPO Recommendation (World Intellectual Property Organization)
- 2) The MPI Working Group Proposal⁵
- 3) The Hague Conference for Private International Law and alternative proposals such as the 'Dreyfus Ginsburg Draft', later endorsed by the American Law Institute working group covering jurisdiction, choice of law and transnational disputes
- 4) establishment of a European Patent Judiciary
- 5) the proposed Rome II Regulation applicable in non-contractual relationships

The text divides selections into sections for Jurisdiction and Choice of Law and has papers covering patent, trademark, copyright as well as an article on Japanese Choice of Law developments. A helpful feature is a List of abbreviations and an Annex of documents.

It is disappointing, but in a minor way, that the IIC text publication precedes the June 2005 conclusion of the Hague Convention on Choice of Court. The agreement represents a bold step toward harmonization of international trade law by providing greater certainty in B2B agreements. It is hoped future IIC volumes will be as thorough in discussion of the limitations and implications of the Hague Choice of Law Agreement such as the many exclusions such as B2C coverage, exclusion of employment contracts and the scope of non-copyright IPR's of Art (2)o and Art 2(2)h as well as the many escape clauses in Art. 9 where for example recognition and enforcement may be refused if the judgment awards "damages including exemplary or punitive damages that do not compensate a party for actual loss or harm suffered" [HCCH Art 11(1)]. This exclusion

⁴ see *Itar Tass News Agency v. Russian Kurier* 153 F. 3d. 82 (2d Cir 1998)

⁵ available at <http://www.ip.mpg.de>

of large damage awards, for example from U.S. courts, is of concern from the American perspective and is one reason among many for U.S. non-accession to such treaties. The U.S. is not a signatory to this or any other treaty as to the enforcement of judgments, although the U.S. is signatory to the U.N. Convention on Recognition and Enforcement of Arbitral Awards.⁶

Also absent from the IIC text is an in-depth discussion of the American Bar Association endorsement⁷ of the Hague Choice of Court Agreement and also for example, parallel efforts in Canada in the form of the Uniform Enforcement of Foreign Judgments Act (UEFJA)⁸ completed as an adjunct to Canada's participation in the Hague Conference on Private International Law as a member.

Nonetheless, despite the inclusion of only one article by a non Western author - Professor Kono of Kyushu University - and a bit of duplication in coverage of the Rome II regulation by both Josef Drexl and Matthew Leistner, the compendium serves as a valuable resource for continued study.

An American perspective, perhaps on the topic of the implications of the Hague Choice of Court Agreement, on U.S. international intellectual property rights litigation and related enforcement of judgments might have been a meaningful addition to the IIC text. However, the achievement of this publication is clear, in providing a substantive analytical compendium of papers reflecting the most current issues in international I.P. jurisdiction, enforcement and choice of law.

⁶ UN Convention on Recognition & Enforcement of Arbitral Awards, opened for signature June 10, 1958; 21 U.S.T. 2517, 330 UNTS 38

⁷ see www.abanet.org/intlaw/newsletter/HCCCARRRFINAL.doc

⁸ ULCC, Enforcement Law Projects, UEFJA Prelim. Draft Report
<http://www.ulcc.ca/en/cls/index.cfm?sec=3&sub=3g>