No. 21-1043

In the Supreme Court of the United States

ABITRON AUSTRIA GMBH, ET AL.,
Petitioners,

v.

HETRONIC INTERNATIONAL, INC.,
Respondent.

On Writ of Certiorari to the
United States Court of Appeals
for the Tenth Circuit

BRIEF OF AMICUS CURIAE PROF. DR. LOUIS PAHLOW IN SUPPORT OF PETITIONERS

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INTEREST OF THE AMICUS CURIAE

Prof. Dr. Louis Pahlow is professor of modern legal history, private law and intellectual property law at Goethe University in Frankfurt am Main, Germany.[1] He has held the chairs for intellectual property and competition law at the University of Mannheim (2007 - 2009), and for intellectual property and legal history at Saarland University (2009 - 2012). He serves as Co-editor of the Journal for Modern Legal History (Zeitschrift für Neuere Rechtsgeschichte, ZNR), and is a Member of the Scientific Advisory Board, Society for Business History (Gesellschaft für Unternehmensgeschichte, GUG), and of the Scientific Advisory Board of the Interdisciplinary Center for Intellectual Property, University of Mannheim. He is a member of the German University Association, the Association for Constitutional History, the German Historian Association, the Association of Civil Law Teachers and the German Association for the Protection of Intellectual Property and Copyright.

Professor Pahlow is the author of numerous scholarly works regarding the international protection of intellectual property rights, *e.g.*, *University Invention Law: A Handbook for Science and Practice* (Springer 2011) (with Klaus Ferdinand Garditz); *Fundamentals And Fundamental issues of Intellectual Property* (Mohr Siebeck 2008); *Licenses*

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[1] Counsel for all parties have consented to the filing of this brief. No counsel for a party in this case authored this brief in whole or in part. No person or entity—other than the *amicus* or his counsel—made a monetary contribution to fund the preparation or submission of this brief.

and License Agreements in Intellectual Property Law (Mohr Siebeck 2006); *Global Flows of Knowledge: Expectations Toward Transnational Regulatory Aspects of Intellectual Property Rights in the 20th Century Chemical Industry,* 14 Management & Organizational History 1-16 (Oct. 2019), and legal history, *e.g.*, *The Temporal Dimension of Law: Historical Legal Research and Historical Jurisprudence* (Schöningh 2005) (with Josef Isensee, Alexander Hollerbach, Otto Depenheuer, Hans-Jürgen Becker, & Tilman Repgen).

As an expert in the international protection of intellectual property rights, and the history thereof, Professor Pahlow is concerned that the decision of the United States Court of Appeals for the Tenth Circuit's (the "Court of Appeals") holding – that the Lanham Act applies extraterritorially – contravenes the United States' international obligations regarding the protection of intellectual property and threatens the territoriality principle that is central to the international order for the protection of intellectual property. Professor Pahlow urges the Court to rule in favor of the Petitioner, holding that the Lanham Act does not apply extraterritorially.

SUMMARY OF ARGUMENT

The history of the international order for the protection of intellectual property, including trademarks, makes clear that the territoriality principle – in which the reach of a nation's legal regime for the protection of trademarks and other intellectual property is limited to the territory of that nation – is fundamental to that order, and the Lanham Act was enacted in 1947 in awareness of, and

with the intent to "carry out" the United States' international obligations, including that principle. Thus, the scope of the Lanham Act is properly limited to trademark infringements in the territory of the United States. Extraterritorial application beyond that would not only circumvent Congress' intent, but would also violate international law. Therefore, the judgment of the United States Court of Appeals for the Tenth Circuit – holding that the Lanham Act applies extraterritorially – should be reversed.

ARGUMENT

I. Congress Intended the Lanham Act to Carry Out the United States' Obligations Under International Agreements.

Although courts have noted that the Lanham Act of 1947, Pub. L. 79-489, 60 Stat. 427, 15 U.S.C. §1051 *et seq.,* provides "almost no indication of the extent to which Congress intended" the statute to have extraterritorial effect,[2] Congress regarded the statute as an enactment of international obligations. Under previous trademark law (the Trademark Act of 1905), non-U.S. citizens' trademark rights in the United States depended, in part, on the question whether U.S. citizens could acquire reciprocal rights in the

[2] *Vanity Fair Mills v. T. Eaton Co.*, 234 F.2d 633, 642 (2d Cir. 1956); *see also* Graeme W. Austin, *The Territoriality of United States Trademark Law*, in Peter Yu (ed.), *Intellectual Property and Information Wealth*, (Praeger 2007); Arizona Legal Studies Discussion Paper No. 06-20, available at SSRN: https://ssrn.com/abstract=896620 (12/11/2022) at 12-19.

non-U.S. citizens' home countries.[3] Seeking to improve the rights of U.S. citizens abroad – who had been "seriously handicapped in securing protection in foreign countries due to our failure to carry out, by statute, our international obligations" – Congress passed the Lanham Act "[t]o carry out by statute our international commitments to the end that American traders in foreign countries may secure the protection to their marks to which they are entitled."[4]

II. The Territoriality Principle is a Bedrock Principle of the International Order for the Protection of Intellectual Property.

The Lanham Act was enacted at a time when the U.S. was already firmly anchored in an international order for the protection of industrial property. In 1947, this international order consisted primarily of the Paris Convention of 1883, as amended by further revision conferences in Washington (1911), The Hague (1925), and London (1934). Article 2 of the Paris Convention incorporates the principle of national equal treatment, which confirms the territoriality principle of international protection of

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[3] Byfleet G. Ravenscroft, *International Trade Mark Law and Practice* (New York 1925) 556.

[4] Senate Report No. 1333, 79th Congress 2d Session, at 5, available at https://www.ipmall.info/sites/default/files/hosted_resources/lipa/trademarks/PreLanhamAct_026_HR_1333.pdf; *see also* J.J.S., Jr., *The 1946 Trade Mark Act,* 33 Virginia Law Review 303 (1947) (Lanham Act was intended, *inter alia*, "to carry out international conventions into which the United States has entered"); Bartholomew Diggins, *The Lanham Trade-Mark Act*, 35 Georgetown Law Journal 147, 205 (1947).

industrial property. That principle can be traced through different phases of legal development and has a high degree of acceptance.

A. Bilateral Trade Agreements

Since the recognition and enforcement of the idea of sovereign states, these states have decided autonomously whether and how to place foreign nationals on an equal legal status with their own nationals. This has been the case with regard to the protection of intellectual property, which, despite its natural law basis and the ubiquitous nature of the rights covered by it, could not give rise to transnational standards of protection. The first patent and copyright laws, such as those in France or England, did not initially contain any special regulations concerning foreigners.[5] Thus, not only was the effect of property rights created by a given nation limited to the territory of that nation; regulations on how to deal with foreign property rights and property right holders were often also lacking, and had to be worked out step by step.[6]

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[5] Frédéric Rideau, *Aspects of French Literary Property Developments in the Eighteenth (and Nineteenth) Centuries*, in Isabella Alexander & H. Tomás Gómez-Arostegui (eds.), *Research Handbook on the History of Copyright Law* (Cheltenham 2016) 409; Gabriel Galvez-Behar, *The Patent System during the French Industrial Revolution: Institutional Change and Economic Effects*, in *Jahrbuch für Wirtschaftsgeschichte* 60 (1) (2019) 31, 38.

[6] Isabella Alexander, *Copyright Law and the Public Interest in the Nineteenth Century*, (Portland 2010) 100; Sean Bottomley, *The British Patent System During the Industrial Revolution*

Cross-border regulations were initially agreed to in the first half of the 19th century by means of bilateral trade agreements between individual states. These agreements were intended primarily to ensure unhindered economic trade that would not be disturbed or impeded by foreign property rights. The protection of intangible goods was therefore not infrequently dependent on overriding trade interests and in part also tied to the principle of reciprocity.[7] In the field of trademarks, 69 agreements have been documented between the industrialized or industrializing countries of Europe and America, which were essentially based on a formal equal status of foreigners and nationals in order to maintain or enable access to the respective market.[8] Representative of many other agreements, a trade treaty between the German Customs Union and France in 1862, for example, stated: "[w]ith regard to the designation or labeling of goods or their packaging, designs and factory or trade marks, the

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1700-1852: *From Privilege to Property* (Cambridge Univ. Press 2014) 69-70, 163-164.

[7] Sam Ricketson, *The Paris Convention for the Protection of Industrial Property: A Commentary* (Oxford Univ. Press 2015) 26-30 (hereinafter, Ricketson, *Paris Convention)* (providing additional examples).

[8] Sam Ricketson, *The Trademark Provisions in the Paris Convention for the Protection of Industrial Property*, in Irene Calboli & Jane C. Ginsburg (eds.), *The Cambridge Handbook of International and Comparative Trademark Law* (Cambridge Univ. Press 2020) (hereinafter, Ricketson, *Trademark)* at 5.

subjects of each of the contracting states shall enjoy the same protection in the other as nationals."[9]

B. The Paris Convention of 1883

The increase in international goods traffic in the second half of the 19th century increased the need for multilateral – and above all practicable – regulation of protected rights. Significantly, the initiative for this came less from the states themselves than from the actors concerned, especially manufacturers, engineers, authors, and lawyers. The World's Fairs held in the mid-Nineteenth Century provided suitable platforms for this, with simultaneous international congresses discussing the first drafts of multilateral protection for patents, trademarks and designs, and authors' rights.[10]

France in particular took up these efforts and initiated a political coordination process that also took into account the national interests of the individual states. Although the discussion initially focused primarily on patents, since the Paris World's Fair of 1878 and the so-called Second International Congress for the Protection of Industrial Property held there, it has extended to other protective rights such as designs or trademarks. According to this, trademarks were to be subject to an international regulation,

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[9] Trade Contract Between States of the German Customs Union and France (August 2, 1862), in Law Collection for the Prussian States, 1862, pp. 333ff., Art. 28; *see also* Frank Bayer, *The system of German Trade Agreements From 1853 and 1914: Principles of International Law and Their Similarities with Today's World Economic Law* (Berlin 2004) 186-187.

[10] Ricketson, *Paris Convention* (note 7, *supra*), 4-6.

according to which a person who has applied for a trademark in his home country can also apply for it or have it protected in other member states, provided that this member state has a corresponding protection regime.[11] On this basis, the "International Convention for the Protection of Industrial Property" (the "Paris Convention") was finally signed by 10 states in Paris in 1883.

The Paris Convention, as well as the Convention for the Protection of Literary and Artistic Works signed in Berne in 1886, marked milestones in the history of international law. Both the Paris and the Berne Conventions went beyond previous bilateral and multilateral agreements. After all, they were open-access treaties that were in principle available to all states of the world, provided they agreed to the regulations agreed upon within.

From the outset, regular revisions were agreed upon to ensure the conventions' ability to develop and adapt to changing conditions. In addition, joint and permanent intergovernmental institutions such as the "Berne Bureau" were established, reflecting not only an increased degree of cooperation, but also an intensified will to regulate.

Thus, from the very beginning, the Paris Union was not just an agreement, but a "federation" with its own budget and personnel, including concrete tasks and responsibilities. The idea of an "international community" that sought to establish a right of cooperation among states in place of the right of coexistence was already being celebrated enthusiastically in some quarters at the end of the

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[11] Ricketson, *Trademark* (note 8, *supra*), 4.

19th century, which hailed the new developments as "world treaties."[12]

However, the conceptual success of the Paris Union for the protection of industrial property was based primarily on the fact that it interfered only minimally with the national regulatory competence of the states. The Convention of 1883 merely standardized certain minimum rights that all member states were required to grant to the rights holders of another member state. These included, in particular, the principle of equal treatment of nationals (Art. 2), which has had a long and successful tradition since 1883. The Paris Union thus expressly adhered to the principle of equal treatment of nationals expressed in earlier agreements:

> *The subjects or citizens of each of the contracting States shall enjoy, in all the other States of the Union, so far as concerns patents for inventions, trade or commercial marks, and the commercial name, the advantages that the respective laws thereof at present accord, or shall afterwards accord to subjects or citizens. In consequence they shall have the same protection as these latter, and the same legal recourse against all infringements of their rights, under reserve of complying with the formalities and conditions*

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[12] Miloš Vec, *Weltverträge für Weltliteratur. Das Geistige Eigentum im System der rechtssetzenden Konventionen des 19. Jahrhunderts*, in Louis Pahlow & Jens Eisfeld (eds.), *Grundlagen und Grundfragen des Geistigen Eigentums* (Tübingen 2008) 107-130; Martti Koskenniemi, *The Gentle Civilizer of Nations: The Rise and Fall of International Law 1870-1960* (Cambridge Univ. Press 2001) 210-13; Bardo Fassbender & Anne Peters (eds.), *The Oxford Handbook of the History of International Law* (OUP Oxford 2012) 338, 654.

imposed upon subjects or citizens by the domestic legislation of each State.[13]

Upon accession to the Paris Convention, member states were obliged to grant the nationals of the other member states the same protection in their territory as their own nationals, in particular before their authorities and courts. Thus, a foreigner could not be treated less favorably by the domestic forum than a national ("prohibition of discrimination"). Equal treatment and thus the prohibition of discrimination applied both to the acquisition of protection and to the defense of protection rights, but also to questions of loss of protection (for example, because of cessation of payment of protection fees, forfeiture of protection rights, or because of exhaustion of rights).

Under the principle of equal treatment, a foreigner could invoke the national substantive law of the country in which he wished to initiate proceedings, which could not be interpreted differently against him than against a national of that country. On the other hand, this also applied in the opposite direction among associated countries – *i.e.,* foreign law could not be applied domestically against a national. Accordingly, the domestic applicant for a U.S. trademark could only claim protection in the United States, and not in a foreign member state since the law of the foreign member state applied there. The borders of the member state were thus always also the borders of the protection right of the respective member state (territoriality principle). This was the case whether or not the nationals of the country of protection could claim the same or equivalent

[13] Charles I. Bevans, *Treaties and other International Agreements of the United States of America*, Vol. 1, 1776-1917, Washington 1968.

protection in the home country of the person seeking protection (reciprocity).[14]

With the Paris Convention, the signatory states thus committed themselves to the recognition and respect of their respective protection regimes; in this regard, bilateral agreements were no longer relevant; formal accession to the Union was sufficient. Although the Convention also standardized individual minimum rights – in particular the recognition (and later also the transfer) of foreign priorities – they play at most a secondary role in the present proceedings. In this context, it is decisive that the sovereignty of the member states with regard to property rights was largely preserved.[15] Each state was able to limit itself to a one-time accession performance, *i.e.,* to compliance with equal treatment of nationals or with the agreed minimum rights.

C. Applicability to U.S. Trademarks

The United States acceded to the Paris Union by ratification effective May 30, 1887, and has been part of this binding international association for the protection of industrial property since then. Thus,

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[14] Ricketson, *Paris Convention* (note 7, *supra*), 57.

[15] Ricketson, *Trademark* (note 8, *supra*), 5; Laurence Boisson de Chazournes & Rajan Dhanjee, *Trade-Related Aspects of Intellectual Property Rights (TRIPS): Objectives, Approaches and Basic Principles of the GATT and of Intellectual Property Conventions*, in *Journal of World Trade 24* (1990) 5, 9; Eugen Ulmer, *Gewerbliche Schutzrechte und Urheberrechte im Internationalen Privatrecht*, in *The Rabel Journal of Comparative and International Private Law*, Vol. 41/3 (1977) at 479-514.

Article 2 of the Convention has been directly applicable to the territory of the U.S. since 1887. The United States explicitly confirmed Art 2 of the Convention in the 1958 Lisbon Agreement, which the United States ratified in 1962.[16]

The principle of equal treatment of nationals referred to the protection of "industrial property" and covered "factory and trademarks" and "trade names" as early as 1883. The Paris Convention did not contain any provisions as to whether the right to the trademark could be acquired by registration, by use, or by both. Instead, the Convention left it to the member states to decide – in accordance with the objective of largely retaining state sovereignty – whether and to what extent they wished to subject trademark applications to examination.

Nor was the scope of protection of a trademark specified in the Convention. Therefore, despite the entry into force of the Convention, the principle of territoriality required that trademarks still had to be applied for or protected separately in each country, in compliance with their respective legal provisions, which in some cases differed considerably from one another.

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[16] The United States ratified the 1967 Stockholm Conference revisions to the Lisbon Convention "with a declaration to the effect that its ratification shall not apply to Articles 1 to 12," https://www.wipo.int/treaties/en/notifications/paris/treaty_paris_20.html (12/11/2022), but this did not render the principle of equal treatment of nationals inapplicable, because, according to Art. 27 (a) para. 2 (a) of the version of the Paris Convention adopted in Stockholm, a reservation by an already existing State Party resulted in the excluded articles being replaced by the earlier versions.

Difficulties with regard to registering a trademark abroad prompted several member states to conclude the Agreement concerning the International Registration of Trade Marks in Madrid on April 14, 1891. To date, the United States has not acceded to this Madrid Agreement. For the U.S., therefore, the principles standardized in the Paris Agreement have remained in force. In this context, however, it is important to note that the Madrid Agreement did not affect the principle of equal treatment of nationals or the principle of territoriality. The same applies to the further revision conferences of the Convention.

Further special agreements specific to trademark law, in particular the Protocol to the Madrid Agreement of 1989, the Nice International Classification Agreement of 1957, and the more recent World Intellectual Property Organization (WIPO) treaties, including Trade-Related Aspects of Intellectual Property Rights Agreements ("TRIPs"), also adhere to the territorial limitation of substantive trademark law. Accordingly, the Paris Convention, with its enshrinement of the territoriality principle, remains the starting point for U.S. trademark owners seeking or claiming protection for their marks in other countries.[17] Those who do not protect their U.S. trademark abroad remain unprotected there as a consequence.[18]

Accordingly, applying the Lanham Act to trademark infringement abroad would be a violation of international law. American judges have made this

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[17] Ricketson, *Trademark* (note 8, *supra*), 6; Alessandro L. Celli, *Internationales Kennzeichenrechtrecht*, (Basel 2000) at 63-89.

[18] *See also* Celli (note 17, *supra),* 65-66.

explicit in decisions in which the Act has been given extraterritorial application – as Justice Reed stated in *Steele v. Bulova Watch Co*., 344 U.S. 280, 292 (1952): Reed in 1952: "[s]uch extensions of power bring our legislation into conflict with the laws and practices of other nations, fully capable of punishing infractions of their own laws, and should require specific words to reach acts done within the territorial limits of other sovereignties."[19]

III. Applying the Lanham Act Extraterritorially Would Violate the Territoriality Principle, and International Law.

The Paris Convention is an expression of a minimum solution accepted by the contracting states at the time. Apart from the minimum rights agreed upon at the time, the negotiators of the treaty did not want to (and could not) interfere with national legislation. A softening of the principle of territoriality by means of a further legal interpretation of the Paris Convention would not only call into question the historically reconstructible ideas of the lawmaking actors, but also the system of international protection as a whole.

Although there were repeated calls – in the run-up to the Paris Convention and afterwards – for a standardization of protection, and so-called "world patents" or "world trademarks,"[20] these efforts did not

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[19] *See also* Austin (note 2, supra), 13-14.

[20] Alard du Bois-Reymond, *Das Weltpatent*, in Josef Kohler *als Festgabe zum 60 Geburtstage zugeeignet von deutschen Praktikern*, Berlin (1909) 465-490; Edwin Katz, *Weltmarkenrecht*, Berlin (1926); Paul Roubier, *Le droit unioniste*

prevail. The 1860s and 1870s were marked not only by ideas of free trade but also by growing rivalry between nation states, which was exacerbated by the Great Depression of 1873 and a growing protectionism that accompanied it. The idea of providing for a uniform patent or trademark law for all states turned out to be impracticable.

As early as 1878, at the "Second International Congress for the Protection of Industrial Property" in Paris, unifying rules were largely ruled out.[21] This was mainly due to the considerable divergences between the existing concepts of protection, which were particularly evident in patent law. While France and other continental European countries practiced a filing system, Germany and the U.S. required an official examination of the invention before a patent could be granted.[22]

A solution based on private international law – in which, in a manner similar to property rights, the protection of industrial property would be assessed uniformly according to the law of the country in which the trademark was first used or registered[23] – was not able to gain acceptance as a regulatory concept in the

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de la propriété industrielle, in *Journal du droit international*, Vol. 78 (1951) 676-769.

[21] Ricketson, *Paris Convention* (note 7, *supra*), at 42.

[22] Gabriel Galvez-Behar, *The 1883 Paris Convention and the Impossible Unification of Industrial Property*, in Graeme Gooday/Steven Wilf (eds.), *Patent Cultures. Diversity and Harmonization in Historical Perspective*, (Cambridge Univ. Press 2020) 38; Ricketson, *Trademark* (note 8, *supra*), 5.

[23] Congrès international de la propriété industrielle, Paris 1878, at 130.

deliberations on the Paris Convention. The Convention was based on negotiating positions that were in principle shaped by the sovereignty interests of the nation states, which could accept voluntary self-restraint in the discrimination of foreigners only because this would simultaneously ensure the protection of their own nationals abroad.

Moreover, there was a legal-practical or procedural-economic argument against such a solution, which also prompted the Berne Union to adopt corresponding regulations. The courts would have been confronted with legal disputes in which they would have had to apply the respective trademark law of the foreign country of domicile without having sufficient knowledge of that law.[24] The consequence would be a considerable impairment of legal certainty if foreign property rights had to be judged domestically according to the law of the country of origin.

Under these circumstances, the principle of territoriality rose to become the comprehensive organizing principle of international industrial property protection. It required neither uniformity of law nor the difficult application of foreign law, but only the willingness of individual countries to apply their own legislation in their territory to nationals and foreigners without discrimination. This realistic idea of ensuring international protection of industrial property through the national law of each contracting state, without having to fundamentally change it, was extremely conducive to the territorial expansion and persistence of the Paris Union through two world wars

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[24] Isabella Löhr, *Die Globalisierung geistiger Eigentumsrechte. Neue Strukturen internationaler Zusammenarbeit* 1886-1952 (Göttingen 2010) 71.

and the East-West conflict. It allowed the national legislature of each country of the Union wide latitude in shaping the protection in detail and enabled countries from different legal circles and social and economic structures to accede to the Convention.

This was particularly evident during the Cold War. Only with this regulation, which was limited to a few principles, was it possible for socialist states such as the Soviet Union – with patent and trademark regimes very different from those in Western legal systems – to decide in favor of accession in 1965. If the Eastern bloc states had had to submit to Western standards from the outset, the extension or retention of the Paris Convention in this part of the world after 1945 would have been unthinkable. For this reason, in particular, repeated calls for legal unification in this era were rejected as "utopian."[25] In other words, the Paris Union was successful in the Cold War primarily because an American in the Soviet Union was to be treated according to Soviet law, and the Soviet national in the United States according to American law.

CONCLUSION

As the history described above makes clear, the territoriality principle is fundamental to the international order for the protection of intellectual property, and the Lanham Act was enacted in 1947 in awareness of, and with the intent to "carry out" the United States' international obligations, including

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[25] Eugen Ulmer, *Die Entwicklung des gewerblichen Rechtsschutzes in internationaler Sicht, in: Gewerblicher Rechtsschutz in Ost und West*, Studien des Instituts für Ostrecht, (Herrenalb 1966) 11, 17.

that principle. Thus, the scope of the Lanham Act is properly limited to trademark infringements in the territory of the United States. Extraterritorial application beyond that would not only circumvent Congress' intent, but would also violate both international law. For the foregoing reasons, the judgment of the United States Court of Appeals for the Tenth Circuit should be reversed.

Respectfully submitted,

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