

ARTICLE

DESIGNING A GLOBAL INTELLECTUAL PROPERTY SYSTEM RESPONSIVE TO CHANGE: THE WTO, WIPO, AND BEYOND

*Graeme B. Dinwoodie**

*Rochelle C. Dreyfuss***

TABLE OF CONTENTS

I.	INTRODUCTION	1188
II.	THE ROLE OF WIPO AND ITS CONVENTIONS IN INTERPRETING TRIPS: THE STORY SO FAR.....	1198
	A. <i>Relying on Incorporated Provisions</i>	1199
	B. <i>Dealing with Potential Discrepancies Between TRIPS and the Incorporated Conventions</i>	1201
	C. <i>Use of WIPO Conventions by Analogy</i>	1205
	D. <i>Coping with TRIPS Standards Expressly Different than the WIPO Conventions</i>	1210
	E. <i>Using Post-TRIPS WIPO Developments to Inform TRIPS</i>	1212
III.	INTERPRETIVE APPROACHES AND RELEVANT SOURCES	1214
	A. <i>The Role of the TRIPS Agreement's Principles and Objectives in Interpretation</i>	1215
	B. <i>TRIPS as a Trade Agreement</i>	1217

* Professor of Intellectual Property and Information Technology Law, University of Oxford – Faculty of Law; Professorial Fellow, St. Peter’s College.

** Pauline Newman Professor of Law, New York University School of Law. I would like to thank Thomas Lang and Guy Ben-Ami, N.Y.U. L.L.M. Class of 2009, as well as Robert Taylor, N.Y.U. J.D. Class of 2011, for their research assistance and the Filomen D’Agostino and Max E. Greenberg Research Fund for its financial support. This Article is based on a chapter that will appear in RESEARCH HANDBOOK ON THE PROTECTION OF INTELLECTUAL PROPERTY UNDER WTO RULES (Carlos Correa ed., 2010) (forthcoming).

C. *Relying on Multiple Sources* 1220

 1. *National Practices* 1221

 2. *Subsequent WIPO Material* 1225

 3. *Other International Developments* 1229

D. *Devices for Ensuring Input* 1230

IV. CONCLUSION 1233

I. INTRODUCTION

In recent years, it has become clear that the TRIPS regime is in trouble.¹ Although lawmaking in the World Trade Organization (WTO) has essentially stalled,² there is a continuing need to recalibrate the rules applicable to knowledge production. For developing countries, entry into the WTO was a compromise. When intellectual property lawmaking was centered in the World Intellectual Property Organization (WIPO), these nations resisted attempts to increase the level of protection. That changed, however, with the inclusion of intellectual property in negotiations over trade; in return for access to markets in the developed world, developing countries were required to enact and enforce new intellectual property laws.³ While the TRIPS Agreement tried to ease their conversion to greater protection, the transitional provisions it included proved to be largely illusory: the time periods for compliance were too short; the promises of technology transfer and technical assistance, inadequately realized.⁴ Furthermore, the Agreement paid little attention to the problem of providing access to the training and educational materials that would allow these countries to advance to the intellectual frontier.⁵ Paradoxically, for some

1. Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments—Results of the Uruguay Round, 33 I.L.M. 1125 (1994) [hereinafter TRIPS].

2. Stephen Castle & Mark Landler, *After 7 Years, Talks Collapse on World Trade*, N.Y. TIMES, July 30, 2008, at A1.

3. See generally CHRISTOPHER MAY & SUSAN K. SELL, INTELLECTUAL PROPERTY RIGHTS: A CRITICAL HISTORY (2006).

4. See TRIPS, *supra* note 1, arts. 66–67 (providing a ten-year grace period for least-developed country members and requiring developed countries to provide incentives to promote technology transfer and technical cooperation); see also Duncan Matthews & Viviana Munoz-Tellez, *Bilateral Technical Assistance and TRIPS: The United States, Japan and the European Communities in Comparative Perspective*, 9 J. WORLD INTELL. PROP. 629, 632–33, 649–50 (2006) (suggesting that the “deficiencies in the design and delivery of IP-related technical assistance to developing countries” may result from built-in limitations to Article 67 of TRIPS).

5. See Margaret Chon, *Intellectual Property and the Development Divide*, 27

developing countries, the WTO regime can also be insufficiently protective: TRIPS rights are structured for the types of knowledge goods generated in the North, but do not cover the traditional knowledge, folklore, and natural endowments that constitute much of the informational wealth of the South. To be sure, the Doha Declaration and subsequent actions dealt with a few of the concerns of developing countries,⁶ but unless more radical accommodations are found, many WTO members may languish in a social and economic backwater, paying high prices for information products without the ability to fully exploit their own creative capacities.⁷

In developed nations, the problems are not very different, for there as well TRIPS now offers both too much and too little protection. The Agreement was, after all, crafted for a particular era—an era that largely predated Internet commerce in trademarked goods, distribution of digitized copyrighted materials, and the informatics revolution within the patent industries.⁸ The explosion in global marketing puts pressure on the territoriality principle embedded in TRIPS,⁹ arguably leading to underprotection, particularly of works distributed electronically. At the same time, however, the emergence of new intellectual opportunities and enterprises alters the economics of information production. The TRIPS Agreement's strong commitment to a particular vision of proprietary rights—and, on the patents side, to technological neutrality—makes it difficult to revise the law to deal with such matters as the thickets of rights created in the software and biotechnological sectors, open source innovation, and new opportunities for serial and collaborative production.¹⁰

CARDOZO L. REV. 2821, 2885–86 (2006) (“Basic needs [including food, education, and health care] have been underemphasized in much of the debate about what to do about intellectual property globalization.”); J. H. Reichman, *From Free Riders to Fair Followers: Global Competition Under the TRIPS Agreement*, 29 N.Y.U. J. INT'L L. & POL. 11, 87 (1997) (stressing the need for accelerated development of technical knowledge within underdeveloped countries).

6. See, e.g., Antony Taubman, *Rethinking TRIPS: 'Adequate Remuneration' for Non-Voluntary Patent Licensing*, 11 J. INT'L ECON. L. 927, 935 (2008) (discussing efforts in the Doha Round to improve access to patented pharmaceuticals in developing countries).

7. Rochelle Cooper Dreyfuss, *Fostering Dynamic Innovation, Development and Trade: Intellectual Property as a Case Study in Global Administrative Law* (Inst. for Int'l Law & Justice, Working Paper No. 2008/4, 2008), available at <http://ssrn.com/abstract=1316925>.

8. See, e.g., Katherine J. Strandburg, *Evolving Innovation Paradigms and the Global Intellectual Property Regime*, 41 CONN. L. REV. 861, 863–64, 871, 889–90 (2009).

9. Graeme B. Dinwoodie, *Trademarks and Territory: Detaching Trademark Law from the Nation-State*, 41 HOUS. L. REV. 885, 955–66 (2004).

10. See Graeme B. Dinwoodie & Rochelle Cooper Dreyfuss, *International Intellectual*

In theory, the problems facing WTO members could be resolved through new lawmaking. This could take a number of forms. For instance, a “bottom up” approach would give states greater flexibility to adapt local laws to deal with the different problems they each encounter. As Jerry Reichman suggests in his contribution to this volume, emerging nations, new to both intellectual property and to innovation, are particularly fertile grounds for such legal experimentation.¹¹ When such adaptations are picked up by other WTO members, the Agreement could be modified to reflect new consensuses. Alternatively, solutions could originate at the international level; after codification into the Agreement, they would then “trickle down” as member states transposed their new obligations into domestic law.¹² For a variety of reasons, however, neither of these approaches has materialized. In part, the problem is simply stasis in the WTO. In part, there is a disconnect between the WTO’s objective of enhancing economic welfare through free trade and the values embodied in intellectual property law.¹³ For example, because of concerns over how liberalizing the rules on compulsory licensing would affect the market, even the one concrete achievement of the Doha Round—assuring developing countries access to essential medicines—has yet to be fully implemented.¹⁴

As many have noted, the WTO’s adjudicatory system has compensated somewhat for the lack of activity in the Ministerial Conference and the General Council.¹⁵ But for a number of

Property Law and the Public Domain of Science, 7 J. INT’L ECON. L. 431, 433–36 (2004) (exploring methods for implementing subject-matter exclusions in patent law while still complying with the technological neutrality requirements of Article 27 of TRIPS).

11. Jerome H. Reichman, *Intellectual Property in the Twenty-First Century: Will the Developing Countries Lead or Follow?*, 46 HOUS. L. REV. 1115 (2009); accord Rochelle C. Dreyfuss, *The Role of India, China, Brazil and Other Emerging Economies in Establishing Access Norms for Intellectual Property and Intellectual Property Lawmaking* 12–13 (Inst. for Int’l Law & Justice, Working Paper No. 2009/5, 2009), available at http://ssrn.com/abstract_id=1442785.

12. Of course, this lawmaking approach can generate its own problems if it seeks to impose a one-size-fits-all model of intellectual property protection. See Dinwoodie & Dreyfuss, *supra* note 10, at 435–36.

13. Graeme B. Dinwoodie, *The International Intellectual Property System: Treaties, Norms, National Courts, and Private Ordering*, in INTELLECTUAL PROPERTY, TRADE AND DEVELOPMENT 61, 76–79 (Daniel J. Gervais ed., 2007); Rochelle Cooper Dreyfuss & Andreas F. Lowenfeld, *Two Achievements of the Uruguay Round: Putting TRIPS and Dispute Settlement Together*, 37 VA. J. INT’L L. 275, 277–81 (1997).

14. See generally DANIEL GERVAIS, *THE TRIPS AGREEMENT: DRAFTING HISTORY AND ANALYSIS* 54, 395–97 (3d ed. 2008) (summarizing the amendment creating a tailored mechanism for compulsory licenses to enhance access to patented pharmaceuticals); Taubman, *supra* note 6, at 929–35 (same).

15. See, e.g., TOMER BROUDE, *INTERNATIONAL GOVERNANCE IN THE WTO: JUDICIAL BOUNDARIES AND POLITICAL CAPITULATION* 214–15 (2004) (noting the DSB is dealing with

reasons, it is not a substitute for a well-functioning “legislative body.” It cannot replicate the top-down approach of an international agreement on substantive norms because, under the Understanding for Dispute Settlement (DSU),¹⁶ the decisions by the Dispute Resolution Board (DSB) may not “diminish the rights and obligations provided in the covered agreements.”¹⁷ And the institutional character of the DSB does not encourage disregard of this formal limit on judicial activism.¹⁸ These constraints, both formal and institutional, appear to allow the DSB to complement a bottom-up approach because the TRIPS Agreement ostensibly leaves members with substantial room to maneuver.¹⁹ Members can, for example, increase the level of domestic protection.²⁰ But as we have explained in other writings, the DSB has interpreted TRIPS flexibilities so narrowly that member states cannot otherwise adapt their laws to new circumstances.²¹

open questions on which of the other organs of the WTO are failing to act); Claus-Dieter Ehlermann & Lothar Ehring, *Decision-Making in the World Trade Organization: Is the Consensus Practice of the World Trade Organization Adequate for Making, Revising and Implementing Rules on International Trade?*, 8 J. INT'L ECON. L. 51, 68–71 (2005) (suggesting reasons why WTO members tend to relegate important decisionmaking to judicial bodies when legislative action would be more appropriate).

16. Understanding on Rules and Procedures Governing the Settlement of Disputes, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 2, Legal Instruments—Results of the Uruguay Round, 33 I.L.M. 1125 (1994) [hereinafter DSU].

17. DSU, *supra* note 16, art. 3.2. The TRIPS Council's role in lawmaking is similarly circumscribed. See Final Act Embodying the Results of the Uruguay Round of Multilateral Trade Negotiations art. IX, Apr. 15, 1994, 33 I.L.M. 1125 (1994).

18. See Graeme B. Dinwoodie, *A New Copyright Order: Why National Courts Should Create Global Norms*, 149 U. PA. L. REV. 469, 503–18 (2000) (rejecting an activist interpretive philosophy in resolving WTO disputes). Whether this constraint holds in the long term might depend in part on whether a sufficient number of intellectual property disputes reach the Appellate Body, whose legally binding reports more closely resemble judicial decisions than the reports of dispute settlement panels (whose reports have a more political or diplomatic resonance). See Robert Howse, *The Most Dangerous Branch? WTO Appellate Body Jurisprudence on the Nature and Limits of the Judicial Power*, in THE ROLE OF THE JUDGE IN INTERNATIONAL TRADE REGULATION 11, 11 (Thomas Cottier & Petros C. Mavroidis eds., 2003).

19. Jerome H. Reichman, *Universal Minimum Standards of Intellectual Property Protection Under the TRIPS Component of the WTO Agreement*, in INTELLECTUAL PROPERTY AND INTERNATIONAL TRADE: THE TRIPS AGREEMENT 23, 65 (Carlos M. Correa & Abdulqawi A. Yusuf eds., 2d ed. 2008) (characterizing the TRIPS enforcement provisions as “favouring broad legal ‘standards’ over narrow rules,” the ambiguity of which “allows dispute settlement evaluators to take account of local circumstances and differing legal philosophies”).

20. New Zealand, for example, offers enhanced protection for the Maori culture. See Graeme W. Austin, *Valuing “Domestic Self-Determination” in International Intellectual Property Jurisprudence*, 77 CHI.-KENT L. REV. 1155, 1198–99 (2002) (explaining how the New Zealand Parliament responded to intellectual property concerns of the Maori tribe by drafting a trademark bill precluding registration of certain Maori words and symbols).

21. See Dinwoodie & Dreyfuss, *supra* note 10, at 435; Graeme B. Dinwoodie &

There are other confounding factors. Countries are showing signs of giving up on the WTO. Some have begun to use bilateral agreements to enhance the level of protection.²² Others are engaging in forum shopping at the multilateral level (“regime shifting”).²³ Claims to the knowledge embedded in natural resources are moving to negotiations over the Convention on Biological Diversity;²⁴ some intellectual property issues have been restructured as human rights claims;²⁵ and a new criminal enforcement regime is under contemplation.²⁶ As Peter Yu suggests in his contribution to this volume, what is emerging is an “international IP regime complex,” consisting of institutions such as the World Health Organization; the Secretariat of the Convention on Biological Diversity; the Food and Agriculture Organization; the United Nations Educational, Scientific and Cultural Organization (UNESCO); and the United Nations Conference on Trade and Development (UNCTAD).²⁷ In part, the focus has even shifted back, *from* the WTO *to* WIPO. Although, in theory, regulatory competition could enrich international innovation policy, the early indication is that asymmetries in bargaining power, coupled with the overlap in lawmaking authority, are leading to a suboptimal global regime: thickets of rights,²⁸ conflicting demands,²⁹ disputes that

Rochelle C. Dreyfuss, *TRIPS and the Dynamics of Intellectual Property Lawmaking*, 36 CASE W. RES. J. INT'L L. 95, 97–100 (2004) [hereinafter Dinwoodie & Dreyfuss, *Dynamics*]; Graeme B. Dinwoodie & Rochelle C. Dreyfuss, *Diversifying Without Discriminating: Complying with the Mandates of the TRIPS Agreement*, 13 MICH. TELECOMM. & TECH. L. REV. 445, 448–49 (2007) [hereinafter Dinwoodie & Dreyfuss, *Diversifying*].

22. Timothy P. Trainer, *Intellectual Property Enforcement: A Reality Gap (Insufficient Assistance, Ineffective Implementation)?*, 8 J. MARSHALL REV. INTELL. PROP. L. 47, 61–68 (2008).

23. Laurence R. Helfer, *Regime Shifting: The TRIPs Agreement and New Dynamics of International Intellectual Property Lawmaking*, 29 YALE J. INT'L L. 1, 55–61 (2004).

24. Convention on Biological Diversity art. 15(1), June 5, 1992, 1760 U.N.T.S. 79.

25. Laurence R. Helfer, *The New Innovation Frontier? Intellectual Property and the European Court of Human Rights*, 49 HARV. INT'L L.J. 1, 12–13 (2008).

26. See, e.g., Anti-Counterfeiting Trade Agreement (ACTA): Request for Public Comments, 73 Fed. Reg. 8910 (Feb. 15, 2008) (requesting public comments regarding a proposed treaty to address international counterfeiting and piracy concerns); Trainer, *supra* note 22, at 75 (describing a report from the office of the U.S. Trade Representative recommending “stronger and more effective criminal and border enforcement” to combat international counterfeiting and piracy).

27. Peter Yu, *The Objectives and Principles of the TRIPS Agreement*, 46 HOUS. L. REV. 979 (2009).

28. Sabrina Safrin, *Hyperownership in a Time of Biotechnological Promise: The International Conflict to Control the Building Blocks of Life*, 98 AM. J. INT'L L. 641, 653–55 (2004) (discussing biotechnological inventions).

29. See, e.g., Panel Report, *European Communities—Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs*, WT/DS174/R (Mar. 15, 2005) [hereinafter *EC-GI*] (resolving a dispute regarding conflicts between geographic

perpetually cycle,³⁰ and uncertainties created by institutional cacophony.³¹

However, the move to WIPO is intriguing, for it suggests an institutional design that could make the international intellectual property system more responsive to changing needs. WIPO and its predecessor, the United International Bureaux for the Protection of Intellectual Property (BIRPI), were established to consolidate the international intellectual property regime and WIPO agreed that, as part of its mission, it would consider the impact of intellectual property protection on the developing world.³² Although WIPO's early attempts at resolving the problems of the South largely faltered, it recently renewed its commitment to a "Development Agenda" and has even taken up questions about overprotection in the North.³³ WIPO has a governance structure that potentially permits more diverse input than the WTO and greater flexibility in voting. It has restructured its norm development processes to enable it to respond expeditiously to new issues through the adoption of soft

indications and trademarks); Mitchell Smith, *The Relationship Between TRIPs and the CBD: A Way Forward?* 3–6 (May 11, 2009) (unpublished manuscript, on file with Houston Law Review) (discussing conflicts between TRIPS and the Convention on Biological Diversity).

30. See, e.g., *Anheuser-Busch Inc. v. Budejovický Budvar N.P.*, [1984] FSR 413 (CA) (U.K.) (one national component of a multi-territorial dispute between Anheuser-Busch, an American brewer, and a Czech brewery dating back to the early 1900s); *Anheuser-Busch Inc. v. Portugal*, App. No. 73049/01 (Grand Chamber 2007) (ECHR), available at <http://cmiskp.echr.coe.int/tkp197/search.asp?skin=hudoc-en> (search "73049/01" under application number) (addressing same long-running dispute in terms of Portugal's compliance with human rights law); *Joined Cases T-225/06, T-255/06, T-257/06 & T-309/06, Budejovický Budvar v. Office for Harmonisation in the Internal Market (Trade Marks & Designs)* (OHIM) (Ct. First Instance 2008) (EC), available at http://curia.europa.eu/jcms/jcms/j_6/home (search "T-225/06" under case name) (overturning OHIM's decision to grant Anheuser-Busch EU-wide rights to use the word "BUD" for beer and other alcoholic beverages); see also *Case T-191/07, Anheuser-Busch, Inc. v. Office for Harmonisation in the Internal Market (Trade Marks & Designs)* (OHIM) (Ct. First Instance 2009) (EC), available at http://curia.europa.eu/jcms/jcms/j_6/home (search "T-191/07" under case number) (refusing to grant Community Trademark in the term "BUDWEISER" to Anheuser-Busch).

31. See *Decision by the Arbitrators, European Communities—Regime for the Importation, Sale and Distribution of Bananas*, ¶ 152, WT/DS27/ARB/ECU (Mar. 24, 2000) [hereinafter *Ecuador-Bananas*] (suggesting that it was not within the jurisdiction of WTO arbitrators to assess whether measures authorized under the WTO agreements might result in noncompliance with obligations under WIPO conventions).

32. See Debora J. Halbert, *The World Intellectual Property Organization: Past, Present and Future*, 54 J. COPYRIGHT SOC'Y U.S.A. 253, 255, 262–66 (2007).

33. World Intellectual Prop. Org. [WIPO], *Report of the Provisional Committee on Proposals Related to a WIPO Development Agenda (PCDA), Fourth Session*, WIPO Doc. PCDA/4/3 (Aug. 20, 2007), available at http://www.wipo.int/edocs/mdocs/mdocs/en/pcda_4/pcda_4_3_prov_2.pdf. An excellent overview of this renewed commitment is provided by THE DEVELOPMENT AGENDA: GLOBAL INTELLECTUAL PROPERTY AND DEVELOPING COUNTRIES (Neil Weinstock Netanel ed., 2009).

law instruments.³⁴ As a result, it is also not suffering as badly from the lawmaking problems confounding the WTO. Post-TRIPS, it has held conferences and issued influential reports on emerging issues;³⁵ it has also successfully concluded negotiations over several new intellectual property instruments.³⁶ Significantly, the TRIPS Agreement contemplates a formal tie with WIPO. The two organizations have entered into an agreement “to establish a mutually supportive relationship”³⁷ and enjoy a host of informal connections.³⁸ In theory, then, WIPO could serve as a vehicle for keeping WTO law abreast of the evolving demands of both producers and consumers of innovation, as well as the varied needs of the WTO’s membership. With WIPO’s greater receptivity to emerging issues and the WTO’s capacity to enforce compliance, some of the impasses caused by regime shifting would hopefully abate, along with the other problems associated with overlapping regulatory authority.

Greater input from WIPO would be beneficial for another reason as well. Because the focus of the WTO is trade, the TRIPS Agreement tends to view intellectual property very much as a commodity. Lost in the drafting process was the sense that intellectual property embodies cultural values, that it

34. See Dinwoodie, *supra* note 13, at 80–84 (describing how WIPO has successfully employed mechanisms to produce soft law instruments such as the Uniform Domain Name Dispute Resolution Policy (UDRP) that may in practice turn out to be harder law).

35. See, e.g., WIPO, *Use of Trademarks on the Internet: Issues Paper*, WIPO Doc. SCT/3/4 (Oct. 7, 1999), available at http://www.wipo.int/edocs/mdocs/sct/en/sct_3/sct_3_4.pdf; WIPO, *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks*, WIPO Doc. 833(E) (Sept. 20, 1999), available at http://www.wipo.int/export/sites/www/about-ip/en/development_iplaw/pdf/pub833.pdf; WIPO, *Final Report of the WIPO Internet Domain Name Process* (Apr. 30, 1999), available at <http://www.wipo.int/export/sites/www/amc/en/docs/report-final1.pdf>.

36. See, e.g., Singapore Treaty on the Law of Trademarks, *opened for signature* Mar. 28, 2006, S. TREATY DOC. No. 110-2 (2007); WIPO Copyright Treaty, *opened for signature* Dec. 20, 1996, S. TREATY DOC. No. 105-17 (1997); WIPO Performances and Phonograms Treaty (WPPT), *opened for signature* Dec. 20, 1996, S. TREATY DOC. No. 105-17 (1997); Trademark Law Treaty and Regulations, *opened for signature* Oct. 27, 1994, S. TREATY DOC. No. 105-35 (1998); Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs, July 2, 1999, available at http://www.wipo.int/export/sites/www/hague/en/legal_texts/pdf/geneva_act_1999.pdf.

37. Agreement Between the World Intellectual Property Organization and the World Trade Organization, Preamble, Dec. 22, 1995, 35 I.L.M. 754 (1996) [hereinafter WTO/WIPO Agreement]; see also TRIPS, *supra* note 1, arts. 63, 68 (addressing cooperation with WIPO in implementing TRIPS).

38. Indeed, the panels of the DSB that have produced reports on intellectual property disputes have included former high-ranking officials of WIPO, such as Mihály Ficsor, who served on the panel that resolved a patent dispute involving Canada. See Panel Report, *Canada—Patent Protection of Pharmaceutical Products*, WT/DS114/R (Mar. 17, 2000) [hereinafter *Canada-Pharmaceuticals*].

encompasses the building blocks of education and future technological development, or that it protects goods essential to social welfare.³⁹ Although WIPO's stated mission is to "promote the protection of intellectual property throughout the world"⁴⁰ and its contributions to the WTO have tended to reflect that pro-protection ethos,⁴¹ its institutional structure—which requires member states to enter into intellectual property agreements without the possibility of side payments in the form of concessions on unrelated matters—has always forced it to strike a balance between access and proprietary interests.⁴² Furthermore, in most intellectual property areas, its standards lend themselves to greater flexibility than do the more comprehensive requirements of TRIPS. Indeed, WIPO has begun a process of examining just how flexible these instruments are.⁴³ In short, the organization, along with the agreements it administers, brings to the table an intellectual property sensibility that is currently lacking in the WTO.

Unfortunately, however, the nature of the lawmaking relationship between these two organizations has yet to be fully elucidated. There are other agreements within the WTO framework that rely explicitly on the expertise of non-WTO organizations: they reference standards enunciated by international bodies with relevant expertise,⁴⁴ mandate

39. See Henning Grosse Ruse-Khan, *A Comparative Analysis of Policy Space in WTO Law* 10–12, 45–46 (Max Planck Inst. for Intellectual Prop., Competition & Tax Law, Research Paper Series No. 08-02, 2008), available at <http://www.ssrn.com/abstract=1309526>.

40. Convention Establishing the World Intellectual Property Organization arts. 3–4, July 14, 1967, 21 U.S.T. 1749, 828 U.N.T.S. 3 (emphasis added).

41. For example, Mihály Ficsor, the WIPO official who served on a DSB panel, see *supra* note 38, is a consultant to the International Intellectual Property Alliance, a trade association of copyright holders. Mihály Ficsor—Biography, http://www.iipa.com/html/Bio_Mihaly_Ficsor.html (last visited Sept. 16, 2009).

42. See, e.g., Pamela Samuelson, *The U.S. Digital Agenda at WIPO*, 37 VA. J. INT'L L. 369, 409 (1997) (discussing how this balance found its way into the WIPO Copyright Treaty).

43. For example, WIPO committees are engaged in an effort to catalog national approaches to limitations and exceptions. See WIPO, *WIPO Study on Limitations and Exceptions of Copyright and Related Rights in the Digital Environment*, WIPO Doc. SCCR/9/7 (Apr. 5, 2003), available at http://www.wipo.int/edocs/mdocs/copyright/en/scr_9/scr_9_7.pdf; WIPO, *Exclusions from Patentable Subject Matter and Exceptions and Limitations to the Rights*, SCP/13/3 (Feb. 4, 2009), available at http://www.wipo.int/edocs/mdocs/scp/en/scp_13/scp_13_3.pdf.

44. See JOOST PAUWELYN, *CONFLICT OF NORMS IN PUBLIC INTERNATIONAL LAW* 348–50 (2003). Pauwelyn cites (1) the WTO Agreement on the Application of Sanitary and Phytosanitary Measures art. 3, Apr. 15, 1994, 1867 U.N.T.S. 493, which refers to standards established by the Codex Alimentarius Commission, the International Office of Epizootics, and the Secretariat of the International Plant Protection Convention; (2) the WTO Agreement on Subsidies and Countervailing Measures, Apr. 15, 1994, 1869 U.N.T.S.

consultations with groups having overlapping jurisdiction,⁴⁵ or establish joint oversight in areas where there are potential conflicts.⁴⁶ In contrast, the WTO's relationship with WIPO is opaque.⁴⁷ TRIPS incorporates provisions of two WIPO instruments (the Paris and Berne Conventions),⁴⁸ and references others.⁴⁹ Still, it is not evident whether (or how) the WTO should be taking account of WIPO's view of these commitments.⁵⁰ Nor is it clear how (or when) new developments within these conventions should affect WTO obligations.⁵¹ The Agreement permits the TRIPS Council to "consult with and seek information from any source it deems appropriate" to carry out its obligations,⁵² but at best WIPO enjoys observer status at meetings.⁵³ Furthermore, the current WTO/WIPO Agreement is

14, which refers implicitly to actions undertaken by the Organisation for Economic Co-operation and Development (OECD); and (3) the WTO Agreement on Technical Barriers to Trade arts. 2.4–5, Apr. 12, 1979, 1186 U.N.T.S. 276, which makes general references to standards developed by international organizations. *Id.*

45. See, e.g., General Agreement on Tariffs and Trade art. XV, para. 2, Oct. 30, 1947, 61 Stat. A-11, 55 U.N.T.S. 194 [hereinafter GATT] (providing for consultations with the International Monetary Fund); PAUWELYN, *supra* note 44, at 347 (describing the interrelationship between certain WTO and IMF rules).

46. See PAUWELYN, *supra* note 44, at 350 (discussing the Ministerial Decision on Trade and Environment, Apr. 14, 1994, Annex 2, MTN.TNC/45(MIN), 33 I.L.M. 1267 (1994), which is part of the 1994 Final Act and establishes a committee that explores potential conflicts between the WTO treaty and other multilateral environmental agreements).

47. This might not be surprising. On the eve of the conclusion of TRIPS, scholars and policymakers seriously debated whether the new international intellectual property system would develop in the WTO or WIPO. See Ulrich Joos & Rainer Moufang, *Report on the Second Ringberg-Symposium, in GATT OR WIPO?: NEW WAYS IN THE INTERNATIONAL PROTECTION OF INTELLECTUAL PROPERTY* 1, 30–40 (Friedrich-Karl Beier and Gerhard Schrickler eds., 1989). The relationship could have been defined quite hierarchically. See Ruth L. Okediji, *WIPO-WTO Relations and the Future of Global Intellectual Property Norms*, 39 NETH. Y.B. INT'L L. 69, 100–04 (2008). And some of the early activity at WIPO after TRIPS might be explained as a quest to prove relevance and thus secure a prominent place in such a hierarchy. See Graeme B. Dinwoodie, *The Architecture of the International Intellectual Property System*, 77 CHI.-KENT L. REV. 993, 1004–05 (2002).

48. TRIPS, *supra* note 1, arts. 2.1, 9.1.

49. *Id.* art. 2.2 (referring to the Rome Convention and the Treaty on Intellectual Property in Respect of Integrated Circuits).

50. See, e.g., W.R. Cornish, *Genevan Bootstraps*, 19 EUR. INTEL. PROP. REV. 336, 336–38 (1997) (discussing the relationship between the Model Provisions on Protection Against Unfair Competition, published by WIPO, and interpretation of the TRIPS Agreement).

51. See, e.g., Neil W. Netanel, *The Next Round: The Impact of the WIPO Copyright Treaty on TRIPS Dispute Settlement*, 37 VA. J. INT'L L. 441, 451–55 (1997).

52. TRIPS, *supra* note 1, art. 68. Earlier drafts of the Agreement contemplated a larger role for intellectual property experts. See GERVAIS, *supra* note 14, at 530–31 (noting that the Draft of July 23, 1990 (W/76) contemplated the creation of a Joint Expert Group designated to advise the TRIPS Committee when requested).

53. See WTO, International Intergovernmental Organizations Granted Observer Status to WTO Bodies, http://www.wto.org/english/thewto_e/igo_obs_e.htm (last visited Sept. 21, 2009).

limited to legal and technical assistance—to providing the WTO with copies and translations of domestic legislation and to assisting WTO members in meeting their obligations.⁵⁴

This Article takes up the institutional design question of how to create an intellectual property system responsive to changing circumstances by examining how the WTO can best make use of WIPO's experience and expertise in intellectual property matters. After considering the intellectual property cases decided to date by the WTO dispute settlement body and determining the ways in which they have relied on the text and negotiating histories of, and other materials relevant to, WIPO conventions to elucidate TRIPS obligations, we suggest some revisions to interpretive approaches pursued thus far by dispute settlement panels. We point out methodologies that would leaven and cabin the trade perspective, and thus allow the WTO to capitalize on WIPO's experience and on WIPO developments that cope with the dynamic nature of intellectual property and the changing landscape of knowledge production. Our analysis is also meant for broader application, for developing a design that permits productive input from all the international institutions that have interests touching on intellectual property norm development.⁵⁵

In suggesting that the WTO adopt a broader perspective, we are cognizant of the well-honed argument that the WTO should confine its attention to trade law and that to incorporate principles developed outside of the WTO would sacrifice goals of legitimacy, uniformity, and predictability.⁵⁶ While we do not

54. WTO/WIPO Agreement, *supra* note 37, arts. 2, 4. In the Doha Round, the TRIPS Council was asked to explore the relationship between the TRIPS Agreement and the Convention on Biological Diversity (CBD), but there is no formal agreement between the Council and the CBD Secretariat to date. See Convention on Biological Diversity, Cooperation with WTO, <http://www.cbd.int/incentives/coop-wto.shtml> (last visited Sept. 21, 2009) (indicating that the CBD Executive Secretary continues to seek observer status at TRIPS Council meetings).

55. The World Health Organization (WHO), for example, is also considering the question of development and essential medicines. See Jack Lerner, *Intellectual Property and Development at WHO and WIPO*, 34 AM. J.L. & MED. 257, 271 (2008).

56. See, e.g., Joshua Meltzer, *Interpreting the WTO Agreements—A Commentary on Professor Pauwelyn's Approach*, 25 MICH. J. INT'L L. 917, 920–21 (2004) (questioning use of non-WTO sources); Joel P. Trachtman, Book Review, 98 AM. J. INT'L L. 855, 858 (2004) (reviewing PAUWELYN, *supra* note 44) (same). Arguments have also been made that WIPO should not be linked to other organizations. See WIPO, *General Report of the Assemblies of the Member States of WIPO*, ¶ 178, WIPO Doc. A/34/16 (Sept. 29, 1999) (statement of Argentina), available at http://www.wipo.int/edocs/mdocs/govbody/en/a_34/a_34_16.pdf (arguing that processes at WIPO establishing binding links between WIPO member states and other international organizations or instruments would create legal uncertainty and “might seriously endanger the international legal responsibility of WIPO Member States”).

advocate that the WTO Agreement become a world constitution, we nonetheless believe that there are consequences to the decision to link trade to other interests. This is particularly true when the linkage is to an area as dynamic as intellectual property, and that has such a strong potential impact on economic welfare.⁵⁷ As lawmaking continues to shift from sovereigns acting alone to states acting in concert, the international organizations they form must increasingly take on the tasks once left to sovereigns, including the duty of finding ways to accommodate each others' needs and to maximize joint interests.

II. THE ROLE OF WIPO AND ITS CONVENTIONS IN INTERPRETING TRIPS: THE STORY SO FAR

It is one thing to recognize that WIPO could help the WTO internalize and update intellectual property norms. Developing effective mechanisms for importing intellectual property values into TRIPS is quite another matter. Aside from the many intentional differences between the agreements each organization administers, there are discontinuities, inconsistencies, and divergent capacities to deal with changing circumstances. Transposing provisions from one context into another is fraught with error-making possibilities. Furthermore, there are no authoritative interpretations of the WIPO instruments.⁵⁸ Neither Berne nor Paris even specifies what

57. We are heartened to see that similar observations have been made about the relationship between trade and human rights law. *See, e.g.*, U.N. Econ. & Soc. Council [ECOSOC], Sub-Comm'n on Promotion & Prot. of Human Rights, *Mainstreaming the Right to Development into International Trade Law and Policy at the World Trade Organization*, ¶¶ 25–30, U.N. Doc. E/CN.4/Sub.2/2004/17 (June 9, 2004) (prepared by Robert Howse).

58. In theory, obligations under the Berne and Paris Conventions can be enforced in the International Court of Justice. *See* Berne Convention for the Protection of Literary and Artistic Works art. 33(1), Sept. 9, 1886, *as revised at* Paris on July 24, 1971, *and amended on* Sept. 28, 1979, S. TREATY DOC. No. 99-27 (1986) [hereinafter Berne Convention]; Paris Convention for the Protection of Industrial Property art. 28(1), Mar. 20, 1883, *revised* July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305 [hereinafter Paris Convention]. However, no cases have been brought there. Nor is WIPO in a position to offer strictly authoritative readings of its own conventions:

Under [Article 15(5) of] the Paris Convention, the [International] Bureau [of WIPO] is required to conduct studies and provide services designed to facilitate the protection of industrial property. On the other hand, it has no power to pronounce on interpretation or application of the Convention and so may express no opinion on the merits of contested views between Member States.

Cornish, *supra* note 50, at 337. In practice, WTO dispute settlement panels have made extensive use of leading works on the WIPO conventions, such as Ricketson on the Berne Convention, and Bodenhausen on the Paris Convention, the latter of which was authored by a leading WIPO official and published by BIRPI. However, on occasion, panels have

interpretive sources are appropriate. TRIPS refers to “customary rules of interpretation of public international law”⁵⁹—generally taken to mean the Vienna Convention on the Law of Treaties.⁶⁰ But, formally, the Vienna Convention discusses prior and subsequent treaties; it does not deal with agreements incorporated by reference.⁶¹ The following Part explores the problems created by incorporation and how they have been resolved to date.

A. *Relying on Incorporated Provisions*

In theory, the incorporation of WIPO measures into the TRIPS Agreement should be straightforward and lead to a successful amalgamation of intellectual property values with trade objectives. Articles 2.1 and 9.1 of the TRIPS Agreement state that WTO members must comply with the principal articles of the Paris and Berne Conventions. At the same time, TRIPS makes clear how far incorporation extends; Article 9.1 disincorporates Berne Article 6*bis* (which addresses moral rights), and Article 2.2 states that there is nothing in the substantive provisions of the TRIPS Agreement that derogates from the obligations incurred under the Paris, Berne, or Rome Conventions, or the treaty on integrated circuits.⁶²

*Havana Club*⁶³ illustrates how the incorporation strategy can work to preserve the balances struck by the WIPO conventions. In that case, the European Communities (EC) challenged a

departed from the interpretations suggested by these preeminent commentaries. See Panel Report, *United States—Section 110(5) of the US Copyright Act*, ¶ 6.41, WT/DS160/R (June 15, 2000) [hereinafter *US-110(5)*].

59. DSU, *supra* note 16, art. 3.2.

60. Vienna Convention on the Law of Treaties, May 23, 1969, 1155 U.N.T.S. 331 (entered into force Jan. 27, 1980) [hereinafter Vienna Convention]; see Steven P. Croley & John H. Jackson, *WTO Dispute Procedures, Standard of Review, and Deference to National Governments*, 90 AM. J. INT'L L. 193, 200 (1996) (“According to negotiators, this admonition [of the DSU] is a direct, albeit implicit, invocation of the Vienna Convention on the Law of Treaties.”).

61. For further discussion of these issues, see Susy Frankel, *WTO Application of “the Customary Rules of Interpretation of Public International Law” to Intellectual Property*, 46 VA. J. INT'L L. 365, 385–87 (2006).

62. TRIPS, *supra* note 1, arts. 2.2, 9.1. The upshot of this is, *inter alia*, that even where the WTO authorizes a member state to deny intellectual property protection to certain works as relief for a WTO treaty violation, this WTO-authorized derogation might be a violation of that member state’s obligations under WIPO conventions. See *Ecuador-Bananas*, *supra* note 31, ¶ 152 (implicitly recognizing that, but declining to pass judgment on, whether WTO-authorized relief might conflict with the party’s obligations under other international agreements).

63. Appellate Body Report, *United States—Section 211 of the Omnibus Appropriations Act of 1998*, WT/DS176/AB/R (Jan. 2, 2002) [hereinafter *Havana Club*].

provision of U.S. law denying protection to the owners of Cuban trademarks and trade names that had been connected to businesses confiscated by the Cuban government during the Cuban revolution. Relying on Article 6*quinquies* of the Paris Convention (the “*telle quelle*” provision), the EC argued that once a trademark qualified for registration in its country of origin, registration in another member state could not be denied for any reason other than those expressly recognized in Article 6*quinquies*. In contrast, the United States took the position that *telle quelle* restricted only the ability of the second state to deny registration based upon the mark’s visual form. The Appellate Body examined the language of the disputed Paris Convention provision and its context, including the Final Protocol of 1883—which it regarded as “an integral part of that Convention”⁶⁴—as well as the Washington Revision Conference of 1911. It also consulted a well-known treatise on the Paris Convention.⁶⁵ In the end, it concluded that “the drafters of the Paris Convention did not intend” the result propounded by the EC, either when the Convention was first concluded or in its subsequent revisions.⁶⁶ In other words, even under Paris and TRIPS obligations, states remain substantially free to regulate the registration of trademarks under national law, so long as there is no interference with their form.⁶⁷

The opinion is at least as significant for what the Appellate Body did not do as for what it did. The EC had criticized the Panel that initially resolved the dispute for resorting directly to the negotiation history of the Paris Convention instead of relying first on the rules of the Vienna Convention,⁶⁸ which, per Article 32, would have required an ambiguity before resort could be made to background materials.⁶⁹ Had the Appellate Body adopted

64. *Id.* ¶ 145.

65. *Id.* ¶ 138 (citing G.H.C. BODENHAUSEN, GUIDE TO THE APPLICATION OF THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY AS REVISED AT STOCKHOLM IN 1967, at 110–11 (1969)). Another report is to similar effect, citing a broad array of treatises and other works to determine the nature of Berne rights. See Panel Report, *China—Measures Affecting the Protection and Enforcement of Intellectual Property Rights*, ¶¶ 7.106, 7.126, WT/DS362/R (Jan. 26, 2009) [hereinafter *China-Enforcement*] (citing four treatises and a WIPO guide). Of course, it is not unusual for international tribunals to make substantial use of treatise writers. See IAN BROWNLIE, PRINCIPLES OF PUBLIC INTERNATIONAL LAW 23–24 (6th ed. 2003).

66. *Havana Club*, *supra* note 63, ¶ 141; see generally *id.* ¶¶ 130–48 (explaining the Appellate Body’s reasoning).

67. *But see* Paris Convention, *supra* note 58, arts. 6*bis*, 6*ter* (requiring member states to deny trademark rights in certain claimed marks).

68. *Havana Club*, *supra* note 63, ¶ 19.

69. *Cf. US-110(5)*, *supra* note 58, ¶ 6.41 (“We note that Article 30 of the Vienna Convention on the application of successive treaties is not relevant in this respect,

this circuitous approach, the meaning of the TRIPS Agreement would have been determined in the first instance through a trade lens: if a term appeared unambiguous when seen from that perspective, that trade-oriented meaning would have automatically prevailed, regardless of its impact on creative production.⁷⁰ By instead allowing decisionmakers to consider the Paris Convention and its associated materials directly, this approach ensured that the sensibilities of intellectual property were brought into play. Since intellectual property is aimed at striking a balance between the demands of right holders and other national interests, the Appellate Body's direct approach leaves WTO members with greater latitude to tailor their law to their domestic intellectual agendas (so long, of course, as their policies are consistent with the explicit provisions of TRIPS and the trade objectives of the WTO agreements).⁷¹

B. Dealing with Potential Discrepancies Between TRIPS and the Incorporated Conventions

The simplicity of this direct approach can, however, be deceptive. For one, there are situations in which TRIPS sets out a rule that, while attempting to incorporate the WIPO instruments, appears inconsistent with them.⁷² But even here, DSB adjudicators have often found techniques that valorize intellectual property values. To stay with the trademark example, *Havana Club* identified several potential discontinuities between TRIPS and the Paris Convention.⁷³ First,

because all provisions of the TRIPS Agreement – including the incorporated Articles 1–21 of the Berne Convention (1971) – entered into force at the same point in time.”)

70. Moreover, most of the panelists serving on dispute panels and on the Appellate Body are trained as experts in trade law, not intellectual property law. See WTO, Appellate Body Members, http://www.wto.org/english/tratop_e/dispu_e/ab_members_bio_e.htm (last visited Sept. 25, 2009).

71. See, e.g., Appellate Body Report, *India—Patent Protection for Pharmaceutical and Agricultural Chemical Products*, WT/DS50/AB/R (Dec. 19, 1997) [hereinafter *India-Pharmaceuticals*]. The Appellate Body Report in *India-Pharmaceuticals*, which concerned the transitional provisions of the TRIPS Agreement, leaves states with maximal flexibility. The Appellate Body rejected claims that India's obligations should be augmented by the expectations of other WTO members. *Id.* ¶¶ 45–48. Furthermore, it held that “[m]embers . . . are free to determine how best to meet their obligations under the *TRIPS Agreement* within the context of their own legal systems.” *Id.* ¶ 59. The *China-Enforcement* Panel also recognized China's substantial discretion to order border measures that balanced right holders' interests and public needs. See *China-Enforcement*, *supra* note 65, ¶¶ 7.240–374, 7.481, 7.602.

72. We deal separately below with cases where TRIPS clearly and intentionally imposes greater obligations on member states. TRIPS was a Berne-plus and Paris-plus convention, so these are to be expected. See *infra* text accompanying notes 113–127.

73. A similar impulse to avoid exploiting textual ambiguities to insert a wedge between the trade and intellectual property conventions can be seen in *EC-GI*, *supra* note

Article 2 of TRIPS explicitly incorporates Article 8 of the Paris Convention, which requires the protection of trade names. However, because Article 1 of TRIPS limits the scope of the Agreement to the subject matter listed in Sections 1 through 7 of Part II—none of which explicitly includes trade names—the *Havana Club* Panel took the position (argued by the United States) that trade name disputes could not be brought in the WTO.⁷⁴ The Appellate Body reversed. Relying on Article 32 of the Vienna Convention to interpret the TRIPS Agreement,⁷⁵ it accorded primacy to the WIPO instrument: “To adopt the Panel’s approach would be to deprive Article 8 of the Paris Convention . . . of any and all meaning and effect.”⁷⁶

A second question in *Havana Club*—on ownership—presented something of the opposite question. The EC contended that the TRIPS Agreement’s references to the “undertakings” of trademark holders set out rules on ownership, even though the Paris Convention did not appear to cover the matter.⁷⁷ Clearly, the TRIPS Agreement does contain instances where it expressly augments or elaborates on the obligations of the earlier WIPO conventions. Here, in contrast, the EC’s contention would have required the Panel to imply an enhancement that was not clear on the face of TRIPS. This time, notwithstanding that the claim appeared to rest on the meaning of TRIPS alone, the Panel looked first at the Paris Convention, asking whether it addressed

29. In that case, the United States alleged that the EC’s regime for the protection of geographical indications violated a number of national treatment obligations, including, *inter alia*, Article 3 of TRIPS and Article 2(1) of the Paris Convention (incorporated by Article 2.1 of TRIPS). However, Article 3 of TRIPS is textually slightly different than Article 2(1) of Paris: Article 3 of TRIPS parrots trade-treaty formulations and talks of offering “treatment no less favourable” to foreign nationals, TRIPS, *supra* note 1, art. 3.1, while the Paris Convention (like the Berne Convention) refers to ensuring for foreign nationals “the advantages that . . . laws now grant, or may hereafter grant” to domestic producers. Paris Convention, *supra* note 58, art. 2(1). Although the Panel set out to treat these provisions separately, it declined to reach a conclusion on the Paris Convention claim because “further findings on this claim would not provide any additional contribution to a positive solution to this dispute.” *EC-GI*, *supra* note 29, ¶ 7.216.

74. Panel Report, *United States—Section 211 of the Omnibus Appropriations Act of 1998*, ¶¶ 8.23–27, 8.41, WT/DS176/R (Aug. 6, 2001) [hereinafter *Havana Club Panel*].

75. *Havana Club*, *supra* note 63, ¶¶ 333–41.

76. *Id.* ¶ 338. Of course, it is not implausible that certain parts of the Paris and Berne Conventions were not made subject to TRIPS enforcement mechanisms. For example, this was true of Article 6*bis* of the Berne Convention. And the statement in TRIPS that the obligations set out in the new agreement not derogate from the WIPO conventions presupposes the possibility that a WIPO obligation may continue post-TRIPS even though not covered by TRIPS. But when the member states wished to exclude a WIPO treaty obligation from the WTO enforcement mechanism, they did so expressly. See TRIPS, *supra* note 1, art. 9.1.

77. TRIPS, *supra* note 1, art. 15.1; *Havana Club*, *supra* note 63, ¶ 191.

the ownership question. To find out, it sent a letter to the International Bureau of WIPO requesting “factual information . . . relevant to the dispute, in particular the negotiating history and subsequent developments.”⁷⁸ In response, the Director-General stated that nothing in the Paris Convention covered ownership and the Panel (apparently) assumed that this resolved the question.⁷⁹ While the Appellate Body in fact examined the TRIPS provisions relied upon by the EC, in the end it too came to the conclusion that TRIPS did not disturb the decision by the negotiators of the Paris Convention to leave the question of ownership to member states.⁸⁰

A third question—again raising a question of implied augmentation of WIPO-based standards by the trade agreement—was similarly answered in a way that did not disturb the accommodations reached by the Paris Convention. The EC had claimed that Article 15.1 of TRIPS, which set out the definition of a trademark, required WTO members to protect every “sign . . . capable of distinguishing the goods . . . of one undertaking”⁸¹ notwithstanding other state interests. That was not the practice under the Paris Convention,⁸² and the Appellate Body once again opted to defer to that understanding:

As with our interpretation of Article 6*quinquies*, here, too, we recall that Article 6(1) of the Paris Convention (1967), which has become a WTO provision by incorporation through Article 2.1 of the *TRIPS Agreement*, reserves to each country of the Paris Union the right to determine the “conditions” for filing and registration of trademarks in its domestic legislation.⁸³

As yet, there are no Appellate Body decisions on the relationship between the TRIPS Agreement and the Berne Convention, which imposes many more substantive requirements than does the Paris Convention. However, the Panel Report in the *US-110(5)* case suggests that here too, efforts will be made to interpret TRIPS in a manner that preserves the flexibilities inherent in the antecedent intellectual property conventions. The issue in that case was whether the United States, which permitted certain establishments to make unauthorized usages of musical broadcasts, had violated its obligations under Articles

78. *Havana Club Panel*, *supra* note 74, ¶ 6.1.

79. *See Havana Club*, *supra* note 63, ¶ 189.

80. *See id.* ¶¶ 190–95.

81. *See TRIPS*, *supra* note 1, art. 15.1.

82. *See Havana Club*, *supra* note 63, ¶¶ 155–65.

83. *Id.* ¶ 165.

11 and 11*bis*, the broadcast and rebroadcast provisions of the Berne Convention. Looking at the Berne Convention directly,⁸⁴ the Panel endeavored to determine what these provisions required. It examined members' practices before 1948, when the provision was proposed; the General Report that was issued contemporaneously with the proposal; and the work of the diplomatic conferences at which the provision was adopted.⁸⁵ The Panel noted that throughout this time, members tolerated "minor exceptions"—limited unauthorized performances of copyrighted materials. Relying on Article 31.3(b) of the Vienna Convention, it concluded:

In our view, state practice as reflected in the national copyright laws of Berne Union members before and after 1948, 1967 and 1971, as well as of WTO members before and after the date that the TRIPS Agreement became applicable to them, confirms our conclusion [that] the minor exceptions doctrine [forms a part of the context of Articles 11 and 11*bis*].⁸⁶

Using the negotiation history of the TRIPS Agreement—including a document the Negotiating Group asked the International Bureau of WIPO to prepare in order "to facilitate an understanding of the existence, scope and form of generally internationally accepted and applied standards/norms for the protection of intellectual property"⁸⁷—the Panel reasoned that absent an indication in the TRIPS Agreement that it intended to eliminate the minor exceptions doctrine, the "entire Berne *acquis*" was incorporated into the TRIPS Agreement.⁸⁸ The Panel concluded that it was important to "adopt the meaning that reconciles the texts of different treaties and avoids a conflict between them."⁸⁹

Although TRIPS claims to be about trade-related aspects of intellectual property, a large part of the rationale for its inclusion in the WTO regime is that the effective enforcement machinery of trade law provides a mechanism for hardening (WIPO-generated) intellectual property norms. These different analyses can be read to suggest that where a complaint is in essence an effort to enforce an intellectual property norm found in a WIPO

84. *US-110(5)*, *supra* note 58, ¶ 6.41.

85. *See id.* ¶¶ 6.50–54.

86. *Id.* ¶ 6.55.

87. *Id.* ¶ 6.64 (quoting GATT Secretariat, *Meeting of the Negotiating Group of 29 February–3 March 1988*, Annex, MTN.GNG/NG11/6 (Apr. 8, 1988)).

88. *Id.* ¶¶ 6.62–66.

89. *Id.* ¶ 6.66.

Convention through the opportunity for dispute settlement within the WTO framework, panels will respect the intellectual property origins of the dispute.

C. Use of WIPO Conventions by Analogy

In some cases, WIPO treaties utilize terminology similar to that used in the TRIPS Agreement. Where the meaning in the WIPO instrument is clear, it can be consulted to infuse the TRIPS Agreement with an intellectual property perspective. The *EC-GI* case provides an example. One issue in that case was whether the EC's rules on protecting geographic indications violated the national treatment provision of the TRIPS Agreement by applying different rules to geographic indications pointing to territories outside the EU. The EC argued that the differential rules did not amount to a discrimination based on "nationality" because certain foreign nationals had, in fact, acquired protection under the challenged EC Regulation.⁹⁰ The Panel rejected the argument on the ground that these rights were derived through subsidiaries located in the EC. To buttress its conclusion that TRIPS treated discrimination according to residence and establishment as close substitutes for nationality-based discrimination, the Panel looked at how the terms were used in other pre-existing intellectual property instruments.⁹¹

Relying on WIPO conventions in this manner is, however, fraught with possibilities for mistake. Importantly, the *EC-GI* Panel relied on the connection between TRIPS and the Paris Convention because the interpretation the Panel proposed was consistent with the purposes of the TRIPS Agreement.⁹² Elsewhere in its report, the Panel rejected efforts to incorporate from the Paris Convention definitions of terms used but undefined in TRIPS.⁹³ The Panel thus showed some sensitivity to when (and when not) to use analogous terms in the pre-existing conventions. Attention must also be paid to the historical context in which the various agreements were negotiated. Otherwise, the attempted analogy can seriously misfire.

One example of this type of miscalculation can be seen from the way in which the TRIPS Agreement's own attempts to

90. *EC-GI*, *supra* note 29, ¶ 7.197.

91. *See id.* ¶ 7.198.

92. *Id.* ¶¶ 7.198–.199.

93. *Id.* ¶¶ 7.170–.171 (concluding the Paris Convention does not provide the meaning of "interested party" for purposes of Articles 22 and 23 of TRIPS).

achieve a measure of balance have been interpreted. Thus, each of the principal intellectual property areas covered by TRIPS includes a provision on “exceptions.”⁹⁴ Although they are all different, their formats are similar: a multi- (usually three-) part test that allows members to limit intellectual property rights so long as they do not overly conflict with normal exploitation of the protected work or unreasonably prejudice the legitimate interests of the right holder.⁹⁵ Except for the copyright test, all explicitly permit adjudicators to also consider the interests of third parties. There have been three panel decisions interpreting the exceptions: (1) the aforementioned *US-110(5)*; (2) *Canada-Pharmaceuticals*, which challenged Canada’s decision to permit generic drug makers to test pharmaceuticals and stockpile them prior to patent expiration;⁹⁶ and (3) the part of the *EC-GI* dispute in which the United States claimed that the EC’s protection for geographic indications impinged on trademark rights.

In these cases, adjudicators left members with leeway to reconcile *conflicting* TRIPS obligations (e.g., the conflict between GIs and trademarks, which are both protected by TRIPS) and to prevent right holders from benefiting from exclusive terms *in excess* of those mandated by TRIPS (e.g., to exploit the de facto exclusivity available to pharmaceutical companies by reason of the need for premarket clearance). At the same time, however, the decisions severely hamper the states’ ability to accommodate national interests in any manner that constitutes a true exception—that is, a *genuine intrusion* into a TRIPS obligation. The panels ignored the domestic rationales for the challenged legislation,⁹⁷ they considered the various parts of the tests cumulatively (which meant that the interests of third parties were not reached),⁹⁸ and they largely refused to interpret terms

94. See TRIPS, *supra* note 1, arts. 13 (copyrights), 17 (trademarks), 26.2 (industrial designs), 30 (patents). The patent provisions of the Agreement also permit exclusions from protection for certain important public purposes. See *id.* arts. 27.2–3. Article 31 gives a modicum of authority to offer compulsory licenses.

95. The trademark provision is only a two-part test because it does not consider normal exploitation of the work. See *id.* art. 17 (allowing for limited exceptions provided they take account of the legitimate interests of the trademark owner and third parties). There are also differences in wording among the other three provisions.

96. See *Canada-Pharmaceuticals*, *supra* note 38.

97. For example, the copyright exception test, like the Berne Convention, uses the term “special.” See TRIPS, *supra* note 1, art. 13; Berne Convention, *supra* note 58, art. 9(2). That could have been used to examine the justification for the measure; instead it was taken to mean “clearly defined.” *US-110(5)*, *supra* note 58, ¶¶ 6.107–.110. On options for examining the justifications, see Graeme B. Dinwoodie, *The Development and Incorporation of International Norms in the Formation of Copyright Law*, 62 OHIO ST. L.J. 733, 751 n.73 (2001); Dinwoodie & Dreyfuss, *Dynamics*, *supra* note 21, at 101–09.

98. See, e.g., *Canada-Pharmaceuticals*, *supra* note 38, ¶¶ 7.20–.21.

like “normal,” “legitimate,” “prejudice,” and “unreasonable” normatively.⁹⁹ Instead, adjudicators did little more than mechanically count the number of rights within the bundle affected by the challenged provision, or the number of situations in which the exception was applicable. Every right received equal weight, no matter how small the impact on the right holder’s market.¹⁰⁰ Markets the right holder had never utilized were counted equivalently to those that it had. Economic effects were regarded as paramount, and estimates of loss were extremely generous.¹⁰¹ At the end of the day, Canada and the United States were not permitted to make allowances for user interests.

What appears to have happened is that the panels relied too heavily on the provenance of these tests. All are based on a three-part exceptions test found in Article 9(2) of the Berne Convention,¹⁰² and the panels may have assumed that because the tests derived from a WIPO instrument, they would automatically balance user and producer interests appropriately. Apparently, the panels did not appreciate how radically the context changed when these provisions were adapted for TRIPS.

99. See, e.g., Jane C. Ginsburg, *Toward Supranational Copyright Law? The WTO Panel Decision and the “Three-Step Test” for Copyright Exceptions*, 187 REVUE INTERNATIONALE DU DROIT D’AUTEUR 3, 17 (2001). To be sure, the *Canada-Pharmaceuticals* Panel considered the practices of other states to determine the patent holder’s legitimate interests, and it was not persuaded that they demonstrated a consensus position. *Canada-Pharmaceuticals*, *supra* note 38, ¶¶ 7.78–.82. Likewise, the *EC-GI* Panel made good on the assertion of the *Canada-Pharmaceuticals* Panel that “legitimate interests” could only make sense as “a normative claim calling for protection of interests that are ‘justifiable’ in the sense that they are supported by relevant public policies or other social norms.” *EC-GI*, *supra* note 29, ¶ 7.663 (quoting *Canada-Pharmaceuticals*, *supra* note 38, ¶ 7.69). Although its determination of the relevant social purposes was drawn largely from TRIPS, the Panel *did* take notice of the differences between Article 17 of TRIPS and the Berne Convention Article 9 antecedent. See *id.* ¶ 7.671. It also took into account the broader principle of discretion regarding precise implementation found in Article 1.1 of TRIPS. See *id.* ¶ 7.682.

100. To be sure, *Canada-Pharmaceuticals* rejected the idea of simply counting rights. *Canada-Pharmaceuticals*, *supra* note 38, ¶ 7.32. But it refused to consider whether some rights are more important than others and in fact appeared to do no more than count rights. See *id.* ¶ 7.33–.34.

101. For example, the *US-110(5)* Panel found that EC copyright holders could lose as much as \$53.65 million per year. *US-110(5)*, *supra* note 58, ¶ 6.253. Later, an arbitrator found the amount was only € 1,219,900 per year (this at a time when a dollar and a euro were close to parity). Award of the Arbitrators, *United States—Section 110(5) of the US Copyright Act, Recourse to Arbitration Under Article 25 of the DSU*, ¶ 5.1, WT/DS160/ARB25/1 (Nov. 9, 2001).

102. Article 9(2) of the Berne Convention provides: “It shall be a matter for legislation in the countries of the Union to permit the reproduction of such works in certain special cases, provided that such reproduction does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author.” Berne Convention, *supra* note 58, art. 9(2).

The Berne Convention test was formulated to protect only the *reproduction* right. Because, for most works, copyright holders make the bulk of their profits through control over reproduction, it is not surprising that Berne might be read to impose firm limits on interferences with the exploitation of that right.¹⁰³ The panels failed to consider the ramification of transposing the measure into TRIPS, where it applies to all user activities, to all markets, and to all of the principal intellectual property regimes. The language of Article 9(2) of the Berne Convention was altered and tailored to each regime; the panels might have accorded some significance to those changes.

The opportunity to consider this issue actually arose in the *US-110(5)* case, where the EC asked the Panel to consider how Article 13 of TRIPS, the copyright test, applied to rights—like the rebroadcast right—that were not within the ambit of Berne’s exceptions test.¹⁰⁴ Consistent with the desire to reflect prior intellectual property conventions discussed above, the Panel rather easily concluded that “the TRIPS Agreement need not lead to different standards from those applicable under the Berne Convention.”¹⁰⁵ However, in arriving at that conclusion, it considered only half the question. As framed by the EC, the issue was whether TRIPS should be read to *narrow* the ambit of exceptions. The Panel never seriously addressed the question of whether TRIPS had *adapted* the exceptions to deal with new situations. Had the Panel done so, it might well have reached a different conclusion. After all, the Panel claimed that it was reconciling Article 13 with the minor exceptions doctrine.¹⁰⁶ Yet, the minor exceptions that it identified—use of music by religious, military, and educational institutions¹⁰⁷—were surely uses the right holders could have otherwise exploited. If the Panel had conducted the thought experiment of applying its interpretation of Article 13 to these uses, it might have seen the fallacy in its analysis and realized that when individual rights are considered in isolation, without giving any thought to their significance within the copyright “bundle” or to the impact of a use on the *total* potential revenue of the right holder, members are straight-jacketed. Rather than grandfathering in existing practices, the Panel might have understood the need to develop normative

103. See 1 SAM RICKETSON & JANE C. GINSBURG, INTERNATIONAL COPYRIGHT AND NEIGHBOURING RIGHTS, THE BERNE CONVENTION AND BEYOND ¶ 11.01, at 622 (2d ed. 2006).

104. *US-110(5)*, *supra* note 58, ¶¶ 6.71–78.

105. *Id.* ¶ 6.81.

106. *See id.* ¶ 6.90.

107. *See id.* ¶ 6.36.

positions on what constitutes normal exploitation, unreasonable prejudice, and legitimate expectations.¹⁰⁸

The simplistic importation of the Berne approach to exceptions into TRIPS also ignores differences in the intellectual property traditions of the WTO membership. The Berne Convention was largely a product of the “droit d’auteur” approach to protecting works of authorship; common law countries tend to have a more utilitarian view. The United States, for instance, did not join the Berne Convention until 1988, and it never fully complied with all of its requirements (which is why Article 6*bis* of the Berne Convention was excluded from TRIPS).¹⁰⁹ The United States also has an open-ended approach to unauthorized uses. Like the three-step test, its key exceptions provision uses a factors approach.¹¹⁰ Significantly, however, the factors are evaluated on a sliding scale.¹¹¹ Thus, it is almost inconceivable that U.S. negotiators understood themselves to be agreeing to the cumulative approach adopted by the *US-110(5)* and *Canada-Pharmaceuticals* Panels.¹¹² Had DSU adjudicators considered the traditions of the WTO membership, they might have been less eager to understand use of the Berne *framework* for exceptions as license to import its *interpretive regime* into TRIPS. They might thus have arrived at a more accommodating view of the three-step tests. Instead, the Panel decision was a rather bare vindication of intellectual property rights as nothing more than commodities to be traded. The Panel *looked* to antecedent intellectual property sources, but it did not

108. The *Canada-Pharmaceuticals* case is somewhat similar. The Panel in that case also canvassed the laws of other countries. Although it held that “the subsequent acts by individual countries did not constitute ‘practice in the application of the treaty which establishes the agreement of the parties regarding its interpretation’ within the meaning of Article 31.3(b) of the Vienna Convention,” *Canada-Pharmaceuticals*, *supra* note 38, ¶ 7.47, it did appear to consider them when determining the legitimate interests of right holders. *See id.* ¶¶ 7.78–79 (“Taken as a whole, these government decisions may represent either disagreement [regarding the proposed interpretation], or they may simply represent that such [an interpretation is] outweighed by other equally legitimate interests.”).

109. TRIPS, *supra* note 1, art. 9.1; *see, e.g.*, Justin Hughes, *American Moral Rights and Fixing the Dastar “Gap,”* 2007 UTAH L. REV. 659, 665–66 (discussing U.S. resistance to the adoption of Article 6*bis*).

110. *See* 17 U.S.C. § 107 (2006).

111. *See* Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978–2005*, 156 U. PA. L. REV. 549 (2008) (studying the correlations between the outcomes of individual factor analyses and the outcome of the fair use claim overall).

112. *Cf.* Ruth Okediji, *Toward an International Fair Use Doctrine*, 39 COLUM. J. TRANSNAT’L L. 75, 114–15, 127–29 (2000) (“It was strongly evident throughout the debates over accession that the international community, including the World Intellectual Property Organization, was willing to accept less than full compliance in exchange for the increased importance that U.S. accession would bring to the Berne Convention.”).

understand the richer complexity of those intellectual property norms.

D. Coping with TRIPS Standards Expressly Different than the WIPO Conventions

Although the previous sections demonstrated that relying on WIPO instruments will often serve as a way to preserve intellectual property values, more intractable problems arise in situations in which TRIPS expressly adds to the requirements of the WIPO agreements. This is especially true with regard to patents, where the Paris Convention did little more than facilitate seriatim patent applications and establish limits on certain types of compulsory licenses.¹¹³ In contrast, the TRIPS Agreement requires protection of inventive developments in all fields of technology, sets a minimum term of protection and minimum rights, and further restricts compulsory licensing.¹¹⁴ Even for copyright and trademarks, TRIPS goes beyond the WIPO instruments. For trademarks, the subject matter of protection is elucidated and the scope of trademark rights is expanded;¹¹⁵ the provisions on copyright and related rights mandate new protection for computer programs and rentals, phonograms, and performances.¹¹⁶ Furthermore, TRIPS establishes obligations regarding other forms of intellectual property, including geographic indications,¹¹⁷ industrial designs,¹¹⁸ and trade secrets.¹¹⁹ In all these areas, TRIPS also adds norms of enforcement.¹²⁰

The Appellate Body's decision in the *Canada-Patent Term* case illustrates what can occur when a dispute concerns one of these new areas, where by definition there is no ready WIPO source to which a panel can refer. In that case, the United States claimed that Canada had violated Article 33 of the TRIPS Agreement by failing to extend the terms of patents that had issued before the Agreement had entered into force, but which continued to subsist afterwards. Canada claimed that Article 70, which required the protection of existing subject matter, was not

113. Paris Convention, *supra* note 58, arts. 2, 4–5.

114. See TRIPS, *supra* note 1, arts. 27–31.

115. See *id.* arts. 15–21.

116. See *id.* arts. 10–14. TRIPS also increases the level of international protection accorded integrated circuits. See *id.* arts. 35–38.

117. See *id.* arts. 22–24.

118. See *id.* arts. 25–26.

119. See *id.* art. 39.

120. See *id.* arts. 41–61.

relevant to “acts” that transpired before the Agreement applied—including the “act” of awarding a patent for a specific term of years.¹²¹

Had the issue of retroactivity arisen in a WIPO negotiation, the problem might have been conceptualized as balancing accessibility interests against the claims of those holding pending patents. Because these right holders had sunk all their investments under the prior regime in reliance on the rewards that would be generated during an (arguably) shorter time period, the negotiators might well have decided not to require the retroactive extension of patent terms.¹²² But the Paris Convention did not deal with patent duration. Accordingly, its negotiators never had occasion to consider the retroactivity issue.¹²³ The Appellate Body was thus left with nothing but definitions in the intellectual property component of a trade agreement. It duly consulted the Paris Convention as well as a WIPO treatise to determine the meaning of “acts.”¹²⁴ But without apparently weighing the interests involved, the Appellate Body concluded that the length of the term was a “right” and not the result of the “act” of granting a patent; it thus held the TRIPS term to apply retroactively.¹²⁵ The adjudicators were equally undeferential to Canada’s own weighing of the interests—the Panel rejected Canada’s argument that its term (seventeen years from issuance, as opposed to the TRIPS Agreement’s twenty years from filing) was effectively compliant with TRIPS.¹²⁶ Canada was thus left with no flexibility to protect the public from windfall gains by right holders.¹²⁷

121. See Appellate Body Report, *Canada—Term of Patent Protection*, ¶¶ 10–18, WT/DS170/AB/R (Sept. 18, 2000) [hereinafter *Canada-Patent Term*].

122. This is particularly likely had the negotiators focused on the type of patents mainly at issue in *Canada-Patent Term*, namely, patents covering pharmaceuticals. See Press Release, Dep’t of Foreign Affairs & Int’l Trade Can., Background, WTO Appellate Body Report on U.S. Challenge of Canada’s Patent Term, (Sept. 18, 2000) (discussing the potential impact of the *Canada-Patent Term* decision on pharmaceutical sales in Canada).

123. Significantly, the Berne Convention does contain a provision on the retroactivity issue—a complex provision that makes retroactivity turn on whether the work remains protected in its country of origin. See Berne Convention, *supra* note 58, art. 18.

124. *Canada-Patent Term*, *supra* note 121, ¶ 54 n.40 (citing the Paris Convention, *supra* note 58, art. 4B, and WIPO, INTRODUCTION TO INTELLECTUAL PROPERTY THEORY AND PRACTICE ¶¶ 7.78–.85, at 134–35 (1997)).

125. See *Canada-Patent Term*, *supra* note 121, ¶¶ 56–60.

126. *Id.* ¶¶ 80–101.

127. Article 28 of the Vienna Convention, which sets out a rule of non-retroactivity with respect to acts and facts predating a treaty, might have also furnished the Appellate Body with a vehicle for giving Canada the flexibility to strike this balance on its own. However, the adjudicators instead used Article 28 to reject Canada’s position by reasoning that a rule that refers to a “situation which ceased to exist” could not apply to subsisting patents. *Id.* ¶¶ 72–79. Arguably, the *Canada-Pharmaceuticals* Panel’s decision to consider

E. Using Post-TRIPS WIPO Developments to Inform TRIPS

There is yet another reason why the full range of relevant intellectual property values cannot be integrated into TRIPS merely through the incorporation of the WIPO instruments: as we noted at the outset, social, economic, and technological situations change. The WIPO conventions that we have discussed thus far were adopted prior to the conclusion of TRIPS. But new rights are needed to respond to evolving technological conditions (such as the delocalization of digitized works), and new exceptions are necessary to accommodate new practices (such as open innovation). Furthermore, as developing and emerging nations begin to cope with intellectual property protection, they are finding approaches to interest-balancing that are different from the methods traditionally utilized by the developed world.¹²⁸ While TRIPS leaves members free to increase the level of their own domestic protection, many of these developments require a collective response. Under current conditions, these responses are taking place outside the WTO, including in WIPO, thus raising the question whether new (or newly modified) WIPO instruments should also be factored into the interpretation of the TRIPS Agreement.

To many commentators, the answer is clearly no. Article 31 of the Vienna Convention permits the use of a treaty or rule of international law to interpret another agreement, but only when all of the parties have agreed to both measures or accept that there is an interpretive relationship between them. Because the parties to the WTO are not all signatories of the WIPO instruments, strict application of the Vienna Convention would suggest that evolution in WIPO cannot affect TRIPS; that the only way to change the rights and obligations in TRIPS is to renegotiate it.¹²⁹

But another response is conceivable. While membership in the WIPO agreements and the WTO are not coextensive, there are very few countries that do not belong to both. For example, most of the states that are in WIPO but not the WTO are absent

technological neutrality as a structural constraint, see Dinwoodie & Dreyfuss, *Diversifying*, *supra* note 21, at 448–50, applicable to the exceptions test suffered from a similar problem: the Paris Convention did not include a similar nondiscrimination clause.

128. Indian patent law is a good example. *See, e.g.*, The Patents (Amendment) Act, 2005, No. 15, Acts of Parliament, 2005, § 3(d) (raising inventive step); Shamnad Basheer, “Policy Style” Reasoning at the Indian Patent Office, 2005 INTELL. PROP. Q. 309 (noting the Indian Patent Office’s conservative approach).

129. PAUWELYN, *supra* note 44, at 265. The Panel in the *Canada-Pharmaceuticals* case was similarly reluctant to consider subsequent practices by many of the parties to inform the meaning of TRIPS. *See supra* note 108.

for purely political reasons.¹³⁰ Furthermore, because the WIPO agreements constitute the backbone of TRIPS, the existence of some relationship between these instruments was evident to all WTO members. Neil Netanel, who addressed this question in the copyright context, thus concluded that, at least with respect to copyright agreements negotiated almost contemporaneously with TRIPS, new developments should be taken into account:

TRIPS drafters must have been well aware [that] the Berne Convention is a dynamic instrument . . . and [that] the rapid development of copyright-related technology require[s] an ongoing process of interpretation and reinterpretation within the framework that Berne sets forth.¹³¹

Under Netanel's approach, WIPO's elucidations of the terms of the instruments it administers would be immediately incorporated into TRIPS, either because WTO members should be regarded as having agreed to an evolving interpretation of the Agreement or because each new interpretation represents a "subsequent agreement between the parties" within Article 31.3(a) of the Vienna Convention.¹³²

At least one panel seems to have agreed about the relevance of such post-TRIPS developments. In the *US-110(5)* case, the United States argued that the WIPO Copyright Treaty (WCT), which was largely designed to deal with the special problem of protecting works in a digital era, along with the statements made during the negotiation of the WCT, shed light on the meaning of the exceptions test in the TRIPS Agreement.¹³³ Although the Panel was careful to note that the WCT (which at the time had very few signatories) did not formally constitute a subsequent agreement within the meaning of Article 31.3, "the wording of the WCT, and in particular of the Agreed Statement thereto, nonetheless supports, as far as the Berne Convention is concerned, that the Berne Union members are permitted to provide minor exceptions to the rights provided under Articles 11 and 11bis."¹³⁴ The Panel went on to say that because the WCT

130. The only WTO members that are not officially in WIPO are the EC (whose members joined WIPO individually), Hong Kong, Macao, Taiwan (where there are political obstacles), and the Solomon Islands. Vanuatu has observer status at the WTO and is not a member of WIPO. Compare WIPO, Member States, <http://www.wipo.int/members/en> (last visited Oct. 21, 2009), with Understanding the WTO: The Organization, Members and Observers, http://www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm (last visited Oct. 21, 2009).

131. Netanel, *supra* note 51, at 471–72.

132. *Id.* at 465–67.

133. *US-110(5)*, *supra* note 58, ¶ 6.67.

134. *Id.* ¶ 6.69.

was unanimously concluded at a diplomatic conference attended by 127 countries, most of which also participated in TRIPS negotiations, “it is relevant to seek contextual guidance . . . in the WCT.”¹³⁵

In a sense, it is no wonder that the DSB has taken this line. As noted in the Introduction, the “right” rules for intellectual property are something of a moving target. As countries become increasingly developed, they encounter competition from emerging nations; as they cope with the challenges and opportunities of new technologies, needs change. The accommodations that were appropriate in the 1990s, when TRIPS was negotiated, are unlikely to be appropriate forever. To the extent that WIPO is more nimble than the WTO—more adept at finding coordinated responses to new developments—its input is invaluable.

III. INTERPRETIVE APPROACHES AND RELEVANT SOURCES

The impasse in WTO lawmaking, coupled with the relatively few intellectual property cases adjudicated by the DSB—and by the Appellate Body in particular—present both a problem and an opportunity. Until WTO lawmaking becomes more robust, nations will have difficulties accommodating changing circumstances. They will undoubtedly require new intellectual property legislation to deal with new challenges but will often be required to live with the uncertainty of not knowing whether these laws comply with their international obligations.¹³⁶ Furthermore, nations must deal with a distorted political economy.¹³⁷ Because TRIPS is a minimum standards regime, those interested in strong intellectual property protection can cite TRIPS in support of their legislative agendas and can use the threat of a TRIPS challenge to block moves intended to safeguard the public interest. At the same time, however, the fluidity of the current regime makes this a good time to ponder the interpretive approaches that are best able to maintain a productive creative

135. *Id.* ¶ 6.70.

136. TRIPS Council reviews can, of course, provide some (non-authoritative) guidance on laws that have been enacted. See Paul Vandoren, *The Implementation of the TRIPS Agreement*, 2 J. WORLD INTEL. PROP. 25, 29 (1999). However, it does not provide advice formally through existing review mechanisms on whether proposed legislation is compatible with TRIPS.

137. For example, Indian law aimed at preventing evergreening has been heavily criticized on TRIPS-compatibility grounds. See Posting of Tushar Dhara, *Thoughts on the Gleevac Controversy*, to India Unplugged (Mar. 14, 2008), <http://arthedains.com/indiaunplugged/2008/03/14/87> (outlining the objections of pharmaceutical companies to the Indian Patents Act on the grounds that the statutory provision was vague and ambiguous and contrary to the requirements of the TRIPS Agreement and the Indian constitution).

environment in the face of changing needs. As we previously suggested, generous and informed use of the intellectual property expertise at WIPO (and, by extension, other international organizations with an interest in intellectual property) is a necessary part of the solution. But encouraging panels to put TRIPS in its historical (Berne/Paris-derived) context and to take account of post-TRIPS international developments will not be enough in and of itself, as existing panel reports show. As the WTO thinks through the problem of interpreting the Agreement in new contexts and incorporating intellectual property values into a trade framework, it will hopefully address the following issues.

A. *The Role of the TRIPS Agreement's Principles and Objectives in Interpretation*

One problem that emerges clearly from studying the existing case law is that a strategy for balancing interests and responding to change that relies solely on the bare text of the incorporated WIPO conventions is likely to fail. Despite the valiant efforts of the Appellate Body in *Havana Club* (and in other cases as well¹³⁸) to preserve flexibility for member states by relying on WIPO conventions for guidance, there are too many inconsistencies, differences, and transpositional errors for this strategy to fully succeed.

Significantly, however, TRIPS furnishes its own guidance, quite apart from the multi-part exceptions tests discussed earlier. The Objectives of the TRIPS Agreement are stated in Article 7 as the use of intellectual property rights to promote innovation “to the mutual advantage of producers and users . . . in a manner conducive to social and economic welfare.”¹³⁹ Furthermore, Article 8 (Principles) permits members to adopt measures that protect public health and promote sectors of vital interest to their economies and to technological development (so long as they are consistent with the Agreement).¹⁴⁰ So far, these provisions have not played an important interpretive role. Indeed, the *Canada-Pharmaceuticals* Panel essentially wrote them off, rejecting the claim that they should be used to determine whether Canada's policies on behalf of generic competition fall within the patents exception provision.

138. See, e.g., *supra* note 71 and accompanying text (discussing *India-Pharmaceuticals*). Some panels have been similarly conciliatory, as the *China-Enforcement* case demonstrates. *Id.*

139. TRIPS, *supra* note 1, art. 7.

140. *Id.* art. 8.1.

While the Panel agreed that the sentiments expressed in the Objectives and Principles had to be “borne in mind,” it also warned against using these provisions to alter the deal struck in the Uruguay Round.¹⁴¹

As Peter Yu so convincingly argues, that reluctance to impose a purposive gloss must change.¹⁴² The Doha Declaration on the TRIPS Agreement and Public Health specifically stated that “each provision of the TRIPS Agreement shall be read in the light of the object and purpose of the Agreement as expressed, in particular, in its objectives and principles.”¹⁴³ The status of the Declaration is not entirely clear (it too is a post-TRIPS development that arguably should be taken into account in interpreting the Agreement).¹⁴⁴ What is clear, however, is that the commitments expressed in the Objectives and Principles would go a long way toward providing a normative dimension to the exceptions test that was absent in both the *US-110(5)* and the *Canada-Pharmaceuticals* cases.¹⁴⁵ A perspective informed by these provisions would be similarly useful in considering other issues, such as the structural relations between the various parts of the Agreement¹⁴⁶ (an issue that arose, with unsatisfying results, in *Canada-Pharmaceuticals*¹⁴⁷), and the role that should be played by a state’s stated rationale for enacting a challenged action.¹⁴⁸

141. *Canada-Pharmaceuticals*, *supra* note 38, ¶ 7.26; *see also India-Pharmaceuticals*, *supra* note 71, ¶¶ 43–48.

142. Yu, *supra* note 27, at 1000–18.

143. World Trade Organization, Ministerial Declaration of 14 November 2001, ¶ 5(a), WT/MIN(01)DEC/2, 41 I.L.M. 746 (2002).

144. *See* Howse, *supra* note 57, ¶ 37; PAUWELYN, *supra* note 44, at 47.

145. GERVAIS, *supra* note 14, at 206–09.

146. The national treatment and most-favored nation obligations are structural, in that they apply to all the forms of intellectual property protection coming within the scope of the TRIPS Agreement, even if the protection accorded is in excess of that mandated by the Agreement. *See EC-GI*, *supra* note 29, ¶¶ 7.130 (national treatment), 7.702 (most-favored nation).

147. In that case, the Panel subjected Canada’s research exemption, which had been held valid under the three-part exceptions test, to a separate analysis under Article 27.1, which requires technological neutrality. *See Canada-Pharmaceuticals*, *supra* note 38, ¶¶ 7.84–104. As we have previously explained, treating technological neutrality as substantive (as outside the reach of the exceptions test) makes it very difficult to draft an exemption limited enough to qualify for an exemption under Article 30. *See* Dinwoodie & Dreyfuss, *Diversifying*, *supra* note 21, at 449. It also makes it hard for states to deal with the divergent interests of, say, the information technology, financial services, biotechnology, and pharmaceutical industries. A different view on the exceptions test may not, however, have saved Canada’s stockpiling provision as the Panel added another constraint on members’ freedom of action. It treated the nondiscrimination provision in Article 27.1 as structural—as a requirement that is not subject to exceptions. *See EC-GI*, *supra* note 29, ¶¶ 7.91–93.

148. *See* Dinwoodie, *supra* note 97, at 750–51.

Article 1 of the TRIPS Agreement, on the Nature and Scope of Obligations, could also play an anchoring role, for it leaves members “free to determine the appropriate method of implementing the provisions of [the] Agreement within their own legal system and practice.”¹⁴⁹ This restates a fundamental assumption of the international intellectual property system: international norms confine national policy choices, but they do not define them. So far, the reach of this provision is unclear. In *China-Enforcement*, for example, the Panel emphasized, on the one hand, that Article 1.1 does not justify derogations from basic obligations.¹⁵⁰ At the same time, it considered the provision in connection with the question whether China was doing enough to keep counterfeit goods out of channels of trade and ensuring that they did not harm trademark holders’ reputations. After examining how China used these goods to serve public welfare interests, it held that China was “free to determine the method of implementation of its obligations under Article 59 [on remedies] in accordance with Article 1.1 of the TRIPS Agreement.”¹⁵¹ Further development of Article 1.1 jurisprudence could help panels take better account of the varying traditions of its members, such as the difference between *droit d’auteur* and utilitarian approaches discussed above.¹⁵² Similarly, explication of Article 1.1 would provide guidance to states about the areas where they have most latitude regarding means of implementation.¹⁵³

B. TRIPS as a Trade Agreement

In addition to a more nuanced intellectual property perspective, and a more purposive reading of the TRIPS agreement, adjudicators could also better preserve the balance needed in intellectual property law by viewing the TRIPS Agreement with its trade-related character consciously in mind. Currently, adjudicators tend to look mainly at how states treat intellectual property within their borders, largely ignoring effects on international trade. Admittedly, the drafters of TRIPS were heavily focused on local infringement. Negotiations over intellectual property moved to the WTO because WIPO was

149. TRIPS, *supra* note 1, art. 1.1.

150. *China-Enforcement*, *supra* note 65, ¶ 7.513.

151. *Id.* ¶ 7.323.

152. See *supra* notes 109–12 and accompanying text.

153. The TRIPS Agreement itself already identifies enforcement measures as an area where states are to be given particularly generous room for maneuver. See TRIPS, *supra* note 1, art. 41.5.

viewed as hostile to raising domestic levels of intellectual property protection, and because the WTO provided a way to pay off developing countries for accepting stronger obligations.¹⁵⁴ Nonetheless, the fact remains that the Agreement is denominated *Trade-Related Aspects of Intellectual Property Rights*. Because dispute resolution is only applicable to intellectual property by virtue of its nexus to trade, the DSB could enable the states to better tailor their intellectual property laws to local interests if it focused its attention on the extent to which challenged actions specifically encumber or distort trade.¹⁵⁵

For example, in *China-Enforcement*, on the issue of whether China was taking strong enough action to remove infringing goods from the channels of commerce, the Panel used a single reference in Article 51 (on border measures) to claim that members' obligations extend only to preventing the *importation* of infringing goods.¹⁵⁶ Even though other provisions in the Agreement explicitly refer to *exportation*,¹⁵⁷ and the Decision of the General Council implementing the Doha Declaration paid particular attention to exports,¹⁵⁸ the *China-Enforcement* Panel found that states have no duty to prevent their territories from becoming information havens—hubs for international infringement operations. This is not surprising in light of the WTO's origins, which focused on barriers to the *entry* of goods into members' markets. However, those concerned with trade in

154. See SUSAN K. SELL, PRIVATE POWER, PUBLIC LAW: THE GLOBALIZATION OF INTELLECTUAL PROPERTY RIGHTS 46 (2003) (explaining that developed countries disfavored WIPO because it "lacked enforcement powers and was dominated numerically by less developed countries"); Jerome H. Reichman & Rochelle Cooper Dreyfuss, *Harmonization Without Consensus: Critical Reflections on Drafting a Substantive Patent Law Treaty*, 57 DUKE L.J. 85, 100–01 (2007) (noting that developed countries could "exchange higher intellectual property standards for trade concessions in other areas" under the WTO framework).

155. See Frankel, *supra* note 61, at 390–91. Of course, the reformulation of trade theory as grounded in comparative advantage (as opposed to the mere free flow of goods) has allowed international regulation a more ready justification for intruding upon purely local conditions. See Dinwoodie, *supra* note 13, at 78–80. But it should not be taken as a given that theories of comparative advantage have wholly displaced traditional justifications for a trade regime. Courts or other adjudicators charged with effectuating traditional trade objectives by ensuring the free movement of goods may in fact view territorial intellectual property rights with much greater suspicion. See GRAEME B. DINWOODIE ET AL., INTERNATIONAL INTELLECTUAL PROPERTY LAW AND POLICY 48 (2d ed. 2008) (discussing the European Court of Justice).

156. *China-Enforcement*, *supra* note 65, ¶ 7.224.

157. See, e.g., TRIPS, *supra* note 1, art. 51 (allowing members to control goods destined for exportation); *id.* art. 59 (creating a duty to prevent the re-exportation of infringing goods).

158. World Trade Organization, General Council Decision of 30 August 2003, *Implementation of Paragraph 6 of the Doha Declaration on the TRIPS Agreement and Public Health*, ¶ 4, WT/L/540 (Sept. 2, 2003).

intellectual property need to be concerned about flows in both directions.

A contrast between the *US-110(5)* case and the stockpiling portion of *Canada-Pharmaceuticals* provides an illustration of how requiring a trade nexus might affect the extent to which the TRIPS Agreement circumscribes national intellectual property lawmaking. Although the complainant won each of the cases, the challenged measures were factually different. The United States had been permitting rebroadcasts of music in small establishments *within the United States*.¹⁵⁹ Since there was no possibility of re-rebroadcast abroad, the potential loss of trade was extremely limited. It consisted only of the claim that without the exemption, the establishments in question would have paid licensing fees for the relevant rebroadcasts. In contrast, Canada was apparently permitting generic drug companies to stockpile drugs for sale *around the world*;¹⁶⁰ thus, Canada's laws had a serious potential impact on trade in goods.¹⁶¹

Perhaps the cases should have come out as they did, but had the adjudicators mandated that closer attention be paid to impacts on world trade, they would have left states with more room to maneuver. In particular, emerging economies would benefit from such an approach. They could provide their populations with easier access to educational materials and training opportunities by raising the inventive step, taking novel approaches to the scope of intellectual property rights, or adopting new defenses to infringement. Because their manufacturing capacities are modest, the activities thus permitted would be unlikely to affect world trade in a meaningful way (and this would be especially true if they made efforts to confine distribution to interstate trade).¹⁶² Accordingly, such activities might not be regarded as TRIPS violations, even if substantially similar actions by developed countries would be.¹⁶³

159. See *US-110(5)*, *supra* note 58, ¶ 2.5–6.

160. See *Canada-Pharmaceuticals*, *supra* note 38, ¶ 2.1.

161. The proposed Anti-Counterfeiting Trade Agreement (ACTA) furnishes an interesting contrast. See generally Charles McManis, *The Proposed Anti-Counterfeiting Trade Agreement (ACTA): Two Tales of a Treaty*, 46 HOUS. L. REV. 1235 (2009).

162. Cf. Award of the Arbitrators, *United States—Section 110(5) of the US Copyright Act, Recourse to Arbitration Under Article 25 of the DSU*, ¶ 4.21–23, WT/DS160/ARB25/1 (Nov. 9, 2001) (suggesting that *harm* may vary according to the historical state of the market). But see Richard Owens, *TRIPs and the Fairness in Music Arbitration: The Repercussions*, 25 EUR. INTELL. PROP. REV. 49 (2003) (criticizing this reading).

163. Dreyfuss, *supra* note 7, at 5–7. For another example of where this issue arises, consider the controversy over the EU's seizure of Indian generic drugs bound for a market where they were not protected. See Intervention by India, *India—Seizure of Generic Drug Consignments at EC Ports* (Mar. 3, 2009), available at <http://www.keionline.org/node/309>.

To put this another way, instead of using trade as a lens through which to filter the scope of international obligations imposed by the eponymous TRIPS Agreement, the Appellate Body and the panels have largely subsumed the international intellectual property system as a whole within the trade apparatus. Thus, as noted above, the treatment by panels of discrepancies between TRIPS and WIPO conventions suggests that it is well understood that intellectual property was incorporated into the WTO system in order to take advantage of the latter's enforcement machinery. But this was a purely strategic move. For reasons we have discussed elsewhere, the coupling of intellectual property and trade is an uneasy one. The relationship is under-theorized in the literature (partly because intellectual property was treated exceptionally under Article XX(d) of the old GATT regime), and neither the Appellate Body nor the TRIPS panels have fully explored the interaction.¹⁶⁴ If trade-relatedness were made a criterion for determining TRIPS compatibility, nations would have more room to adapt their laws to domestic needs and to make them responsive to local changes in circumstances.

C. *Relying on Multiple Sources*

Our short survey of the TRIPS cases reveals that the panels and Appellate Body have on occasion taken an eclectic approach

164. Any doctrinal exploration that has occurred had been formalistic and motivated largely by a desire to maintain internal coherence in the enforcement of TRIPS norms. For example, the Appellate Body in *Havana Club* and the Panel in *EC-GI* each subjected challenged national laws to analysis under the separate national treatment obligations in both GATT Article III and TRIPS Article 3, rejecting the contention that compliance with one (for example, the GATT provision with its generous exclusion) would automatically result in compliance with the other. See *EC-GI*, *supra* note 29, ¶ 7.184. And there are important differences between the two obligations. GATT national treatment prohibits unequal treatment of goods, GATT, *supra* note 45, art. III, while TRIPS focuses on the treatment of nationals. TRIPS, *supra* note 1, art. 3. And, most significantly, the obligations are subject to different exceptions: TRIPS to provisions taken over from prior intellectual property conventions, and GATT to the exclusion of laws "necessary" for protection of intellectual property under Article XX(d). TRIPS, *supra* note 1, art. 2; GATT, *supra* note 45, art. XX(d). But these approaches are largely grounded in making the incorporation of WIPO conventions real and in maintaining internal coherence in the enforcement of TRIPS norms. For example, subjecting intellectual property laws to both (different) national treatment obligations is important if the incorporation of the national treatment obligations of the WIPO conventions is to have any effect; if compliance with GATT were sufficient, incorporating the national treatment commitments of Berne and Paris would have been unnecessary. Likewise, the *EC-GI* Panel correctly noted that if it allowed the scope of Article 3 of TRIPS to be affected by the potential applicability of GATT Article III, it might result in the non-uniform application of Article 3 of TRIPS to other intellectual property rights that were not inherently linked to the territorial origin of a product. See *EC-GI*, *supra* note 29, ¶ 7.184.

to the materials they use to interpret the TRIPS Agreement. For example, the adjudicators in *Havana Club* and the *US-110(5)* cases consulted the 1883 Final Protocol to the Paris Convention, materials from the 1911 Paris Revision Conference, the General Report and materials of the diplomatic conferences leading to the inclusion of broadcast rights in the Berne Convention, as well as learned treatises interpreting the conventions.¹⁶⁵ To be sure, some reports place undue reliance on the dictionary,¹⁶⁶ and references to WIPO materials without proper regard for history and context can undermine the intellectual property values at stake. Unfamiliar materials must be handled with care. However, unless WTO lawmakers are open to a variety of sources, intellectual property norm development will be incomplete. Furthermore, the cacophancy and recycling created by the emerging “international IP regime complex” will persist. Instead, ways must be found to integrate developments from a multiplicity of sources. In particular, the Vienna Convention allows practices of states to be considered in determining the meaning of TRIPS.¹⁶⁷ So too might other bilateral and multilateral international agreements be taken into account. WTO panels should view these sources of law broadly to ensure the most intellectual property sensitive reading of the TRIPS Agreement. And they should be willing to innovate procedurally to optimize their awareness and appreciation of these broader materials.

1. *National Practices.* Article 31.3(b) of the Vienna Convention permits interpretation to be shaped by subsequent practices by the parties that reflect on an agreement’s meaning. In the context of TRIPS, there are two time periods to consider: practices adopted under the WIPO conventions and practices adopted only subsequent to TRIPS. While the *Canada-Pharmaceuticals* Panel was reluctant to take account of practices in the first time period, even in determining the legitimate expectations of patent holders,¹⁶⁸ these practices would appear to be extremely relevant. They reflect not only on the meaning of underlying Paris and Berne obligations, they also shed light on what the states thought they were agreeing to when they joined the TRIPS Agreement (especially if these practices continued

165. See *supra* notes 64–65, 85, 124 and accompanying text.

166. See Dinwoodie, *supra* note 47, at 1005–06.

167. Vienna Convention, *supra* note 60, art. 31.3.

168. See *supra* note 108; *supra* text accompanying note 86. However, the Panel expressed skepticism about relying on the laws of individual countries. See *Canada-Pharmaceuticals*, *supra* note 38, ¶ 7.82.

after TRIPS went into force). And, indeed, the *US-110(5)* Panel was extremely attentive to how WIPO members viewed their Berne obligations: it made considerable use of exceptions found in different national laws to shed light on the meaning of the “minor exceptions” doctrine that it held to be part of the Berne *acquis*.¹⁶⁹ Furthermore, in *EC-GI*, the Panel’s decision on whether the protection the EC offered geographic indications was unduly interfering with trademarks was importantly informed by the ways in which the EC had dealt with potential interferences in the recent past and by the paucity of confusing simultaneous registrations.¹⁷⁰ Although such regard might not, as a formal matter, satisfy the definition of state practice within the meaning of the Vienna Convention,¹⁷¹ the Panel’s flexibility toward the relevance of state practices ensured that the context of how international norms operate locally was fully taken into account. Among other things, this approach validates the freedom expressed in Article 1.1 to implement international obligations in ways appropriate to the national regime in question.

Events post-TRIPS are relevant for many of the same reasons. Post-TRIPS practices also speak to a country’s understanding of both its TRIPS obligations and the requirements of the underlying Paris and Berne Conventions. Consulting them contributes to a coherent understanding of the international intellectual property regime as a whole.¹⁷² More

169. See *supra* text accompanying notes 133–35.

170. *EC-GI*, *supra* note 29, ¶¶ 7.573 (on the Budvar issue), 7.667–.679 (on how EC handled applications), 7.674 (on instances of potential confusion). In its analysis of the trademarks exception test, the *EC-GI* Panel also drew significant support from the example of an acceptable practice included in Article 17 of TRIPS, which allows fair use of descriptive terms. *Id.* ¶ 7.655. When TRIPS lawmaking resumes, drafters should keep in mind how useful it is to provide adjudicators with such examples.

171. Elsewhere in its report, the Panel also looked at implemented laws operating in other countries, a method of interpretation that more formally satisfies the understanding of state practice in the Vienna Convention. See *id.* ¶ 7.642.

172. See Netanel, *supra* note 51, at 447 (“[S]tate practice under Berne should indeed be the fundamental starting point for interpreting Berne-in-TRIPS [the interpretation of the Berne provisions as incorporated into TRIPS], although the Berne provisions that are incorporated into TRIPS will necessarily be colored by TRIPS’s state practice and overall object and purpose as well.”). The panels appear to have avoided the problems of the pre- and post-TRIPS dichotomy in dealing with international materials. Thus, the Appellate Body has articulated the doctrinal difference between using the preparatory work for the TRIPS Agreement and relying on the negotiation history of the Paris and Berne Conventions: the former is subject to Article 32 of the Vienna Convention and can be used only in the case of ambiguity or unreasonableness; the latter is a constitutive part of the parties’ understanding of their TRIPS commitments. See *id.* at 460 n.77, 469. However, since the relevant time to gauge this understanding is at the conclusion of the TRIPS Agreement, relevant sources include not only texts prepared in the run-up to the WIPO instruments, but also interpretive materials published prior to the conclusion of TRIPS.

important, sensitivity to post-TRIPS practices keeps the TRIPS Agreement relevant. As noted in the Introduction, intellectual property norms are something of a moving target because they must respond to changes in technology, the imperatives of development, and also to cultural shifts (greater appreciation for authenticity, and hence, GIs; greater recognition of human rights claims, and therefore access interests). As countries attempt to accommodate their contemporary national interests to the mandate of TRIPS, new solutions develop. For example, India has pioneered a new interpretation of the inventiveness requirement.¹⁷³ Should similar economies adopt the same strategy, the emerging consensus should be taken into account in interpreting the reference in TRIPS to the “inventive step.”¹⁷⁴ Similarly, widespread adoption of rules like Germany’s on the scope of gene patents¹⁷⁵ might be interpreted as a response to upstream patenting, rather than as an attempt to treat the biotechnology sector specially, in violation of the nondiscrimination proviso of the TRIPS Agreement.¹⁷⁶ The Panel in *US-110(5)* appeared alert to the danger of viewing international norms statically and specifically noted that minor exceptions were not “frozen in 1967” when broadcasting rights were added to the Berne Convention.¹⁷⁷ Being willing to consider national practices across time allows dispute settlement panels to decide cases based on the most refined conceptualization of available policy levers and in ways relevant to new social and technological developments.

But as helpful as these national sources are, their use is not without problems (just as the same was true of a historical use of international treaties¹⁷⁸). First, there is no reason to believe that the parties to the Paris and Berne Conventions fully utilized the flexibilities available to them under those instruments. Indeed, the opposite is clearly true: developed countries have long had trademark and patent laws that vastly exceed the requirements of the Paris Convention. Accordingly, while laws that pre-existed TRIPS may identify practices that are allowable, no inference can be made about whether other measures should also be considered permissible.¹⁷⁹

173. The Patents (Amendment) Act, 2005, No. 15, Acts of Parliament, 2005, § 3(d).

174. TRIPS, *supra* note 1, art. 27.1.

175. Patentgesetz, [PatG, Patent Act], Dec. 16, 1980, *as amended by* Gesetz, Jan. 21, 2005, BGBl. I, at 146, § 1a(4) (F.R.G.).

176. *See* TRIPS, *supra* note 1, art. 27.1.

177. *US-110(5)*, *supra* note 58, ¶ 6.59 (internal quotation marks omitted).

178. *See supra* text accompanying notes 103–21.

179. This is also important when panels look to commercial practices in particular

Second, care must be taken lest national norms adopted in a few countries be quickly consolidated at the international level, precluding reversal of any national experiments deemed unsuccessful. In recent years, the United States (and, to some extent, other developed countries) have embarked on a series of bilateral trade agreements, often with developing countries, which are intended to raise the level of intellectual property protection above the requirements of the TRIPS Agreement. Many fall on the heels of WIPO efforts to expand the Paris or Berne Conventions to cover new regimes, and they appear in part to be intended to convert WIPO's "soft law" into genuine obligations.¹⁸⁰ In effect, however, these agreements are pay-offs: they give one country greater access to the other's markets in exchange for raising the level of protection.¹⁸¹ While many of them may be in the contracting parties' mutual trading interests, they should not be viewed as evidence of how the WIPO instruments or the TRIPS Agreement should be interpreted. Nations that have not received the quid pro quo should not be required to nonetheless accord higher levels of protection to intellectual products.

Third, it is important to ensure that grandfathering—the practice of relying on pre-TRIPS practices and materials—does not end up privileging developed countries, which have evolved a considerable repertoire of practices under the Paris and Berne Conventions, over developing countries that are so new to intellectual property that they have never considered how to adjust their implementing legislation to their national interests. This problem of privileging the approaches of the developed world could be ameliorated simply by incorporating this historical understanding into any analysis of state practice or by

states. See Dinwoodie, *supra* note 97, at 758. The same can be said of learned treatises: they may shed light on practices that states were using or had contemplated, but omissions do not constitute evidence that a practice is inconsistent with WIPO obligations.

180. See Anselm Kamperman Sanders, *Intellectual Property, Free Trade Agreements and Economic Development*, 23 GA. ST. U. L. REV. 893 (2007); Peter K. Yu, *TRIPs and Its Discontents*, 10 MARQ. INTELL. PROP. L. REV. 369, 408 (2006).

181. Of course, these agreements look quite different if they are subject to most-favored-nation obligations. That question is, however, unresolved. An exception for bilateral agreements is contained in Article XXIV of the GATT and in the GATS. See GATT, *supra* note 45, art. XXIV; General Agreement on Trade in Services, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1B, Legal Instruments—Results of the Uruguay Round, 33 I.L.M. 1125 (1994). Although a somewhat similar provision was present in drafts of the TRIPS Agreement, it was not included in the final version. See Susy Frankel, *The Legitimacy and Purpose of Intellectual Property Chapters in FTAs*, in CHALLENGES TO MULTILATERAL TRADE 185, 186–87 (Ross Buckley et al. eds., 2008).

adapting the role of state practice as an interpretative device to require consensus across countries of different development.¹⁸²

2. *Subsequent WIPO Material.* The most straightforward way to keep TRIPS current with changes in the innovation landscape is to take post-TRIPS developments in international intellectual property lawmaking into account in interpreting the Agreement. Article 31.3(a) of the Vienna Convention allows resort to subsequent agreements among all of the parties, and, as we saw, the *US-110(5)* Panel relied on the WCT to interpret the copyright exceptions test of the TRIPS Agreement.¹⁸³ It remains to be seen whether the Appellate Body will agree to this approach and, if it does, how much further it would go.¹⁸⁴ The *US-110(5)* Panel was careful to note that the WCT was concluded only a year after TRIPS;¹⁸⁵ negotiators could not have anticipated agreements made much later. The WCT is also a completed treaty, although it had not entered into force at the time the Panel consulted it.¹⁸⁶ More informal WIPO actions, such as the Reports of Standing Committees, Model Laws, or the advice given by WIPO technical advisors to WTO members, present a very different situation. Finally, the WCT is an easy case because it deals with the same type of works that are covered by TRIPS, and it supplements (increases) the level of intellectual property protection.¹⁸⁷ Far more tenuous would be the incorporation of instruments that recognize rights in new kinds of subject matter—databases, folklore, genetic endowments, or traditional

182. Cf. Laurence R. Helfer, *Adjudicating Copyright Claims Under the TRIPS Agreement: The Case for a European Human Rights Analogy*, 39 HARV. INT'L L.J. 357, 431 (1998) (suggesting that panels rely on emergent state practice where there is concordant state practice in all four developmental categories).

183. See *supra* text accompanying notes 133–35.

184. Interestingly, in the *Havana Club* case, the Appellate Body was apparently willing to consider a somewhat subsequent development, namely the letter that WIPO wrote in response to the questions posed by the Panel. See *supra* text accompanying note 78.

185. *US-110(5)*, *supra* note 58, ¶ 6.70.

186. *Id.* ¶ 6.68.

187. The Singapore Treaty on the Law of Trademarks, which updates WIPO's Trademark Law Treaty, is another example of a relatively easy case. See Singapore Treaty on the Law of Trademarks art. 2, *opened for signature* Mar. 27, 2006, S. TREATY DOC. No. 110-2 (2007). The treaty was the product of extensive working sessions by the WIPO Standing Committee on the Law of Trademarks, Geographical Indications and Industrial Designs (SCT). Among other things, it settles the question whether three-dimensional marks are protectable in Rule 3(b)(4), which was a longstanding issue under Article 15.1 of the TRIPS Agreement. See Regulations Under the Singapore Treaty on the Law of Trademarks, Rule 3(b)(4), *opened for signature* Mar. 27, 2006, S. TREATY DOC. No. 110-2 (2007); see, e.g., *Philips Elecs. BV v. Remington Consumer Prods.*, [1998] R.P.C. 283, 290–91 (1997) (Ch.) (U.K.).

knowledge—or agreements (such as the potential findings of the WIPO Development Agenda) that mandate a level of protection below that which TRIPS explicitly requires.

Nonetheless, a strong case can be made for consulting many of these materials. Certainly, contemporaneity with TRIPS should not be dispositive. Indeed, the more distant from TRIPS, the more likely the measure will reflect members' efforts to cope with new developments in TRIPS-consistent ways. If one understands the interpretive project as avoiding the obsolescence of the system of international intellectual property rather than an historical inquiry designed to divine what negotiators thought appropriate in 1994, this argument is even stronger.¹⁸⁸ While many WIPO measures are not formal agreements, neither was the WCT at the time it was cited in *US-110(5)*.¹⁸⁹ Even when WIPO instruments are not destined to become formally binding, they represent the work of experts in the field and are open to input from state delegations. As such, they are somewhat akin to the internationally developed standards that other WTO framework agreements expressly take into account.¹⁹⁰ These materials demonstrate how the terms in the TRIPS Agreement are construed in new contexts, and what interested parties see as appropriate ways to resolve novel issues.¹⁹¹

Of course, not every document issued by WIPO is subject to the kind of vetting that produces a balanced instrument, and many are not the product of genuine consensus among the WIPO membership (let alone the WTO). These issues should, however, go to the weight these materials are given in the interpretive process.¹⁹² The nature of the measure—be it report, model laws, or resolution—should be taken into account, along with such matters as the degree of transparency accorded to interested parties (including civil society); the diversity of the input; the extent to which state delegations participated; how states, commentators, and practitioners reacted to the instrument; and

188. Cf. STEPHEN BREYER, *ACTIVE LIBERTY: INTERPRETING A DEMOCRATIC CONSTITUTION* 16 (2008) (noting that the drafters of the U.S. Constitution used the words "We the People" rather than "we the people of 1787").

189. See *US-110(5)*, *supra* note 58, ¶ 6.68. Admittedly, the parties to the dispute had both ratified it, but the Vienna Convention is usually interpreted as requiring ratification by the parties to the *agreement* at issue, not the *dispute*.

190. See *supra* note 44 (discussing the various WTO agreements that reference pre-existing standards).

191. See PAUWELYN, *supra* note 44, at 257–60.

192. See Graeme B. Dinwoodie, *Copyright Lawmaking Authority: An (Inter)Nationalist Perspective on the Treaty Clause*, 30 COLUM. J.L. & ARTS 355, 386–91 (2007) (suggesting similar considerations in weight to be given to international instruments in domestic constitutional analysis).

how many WIPO members formally adopted the conclusions (and under what circumstances¹⁹³). Thus, as we saw, the *US-110(5)* Panel took account of the WCT, even though that agreement had yet to enter into force.¹⁹⁴ Notably, the WCT was heavily debated in an exceedingly open process.¹⁹⁵

In contrast, the *China-Enforcement* Panel, when considering what counted as “commercial scale” for determining whether China had breached its enforcement obligations, consulted how that term was used by the WIPO Committee of Experts on Measures Against Counterfeiting and Piracy and the Draft Model Provisions for National Laws set out in a memorandum by the International Bureau of WIPO.¹⁹⁶ However, the Panel ultimately decided not to use the explanatory material because there had been no agreement on them. According to the Panel, the materials should not be “elevate[d] . . . to the status of the proper interpretation of a treaty text that was negotiated in another forum and that *was* finally agreed.”¹⁹⁷ The Panel did not specify what sort of agreement it was looking for. Were the WTO to consider the factors we have enumerated in determining how much deference to accord this material, there would be an interesting side benefit: WIPO negotiators would have a new incentive to make their deliberations more open and participatory. Interpretive canons of this sort thus not only allow for the updating of international norms, they can also alter the political and institutional economy in more structural ways.¹⁹⁸

The Joint Resolution Concerning Provisions on the Protection of Well Known Marks, a 1999 document interpreting Article 6*bis* of the Paris Convention, furnishes an example of how this approach could work.¹⁹⁹ TRIPS was concluded before the Internet revolutionized global marketing. Consequently, the negotiators did not grapple with the ramifications of e-commerce, including the extent to which it increases the likelihood of consumer confusion and leads to interference between domain

193. See *supra* text accompanying notes 179–82 (noting the extent to which states have been forced into “TRIPS-plus” measures through bilateral agreements).

194. See *supra* text accompanying notes 133–35.

195. See generally Samuelson, *supra* note 42 (tracing the WCT debate).

196. *China-Enforcement*, *supra* note 65, ¶ 7.562.

197. *Id.* ¶ 7.567.

198. Cf. Dinwoodie & Dreyfuss, *Dynamics*, *supra* note 21, at 99–103 (discussing how a more flexible approach to national implementation could affect the political structure of WTO member states); see also Dreyfuss, *supra* note 11 (discussing the role of emerging nations in developing intellectual property norms, operating under TRIPS flexibilities).

199. See WIPO, *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks*, WIPO Doc. 833(E) (Sept. 29, 1999), available at http://www.wipo.int/export/sites/www/about-ip/en/development_iplaw/pdf/pub833.pdf.

names and trademarks. These issues were, however, tackled by the Joint Resolution, which was adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of WIPO, and was based on work by a committee of experts and the work of the Standing Committee on the Law of Trademarks, Industrial Designs, and Geographic Indications. The Resolution provides rules for determining when a mark is well known and when a mark has priority over similar domain names.²⁰⁰ Both of these issues had vexed the membership, and, in each case, most of the guidance (arguably) flows naturally from agreed norms on the role trademarks play in the marketplace. Should either the definition issue or the domain name question arise in dispute resolution, adjudicators ought to regard the Joint Resolution as highly informative of the meaning of Article 6*bis*. At the same time, however, the Joint Resolution also contains a provision protecting well-known marks from dilution.²⁰¹ This protection, which is independent of consumer confusion, was hotly contested and several members refused to join in the recommendation.²⁰² Accordingly, if the DSB were called upon to decide whether TRIPS requires dilution protection, adjudicators would have sufficient information to conclude that the Joint Resolution does not shed light on the issue.²⁰³

Skepticism is also appropriate for WIPO measures that recommend protection for new kinds of subject matter, such as databases, traditional knowledge, or publicity rights. While national intellectual property laws tend to be interpreted capaciously in order to encourage revolutionary advances,²⁰⁴ the legitimacy of international instruments is strongly dependent on genuine agreement among the parties. There will be some close

200. *Id.* arts. 2, 6.

201. *Id.* art. 4.

202. WIPO Director General, *Memorandum on the Joint Resolution Concerning Provisions on the Protection of Well-Known Marks*, ¶ 8, WIPO Doc. A/34/13 (Aug. 4, 1999), available at http://www.wipo.int/edocs/mdocs/govbody/en/a_34/a_34_13.pdf.

203. Another example is the WIPO Model Provisions on Protection Against Unfair Competition, WIPO Publication No. 832(E) (1996), which was based on a study by the Max Planck Institute, and expands upon the meaning of Article 10*bis* of the Paris Convention. Although such publications have been criticized as exceeding the scope of WIPO's authority, see Cornish, *supra* note 50, at 338, that critique could be taken into account in their utilization. See *China-Enforcement*, *supra* note 65, ¶ 7.567 (declining to use the Report of the WIPO Committee of Experts on Measures against Counterfeiting and Piracy of April 1988 to clarify the meaning of "commercial scale" because the experts never agreed on a particular meaning); see also *id.* ¶ 7.586 (considering the Model Provisions but acknowledging that the lack of consensus negates much of their impact). The McManis account of ACTA suggests that it too is an instrument that should not be taken into account in interpreting the TRIPS Agreement. See McManis, *supra* note 161.

204. See, e.g., *Diamond v. Chakrabarty*, 447 U.S. 303, 308–09 (1980).

calls where the work of WIPO could be helpful in determining whether TRIPS covers the new subject matter; patent protection for software is an example.²⁰⁵ But new kinds of intellectual property are likely to require new minimum standards. Thus, even when there is substantial activity in WIPO, extending coverage to new fields is best done through formal revision of TRIPS rather than through more ad hoc actions, such as adjudication.²⁰⁶

So far, most WIPO developments tend to be in the direction of interpreting agreements to maximize intellectual property holders' rights. That could change with WIPO's new Development Agenda. If it does, then similar considerations should apply: in disputes over how TRIPS structures the balance between consumer and producer interests (or how much authority it leaves to member states), recommendations that are the product of expert views, that were subject to transparent procedures, are well-supported by members, and are clearly within the scope of WIPO's core expertise, ought to be consulted. Where there is evidence of disagreement or overreaching, or where the WIPO measure involves new types of rights, the WIPO instrument should not be used to construe the meaning of TRIPS and move international intellectual property forward too quickly.

3. *Other International Developments.* Expanding the sources to which panels might refer is part of a larger effort to understand the international intellectual property system as a broad regime with a number of constituent parts.²⁰⁷ The international intellectual property system has always been highly textured. In the past, it required regard for national developments and a web of bilateral agreements.²⁰⁸ As previously noted, the current system is even more complicated, for many of the moving parts are now multinational in nature, compelling

205. See Dreyfuss & Lowenfeld, *supra* note 13, at 284–97 (noting that the Agreement only specifically requires copyright protection for software).

206. This is not to say that national protection for new subject matter might not be subject to existing international obligations that are more structural in nature. For example, the protection extended to databases by the European Union in its Database Directive arguably could have been conceptualized as protection against unfair competition and subject to the national treatment provisions of the Paris Convention. See Dinwoodie & Dreyfuss, *Diversifying*, *supra* note 21, at 447–48 (discussing the different character of structural provisions); J.H. Reichman & Pamela Samuelson, *Intellectual Property Rights in Data?*, 50 VAND. L. REV. 51, 138–45 (1997) (examining an unfair competition approach to protecting database content).

207. See generally Dinwoodie, *supra* note 18.

208. See RICKETSON & GINSBURG, *supra* note 103, ¶¶ 1.29–.31.

attention to more varied international sources. Thus, much of what was said here applies equally to the efforts of other international organizations. For example, the WTO ought to regard the work of the World Health Organization as highly relevant to deciding when state actions improving access to medicines are compatible with TRIPS. It should take the actions of the Convention on Biological Diversity into account on issues regarding rights in agricultural knowledge. Because intellectual property often raises human rights issues, the work of the UN Millennium Project and the Commission on Human Rights would likewise interject important principles into TRIPS decisionmaking. “Mainstreaming”²⁰⁹ these values into TRIPS will not only provide a normative dimension currently missing from trade law, but it will also make the decisions of the WTO more acceptable to a broad array of constituents. This enriched perspective would help panels to engage in the normative analysis that they declare relevant to decisionmaking but seem unable (or unwilling) to undertake.²¹⁰ And, to the extent that conformity with international norms should, as we believe, depend in part upon the relationship between a national law and its stated purpose, these sources should help panels to assess the policy justifications for different approaches.

D. Devices for Ensuring Input

Collectively, these arguments represent a call for deciding international intellectual property cases on the basis of a richer factual and normative record. How is this to be achieved within the WTO dispute settlement machinery? It appears that the Appellate Body approves of the practice, initiated by the *Havana Club* Panel, of asking the International Bureau of WIPO for relevant information on the negotiation history of particular agreements and subsequent developments.²¹¹ This practice apparently follows one that the TRIPS negotiators used themselves; indeed, the document that the TRIPS Negotiating Group asked the International Bureau of WIPO to prepare was itself used in the *US-110(5)* case.²¹² As we saw, WIPO does not have a seat at the table in the meetings of the TRIPS Council; asking it to provide its views during dispute resolution interjects

209. See Howse, *supra* note 57, ¶ 5 (suggesting “the ‘mainstreaming’ of the general normativity of human rights into the making and administrating of global economic and social regulation and policy”).

210. See, e.g., *US-110(5)*, *supra* note 58; *Canada-Pharmaceuticals*, *supra* note 38.

211. See *supra* text accompanying note 78.

212. See *supra* text accompanying note 87.

a measure of intellectual property sensibilities into the WTO lawmaking process.

It may, however, be possible to build on these practices in ways that are helpful in addressing a pervasive problem—how to maintain the currency of international intellectual property law. As we suggested above, consulting only sources about the Paris and Berne Conventions that existed at the end of the Uruguay Round does not provide a mechanism for adapting the TRIPS Agreement to new circumstances. One idea is to continue to ask for input from WIPO's International Bureau. However, these requests could be broadened to include not only "factual information" about pre-TRIPS practices,²¹³ but also its opinions on implementation options and how to handle new problems. The technical assistance that WIPO is currently providing to TRIPS members gives it a window on the problems confronting developing countries and a unique position from which to devise TRIPS-consistent solutions. Pursuant to Article 67 of TRIPS, nations in the North are required to offer help to the countries of the South in implementing their laws;²¹⁴ as previously noted, the WTO has an agreement with WIPO to assist in this process.²¹⁵ While there are continuing suspicions about the nature of the help thus offered (including claims that the North is using this duty to impose on emerging economies laws more appropriate for the developed than the developing world), both WIPO and the WTO have embarked on Development Agendas. If the organizations are true to the spirit of Article 67, the advice given should include information about the flexibilities in the Agreement and the steps these countries could take to promote their domestic interests. The practices resulting from this collaboration ought then to be regarded as strong evidence of the meaning of the TRIPS Agreement.²¹⁶ More radically, perhaps, WIPO could provide advice directly to adjudicators, playing a role not unlike the Advocate-General in the European Court of Justice.²¹⁷

213. See *supra* text accompanying note 78.

214. TRIPS, *supra* note 1, art. 67.

215. WTO/WIPO Agreement, *supra* note 36.

216. See Howse, *supra* note 57; Matthews & Munoz-Tellez, *supra* note 4.

217. The use of devices such as Advocates-General might help to ameliorate the skewing of dispute panel jurisprudence depending upon the identity of the parties. See Dinwoodie, *supra* note 18, at 508–10. Generous permission for third party involvement has arguably already helped address some of these concerns. The DSU currently provides developing countries with legal assistance from the WTO Secretariat. See DSU, *supra* note 16, art. 27.2. Developing countries have long sought to increase that assistance, through such devices as a Permanent Defense Counsel to assist developing countries in proceedings brought against them. See Kim Van der Borgh, *The Review of the WTO*

Either of these ideas would, of course, confer on WIPO broader authority than currently exists.²¹⁸ And despite recent movements to embrace the Development Agenda, many groups remain skeptical of investing too much power in WIPO. But it might be possible to lift traditional restraints on the form of WIPO involvement if other institutional checks are put in place to ensure balance. If there are concerns about whether WIPO adequately represents the collective views of its members, then the WTO could predicate its willingness to solicit WIPO's opinion on the transparency of WIPO's deliberative process.²¹⁹

There is also an obverse concern: the WTO could perceive the requirement to seek information from other sources as a diminution in its power. To preserve its authority, the WTO could resist using this information to inject non-trade-based considerations into its decisionmaking. In national contexts, such problems are avoided through a variety of devices that exert control over agencies.²²⁰ But because there is no source of such control in the international setting, the WTO could, in theory, decide to ignore input from other sources. Nonetheless, we believe that a practice of considering other sources could institutionalize over time. Use of outside materials in no way changes the WTO's authority; these materials merely aid in its decisionmaking. For example, the Objectives and Principles in the TRIPS Agreement are very general, as are the concepts of "normal exploitation" and "legitimate interest."²²¹ The absence of "judicially manageable standards"²²² may be one reason that panels are reluctant to rely on the former or to give meaning to the latter.²²³ To the extent that other materials supply context

Understanding on Dispute Settlement: Some Reflections on the Current Debate, 14 AM. U. INT'L L. REV. 1223, 1230–32 (1999) (listing a range of proposals to augment assistance to developing countries, funded by WTO budget surpluses).

218. See *supra* note 203 (illustrating the limitations on the scope of WIPO's authority).

219. As noted in the Introduction, there are structural reasons to believe that WIPO is representative of its members. See *supra* text accompanying notes 32–38; see also *Memorandum of the Director-General*, *supra* note 202, ¶ 13 (describing informal consultations with WIPO regional groups used to develop the recommendation).

220. See, e.g., Nicholas Bagley & Richard L. Revesz, *Centralized Oversight of the Regulatory State*, 106 COLUM. L. REV. 1260, 1263–64, 1267 (2006); Harold H. Bruff & Ernest Gellhorn, *Congressional Control of Administrative Regulation: A Study of Legislative Vetoes*, 90 HARV. L. REV. 1369, 1373, 1375–76 (1977); Cass R. Sunstein, *Constitutionalism After the New Deal*, 101 HARV. L. REV. 421, 454–80 (1987).

221. See TRIPS, *supra* note 1, arts. 7–8 (objectives and principles); see, e.g., *id.* art. 13 (using the terms "normal exploitation" and "legitimate interest" but not defining them).

222. See, e.g., *Baker v. Carr*, 369 U.S. 186, 223 (1962).

223. See *supra* text accompanying notes 99, 141.

and content, adjudicators may become quite receptive to their use. And such use tends only to legitimize politically the decisions of the adjudicators, a concern that is manifested in many ways by the reports that have been handed down to date.

IV. CONCLUSION

Much ink has been spilled on how to interpret WTO agreements.²²⁴ However, as we and others have noted, TRIPS presents many special problems. Trade law is largely negative in nature (it sets limits on what countries can do). It is highly technical in effect and aims at producing a result—lowering trade barriers—that is regarded as an unmitigated benefit from a global perspective. In contrast, TRIPS imposes positive rights (it requires states to enact new law). Because these rights touch on critical spheres, such as health, safety, culture, and political life, the thrust of TRIPS—maximizing protection—is not always the optimal result. Indeed, the optimal result is difficult to determine: as nations become more developed, their intellectual property needs change; cultural shifts produce different attitudes toward exclusive rights, and the innovations that intellectual property law encourages alter the terms on which innovation occurs. To make matters even worse, TRIPS does not include robust protection for national interests. The “general exceptions” clause that safeguards the impact of other parts of the WTO agreements on the welfare of member states does not appear to apply to TRIPS, and multiple panel decisions have eroded the value of the flexibilities that TRIPS expressly mentions.²²⁵

WIPO (and, by extension, the work of other international organizations) holds considerable potential for helping the WTO mitigate these concerns. WIPO has long experience in

224. See, e.g., PAUWELYN, *supra* note 44 (exploring the interpretation of WTO law with considerations of other rules of international law); Christopher Arup, *The State of Play of Dispute Settlement “Law” at the World Trade Organization*, 37 J. WORLD TRADE 897 (2003) (discussing interpretative approaches of the WTO in dispute settlements); Michael Lennard, *Navigating by the Stars: Interpreting the WTO Agreements*, 5 J. INT’L ECON. L. 17 (2002) (exploring the WTO Panel and Appellate Body’s approaches to treaty interpretation under Article 31 of the Vienna Convention); Richard H. Steinberg, *Judicial Lawmaking at the WTO: Discursive, Constitutional, and Political Constraints*, 98 AM. J. INT’L L. 247 (2004) (noting the varying degrees of deference that may be given in the interpretation of WTO agreements); Joel P. Trachtman, *The Constitutions of the WTO*, 17 EUR. J. INT’L L. 623 (2006) (exploring the “constitutional functions” of the WTO).

225. GATT, *supra* note 45, art. XX (general exceptions clause); see Dinwoodie & Dreyfuss, *Dynamics*, *supra* note 21, at 101–03 (noting the TRIPS exceptions are narrowly circumscribed); Henning Grosse Ruse-Khan, *supra* note 39, at 45–46 (comparing interpretations of TRIPS Article 8 and GATT Article XX); see also PAUWELYN, *supra* note 44, at 159–61.

intellectual property matters and in accommodating the various interests of the creative community and those who consume its products. By relying on WIPO's instruments and expertise, the WTO could incorporate intellectual property values into its lawmaking process. We are aware that some readers will find it odd that we recommend relying on WIPO as a source for a more balanced approach to intellectual property protection; some will think it easier to amend TRIPS (for example by adding user rights²²⁶) than to put faith in an organization whose primary goal is not to balance interests, but rather to promote intellectual property protection.²²⁷ While we share these concerns, we believe that WIPO brings to the table an intellectual property sensibility that the WTO currently lacks. WIPO's Development Agenda also suggests that its approach to intellectual property rights is changing in a manner conducive to a more sophisticated analysis of the role intellectual property plays in the economy. Besides, with so many organizations working on issues that relate to intellectual property, the time has come to conceptualize their interaction. There is no better place to begin than with the relationship between WIPO and the WTO.

226. See P. BERNT HUGENHOLTZ & RUTH L. OKEDIJI, OPEN SOC'Y INST., CONCEIVING AN INTERNATIONAL INSTRUMENT ON LIMITATIONS AND EXCEPTIONS TO COPYRIGHT 11–25 (2008), available at http://www.ivir.nl/publications/hughholtz/limitations_exceptions_copyright.pdf; Graeme B. Dinwoodie, *The International Intellectual Property Law System: New Actors, New Institutions, New Sources*, 98 AM. SOC'Y INT'L L. PROC. 213, 219 (2004); Rochelle Cooper Dreyfuss, *TRIPS-Round II: Should Users Strike Back?*, 71 U. CHI. L. REV. 21, 30, 32–33 (2004); Annette Kur & Henning Grosse Ruse-Khan, *Enough Is Enough—The Notion of Binding Ceilings in International Intellectual Property Protection* 41–44, 64–67 (Max Planck Inst. for Intellectual Prop., Competition & Tax Law, Research Paper Series No. 09-01, 2008), available at <http://ssrn.com/abstract=1326429> (proposing an amendment to the TRIPS Agreement that replaces the “three-step test” with a provision that better identifies and weighs the relevant factors).

227. Ruth Okediji, in particular, has made a strong case for giving a hierarchically superior role to the WTO, based on the theory that it is too late for WIPO to “successfully divest itself of its own institutional culture” as a promoter of strong intellectual property rights. Okediji, *supra* note 47, at 9–10.