Contents

Acknowledgments  page xv
List of Abbreviations  xvii
Table of Cases  xxviii

Introduction  1

1 Civil Law History—Germany and Europe  6
   Introduction  6
   1 Substantive Trademark and Unfair Competition Law  9
      I Structure: State Regulation and Formal Privileges  9
         A The Criminal Law Beginnings  10
         B From State Regulation to Individual Rights Protection  14
         C The Positivist Concept of Privilege Grants  17
      II Substance: Personality Rights and Private Property  21
         A Josef Kohler’s Personality Rights Theory  21
         B The Statutory Introduction of Private Rights Protection  24
      III Consequences: The Field’s Dichotomies  27
         A The Trademark/Unfair Competition Dichotomy  27
         B The Privilege/Personality Right Dichotomy  32
   IV The Twentieth Century: A Triumph of Separatism  39
      A Reichsgericht Sansibar and Pecose: A Shaky Hierarchy of Policies  40
      B Eugen Ulmer: An Almost Reconciliation  42
      C Europe: Rights Formalism and Individualization  46
      D The Final Blow: Propertization vs. Socialization  50

2 Trademark and Unfair Competition Choice of Law  53
   I From Universality to Territoriality  53
      A The Worldwide Scope of Personality Rights  53
      B Alfred Hagens and the Territoriality of Trademarks  57
      C Under the Surface: Fairness-Standard Universality  60
   II From International Torts to International Economic Law?  64
      A From Lex Locis Commissi to Nussbaum’s Rule  64
      B A Silver Lining: The Kindersaugflaschen Doctrine  68
      C Twenty-First Century: A Merger of Conflict Rules?  71

Conclusions  74
2 Common Law History—United States 76

Introduction 76

1 substantive trademark and unfair competition law 77

i the early straightjacket: equity, passing off, and universality 78

a trademark protection in the distorting mirror of law and equity 79

b passing off: “the whole law and the prophets on the subject” 84

c kidd/derringer: trademark universality “us style” 90

ii the right/markets connex: materialization, goodwill, and trade diversion 94

a the materialization of trademark rights 95

b the reverse picture: trade-diversion prevention 99

c tea rose/rectanus: the doctrine of market-based rights 102

iii the realist attack: much ado about . . . quite little 110

a the turn-of-the-century crisis 110

b courts’ adherence to “transcendental nonsense” 112

c frank i. schechter: the victory of goodwill 117

iv modern theory and practice: economic analysis and repropertization 121

a the 1946 lanham act: monopoly phobia well cured 121

b the economization of us trademark law 123

c modern propertization and repropertization 126

2 interstate trademark and unfair competition law 127

i the “market universality” of trademark rights 128

a a. bourjois & co. v. katzel: the one-way street of trademark extension 128

b tea rose/rectanus: the doctrine of nonterritorial rights 129

b holmes concurring: a “passive figurehead” of state sovereignty 132

ii the federal common law of trademarks and the erie doctrine 134

a the traditional hodgepodge of state and federal common law 135

b the erie impact: the “passive figurehead” of state sovereignty reloaded 138

iii the 1946 lanham act: an innovation of almost territorial rights 141

a the common law foundation of federal statutory rights 141

b scholarly distortions: a mirage of “territorial extraterritoriality” 147

iv summary: nonformalism and the nonterritoriality of trademarks 149

3 international trademark and unfair competition law 151

i the porosity of national borders and international goodwill theory 152

a the well-known marks doctrine: transnational goodwill misappropriation 152

b rudolf callmann: a theory of international unitary goodwill 156

ii trademarks’ extraterritorial scope: steele v. bulova watch co. and its progeny 159

a the epicenter of extraterritoriality: steele v. bulova watch co. 159

b the steele progeny: a motley crew of circuit court tests 161

iii doctrinal analysis: use-based rights and commercial effects 164

a the common law roots of lanham act subject-matter jurisdiction 164

b an element of modernity: the effects-on-commerce factor 170
### Contents

<table>
<thead>
<tr>
<th>Section</th>
<th>Page</th>
</tr>
</thead>
<tbody>
<tr>
<td>IV A Bird’s-Eye View: Taking Stock of Lanham Act Extraterritoriality</td>
<td>171</td>
</tr>
<tr>
<td>A The Antitrust Gene: A Dominance of Effects</td>
<td>172</td>
</tr>
<tr>
<td>B Common Law Goodwill Protection: <em>Tea Rose/Rectanus</em> Goes Global</td>
<td>177</td>
</tr>
<tr>
<td>V Summary: An Era of International Trademark Propertization</td>
<td>185</td>
</tr>
<tr>
<td>Conclusions</td>
<td>186</td>
</tr>
<tr>
<td>3 A Ragged Landscape of Theories</td>
<td>190</td>
</tr>
<tr>
<td>Introduction</td>
<td>190</td>
</tr>
<tr>
<td>1 Traditional Civil Law Trademark Conflicts</td>
<td>193</td>
</tr>
<tr>
<td>I The Principle of Territoriality</td>
<td>193</td>
</tr>
<tr>
<td>II Analysis: The Curse of Formal Reasoning and Conduct Orientation</td>
<td>200</td>
</tr>
<tr>
<td>2 Modern Civil Law Unfair Competition Conflicts</td>
<td>203</td>
</tr>
<tr>
<td>I The Marketplace Principle, Determination of Effects, and the <em>De Minimis</em> Rule</td>
<td>203</td>
</tr>
<tr>
<td>A Collision-of-Interests and Substantive-Purpose Analysis</td>
<td>203</td>
</tr>
<tr>
<td>B Multistate Scenarios: Determination of Marketplace Effects and <em>De Minimis</em> Limitations</td>
<td>209</td>
</tr>
<tr>
<td>II Analysis: The Obsolescence of Tort Foundations</td>
<td>214</td>
</tr>
<tr>
<td>3 The New Paradigm—A Law of Market Regulation</td>
<td>220</td>
</tr>
<tr>
<td>I Antitrust Conflicts Reloaded: The Effects Principle</td>
<td>220</td>
</tr>
<tr>
<td>II Analysis: The Unboundedness of Unqualified Effects</td>
<td>223</td>
</tr>
<tr>
<td>4 Modern Soft Law—WIPO Recommendation, ALI Principles, and Others</td>
<td>225</td>
</tr>
<tr>
<td>I Nonbinding Suggestions of Substantive Law and Conflicts Resolution</td>
<td>226</td>
</tr>
<tr>
<td>A The Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet</td>
<td>226</td>
</tr>
<tr>
<td>B ALI Principles, CLIP Principles, and the Japanese Transparency Proposal</td>
<td>228</td>
</tr>
<tr>
<td>II Analysis: “Chips off the Old Block”</td>
<td>232</td>
</tr>
<tr>
<td>A The Joint Recommendation</td>
<td>233</td>
</tr>
<tr>
<td>B ALI Principles, CLIP Principles, and the Japanese Transparency Proposal</td>
<td>234</td>
</tr>
<tr>
<td>5 The American Scholarly Debate</td>
<td>236</td>
</tr>
<tr>
<td>I Common Law Tradition and Transnational Market Protection</td>
<td>237</td>
</tr>
<tr>
<td>A The General Tendency of Equitable Rights Limitlessness</td>
<td>238</td>
</tr>
<tr>
<td>B The <em>Nintendo</em> Transformation: From Act-of-State-Doctrine to Substantive Dichotomy</td>
<td>241</td>
</tr>
<tr>
<td>C The Revival of Territoriality: A Quasi Continental Choice-of-Law Approach</td>
<td>244</td>
</tr>
<tr>
<td>D The “Domestic Extraterritoriality” of Statutory Trademark Rights</td>
<td>246</td>
</tr>
<tr>
<td>E <em>Tea Rose/Rectanus</em> “Transnationalized”: The Common Law Cross-Border Crusade</td>
<td>247</td>
</tr>
<tr>
<td>F The Shift to Effects Testing: An Idea of Transnational Market Regulation</td>
<td>249</td>
</tr>
<tr>
<td>II Analysis: Common Law Tradition Meets Extraterritorial Market Regulation</td>
<td>251</td>
</tr>
</tbody>
</table>
6 Substantivism and Transnational Uniform Law 256
   I Overview 256
      A Foundations 256
      B Modern Concepts of Substantivism in Intellectual Property Law 258
      C Nonterritorial Concepts: “Cyberlaw” and the “Collision of Rights” 262
   II Analysis: The Fata Morgana of Universal Policy 265
7 The Rediscovery of International Comity 268
   I The Comitas Approach 268
   II Analysis: A “Quadrature of the Circle” 269
Conclusions 270

4 Substantive Policy—Convergent Foundations 273
Introduction 273
1 Foundations—The Market Mechanism 275
   I The Concept of “Economic Competition” 275
      A The Legal Framework 275
      B The Rediscovery of Chaos 276
      C The Dynamics of Competition 280
         1 A Tradition of Competitor Protection 280
         2 The Advent of (Consumer) Decision Making 281
         3 The Complementary Spheres of Transactional Freedom 283
   II The “Triangular” Structure of the Market Mechanism 285
   III The Stages of Consumer Decision Making and Transacting 287
      A Information Transmission 288
      B Information Processing 290
      C Implementation of the Consumer’s Decision 291
      D Caveat: Limitations of Consumer Decision Making 293
   IV Summary 294
2 Implementation—Substantive Law 295
   I Tort and Unfair Competition Law 295
      A The Mirage of Practical and Formal Differences 296
      B The Relativity of Protection Levels 300
         1 Early Starting Point: Claims “against the World at Large” 300
         2 United States: From Property to Policy and Back Again 301
         3 Germany: The Eternal Dichotomy of Rights and Competition 305
      C The Heterogeneity of Policies: Vertical and Horizontal Competition 309
         1 Two Types of Unfair Competition Cases and Regulatory Policies 310
         2 Clarification: The Horizontality of Neminem Laedere 313
      D Summary 314
   II Antitrust and Unfair Competition Law 315
   III The Intellectual Property Dichotomy: Innovation vs. Competition 317
      A The Mistaken Concept of Intellectual Property Uniformity 318
         1 Historical Remnants: The “Immaterialization” of Trademarks 318
         2 Current Doctrine: Intellectual Property Homogeneity 319
5 International Comity—A Doctrine of Self-Restraint 381

Introduction 381

1 From Comitas Gentium to Transnational Law 383

I The Status Quo: A Publicization of Private International Law 384

A The (Non)Historical Dichotomy: Private and Public International Law 385

B The Duality of Methods 388

C A Blurring of Boundaries 391

II In the Shadows: The Creeping Deformation of Comity 395

A Transnationalization: A Resurrection of the Ius Cosmopoliticum 396

B The Historical Leitmotif: Convenience of International Transacting 398

1 Joseph Story: The Consensual Administration of Conflicts 400

2 Friedrich Carl von Savigny: A Legal Community In Statu Nascendi 402

3 Ernst Zitelmann: The Welrecht of Uniform Policy 406

4 Summary 407

C The Modernity of Transnational Law: An Apotheosis of Substantive Uniformity 408

1 Philip C. Jessup: The Hybridity and Universality of Transnational Law 409

2 Twentieth Century: Conflicts Doctrine Internationalized 410

(a) Maritime Internationalism: The Lauritzen Doctrine 411

(b) Savigny Diluted: A Theory of Separate Attachment 413

(c) Public International Law Osmosis: The Ordre Public International 415

3 Turn of the Century: The Unearthly Detachment of Transnationalization 417

(a) The Odyssey of Interest Analysis: Currie’s Game-Theoretical Return to Savigny 418

(b) Law and Economics: The Super-Value of Welfare Maximization 421

(c) Global Legal Pluralism: Fragmentation, Functionality, and Universality 425

III Summary 431

2 Transnationalization Exhausted 432

I International Antitrust: A History of Effects, Public International Law, and Comity 433

A Lotus Isolationism: A Lacuna of Nation-State Sovereignty 434

B General Principles: The Droit Idéal of Public International Law 435

C The Practical Proxy: Interest Balancing 437

1 Theoretical Approaches 438

2 The Practice: Timberlane and Mannington Mills 440

3 The Rule of Reason 442

D The Effects Principle: From Unboundedness to Self-Restraint 445

1 Europe: A Theory of Public International Law Limitations 446

2 Alcoa to Hartford Fire: From Unlimited to Substantial Effects 448

3 Empagran: The About-Face toward Comity 453

4 The Empagran Critique: Capitulation, Isolationism, and Imperialism 456
Contents

5 The Comity of Self-Defense: Ostracizing the Private Attorney General 457
E Summary 463

II The Zenith of Transnationalization: A Story of Alien Tort Statute Contraction 464
A The “Legal Lohengrin”: From Comity to Settled International Law 464
B The Sosa Transnationalization: Hybridity, Universality, and Specificity 466
C Pandora’s Box: Politics and Economics 469
D Kiobel v. Royal Dutch Petroleum Co.: The Swan Song of Transnationalization? 474

III Summary 478

3 The Shadowy Existence of Trademark and Unfair Competition Conflicts 480
I The Mirage of Extraterritorial Enforcement Efficiency 481
II The Reality of International Trademark Rights Protection 483
A International Intellectual Property Rights Segmentation 484
B The International Vacuum of Nation-State Capacities 486
C Trademark Extraterritoriality: Individual Propertization and Overall Taxation 487

III Summary 488

Conclusions 489

6 Reconceptualization, Reinterpretation, and Typology 491

Introduction 491

1 The New Conflicts Resolution Structure 492
I Trademark/Unfair Competition Uniformity: Core Policies 493
II Quality of Effects: A Rule of Alternatives 494
III Quantity of Effects: Jurisdictional Self-Restraint 497
A A Word in Advance: Practical Relativity 498
B Objective Foreseeability 501
  1 Party Expectations and the International Private Law Order 501
  2 Technique and Factors of Market Analysis 504
  3 Clarification: Defendant’s Intent and Actual Effects 505
C International Comity 507
  1 Current De Minimis Standards 508
     (a) The Paradigm of “Shields” and “Swords” 508
     (b) Analysis: An Ad Hoc Rule of “International-Individual Equity” 510
  2 Reconceptualization 512
     (a) Structural Underpinning and Relevant Interests 513
     (b) Practical Rules and Presumptions 515
        (i) Starting Point: Fact-Based Crafting of Remedies 515
        (ii) Prima Facie “Effects Sufficiency”: Defendant’s Intent 517
        (iii) Caveat: “Effects Unavoidability” 518

IV Summary 520

2 The Reinterpretation of Steele and Rome II 521
I US Lanham Act Subject-Matter Jurisdiction 521
# Contents

A Modification: A Qualitative Reformulation of “Effects on US Commerce”  

522

B Reinterpretation: Dusting Off “Nationality” and “Conflicts with Foreign Law”  

525

1 Nationality, Citizenship, and What Else—or Nothing at All?  

525

2 Conflicts with Foreign Law: Another Shell of Formalities  

528

3 A New Paradigm  

529

(a) The Neutralization of Nationality and Citizenship  

529

(b) The Deformalization and Depropertization of “Conflicts with Foreign Law”  

531

II European Trademark and Unfair Competition Choice of Law  

533

A Clarification: Characterization of Trademark and Unfair Competition Conflicts  

533

B Foundation: Marketplace Effects Rule and the *Lex Loci Protectionis*  

538

C Application: Marketplace Effects and the *Gran Canaria* Conundrum  

539

1 Recapitulation: The *Gran Canaria* Scenario  

539

2 Problem: Economic Concepts and Legal Terminology  

541

3 Analysis: The Chronology of Consumer Decision Making  

542


545

5 Conclusion  

548

3 The Typology of Trademark and Unfair Competition Conflicts  

548

I Consumer Decision Making: Protecting the Market Information Infrastructure  

549

A The Common Core of Trademark and Unfair Competition Policies  

549

1 Advertising Communication: A General “Rule of Alternatives”  

549

2 No Exceptions: Trademarks, Trade Names, Geographical Indications, and Designations of Origin  

551

B Implementation of Decision-Making Results: Transacting  

553

1 The Core Policy  

553

2 Policies Beyond  

555

II Theories of Misappropriation and Other Impact on Competition  

556

A Modern Extensions of Trademark-Infringement Theory  

556

B Product Imitation  

560

C The Antitrust Concurrence  

563

D Breach of Statutory Duties as Unfair Competition  

565

III Competitor-Related and Bilateral Commercial Torts  

566

*Appendix A*  

572

*Appendix B*  

576

*Bibliography*  

583

*Index*  

637