

**TRANSNATIONAL INTELLECTUAL PROPERTY LAW. TEXT
AND CASES BY ROBERT P. MERGES AND SEAGULL
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International intellectual property law has generated a voluminous literature¹, particularly since 1995, when compliance with the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) became an obligation for members of the World Trade Organization (WTO).² TRIPS prescribed the minimum standards with which countries had to comply when enacting laws on patents, copyright, trademarks, trade secrets, layout designs of integrated circuits, industrial designs and to a lesser extent plant variety rights and intellectual property licences. TRIPS also obliged the enactment of legislation providing for the civil and criminal enforcement of intellectual property rights and the control of the trade in infringing goods at the border.

This book announces on its first page that it “is *not* a book on international IP law”, but a book “for students whose clients will have business activities across national IP jurisdictions”. In the same paragraph the authors explain that their focus is “with the coordination of IP protection by private companies that operate in many jurisdictions around the world”. They then explain that “trans” means across or between national IP systems. On the following page the authors explain that “our use of ‘transnational’ is meant to be broadly descriptive”. They eschew an engagement with the scholarly debate on transnational law.³ To them the prefix “trans” means “legal practice that spans across a single nation; to or over to, other nations; applying from one state (or nation to another”. They say that they are “more interested in legal activity that is (mostly based on national laws, but that spans or relates to multiple legal jurisdictions”.

¹ Eg Anthony A. D'Amato and Doris E. Long, *International Intellectual Property Law*, Kluwer Law International, 1997; G. Gregory Letterman, *Basics of international intellectual property law*, Ardsley, NY, Transnational Publishers, 2001; Alfredo Iardi and Michael Blakeney, *International encyclopaedia of intellectual property treaties*, Oxford, OUP, 2004; Daniel C. K. Chow and Edward Lee, *International Intellectual Property: Problems, Cases, and Materials*, 2d ed, West Academic, 2006; F. Gurry, F. Abbott and T. Cottier, *International Intellectual Property in an Integrated World Economy*, Aspen Publishers, Wolters Kluwer Law & Business, 2007; Graeme B. Dinwoodie, Shira Perlmutter, and William O. Hennessey, *International Intellectual Property Law and Policy*, 2d ed, LexisNexis, 2008; Robin Ramcharan, *International Intellectual Property Law and Human Security*, Springer, 2012; Daniel J. Gervais, *International Intellectual Property: A Handbook of Contemporary Research*, Edward Elgar, 2015; Paul Goldstein and Marketa Trimble, *International Intellectual Property. Cases and Materials*, 4th ed, St. Paul, MN Foundation Press, 2016.

² See Michael Blakeney, *Trade related aspects of intellectual property rights : a concise guide to the TRIPs Agreement*, London, Sweet & Maxwell, 1996.

³ Citing by way of example, Roger Cotterell, ‘What is Transnational Law?’ (2012) 37 *Law and Social Inquiry* 500 and Gregory Shaffer, ‘Theorizing Transnational Legal Ordering of Private and Business Law’ (2016) 1 *UC Irvine J. of Int'l & Comparative Law*, 1

So then is there a body of law which can be described as “transnational intellectual property law”? If there is, this is not the book which describes it. As the authors point out intellectual property law is territorial and generally speaking makes no claim of extraterritorial effect.⁴ Thus they point out that “IP law is in general country specific”, although they concede that countries might voluntarily surrender some of their sovereignty, which is arguably what the signatories to the TRIPS Agreement have done.

The jurisdictional scope of the book is limited to China, Europe and the USA and the principal categories of intellectual property that are discussed are patents, copyright and trademarks. There is also some coverage of trade secrets and designs.

The structure of each of the sections dealing with these three intellectual property categories is that they are introduced with a hypothetical commercial scenario which has transnational implications. Then each of the ingredients of the respective intellectual property right are outlined in relation to each of the three selected jurisdictions. These elements are discussed mainly by reference to case law or extracts from statutes. For example, the section on patents has chapters dealing with patentable subject matter, novelty, inventive step/non-obviousness, adequate disclosure, claim interpretation and infringement, then remedies and commercialisation. Thus, the chapter dealing with patentable subject matter covers first software and business methods. The US law on this is explained by reference to *Alice Corp Pty Ltd v CLS Bank International*.⁵ In relation to China, reference is made to the 2017 Guidelines for Patent Examination, which state that a computer program is not patentable, but that an invention relating to a computer program might be, although there are no case examples of this as Chinese patent law is in its infancy. The European example is the European Patent Office’s Technical Board of Appeal decision: *Computer program product/IBM*.⁶

The next section of the chapter on patentable subject matter deals with biotechnology. The US law is discussed in an extract from *Ass’n for Molecular Pathology v Myriad Genetics, Inc*.⁷ This Supreme Court case ruled against the patentability of DNA as it exists in nature. The Chinese law is an extract from the China Patent Law, which in article 5 excludes from patentability inventions “based on genetic resources”. The European Law on the subject is the European Biotechnology Directive which permits the patenting of isolated DNA.

Both in relation to business methods patents and biotechnology there would be examples of transnational commercial transactions involving one or more of the three jurisdictions, which had generated litigation. For example, the extracts of biotechnology patenting law suggest that the Myriad Genetics patents might find

⁴ Citing *Deepsouth Packing Co. v. Laitram Corp.* 406 US 518, 531 (1972) quoting *Brown v. Duchesne* 60 US 183, 195 (1856).

⁵ 134 S. Ct. 2347 (2014)..

⁶ Case No T 1173/97.

⁷ 133 S. Ct. 2107 (2013).

favour under the European Biotechnology Directive, but the patents were rejected in Europe.⁸

The approach of the book is to treat the elements of intellectual property rights in each jurisdiction as discrete topics. This is useful for the coverage of intellectual property rights in each jurisdiction, but does not communicate anything about the transnational implications of individual transactions. There are some subjects which lend themselves to a transnational approach. There have been global patent fights concerning mobile phones and computer software. Global copyright disputes have been precipitated by the launch of movies and pop songs. Global branding campaigns have launched trademark disputes in a number of countries. Also in the field of trade marks, different countries have taken different positions on disallowing the registration of “functional” marks, such as the global litigation between Phillips and Remington in relation to the registration of the arrangement of blades on electric shavers.

One trademarks topic which was responsible for the TRIPS trademarks provisions was the protection of well-known marks in jurisdictions in which they had not been registered. Does “fame” in one jurisdiction carry over to fame in the others? The extract in the book from the Beijing High Peoples’ Court in *Sotheby’s v. Sichuan Sotheby*,⁹ suggests that in China there have to be some activities in the jurisdiction. This seems to be much narrower than the requirements of the TRIPS Agreement and to resemble the narrow line of passing off authorities in the common law courts.¹⁰

The book does not discuss geographical indications, which is a subject of great interest in China and Europe. It also has some relevance for the USA in the way in which it collides with trademark protection. The book reproduces the CJEU decision in *Anheuser Busch v Budějovický Budvar*,¹¹ which concerns an opposition to the registration of a Community Trademark. This is in fact only one of at least 100 cases which have been brought around the world and which have raised, inter alia, the question of the primacy of geographical indications over trademarks.

The authors discuss the remedies which are available in relation to each of the categories of intellectual property right which they cover. This coverage will of interest to transnational practitioners. Some coverage of seizure orders and freezing orders in each of the jurisdictions would have been useful.

This book will be useful to postgraduate intellectual property law students who have mastered the introductory elements of intellectual property law and who have some sense of international intellectual property law, such as the requirements of the TRIPS Agreement. They will be in a position to appreciate the differences in the substantive intellectual property requirements of each of the three jurisdictions covered, as well as the possibilities for differences between jurisdictions not covered.

⁸ See Jessica C. Lai, ‘Myriad Genetics and the BRCA Patents in Europe: The Implications of the U.S. Supreme Court Decision’ (2015) 5 *UC Irvine Law Review* 1041.

⁹ (2008) Gaominzhonzi No. 322.

¹⁰ See Christopher Wadlow, *The Law of Passing Off*, 2nd ed., London, Sweet & Maxwell, 1995.

¹¹ Case C-96/09, 29 March 2011.

The only other book in this area is Xuan-Thao Nguyen, Danielle Conway and Lateef Mtima, *Transnational Intellectual Property Law*¹² In addition to covering the China, the EU and the USA, this book also looks at Japan. It is organized similarly to Merges and Song, detailing the doctrinal intellectual property laws of each jurisdiction readers are left to identify the similarities and differences in each jurisdiction from reading the case extracts.

What is now required in the intellectual property literature is a comparative analysis of intellectual property law, synthesizing the approaches taken in the international and transnational intellectual property literature.

¹² West Academic, 2016.