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SYMPOSIUM: INTELLECTUAL PROPERTY, TRADE AND DEVELOPMENT: ACCOMMODATING AND RECONCILING DIFFERENT NATIONAL LEVELS OF PROTECTION

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I. ACCESS TO INFORMATION: DATABASE PROTECTION

THE PROTECTION OF DATABASES

Daniel J. Gervais

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In Parts I and II of this Paper, the author analyzes the legal protection of databases first in international treaties, in particular the Berne Convention and the WTO TRIPS Agreement, and second under national and regional copyright, *sui generis*, or other (e.g., tort) law in Europe (both the European Directive on the legal protection of databases of 1996, which was under review, and a number of relevant national laws), the United States, and a number of foreign jurisdictions (Australia, Canada, China, Nigeria, Russia, and Singapore). In Part III, the author provides a critical analysis of the effort to expand the legal protection of databases from both theoretical and empirical perspectives. In his conclusion, the author suggests three paths for the future evolution of the protection of databases at the international level.

Comment

A MARRIAGE OF CONVENIENCE? A
COMMENT ON *THE PROTECTION OF
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I. DIFFERENT LAYERS OF LAWMAKING: NATIONAL, REGIONAL, AND INTERNATIONAL

COPYRIGHT, TRANSLATIONS, AND
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Lionel Bently

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This paper examines the tension between trade and development, and its handling in multiple layers of law-making through an historical case study concerning copyright in India in the late-nineteenth and early-twentieth century. The paper explains the emergence of views in the Government of India of what copyright law should cover that reflected longstanding but not unproblematic assumptions about India's need for European knowledge and learning. The belief that India needed access to European knowledge informed resistance to the desires of British

publishers that copyright owners should be able to control the making of translations of their works. These divergences between what are broadly described as “British” and “Indian” views as to the desirability of translation rights emerged towards the end of the nineteenth century in a complex legal environment in which international copyright arrangements were added to those of imperial and local Indian copyright. After two cases in which the Bombay High Court denied the existence of a translation right (under both Indian and the imperial Copyright Act), the British government and the Government of India came under pressure from publishers to adopt such a right. The paper describes how the Government of India resisted such attempts and the deference the British Government was willing to offer it. However, specifically Indian desires were neglected when Britain negotiated copyright matters on the international stage. Instead, Britain committed itself to an increasingly full translation right in the various revisions of Berne Convention, and following the 1908 Revision, sought to legislate a new Imperial Code that reflected these commitments. While India complied with British wishes, and introduced the imperial copyright regime, it utilized the residual powers granted to it to modify and limit the duration of the translation rights. However, the limited application of the modified translation right to works published in India meant that it was an unsuitable means for facilitating the acquisition of European knowledge. Rather, the modifications must be understood symbolically as a proclamation of autonomy, and instrumentally, as a mechanism for the production of an Indian national culture. The case study of the translation right in India highlights the critical importance of social, economic, and cultural context to the operation of copyright and simultaneously resonates with contemporary discussions as to how to accommodate local difference in the context of globalized norms.

Comment

CREATIVE LAWMAKING: A COMMENT
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III. GEOGRAPHIC INDICATION AND TRADEMARKS

QUIBBLING SIBLINGS: CONFLICTS
BETWEEN TRADEMARKS AND
GEOGRAPHICAL INDICATIONS

DEV GANGJEE

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The relationship between trademarks and geographical indications (“GIs”) has historically been tempestuous. Each of these quibbling siblings, members of the broader family of unfair competition law, entitles registrants to the exclusive use of a sign. So what happens when a GI collective and a trademark proprietor lay claim to the same sign within a single jurisdiction? As part of the renewed interest in TRIPs flexibilities and attempts at accommodating or reconciling differences between national laws, this paper explores a newly emerging space that may just be big enough for the both of them. The analysis draws on a recent World Trade Organization (“WTO”) Panel Report, which identifies the legal foundations for cohabitation. The Report coincides with doctrinal developments at the national and regional level which initially identified this zone of compromise: the geographical “descriptive use” defense in trademark law. Coexistence is significant as it alters the dynamic of a venerable conflict between trademark and GI regimes, which has been locked in the language of trumps for several decades. Accordingly, this paper introduces the players and describes the game of one-upmanship prior to this development in Part I; outlines the WTO decision in Part II; and then draws parallels with doctrinal developments in the EU and U.S. which presaged the possibility of coexistence in Part III. It concludes with an endorsement of coexistence as an equitable solution.

Comments

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International NGOs play a significant role in relation to intellectual property policy-making and norm-setting in the following multilateral institutions: the World Trade Organization (“WTO”); the World Intellectual Property Organization (“WIPO”); the World Health Organization (“WHO”); the Convention on Biological Diversity Conference of the Party (“CBD-COP”); and the Food and Agriculture Organization (“FAO”) of the United Nations. International NGOs enhance the capacity of developing country delegates to multilateral institutions to negotiate on intellectual property issues. Although there are limits to the relationship between developing country delegates and international NGOs, relative to the resources available, international NGOs have had a considerable impact, enriching the debate on intellectual property rights and development policy. However NGOs must remain vigilant to ensure that they do not become donor driven and subject to pressures to champion particular issues or to switch attention away from intellectual property rights and towards issues of more immediate concern.

V. THE ROLE OF CONTRACTS AND PRIVATE INITIATIVES

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Private ordering mechanisms, such as contracts or technological measures, have increasingly been used to shift the balance between exclusive property and free access to intellectual creation embedded in all IP regimes. Most surprising is the use of private ordering mechanisms, mainly licensing schemes. This article aims at assessing the nature of norm-making operated by open-access initiatives, as well as its normative sustainability as a project to enlarge the public domain within intellectual property. My conclusion is that public ordering still has a crucial role to play to moderate the expansion of intellectual property and to ensure that intellectual creations remain available to the public and promoted alongside open access strategies.

Comment

- “OPEN SOURCE” AND PRIVATE ORDERING: A COMMENTARY ON DUSOLLIER *Arti K. Rai* 1439

VI. THE POLICY-MAKING DYNAMICS IN INTERGOVERNMENTAL ORGANIZATIONS

- THE STRUCTURE AND PROCESS OF NEGOTIATIONS AT THE WORLD INTELLECTUAL PROPERTY ORGANIZATION *Geoffrey Yu* 1445

On October 13, 2006, the Deputy Director General of the World Intellectual Property Organization, Geoffrey Yu, spoke at the Chicago-Kent Symposium *Intellectual Property, Trade and Development: Reconciling and Accommodating Different National Levels of Protection*. Included here is a transcript of his remarks, which outlined the organizational structure of the Organization and the management and process of international discussions within the Organization.

Comment

- THE POLICY-MAKING DYNAMICS IN INTERGOVERNMENTAL ORGANIZATIONS: A COMMENT ON THE REMARKS OF GEOFFREY YU *Coenraad Visser* 1457

VII. ACCESS TO ESSENTIAL MEDICINES

- A NEW WORLD ORDER FOR ADDRESSING PATENT RIGHTS AND PUBLIC HEALTH *Cynthia M. Ho* 1469

Can patent rights and public health coexist? This is a pressing global question in an era where the AIDS pandemic rages in countries that cannot afford to pay for the most effective—and patent-protected—AIDS treatment. Even in countries with higher levels of income, patent problems may nonetheless loom large in unanticipated situations that could turn deadly without access to patented drugs, such as the 2001 anthrax “crisis” or the potential avian flu epidemic. This article provides an important perspective on how international laws currently impact the intersection between patent rights and public health. This article begins with an explanation of patent requirements under TRIPS that most countries must abide by (as WTO members) regardless of their national commitments to public health. The recent compulsory licenses in Thailand and Brazil are used as illustrations of some of the TRIPS requirements, as well as what issues receive the most controversy. The article also highlights terms in subsequent TRIPS-plus agreements that may further impede access to public health. The last part provides an overview of recent international and national actions that respond to TRIPS-plus agreements. International discussions within the WIPO and WHO forum are discussed, as new proposals, including the proposed treaty for Access to Knowledge (“A2K”) and a Research and Development Treaty. India's unique approach to limiting patentability to foster public health is also highlighted as an illustration of how nations may comply with TRIPS without sacrificing concern for public health. Finally, technological solutions to address the balance are also considered.

Comment

VIII. THE PROTECTION OF RIGHTS IN PLANT VARIETIES

In this paper, we examine the potential for plant variety protection (“PVP”) regimes—that is, *sui generis*, industry-specific intellectual property regimes—to become compromised as a result of technological change. In particular, we analyze the shift in plant breeding from phenotypic selection to genotypic selection, and consider the impact of that shift on existing plant variety protection. We also lay out an alternative structure for plant intellectual property protection based on unfair competition, a model that differs radically in some respects from current PVP schemes. We offer our model as a starting point for debate on adaptations that might improve PVP schemes, whether those adaptations be systemic or (more likely) incremental changes to existing rules and practices.

STUDENT NOTES

The latest patent reform bill, the United States Patent Act of 2005, has rehashed one of the most hotly contested debates in patent law: whether the United States should switch to a first-to-file system. Most arguments for keeping the current first-to-invent system center on fairness to small businesses or individual inventors. Although this argument has held its own for many years, it is beginning to erode in the face of counterarguments that the switch to a first-to-file system would be economically beneficial by simplifying matters and encouraging faster public disclosure. Thus fairness is no longer enough to justify maintaining the current system.

This Article will attempt to justify the current first-to-invent system on another ground: that it is more economically beneficial than a first-to-file system. Despite the purported benefits of a first-to-file system, this Article contends that the United States should not adopt the first-to-file provision of the Patent Act of 2005. Although a first-to-file system could offer some potential economic benefits, only the current system satisfies the economic goal of wealth maximization while simultaneously achieving the constitutional policy goal of promoting “the progress of Science and the useful Arts.” The patent system was designed as a delicate balance of incentives for promoting invention and public policy goals, such as wealth maximization, and only the current system strikes the correct balance between those two goals.

Encouraging technological innovation and improvement lies at the heart of the U.S. patent system. To achieve this goal, the patent system must provide robust protection to patentees while assuring that would-be inventors know exactly where protected inventions end and areas open to development begin. In recognizing the importance of these two functions of the patent laws, the Supreme Court in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.* (“*Festo VIII*”) set out to clarify the relationship between two important, yet troublesome, patent law doctrines—the doctrine of equivalents and prosecution history estoppel. However, in its attempt to restore balance

between the protective and notice functions, the Court may have merely exacerbated the problem between these doctrines by elevating the protective function of patents over providing notice to the public. This Note will focus on the Court's new presumption for determining when the doctrine of equivalents applies and when prosecution history estoppel bars its use. Specifically, this Note will argue that the third method defined by the Court for a patentee to rebut its new presumption sacrifices the notice function by making it virtually impossible for a would-be inventor, attempting to design around a patented invention, to determine the scope of equivalents *ex ante*. The policies underlying the patent laws direct that innovation will suffer greatly if the interests of the patentee and the public are not brought back into balance.