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Global economy calls for stronger training in international IP issues

As readers of this column know, a multi-lateral treaty designed to ensure access to copyrighted works in formats that make them accessible to the visually impaired, the Treaty to Facilitate Access to Published Works by Visually Impaired Persons and Persons With Print Disabilities (referred to informally as VIP), was negotiated in June in Marrakesh, Morocco. (See my March 29, 2013, column.)

Despite strong support for such access across a wide range of developed and developing countries, only down-to-the-wire, midnight negotiations secured its ultimate success. Part of the blame for the difficult and prolonged negotiations has been aimed at U.S. law schools and professors and their lack of focus on international issues. Speaking as one with a clear stake in the matter, there may be more than a few grains of truth to the claim.

Along with Anthony D'Amato, a renowned international law professor at Northwestern University, I co-authored the first U.S. textbook for international intellectual property law, published by West.

Multi-lateral treaties governing international intellectual property rights have existed since the 1880s. Yet the first U.S. textbook dealing with these issues was not published until 2000. Post-TRIPS (Agreement on Trade Related Aspects of Intellectual Property Rights) courses on international IP law have subsequently mushroomed.

Of the six law schools located in Chicago, most offer at least one IP course specifically covering international or comparative law issues. Some are narrowly focused on patents and health care, while others are more holistic in their international focus. Yet, the opportunity to study international applications of intellectual property rights plainly exists. Coverage, however, does not necessarily mean that lawyers are graduating as well-versed in the subject.

At The John Marshall Law

School, we offer six courses directly related to international and comparative law issues. Yet enrollment in these classes is relatively small. In the past three years, only 18.5 percent of all students enrolled in J.D., master's and LL.M. classes in intellectual property law have taken at least one of these courses. The problem, therefore, may not be a lack of coverage of the subject matter. Instead, it may be a lack of appreciation for the impact of international issues on U.S. practice.

There is no simple solution to the problem. More courses and Continuing Legal Education conferences, and columns like this one, that focus on international issues help. But what is really needed is a sea change in attitude in the way U.S. lawyers approach international protection issues.

I teach various international IP classes to J.D., master's and LL.M. students. One constant over the years is the students' surprise that the same philosophies and standards that govern U.S. law do not represent international standards. To the contrary, most countries do not grant pre-filing grace periods for patents, for example.

Instead, absolute novelty is the rule. Most countries also do not apply the same "balancing" test for fair use under copyright. Instead, they apply category-specific "fair dealing" exceptions. Even in trademarks, most countries do not recognize "common law" trademarks or provide protection against diluting uses. These fundamental distinctions could have a strong impact on how IP owners protect their marks domestically as well as internationally.

To use an obvious example, even under the revised patent norms of the America Invents Act, inventors can make public disclosures of their invention within one year of filing without creating a bar to patentability. (35 U.S.C. Section 102(b)). Yet this same public disclosure may destroy the inventor's rights internationally where absolute novelty

GLOBAL IP



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is the norm.

This untenable result is only obvious to practitioners who are aware of the distinctions between U.S. and international practices and can plan filing strategies to avoid these traps.

Staying with the issue of international patent protection, there is a growing international trend toward resisting strong protection for health-related patents, such as those for prescription medicines. These trends include the imposition of in-country obligations to practice a patented invention in the granting country (i.e., China and India).

This "working obligation" cannot be met simply by importing the patented drug. Instead, the patented pharmaceutical must be produced in the granting country, generally within three to five years of the patent grant.

Other growing trends include rejecting patent protection for new uses of existing drugs (i.e., India and New Zealand) and imposing compulsory licenses to fill domestic gaps for "reasonably" priced pharmaceuticals (i.e., India and Thailand). These trends are matched by an equally aggressive challenge to patent protection under human rights and other social justice norms (i.e., Kenya, Brazil

and diverse UN agencies). Lack of knowledge of such trends can cause serious gaps in strategic planning for patent-based industries seeking to take advantage of a global marketplace.

Similar issues exist for those seeking to protect copyrights in popular movies and songs. Free speech and access to information concerns have blocked injunctions in the European Union to remove infringing content from websites.

Heightened evidentiary standards have been imposed to secure end-user identities in cases of digital piracy that make reliance on simple technological searches for potentially infringing content on end-users' computers problematic (i.e., Canada and Sweden). Such trends do not eliminate protection for copyrighted works, but they do require strategies for dealing with such distinctions in an effective manner.

One of the difficulties in trying to get the message out about the importance of international developments to those involved largely in a U.S. domestic practice is reaching the students and practitioners who have not yet internalized this need. If you are reading this column, you are not the problem.

A greater emphasis by local bar associations on the need to be aware of international developments in the field would help. Just as many CLE programs currently include an ethics component, an international developments component could also be included to raise awareness.

In the push to make legal education even more practice-ready, law schools should also do more to incorporate international issues into the required curriculum. Law professors should also raise awareness by incorporating international issues into U.S. subject matter courses.

These small steps would help begin the process of raising the awareness that in the 21st century, there is no such thing as a purely domestic IP practice.