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TOWARD RECONCILIATION IN THE MIDDLE EAST: A FRAMEWORK FOR CHRISTIAN-MUSLIM DIALOGUE USING NATURAL LAW TRADITION

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I. Introduction

Islam is the fastest growing religion in the world with approximately 1.2 billion adherents.[1] If current growth trends continue, by 2025 Muslims will constitute 30% of the world's population.[2] The history of competition, animosity, and violence that began with the early expansion of Islam was exacerbated by the Crusades and is still evident in geopolitical conflict today.[3] If Christians and Muslims are not able to enter into meaningful dialogue, providing a framework for peaceful coexistence, the world will likely continue in a tragic spiral of violence and decline.[4] While most modern legal theory lies within the realist tradition,[5] both Western and Islamic jurisprudence contain core natural law assumptions.[6] By identifying specific realms of commonality, I hope to provide a common language and the opportunity for more meaningful interaction between Muslims and Christians that will promote reconciliation.

I argue that the thinking of Bernard Lonergan, in light of the natural law insights of St. Thomas Aquinas, Ali Ezzati, and Abdullahi Ahmed An-Na'im, provides a framework for Christian-Muslim dialogue. Lonergan's transcendental method moves from the individual subject to universal insights rather than presuming to deduce universals *a priori*, without regard for history, culture, and individual experience.[7] I assert that the most fruitful starting place for meaning-

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1 The New York Times Almanac 497 (World Almanac Books 2001).

2 The Canadian Society of Muslims - Muslim Population Statistics, *at* http://muslim-canada.org/muslimstats.html (last visited Sept. 02, 2004).

3 REINHARD SCHULZE, A MODERN HISTORY OF THE ISLAMIC WORLD xi-xv (N.Y. Univ. Press 2002).

4 *See* BERNARD LEWIS, WHAT WENT WRONG? WESTERN IMPACT AND MIDDLE EASTERN RESPONSE 156-60 (Oxford Univ. Press 2002).

5 *See* ROBERT L. HAYMAN ET AL., JURISPRUDENCE: CLASSICAL AND CONTEMPORARY: FROM NATURAL LAW TO POSTMODERNISM 156-62 (2d ed. West 2002). Legal problem-solving is situated in the actual experience of the problem-solver; the scheme embraces the full realm of practical and theoretical knowledge; the processes are ultimately pragmatic; and the correctness of the result is to be measured by (what the formalist at least would consider) an "external analysis," i.e., by asking whether our claims cohere with experience. *Id.* at 157.

6 ALI EZZATI, ISLAM AND NATURAL LAW 39-42, 60-61 (ICAS Press 2002).

7 *See generally* BERNARD J.F. LONERGAN, INSIGHT (Harper and Row 1978) [hereinafter LONERGAN, INSIGHT]. Lonergan provides a framework for the process of analyzing and knowing by turning to the human subject. Human persons grow by experiencing (being aware), understanding, judging and acting.

ful dialogue is to address questions of human rights and social justice using natural law theory, rather than focusing on theological concerns or distinctions.

My proposal to use natural law tradition as a framework for Christian-Muslim dialogue is made within the broader context of natural law jurisprudence, particularly in the Anglo-American context. While my view fits within the Thomistic tradition,[8] I accept certain postmodern intuitions including fragmentation,[9] the importance of critical historical and social context,[10] and the limits of language in particular.[11] Thus, my theoretical approach tends to be more like that of Bernard Lonergan[12] or Steven D. Smith[13] than that of John Finnis.[14] My concern for rights and procedure makes me sympathetic to the works of Ronald Dworkin[15] and Lon Fuller,[16] respectively, particularly with regard to praxis.

This paper addresses the human challenges to Christian-Muslim dialogue rather than providing an exhaustive analytical guide. I begin by providing a theoretical framework for inter-religious dialogue. I then describe bias as an impediment to inter-religious dialogue. With that framework in mind, I describe some of the challenges and contributions to successful dialogue in the Christian tradition. As a Christian, I cannot claim to speak from a Muslim perspective, but I do attempt to explain how the proposed method might be applied within Islamic

This four-fold process enables the appropriation of truth. According to Lonergan, it is a description of the inherent human pattern of thinking and learning and the key to self-transcendence.

[8] The last quarter of the twentieth century saw a reemergence of interest in natural law among philosophers and legal theorists, who have resurrected natural law principles regarding issues of public law and morality. Modern capital punishment debates address ideas of innate human dignity and the relation of individuals to the state. The Supreme Court's recent assisted suicide cases can be understood in part as discourses in moral philosophy. Natural law also provides the base for much of the environmental movement in the twentieth and twenty-first centuries and also for almost all international human rights initiatives. At the heart of civil disobedience discussions is a search for fundamental community values. *See* HAYMAN, LEVIT & DELGADO, *supra* note 5, at 9-10. For a primary example of contemporary natural law theory, *see also* JOHN FINNIS, NATURAL LAW AND NATURAL RIGHTS 18 (Clarendon Press 1996). A theory of natural law claims to be able to identify conditions and principles of practical right-mindedness, of good and proper order among men and in individual conduct. Unless some such claim is justifies, analytical jurisprudence in particular and (at least the major part of all the social sciences in general can have no critically justifies criteria for the formation of general concepts, and must be content to be no more than manifestations of the various concepts peculiar to particular peoples and/or to the particular theorists who concern themselves with those people. *Id.*

[9] *See* Allan C. Hutchinson, *Identity Crisis: The Politics of Interpretation*, 26 NEW ENG. L. REV. 1173, 1173 (1992).

[10] Joan C. Williams, *Culture and Certainty: Legal History and the Reconstructive Project*, 76 VA. L. REV. 713, 743-46 (1990).

[11] Margaret J. Radin, *Reconsidering the Rule of Law*, 69 B. U. L. Rev. 781, 793-97 (1989).

[12] *See generally* LONERGAN, INSIGHT, *supra* note 7; *see generally* BERNARD J.F. LONERGAN, METHOD IN THEOLOGY (Univ. of Toronto Press 1996) [hereinafter LONERGAN, METHOD IN THEOLOGY].

[13] *See generally* Steven D. Smith, *The Pursuit of Pragmatism*, 100 Yale L.J. 409 (1990) (proposing a synthesis of postmodern pragmatism and natural law tradition).

[14] *See generally* FINNIS, *supra* note 8 (proposing a reevaluation of natural law principles in the modern tradition).

[15] *See generally* RONALD DWORKIN, LAW'S EMPIRE (Belknap Press 1986) (approaching natural law within the context of the common law tradition, incorporating narrative and other postmodern approaches).

[16] *See generally* LON FULLER, THE MORALITY OF LAW (Yale Univ. Press 1977) (proposing a core principle of natural law within legal procedures if not within substantive law).

thought utilizing the context of natural law reasoning. I conclude with observations applicable to both Christians and Muslims open to dialogue.

II. The Theoretical Framework for Inter-religious Dialogue

Although Islam has encountered and competed with Christianity since the 7th Century CE,[17] there have been relatively few successful attempts at engaging in meaningful inter-religious dialogue.[18] Western hegemony,[19] fear of terrorism,[20] and the threat of war[21] make it imperative that intercommunal relations begin to transcend superficial apologetic and polemical exchanges. Of the attempts to promote such dialogue, only a few have succeeded.[22]

The best known and perhaps most significant experiment in Christian-Muslim dialogue is the International Islamic Christian Congress in Cordoba which is documented in *Encuentro*.[23] Despite the successes of this experiment, it is not a model that can be easily reproduced, principally because the pluralism accepted by Muslim intellectuals who participated in this dialogue is typically rejected by Muslim clerics and jurists.[24] Although there may be a place for such theological exchanges, I believe that without a stronger foundation of trust, understanding, and cooperation, it will be impossible for dialogue to become relevant in the larger realm of Christian-Muslim interaction.

As an alternative to theological discourse, I propose that dialogue begin with questions of social justice and human rights. In the sphere of human rights it is generally accepted that many (though certainly not all) of the principles in the Universal Declaration of Human Rights[25] are normative and transcend culture.[26] Hans Kung's *A Global Ethic* further demonstrates that there are some moral insights that appear to be universal.[27] If agreement leads to deeper understanding and solidarity, more effective cooperative action and the actualization of common justice goals become more likely.[28] Then, perhaps a basis for cross-cultural relationships can be established that may move to a deeper place of interpersonal

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17 *See* LEWIS, *supra* note 4, at 3-17, 163-65.

18 *See generally* WILLIAM MONTGOMERY WATT, MUSLIM-CHRISTIAN ENCOUNTERS 125-29 (Routledge 1991).

19 SCHULZE, *supra* note 3, at 4-6.

20 *See* LEWIS, *supra* note 4, at 163.

21 *Id.* at 159-60.

22 WATT, *supra* note 18, at 125-29.

23 MOHAMMED ARKOUN, DIALOGO ISLAMO-CRISTIANO Y NUEVO PENSAMIENTO RELIGIOSO, LEAFLET 31-36 IN FE ADELANTE LOS PROBLEMAS DE FONDO DEL DIALOGO ISLAMO-CRISTIANO: PROCEEDINGS OF THE PRIMER CONGRESO INTERNACIONAL A DISTANCIA ORGANIZADO POR CRISLAM (Darek-Nyumba, Madrid, Spain 1988).

24 WATT, *supra* note 18, at 119-22. *See also* ATAULLAH SIDDIQUI, CHRISTIAN-MUSLIM DIALOGUE IN THE TWENTIETH CENTURY 60-69 (St. Martin's Press 1997).

25 MARY ANN GLENDON, A WORLD MADE NEW 235 (Random House 2001).

26 *Id.* at 221-33.

27 *See generally* HANS KUNG, A GLOBAL ETHIC (Continuum Int'l Publ'g Group 1994).

28 *See* JOHN RAWLS, A THEORY OF JUSTICE 340 (Belknap Press 1999) (1971) (discussing the overlapping consensus).

exchange, and at that point the differences will seem less relevant. If Christians and Muslims can engage in the four operations of Lonergan's transcendental method - be attentive (awareness), be intelligent (thinking), be reasonable (judging) and be responsible (acting together)[29] - it is possible that the collective experience of gaining insight could become a foundation for real solidarity even if there is never agreement on articles of faith.

In my own experience, there is such distrust and resentment between Christians and Muslims that the mere mention of theological issues can put people on the defensive. For example, inquiring as to the nature of Mohammad's prophethood or the resurrection of Jesus forces people to retreat into their texts with no hope of reaching new understandings.[30] To contrast, I have found Muslim scholars quite open to discussing questions of practical jurisprudence that are not specifically proscribed by theology (here the Quran, the traditions of the Prophet and *Shari'ah*[31]). Many scholars are willing to use a wide range of analytical tools, including those generally identified with the West, to find pragmatic and efficient solutions to problems of practical justice.[32]

While teaching American law to Muslim graduate students in Amman, Jordan, I was able to foster lively debate on issues ranging from freedom of expression to capital punishment. Students would argue from utilitarian, feminist, and socialist perspectives (just to name a few). I had students of *Shari'ah* who would never knowingly deviate from a Quranic understanding of theological concerns, but in the realm of practical justice they did not feel the need to directly apply sacred texts or principles (other than reason).

Since the basic teachings of justice and the dignity of human beings in both Christianity and Islam share some common roots,[33] justice is a realm where there is a real possibility for significant agreement. If members of both faith traditions agree on social justice issues (regarding torture, freedom of conscience, hunger, etc.), it is reasonable and possible to act upon those insights together. This could become a basis for relationships that leads to more meaningful sharing, and it is where I see the greatest hope for dialogue.[34]

A. A Method for Intercommunal Dialogue

The notion of overlapping intellectual horizons and awareness is described in Lonergan's *Insight,*[35] and the similar notion of overlapping consensus is found in

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29 BERNARD J.F. LONERGAN, THE LONERGAN READER 22, 450-51 (Mark and Elizabeth Morelli eds., Univ. of Toronto Press 1997) [hereinafter LONERGAN, LONERGAN READER].

30 LONERGAN, METHOD IN THEOLOGY, *supra* note 12, at 155-62.

31 *Shari'ah* is the comprehensive system of Islamic law.

32 WATT, supra note 18, at 136-37; EZZATI, *supra* note 6, at 11-59; ABDULLAHI AHMED AN-NA'IM, TOWARD AN ISLAMIC REFORMATION: CIVIL LIBERTIES, HUMAN RIGHTS, AND INTERNATIONAL LAW 60-68 (Syracuse Univ. Press 1990).

33 EZZATI, *supra* note 6, at 193-206.

34 RAIMON PANIKKAR, THE INTRA-RELIGIOUS DIALOGUE 82-83, 98-101 (Paulist Press 1999).

35 LONERGAN, METHOD IN THEOLOGY, *supra* note 12, at 235-39.

Rawls' *A Theory of Justice*.[36] For Lonergan, horizons are the boundary of an individual's experience; they are "the structured resultant of past achievement and, as well, both the condition and the limitation of further development."[37] Individual horizons may be complementary, as is more likely the case for people from the same culture and background; they may be genetic, that is, they may be related as "successive stages in some process of development;" or they may be opposed dialectically, so that what is intelligible for one is unintelligible to another.[38] One of the goals of Rawls' theory is to reach consensus about questions of justice through some commonality in horizon.[39] This consensus is not strict in the sense that it does not require complete agreement. Instead, both sides "must believe that however much their conceptions of justice differ, their views support the same judgment in the situation at hand, and would do so even should their respective positions be interchanged."[40]

It is crucial that Christians and Muslims develop overlapping horizons[41] if they ever hope to understand each other. Understanding can lead to solidarity in a world characterized by poverty, exploitation, and hopelessness.[42] Both Christian and Muslim religious beliefs require believers to make ethical judgments about assaults on human dignity.[43] Living according to these ethics (*praxis*) is critical for the continued existence and flourishing of the human person.[44] Lonergan would assert that there is a pattern of awareness, understanding, making judgments, and acting that reflects the operations of human cognition.[45] This framework may provide a method for inter-religious dialogue.

B. Realms of Meaning and Transcendental Method

The fundamental purpose of dialogue is to communicate meaning. According to Lonergan, there are four realms of meaning that are involved in "self-appropriation"[46] and dialogue: common sense, theory, interiority, and transcendence.[47]

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36 RAWLS, *supra* note 28, at 340.

37 LONERGAN, METHOD IN THEOLOGY, *supra* note 12, at 236-37.

38 *Id.* at 236.

39 RAWLS, *supra* note 28, at 16.

40 *Id.* at 340.

41 "Horizons" here is used in a Lonerganian sense and refers to the limits of individual or group understanding and experience.

42 JOHN HAUGHEY, HOUSING HEAVEN'S FIRE: THE CHALLENGE OF HOLINESS 159 (Loyola Univ. Press 2002) [hereinafter HAUGHEY, HOUSING HEAVEN'S FIRE].

43 SIDDIQUI, *supra* note 24, at xv.

44 LONERGAN, LONERGAN READER, *supra* note 29, at 577-79.

45 *Id.* at 381-86.

46 *Id.* at 18-19. Self-appropriation for Lonergan is "first and foremost a process of taking possession of oneself as a knower and a doer. Our knowing and deciding are of the greatest strategic importance in the effort to uncover a transcultural foundation. . .Self-appropriation is radically different from the Cartesian strategy of cutting oneself off from external objects in order to find oneself in the internal remainder. Self-appropriation is not disengagement from the world of objects but development of an understanding of oneself in the widest possible range of cognitive and moral engagements. The criteria immanent in interior operations cannot be discovered unless the interior operations occur." *Id.* It is achieved through

Appropriate terminology within a particular realm of meaning is essential for higher levels of appropriation.[48] Abdullahi Ahmed An-Naim's *Toward an Islamic Reformation*, which I will refer to below, reflects a very sophisticated level of this kind of self-appropriation from a thoroughly Islamic perspective.

Lonergan provides a framework for the human processes of analyzing and knowing through self-appropriation and the transcendental method. Human persons grow by consciously experiencing, understanding, judging, and acting.[49] This four-fold process enables the appropriation of truth.[50] According to Lonergan, it is a description of the inherent human pattern of thinking and learning.[51] If this premise is accepted, questions relating to inter-religious dialogue must be analyzed and appropriated using these same operations. It is a dynamic process that would encourage both Christians and Muslims to be open to new insights in the context of dialogue.[52] I use this framework in my analysis of inter-religious dialogue, and, to that extent, accept Lonergan's views regarding human cognition.

Lonergan identifies a tripartite invariant structure of the good.[53] There are particular goods (the product of desires), goods of order (a coalescence and recurrence of desires), and goods of value (desires that have been evaluated and lead to action on the basis of the good out of a rational self-consciousness).[54] Human rights are a type of good of order, but they must be reflected on and appropriated in the context of goods of value in order to be a source of order.[55] The good (including human rights) is always concrete, never abstract, and must be continually evaluated.[56] Even then, there must be a critical mass of people asking these questions in order for human rights to be accepted and protected.[57] This becomes more likely if various religious traditions can enter into dialogue.

C. Bias as a Challenge to Dialogue

The greatest challenge to dialogue is bias, which for Lonergan is rooted in the failure to allow free reign in our drive to understand.[58] The drive to understand

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the transcendental precepts, and it is rooted in an epistemology that Lonergan believes provides a solution to the Hegelian objection, that any explicitly formulated ideal is going to be abstract. *Id.* at 21-23.

47 LONERGAN, METHOD IN THEOLOGY, *supra* note 12, at 81-84.

48 *Id.* at 260.

49 LONERGAN, LONERGAN READER, *supra* note 29, at 351-59, 446-54.

50 LONERGAN, METHOD IN THEOLOGY, *supra* note 12, at 4-5.

51 *Id.* at 2, 18-19.

52 LONERGAN, INSIGHT, *supra* note 7, at 320-21.

53 *Id.* at 596-98.

54 LONERGAN, LONERGAN READER, *supra* note 29, at 431.

55 John C. Haughey, S.J., *Responsibility for Human Rights: Contributions from Bernard Lonergan*, 63:4 THEOLOGICAL STUDIES 764-85 (2002) [hereinafter Haughey, *Responsibility for Human Rights*].

56 *Id.*

57 PANIKKAR, *supra* note 34, at 98-101.

58 LONERGAN, LONERGAN READER, *supra* note 29, at 20.

impels human beings to progress.[59] However, bias undercuts this process by censoring the spontaneous questions that lead to making correct judgments.[60] Bias is generated by a tension between the "higher" (intellectual operations) and "lower" (emotional and physical drives and needs) operations of the psyche.[61] This tension points to the reality of human selfishness that underlies bias. Decline stems from bias. Thus, bias is an incomplete unfolding of inquiry - a "flight from understanding."[62] The related notion of scotosis is defined as suppressing the question, which results in an intellectual lacuna.[63]

The source of bias that most hinders inter-religious dialogue is the exclusive and narrow use of sacred texts.[64] This is true in much of fundamentalist Christianity and traditionalist Islam. Another product of bias is the social 'surd' described by Lonergan.[65] "It is characterized by disillusionment due to cultural crisis, [and] its related disarray, and the conflict within the domains of philosophical and theological practice that causes a collapse in the structure of meanings.[66] The failure to replace them creates a vacuum of meaning and value."[67]

D. Bias and Historical Discount

The discounting of history is another challenge of the bias created by strictly adhering to a traditional and uncritical understanding of sacred texts, both for Christians and Muslims.[68] If all-important questions are answered completely by sacred texts, then there is little need to learn from human history. However, historical awareness is a crucial component of Lonergan's project and the transcendental method, with regard to the postmodern era.[69] Historical awareness provides a context for understanding insights and for describing horizons.[70] Looking to historical contexts justifies a kind of relativism that acknowledges that manifolds of insights are true in certain contexts, though not apparently consistent when removed from their respective contexts.[71]

Relativism and historicism are challenging notions for those who hold to presumably unchanging truths contained in sacred scripture.[72] However, relative truths may be understood in such a way that does not denigrate eternal verities.

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59 LONERGAN, INSIGHT, *supra* note 7, at xiv.

60 LONERGAN, LONERGAN READER, *supra* note 29, at 306.

61 LONERGAN, INSIGHT, *supra* note 7, at 191-203.

62 LONERGAN, LONERGAN READER, *supra* note 29, at 306.

63 *Id.* at 128-35.

64 WATT, *supra* note 18, at 119-20.

65 LONERGAN, INSIGHT, *supra* note 7, at 229-32.

66 LONERGAN, LONERGAN READER, *supra* note 29, at 15.

67 *Id.*

68 *Id.* at 509, 514-15.

69 LONERGAN, METHOD IN THEOLOGY, *supra* note 12, at 181-84.

70 LONERGAN, LONERGAN READER, *supra* note 29, at 508-17.

71 Lonergan does not specifically define "context" in his discussions of relativism; however, it is likely that he means an insight's location in time, space, history and culture. *Id.* at 439.

72 LONERGAN, METHOD IN THEOLOGY, *supra* note 12, at 232.

Although relativism implies that the meaning of any statement is relative to its context, "it does not follow that the context is unknown, or if unknown that it is undiscoverable."[73] A statement may be true within its own context, though false in another, but historical and interpretive methods allow us to understand the context.[74] Both Christianity and Islam recognize some degree of progressive revelation; therefore, there is a basis for accepting relativism to the extent that it simply acknowledges changing contexts.[75] This insight is extremely important for dialogue because it facilitates movement beyond the apparent conflicts found in different textual traditions, let alone the internal conflicts found within any single tradition.[76] This is possible even though both Christians, in the Bible, and Muslims, in the Quran, generally hold that formal revelation is closed.[77]

III. A Basis for Dialogue in Christianity

For dialogue to be successful, each party must have a motivation for entering into the process.[78] There is a clear call for inter-religious dialogue in contemporary Christianity – particularly with Muslims and Jews.[79] For both Christianity and Islam, the possibility for dialogue is challenged by internal tension between forms of exclusivism and inclusivism.[80] Many contemporary Christian theologians advocate moving from inclusivism to pluralism.[81] The inclusive view considers Jesus as the source of truth and salvation, even in cultures that are not Christian, while religious pluralism, in the Christian context, holds that truth and salvation may be found outside the Christian tradition. I comment below on the implications this has for inter-religious dialogue with Muslims.

While some cross-cultural encounters in the early history of the Christian church may be considered precursors to inter-religious dialogue,[82] the commitment to such dialogue has been made explicit within the Catholic tradition in the documents of the Second Vatican Council ("Vatican II")[83] and in the 34th Gen-

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[73] LONERGAN, LONERGAN READER, *supra* note 29, at 439.

[74] *Id.*

[75] AN-NA'IM, *supra* note 32, at 63-64, 158-59; LONERGAN, METHOD IN THEOLOGY, *supra* note 12, at 117.

[76] DAVID LOCHHEAD, THE DIALOGICAL IMPERATIVE 36 (Orbis 1988).

[77] *Id.* at 35-37.

[78] PANIKKAR, *supra* note 34, at 67-83.

[79] LOCHHEAD, *supra* note 76, at 5-11.

[80] PANIKKAR, *supra* note 34, at 5-6.

[81] *Id.* at 10-11; *See also* John Hick, *The Theological Challenge of Religious Pluralism, in* CHRISTIANITY AND OTHER RELIGIONS: SELECTED READINGS 156, 156-71 (Hick and Hebblethwaite eds., One World 2001).

[82] *See generally* WATT, *supra* note 18, at 59-88.

[83] *Declaration on the Relationship of the Church to Non-Christian Religions (Nostra Aetate)* (Austin Flannery trans., Costello Publ'g 1999) [hereinafter Nostra Aetate], *available at* http://www.bc.edu/research/cj1/,eta-elements/texts/documents/catholic/Nostra_Aetate.htm (last visited Oct. 19, 2004). This declaration was approved by Pope Paul VI and the Second Vatican Council in 1965 from Vatican Council II.

eral Congregation of the Society of Jesus.[84] Vatican II speaks both to the need for inter-religious dialogue generally and to the special relationship between Christianity and Islam as monotheistic, Abrahamic faiths.[85] Generally, it adopted a clearly inclusive approach to other faith traditions.

> The Catholic Church rejects nothing which is true and holy in [other] religions. She looks with sincere respect upon those ways of conduct and of life, those rules and teachings which, though differing in many particulars from what she holds and sets forth, nevertheless often reflect a ray of that Truth which enlightens all men. . . The Church therefore has this exhortation for her sons: prudently and lovingly, through dialogue and collaboration with the followers of other religions, and in witness of Christian faith and life, acknowledge, preserve, and promote the spiritual and moral goods found among these men, as well as the values in their society and culture.[86]

Although the Catholic Church maintains that preaching with the hope of conversion is still a component of its teaching,[87] this declaration of Vatican II makes it clear that Catholics have an obligation to engage in dialogue which searches for and encourages commonly-held truths in non-Christian religions.[88] With regard to Islam, in particular, the Council recounts many of the theological and moral convictions held in common with Christianity as exemplified in the following exhortation:

> Although in the course of the centuries many quarrels and hostilities have arisen between Christians and Moslems [sic], this most sacred Synod urges all to forget the past and to strive sincerely for mutual understanding. On behalf of all mankind, let them make common cause of safeguarding and fostering social justice, moral values, peace, and freedom.[89]

This command unequivocally calls for a new approach to intercommunal relations. This sort of dialogue, cooperation and peace is unattainable as long as Christians presume to have a monopoly on truth and work toward these goals in order to proselytize.[90]

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[84] DOCUMENTS OF THE 34TH GENERAL CONGREGATION OF THE SOCIETY OF JESUS 67-81 (Institute of Jesuit Sources 1995) [hereinafter 34TH GENERAL CONGREGATION], *available at* http://www.jesuit.org/sections/sub.asp?SECTION_ID=363&PARENT_ID=253.

[85] "There had been nothing like it in the history of the Catholic Church, clearly proclaiming that 'The Catholic Church rejects nothing that is true and holy in these religions.'" Cardinal Roger Mahoney, *In preparation for the 40th anniversary of 'Nostra Aetate,'* TIDINGS, Feb. 20, 2004, *at* http://www.thetidings.com/2004/0220/nostra.htm (last visited Nov. 16, 2004).

[86] Nostra Aetate, *supra* note 83, at § 2.

[87] *Id.*

[88] JACQUES DUPUIS, TOWARD A CHRISTIAN THEOLOGY OF RELIGIOUS PLURALISM 159-61 (Orbis 2001).

[89] Nostra Aetate, *supra* note 83, at § 3.

[90] *See id.* at §§ 1-3.

The 34th General Congregation of the Society of Jesus is a more recent document and reflects the way in which *Nostra Aetate* has been interpreted.[91] The section on "Our Mission and Inter-religious Dialogue" recasts evangelization and mission in terms of dialogue.[92] It encourages all Jesuits to "move beyond prejudice and bias, be it historical, cultural, social or theological, in order to cooperate wholeheartedly with men and women of goodwill in promoting peace, justice, harmony, human rights and respect for all of God's creation."[93] The same section goes on to quote The Federation of Asian Bishops' Conferences, who write that dialogue should "never be made a strategy to elicit conversions."[94] The document gives a framework for entering into dialogue at four levels: (1) dialogue of life; (2) dialogue of action; (3) dialogue of religious experience; and (4) dialogue of theological exchange.[95] The dialogue of life must either be predicated by or include dialogue about common justice convictions and human rights.[96] Without discovering and discussing this commonality, there is no real basis for dialogue in action; this dialogue is so necessary for the solidarity and relationship, which must exist in order to discuss personal religious experience and theology.[97]

IV. A Basis for Inter-religious Dialogue Within Islamic Thought

According to Lonergan, all people engage in the transcendental method.[98] While traditional Islamic history identifies the greatest creative flourishing of the Muslim World to have taken place in the first six centuries after the Prophet Mohammad,[99] there has been a flowering of contemporary Muslim scholarship, which is reflective and critical in ways that seem to incorporate the transcendental precepts.[100] The practice of awareness in the Lonerganian sense can be a stumbling block for many due to the rise in a traditionalism, which eschews criticism; however, some scholars have escaped this problem.[101] The traditionalist bias challenges the precept of judging when there is a possibility that new insights might appear to contradict the prevailing orthodoxy.[102] However, as a result of the emphasis on epistemological unity, thinking and acting have always

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[91] The 34th General Congregation of the Society of Jesus was a 1992 meeting in Rome of Jesuit leaders from around the world that culminated in a major restructuring of Jesuit governance. 34TH GENERAL CONGREGATION *supra* note 84, at 1-17. It largely struggled with the challenges of modernism and post-modernism, including questions of inclusivism and pluralism.

[92] *Id.* at 73.

[93] *Id.* at 68.

[94] *Id.* at 69.

[95] *Id.*

[96] *Id.* at 70; *see also* LOCHHEAD, *supra* note 76, at 75-80.

[97] *See generally* JOHN B. COBB JR., TRANSFORMING CHRISTIANITY AND THE WORLD: A WAY BEYOND ABSOLUTISM AND RELATIVISM 179-86 (Paul F. Knitter, ed., Orbis Books 1999).

[98] LONERGAN, INSIGHT, *supra* note 7, at 339-40.

[99] ALBERT HOURANI, A HISTORY OF THE ARAB PEOPLES 1-4 (Warner Books 1991).

[100] SCHULZE, *supra* note 3, at 281-92.

[101] The author would suggest Professors An-Naim and Ezzati as examples.

[102] *Id.* at 286-90.

been critical components of Islamic thought and learning.[103] I return to the importance of unity below because it is highly significant in transcending presumed barriers between body and mind, world and spirit, and reason and faith.[104]

A. Awareness as Practiced Within Islam

Although Islamic civilization provided fertile soil for developments in science and language during its golden age,[105] that flowering of thought and openness has been marred by fear and reaction since the rise of colonialism in Europe.[106] In the modern period, popular Islam has become increasingly identified with the more literalist approach of the *Hanbali* school of jurisprudence, particularly in its Wahhabi form.[107] Although, at the other end of the spectrum are those Muslim thinkers who recognize the limitations and dangers of a literalism that holds to traditional understandings of sacred texts—even when those understandings cannot be reconciled with reason, history, and individual experience.[108]

The Wahhabi approach to modernism is to integrate technology while rejecting liberal and secular morality,[109] which represent *shirk* (an inappropriate association with divine authority).[110] Although the funding and mission efforts of the Gulf States have played a role in the influence of Wahhabi spirituality.[111] It is its ability to provide purpose and answer complex questions with simple answers, thus making clear the distinction between good and evil, that has made it an attractive alternative for people who face poverty and foreign imperialism.[112]

Even traditionalist views of Islam acknowledge an evolutionary growth in understanding.[113] This growth indicates an expanding horizon. There is a sense that revelation was gradual, starting with the patriarchs, then the Jewish prophets, then Jesus and finally Mohammad.[114] Even Mohammad's revelation in the Quran is divided into two distinct periods.[115] The earlier period, revealed in Mecca before the flight to Medina and the establishment of a Muslim state, is characterized by universal themes of free will, equality, and justice in ways that bear a striking resemblance to similar notions within Christianity.[116] For exam-

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103 EZZATI, *supra* note 6, at 66-68.

104 *Id.*

105 HOURANI, *supra* note 99, at 22-37.

106 *Id.* at 434-58.

107 HAMID ALGAR, WAHHABISM: A CRITICAL ESSAY 31-37 (Islamic Publ'n Int'l 2002).

108 AN-NA'IM, *supra* note 32, at 182-86.

109 *Id.*

110 *Id.* at 18-22

111 *Id.* at 60-66.

112 *Id.* at 51-52.

113 *Id.* at 186-87.

114 HOURANI, *supra* note 99, at 14-20.

115 AN-NAI'M, *supra* note 32, at 52-57.

116 *Id.* at 52-53.

ple, verses from this period refer to humanity as a whole or to all "children of Adam."[117] Similar passages also affirm the dignity of the human person without regard to gender, race, nationality, or religion.[118] The latter period of sayings revealed after the flight to Medina represent a stricter and more pragmatic perspective that addressed the governance needs of the early Arab, Muslim state.[119]

Traditionally, the interpretive theory of *naskh* (supercession) has been invoked to conclude that the later period contains the fullness of Mohammad's revelations.[120] The Wahhabi view, in particular, admits little need for growth or understanding beyond this static interpretation of the Quran and the *Sunnah* (the traditions of the Prophet).[121] Certain Muslim traditions, particularly Shiism and branches of Sufism, tend to see a continuous movement toward more perfect understanding of revelation in a way that is generally more open to ecumenism and an expanding horizon.[122]

The crisis Islamic culture faced during the 19th and 20th Centuries as it confronted Western value systems and hegemony resulted in an ideological vacuum that has been filled, in some cases, by various forms of traditionalism and literalism.[123] Many Muslim scholars do not aver to historical analysis except within the traditional constraints of the Quran, *Hadith* (the sayings of the Prophet) and *Sunnah*.[124] Anything that contradicts these sources, as they are generally understood, is problematic.[125] Even commenting on issues about which the sources are silent can be troublesome if it is perceived as un-Islamic.[126] Textual criticism as understood in Western academia is generally considered inappropriate within the religious sphere.[127]

B. The Mystic Mode Facilitating Awareness

Although open intellectual discourse flourished in the early centuries of Islam, the reactionary and defensive trends of the last century have tended to limit free academic investigation in the Muslim world.[128] Those who propose unorthodox or controversial ideas risk their livelihood and even their lives.[129] As a result, it is somewhat uncommon to find mainstream Sunni academics or jurists willing to

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[117] *See e.g. The Holy Quran* Surah 17:70.

[118] *See also id.* at Surah 49:13.

[119] AN-NAI'M, *supra* note 32, at 12.

[120] *Id.* at 21.

[121] ALGAR, *supra* note 107, at 10-11.

[122] *See* AN-NAI'M, *supra* note 32, at 52, 57-60; CHARLES LINDHOLM, THE ISLAMIC MIDDLE EAST: TRADITION AND CHANGE 181, 185-87 (Blackwell Publ'g 2002).

[123] LEWIS, *supra* note 4, at 156-57.

[124] WATT, *supra* note 18, at 137; *see also* LEWIS *supra* note 4, at 141.

[125] Irshad Abdal-Haqq, *Islamic Law: An Overview of Its Origin and Elements*, J. ISLAMIC L. & CULTURE 27, 33-36 (2002).

[126] *Id.* at 35-37.

[127] *Id.* at 32-33.

[128] *Id.*

[129] AN-NAI'M, *supra* note 32, at xi.

challenge or contradict prevailing understandings of *Shari'ah*.[130] The most creative source of ideas coming from the contemporary Muslim world tends to be Sufism, or Islamic mysticism. Sufism is incredibly diverse and ranges from the syncretic/universalistic teachings of the *Chishtiyya*[131] to the more conservative/exclusivist teachings of the *Naqshbandi*.[132] There is, however, an emphasis on individual spiritual experience that creates a greater possibility for authentic subjectivity as described by Lonergan.[133]

The Mevlevi Order[134] founded by Maulana Jalal ud-Din Rumi in the 13th Century in Turkey and the Republican Brotherhood[135] founded by Mahmoud Mohamad Taha during the 20th Century in Sudan are examples of spiritual movements with very different traditions and values; yet, both encourage individual appropriation of knowledge through spiritual experience and intellectual pursuit.[136] Abdullahi Ahmed An-Naim, now a professor of law in the United States ("U.S."), was a follower of Taha.[137] He has developed a view of Islam that intends to be completely faithful to the Quran and the spirit of divine revelation; however, he is willing to break from traditional modes of understanding when they do not comport with reason and the central truths of Islam.[138] As a result of his unpopular stance, he was forced to leave Sudan, but his writing continues to apply sophisticated, nuanced arguments to justify his call for reform within Islam. Someone like Abdullahi Ahmed An-Naim is able to enter into meaningful intercultural and inter-religious dialogue; his writing indicates a process of reflection and criticism that resembles Lonergan's transcendental method, probably in a more rigorous and sophisticated manner than the work of most Christian scholars. The key appears to be the willingness to question and be attentive in a way that is authentically rooted in academic integrity and his mystical approach to faith.

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130 LINDHOLM, *supra* note 122, 181-93.

131 ANNEMARIE SCHIMMEL, MYSTICAL DIMENSIONS OF ISLAM 345 (Oxford Univ. Press 1998). The Chishti order of the Sufis derives its name from Chisht, a small town near Herat in Afghanistan. The first person to call himself Chishti was Abu Ishaq Shami. The name Shami implies he came from Syria or even from Damascus (ash-Sham). He met a Sufi who directed him to settle in Chisht and from then on he was known as Abu Ishaq Shami Chishti. The Chishtiyya order is one of the oldest existing Sufi orders. Most of its adherents live in South Asia, where it flourished due to its tolerance of Hindu practice and its inclusivism.

132 *Id.* at 363-68. The Naqshbandiyya is an order in Sufi Islam. It started in the Khorasan region of Iran but is also traditionally affiliated with the Ottoman Empire and has adherents in South Asia. It is a secretive order and has historically tended to support traditionalism within Sunni Islam.

133 *Id.* at 3-4.

134 *Id.* at 309.

135 AN-NAI'M, *supra* note 32, at x-xii.

136 *Id.* at ix.

137 *Id.* at xi. *See also* http://www.law.emory.edu/faculty (biographical information for Abdullahi Ahmed An-Na'im).

138 *Id.* at ix.

C. Understanding, Judging and Acting within Islam

Ijtihad[139] is the art of interpretation within Islamic jurisprudence ("*Usul ul-Fiqh*"),[140] the process of seeking to form correct legal opinions through reasoning from the Quran and the *Sunnah*. Whenever there is no clear text on a particular issue, a jurist uses the methods of analogy, precedent, consensus, custom, public policy analysis, and logic to reach a decision that is consistent with Quranic principles.[141] This process, if practiced authentically, contains the key elements of thinking in the transcendental precepts. The requirement to remain true to the text may limit thinking in certain areas, but this portion of the transcendental method is clearly evident in Islamic thought. The chief stumbling block in the process is the bias created by narrow and unchanging textual interpretations. The difference is that the tools of intelligence are widely recognized and understood within Islamic culture,[142] so that if one overcomes bias to the point that real awareness is possible, the act of intelligence should be a very natural next step. Islamic jurisprudence has not widely adopted the tools of Western textual criticism,[143] but its approach to interpretation was generally far more sophisticated than corresponding Christian approaches until the 19th Century.[144]

Although the stages of judging and acting are distinct, I treat them together while considering Lonerganian self-appropriation in an Islamic context because the problems that arise are often related. Bias is perpetuated because the consequences for arriving at unorthodox or unconventional ideas can be severe.[145] It creates a strong disincentive for acting on insights and even analyzing or judging potential insights. Thus, the integrity and boldness of someone like Abdullahi Ahmed An-Naim seems heroic given the cost for holding controversial intellectual positions.

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[139] *Id.* at 27. "Ijtihad literally means hard striving or strenuousness, but technically it means exercising independent juristic reasoning to provide answers when the Qur'an and Sunna are silent. Sunna is reported in support of ijtihad as a source of Shari'a. . .[T]he concept of ijma (consensus) appears to have come about as a result of the exercise of ijtihad, in the sense that the ijtihad of the founding jurists led them to the conclusion that the consensus of the community in general, or that of the Muslim scholars in particular, should be mad ea source of Shari'a. . .Qiyas (analogy) may also be seen as a technique of ijtihad. . .Whenever a principle or rule of Shari'a is based on the general meaning or broad implications of a text of Qur'an or Sunna, as opposed to the direct ruling of a clear and definite text, the link between the text and the principle or rule of Shari'a is established through juristic reasoning. It is hard to imagine any text of the Qur'an or Sunna, however clear and definite it may appear to be, that does not need this type of ijtihad for its interpretation and application in concrete situations." *Id.*

[140] Abdal-Haqq, *supra* note 125, at 36. "The process of *deducing* and *applying* Shari'ah principles and injunctions in real or hypothetical cases or situations is called fiqh or *Islamic jurisprudence*." *See also* AN-NAI'M, *supra* note 32, at 50. "Esposito referred to a distinction between Shari'a and fiqh (opinions and commentaries of muslim jurists) which is frequently made by modern Muslim authors to make their task of criticizing what they describe as fiqh appear less drastic than criticizing Shari'a itself." *Id.*

[141] IBRAHIM ABDULLA AL-MARZOUQI, HUMAN RIGHTS IN ISLAMIC LAW, 10-30 (Dhabi 2000).

[142] Abdal-Haqq, *supra* note 125, at 50-62.

[143] WATT, *supra* note 18, at 135-37.

[144] RAYMOND BROWN, AN INTRODUCTION TO THE NEW TESTAMENT 35-40 (Doubleday 1977).

[145] AN-NAI'M, *supra* note 32, at xi-xii.

According to Lonergan, all people engage in the transcendental method to varying degrees.[146] I believe that many of my law students in Jordan cultivated awareness and intelligence (in the Lonerganian sense), but I sensed a deep apprehension for making judgments or taking action that would appear to be inconsistent with the prevailing orthodoxy.[147] For instance, in class discussions of capital punishment no student criticized the use of capital punishment in the Arab World or even more generally. However, when given a test question about abuses in the American criminal justice system, four students condemned the use of capital punishment in the U.S. Their arguments were thoughtful and sophisticated, but none had been made publicly. I wondered whether addressing capital punishment in the U.S. for a test read only by a foreign professor gave these women the opportunity for real self-criticism and confirmed an insight for them. This was an environment that removed the immediate threat of bias and made the transcendental method possible. I do not know how these opportunities might become more normative, but I am convinced that, when free from the threats of group bias, many Muslims would naturally pursue rigorous self-appropriation. Although bias created by literalism is also a stumbling block for Christians, the consequences for breaking with accepted norms are not nearly as serious as they tend to be in Islamic societies.[148]

V. Discerning the Natural Law as an Exercise of the Transcendental Method

Since Lonergan had his intellectual roots in Thomism,[149] it is not surprising that the transcendental method resembles the model for discerning the natural law found in the *Summa Theologiae*.[150] Therefore, the exercise of the transcendental precepts could occur within the context of discovering the natural law in both Christianity and Islam.[151] Since there is a basis for natural law reasoning in both traditions, it may prove to be a useful neutral starting place for inter-religious dialogue.[152] Because natural law discourse is rooted in reason rather than revelatory tradition (which may inform it), Christians and Muslims can bring the common tools of logic, interpretation and criticism to bear even though they were

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[146] FREDERICK E. CROWE, SJ, APPROPRIATING THE LONERGAN IDEAL 8-10 (Catholic Univ. Press 1989).

[147] The author taught a graduate course in U.S. Law at the University of Jordan in the spring of 2001. Most of the students were lawyers or were studying law (Jordanian civil or Shari'a). The curriculum covered some basic topics of the first year in U.S. law school (torts, contracts, constitutional law and criminal law), as well as an overview of Anglo-American jurisprudence and American legal history. The final exam included an essay question in which students were asked to critique some feature of U.S. criminal law. They could choose any topic, and most wrote about the jury system.

[148] WATT, *supra* note 18, at 121-22.

[149] CROWE, *supra* note 146, at 21-30; *See also* LONERGAN, LONERGAN READER, *supra* note 29, 402-07.

[150] HAUGHEY, *supra* note 55, at 763 & 776-78.

[151] *Id.* at 777.

[152] EZZATI, *supra* note 6, at 60-64.

developed in different cultural contexts.[153] Coming to an agreement on notions of social justice and the common good can itself become a basis for cooperation to achieve the good.[154] While the process will ideally lead to greater solidarity, it will not begin without a modicum of that same virtue.[155]

This inter-traditional encounter requires a virtue that can be called intellectual solidarity—a willingness to engage other persons with other traditions in conversation and debate about what makes for a good life. . . .[156]

A. Natural Law in the Thomistic Tradition

Natural law in the Catholic tradition holds to the view of St. Thomas Aquinas, that law flows from our nature as beings capable of reason.[157] Human beings discover natural law by observing and reflecting on the world and their relationships in it.[158] The capacity to understand and act on the principles we discover is a function of our reason and free will.[159]

Aquinas viewed all true law as rooted in what he calls the eternal law of God.[160] Within the eternal law, he identifies two sets of laws: divine law that is revealed[161] and natural law which is discernable by human observation and reason.[162] Eternal law is the sum of both natural law and divine law. It contains everything considered fully law.[163] The intersection between natural law and divine law represents that portion of the divine law, which may be discerned by reason. For example, the commandment not to kill is revealed in scripture and thus part of the divine law. At the same time, the prohibition against murder can be arrived at by reason, which for Aquinas included both observation (the order of nature)[164] and discursive reason (the order of reason).[165]

Islamic tradition also acknowledges that all true law is rooted in God.[166] Most scholars would identify both divine law and a form of natural law.[167] However, the concept of *Shari'ah* is broader than the Thomistic concept of divine law, at

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153 *Id.*

154 DUPUIS, *supra* note 88, at 381-84.

155 PANIKKAR, *supra* note 34, at 35-37.

156 David Hollenbach, S.J., *The Common Good in the Postmodern Epoch: What Role for Theology?* 41 RELIGION, ETHICS AND THE COMMON GOOD 3 (2001).

157 SAINT THOMAS AQUINAS, *Summa Theologiae*, pts. I-II, quest. 90 (Fathers of the English Dominican Province trans., Benziger Bros. 1947).

158 *Id.* at pts. I-II, quest. 94, art. 4.

159 *Id.* at pts. I-II, quest. 8, art. 2.

160 Human law which is inconsistent with the eternal law would not be considered true law by Thomas though it bears the name law. *See id.* at pt. I-II, quest. 93, art. 3.

161 *Id.* at pts. I-II, quest. 91, art. 4-5.

162 *Id.* at pts. I-II, quest. 91, art. 2, quest. 94.

163 Aquinas, *supra* note 157, at pts. I-II, quest. 91, art. 1, quest. 93.

164 CHRISTINA TRAINA, FEMINIST ETHICS AND NATURAL LAW 60-63 (Georgetown Univ. Press 1999).

165 *Id.* at 63-69.

166 EZZATI, *supra* note 6, at 74.

167 *Id.* at 60-65.

least in its applicability.[168] Within Islamic thought, there is a greater correlation between natural law and divine law[169] and the overlap of the two would likely be considered theoretically larger. Some traditions would insist that the corpus of natural law is fully contained within revealed divine law.[170]

For Aquinas, that which we call law outside of the eternal law is not fully law because it is neither part of the natural law nor part of the divine law, though it is at least related to the natural law to the extent that it is the product of human reason.[171] Note that within this framework there are rules, which require a violation of the divine law, and are not merely unjust but are non-law in an absolute sense and should not be obeyed. For example, "laws" that require sin (e.g. the killing of innocents) were in no sense law for Aquinas.[172]

The ideal of human law is located completely within the boundaries of natural law.[173] This ideal presumes that human law, though not a complete expression of natural law is always rooted within natural law. However, some human law may be positive law not rooted in reason. In some cases the result will be benign, but in others it will be a source of significant injustice.[174] As mentioned above, human *law* does not include those rules that require subjects to violate divine law.[175] The intersection between human law and that portion of the divine law, which is not shared in common with natural law, would be laws that require adherence to precepts found in revelation, but which are not derivable by reason. Such laws govern issues such as conscience, liturgy and purity, which are not the proper domain of human law in the modern Christian tradition.[176] An Islamic natural law theory would probably not make this distinction, because ideal human law is presumed to require *Shari'ah*, which would include all revealed divine law.[177]

Aquinas' method consisted of a holistic approach to theology, philosophy, and science that integrated the best scholarship of his day.[178] As a result, his natural law theory was related to eternal law and divine law. Jesus and scripture constituted norms in his tradition.[179] Similarly, within an Islamic context, the Quran would constitute a norm for discovering the natural law.[180] However, beyond the

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168 *Id.* at 89.

169 *Id.* 88-90.

170 *Id.* at 86-87.

171 Aquinas, *supra* note 157, at pts. I-II, quest. 95, art. 2.

172 *Id.* at pts. I-II, quest. 93, art. 3.

173 *Id.* at pts. I-II, quest. 95, art. 2.

174 *Id.* at pts. I-II, quest. 93, art. 3, reply objections 2-3.

175 *Id.* at pts. I-II, quest. 93, art. 3, reply objections 2-3 & quest. 95.

176 Susan Dimock, *The Natural Law Theory of St. Thomas Aquinas, in* PHILOSOPHY OF LAW 30 (Joel Feinberg & Jules Coleman eds., Wadsworth 2000).

177 EZZATI, *supra* note 6, at 89-90.

178 *See* TRAINA, *supra* note 164, at 128-31; *see also* MARY MIDGLEY, BEAST AND MAN: THE ROOTS OF HUMAN NATURE 190 (Routledge Press 1995) (1979).

179 ROGER HAIGHT, S.J., JESUS SYMBOL OF GOD 405-10 (Orbis 1999).

180 AN-NA'IM, *supra* note 32, at 19-21.

realm of sectarian theology, any serious attempt to contextualize natural law jurisprudence must examine it outside of particular theological contexts.[181]

Perhaps the most significant challenge to the jurisprudence of Aquinas can be levied against his method for identifying natural law precepts. On the one hand are deductive rationalists such as Kant[182] and on the other are thinkers in the Aristotelian tradition[183] who rely on an empirical approach. Although Aquinas consistently defined law as a rule of reason (a position which might seem to favor rationalists), his understanding of reason combines deductive rationalism with scientific empiricism.[184] His reference to social order observed in the behavior of bees is an example of his empiricism.[185] So, it appears that his notion of reason is both deductive and inductive, rational and empirical.[186] This mixing of standards gives the system flexibility, but it also provides the opportunity for ambiguity when anecdotal observations in nature become the basis for "natural" law.[187] This general view of Aquinas seems to be shared by Ali Ezzati, who has written the most significant published work on Islam and natural law.[188] His treatment begins with St. Thomas and is generally quite sympathetic to that tradition of natural law reasoning.[189] Significantly, he notes that Aquinas was profoundly influenced by Muslim philosophers, particularly Averroes (*Ibn Rushd*),[190] through whom most of Aristotle was transmitted to the

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[181] ALEXANDER PASSERIN D'ENTREVES, NATURAL LAW: AN INTRODUCTION TO LEGAL PHILOSOPHY 48-49 (Transaction Publishers 2002).

[182] LONGERGAN, INSIGHT, *supra* note 7, at 339-42.

[183] *See id.* at 406-407. *See also* TRAINA, *supra* note 164, at 64-65.

[184] TRAINA, *supra* note 164, at 71-73.

[185] SAINT THOMAS AQUINAS, ST. THOMAS AQUINAS ON POLITICS AND ETHICS 17 (Paul E. Sigmund ed., Norton & Co. 1988).

[186] *See* TRAINA, *supra* note 164, at 56-86.

[187] *Id.* at 60-63.

[188] EZZATI, *supra* note 6, at 24-29.

[189] *Id.* at 25. "Although Aquinas tried to picture Christianity in the light of natural law, his theories of the state, politics and natural law put European political thought on a new plane. It legitimized the autonomy of secular rulers and a prudent rationality of decision-making. It influenced an increasing number of thinkers from the fourteenth century onwards. Thomism, the doctrines of Aquinas, also revived in nineteenth- and twentieth-century Europe and America. But the theory of natural law, of which Aquinas was one of the most influential exponents, helped lay a foundation for the theory of international law in Suarez and Grotius. John Locke also owed much to the Thomist theory of authority based upon and limited by natural law and the common good." *Id.*

[190] "Abu'l-Walid Ibn Rushd, better known as Averroes (1126-1198), stands out as a towering figure in the history of Arab-Islamic thought, as well as that of West-European philosophy and theology. In the Islamic world, he played a decisive role in the defense of Greek philosophy against the onslaughts of the Ash'arite theologians (Mutakallimun), led by al-Ghazali (d. 1111), and the rehabilitation of Aristotle. A common theme throughout his writings is that there is no incompatibility between religion and philosophy when both are properly understood. His contributions to philosophy took many forms, ranging from his detailed commentaries on Aristotle, his defense of philosophy against the attacks of those who condemned it as contrary to Islam and his construction of a form of Aristotelianism which cleansed it, as far as was possible at the time, of Neoplatonic influences. In the Western world, he was recognized, as early as the thirteenth century, as the Commentator of Aristotle, contributing thereby to the rediscovery of the Master, after centuries of near-total oblivion in Western Europe. That discovery was instrumental in launching Latin Scholasticism and, in due course, the European Renaissance of the fifteenth century. Notwithstanding, there has been very little attention to Averroes' work in English, although greater interest has been shown in French, since the publication of Ernest Renan's Averroes et l'averroisme in 1852,

West.[191]

B. Natural Law as an Islamic Concept

Historically, the bulk of Islamic jurisprudence has been suspicious of naturalism.[192] There is a sense in which all law is considered a part of God's divine law expressed in revelation.[193] However, a sophisticated approach to the Thomistic understanding of eternal law (all of which comes from God) as the sum of natural law (which is discernable in creation) and divine law (which is revealed) may be consistent with the orthodox Islamic view.[194] Contemporary Muslim philosophers such as Seyyed Hossein Nasr acknowledge that natural law theory exists in *Shari'ah*, "which governs not only men but also the cosmos."[195] The tools for interpreting *Shari'ah* include methods for construing the universal principles of creation as well as revealed texts.[196] Since the Quran remains a norm for all law and contains more specific standards for governance than the New Testament, its norms may have more potential for discounting "natural laws" which could contradict revelation. Thus, there are likely differences in what would be considered natural law in an Islamic sense and what would be considered natural law in a Thomistic sense.[197]

Ali Ezzati affirms that Islam, even in its more traditional expressions, accepts a form of natural law theory.[198] This system is similar to natural law in the tradition of Aquinas to the extent that it looks to an order of reason (*'aql*),[199] an order of nature (*takwin*)[200] and primordial human nature (*fitrah*).[201] The chief dispute in Islamic philosophy has been the tension between rationalists and those who find truth only in God himself.[202] Rationalists such as the *Mu'tazelah*[203] observe that truth is communicated vertically from God to creation and that truth may be discerned in the horizontal relationships between creatures by observation and reason.[204] Those who acknowledge truth only in revelation are associated with the *Ash'ari*[205] and the *Hanbali* school of jurisprudence[206] by Ezzati.

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and since that time in Spanish." Abu'l Walid Muhammad Ibn Rushd al-Qurtubi (Averroes), *available at*, http://www.muslimphilosophy.com/ir/default.htm (last updated Aug. 25, 2004).

191 EZZATI, *supra* note 6, at 164.

192 *Id.* at 86-87

193 *Id.*

194 *Id.* at 81, 89-91.

195 SEYYED HOSSEIN NASR, RELIGION AND THE ORDER OF NATURE 132-33 (Oxford Univ. Press 1996).

196 *Id.*

197 EZZATI, *supra* note 6, at 89-91, nn. 2, 3, 8, 12-14.

198 *Id.* at 85-91, nn. 4-7 & 9-11.

199 *Id.* at 86-87.

200 *Id.* at 89, n. 2.

201 *Id.* at 19.

202 *Id.* at 75-79.

203 EZZATI, *supra* note 6, at 61.

204 *Id.* at 125

205 *Id* at 75-76.

They maintain that truth must come directly from God. It would be inappropriate to understand these positions in the context of the tension between Western rationalism and faith, however. Both groups acknowledge that truth is ultimately rooted in God and that human beings ought to use reason to understand and obey God.[207] Nevertheless, the *Ash'ari* do not find truth claims founded on human reason to be sufficiently reliable.[208] Ezzati claims that even the *Ash'ari* embrace a form of natural law, though it is rooted in the reason of Islamic and Quranic texts rather than in abstract speculations.[209]

Ezzati identifies several major features of Islam and natural law. First, "Allah is the only legislator."[210] His will is found in the textual sources of the Quran and Islamic tradition as well as consensus based on sound human reason.[211] These sources may be supplemented by public interest, analogy, and legal precedent.[212] Human nature is not a source unless it corresponds with sound reasoning.[213] The relative weight of these sources is highly debated among Muslim legal scholars.[214]

Second, Islam acknowledges the order of nature as well as the order of divine law, and the two cannot contradict each other.[215] Both of these are rooted in human nature (*fitrah*).[216] Aquinas would agree that natural law may not contradict divine law (although the two may overlap).[217] Human nature for Aquinas, though more optimistic than the anthropology of Augustine, incorporated the notion of original sin,[218] which is rejected by Islam.[219] The relative optimism about the human condition found in Islam laid the foundation for the emergence of philosophy and rationalism integrated with a revelatory faith much earlier in its history than in Christian history.[220]

Islam conditionally accepts the maxim "whatever is recommended by human intellect is also recommended by *Shari'ah* and vice-versa."[221] Corollary to this, Islamic law in general accepts that acts can be good or bad in themselves apart from *Shari'ah*.[222] However, reason alone cannot identify the wrongness or right-

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206 *Id* at 125.

207 *Id.* at 122-23.

208 *Id.*

209 EZZATI, *supra* note 6, at 76.

210 *Id.* at 89, n. 1.

211 *The Holy Quran* Surah 4:59, 83 and 16:43.

212 BERNARD G. WEISS, THE SPIRIT OF ISLAMIC LAW 122 (Univ. Ga. Press 1998).

213 EZZATI, *supra* note 6, at 94.

214 WEISS, supra note 212, at 123-26.

215 EZZATI, *supra* note 6, at 86-87.

216 *Id.* at 93-109.

217 AQUINAS, *supra* note 157, at pts. I-II, quest. 93, art. 3.

218 *Id.* at pts. I-II, quest. 91, art. 6.

219 EZZATI, *supra* note 6, at 70.

220 *Id.* at 149.

221 *Id.* at 89, n. 4.

222 *Id.* at 90, n. 5.

ness of all acts, making divine law necessary.[223] These positions tend to parallel the dynamic between natural law and divine law in Aquinas.

Ezzati claims that most Islamic jurists accept that "ethical principles are inherent in the nature of things and are apprehensible through human reason or human primordial nature."[224] This statement would be unacceptable to *Ash'ari* scholars on its face,[225] but it might be understood in the context of revelation rather than in nature alone. As in Thomistic doctrine, God is the source of these principles, which are expressed in nature.[226]

The most fundamental principle of Islam is the oneness of Allah (*tawhid*).[227] It implies unity, harmony, and order in all of creation.[228] This further implies a unified order of law, including moral law. Human beings were created within this order and are subject to its provisions, as is all of creation.[229] The provisions of the natural law are imprinted on human nature and are discernable through reason.[230] In this sense, Islam lends itself to a consistent view of natural law more easily than Christianity, which wrestles with original sin, dualism, and trinitarianism.[231] Islam rejects all three of the preceding ideas.[232]

According to Ezzati, Islam holds that human beings can apprehend the natural law and are responsible for obeying it.[233] The Muslim community is charged with discerning and enforcing natural law principles as well as scriptural provisions.[234] Although many contemporary Western thinkers reject this view of natural law, it is not so different from Aquinas' view of both the individual and the just community.[235]

Natural law is both predictable and rational; however, Allah is not bound by natural law and may change it.[236] Within conventional Islamic thought, Allah cannot be bound by nature in any way or he would not be Allah.[237] In this sense there is macro natural law at the level of the Creator (Allah is the rule and arbiter of all things), but there is no micro natural law at the level of creation, which would bind Allah.[238] This issue is given a similar answer with a different emphasis in Christianity. God may change natural law as a theoretical possibility,

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223 *Id.* at 90, n. 6.

224 *Id.* at 90, n. 7.

225 *Id.*

226 *Id.*

227 *Id.* at 90, n. 8.

228 *Id.* at 74-77.

229 *Id.* at 74.

230 *Id.* at 91, n. 10.

231 *Id.* at 71-72.

232 *Id.* at 71-73.

233 *Id.* at 91, n. 11.

234 *Id.* at 86-88.

235 AQUINAS, *supra* note 157, at pts. I-II, quest. 90, art. 4.

236 EZZATI, *supra* note 6, at 91, n. 13.

237 *Id.*

238 *Id.*

which is realized when God performs miracles.[239] However, Christianity is not bothered by the fact that God chooses to abide by His own edicts as a general matter.[240] There may then be a greater sense of permanence to natural law within Christian thought.

Islamic natural law is understood by observing human nature and by applying human reason, but this is done in the light of the code of spiritual behavior and practice found in revelation.[241] Ezzati makes it clear that the Quran and tradition are not meant to constitute a system of sciences but are revealed for spiritual and religious purposes.[242] The Quran, in particular, maintains and sustains the state of human nature (which is not fallen in Islam).[243] Ultimately, Islamic epistemology is rooted in revelation, reason, and human nature.[244] Christianity is not so different. The deepest differences would be those of emphasis within the two revelatory traditions. Within Islam, unity is clearly the overarching epistemological principle.[245] Christianity begins with self-giving love.[246]

C. Islamic Principles Bearing on Natural Law Theory

There are a number of principles that are of great significance within Islamic jurisprudence and philosophy that are important in discerning natural law principles that might form a basis for inter-religious dialogue. As mentioned above, the most important concept is that of unity (*tawhid* in Arabic).[247] It is the fundamental principle of Islamic epistemology and theology. In addition to *tawhid*, *ijma'* (consensus),[248] *ahkam* (rules),[249] and *shura* (consultation)[250] are also significant principles of Islamic theological doctrine.

Tawhid is the central Quranic "principle of the unified, irreducible epistemology of universal values."[251] Its principal expression is in the radical unity of God, but it also reflects a preference for unity and integration in every field.[252] Personalism, individualism, and pluralism are generally considered to be inconsistent with this fundamental unity.[253] One ramification of *tawhid* is that author-

239 AQUINAS, *supra* note 157, at pt. I, quest. 25, art. 5.

240 *Id.*

241 EZZATI, *supra* note 6, at 91, n. 14.

242 *Id.* at 91-92, n. 14.

243 *Id.* at 92.

244 *Id.*

245 *Id.* at 66.

246 LONERGAN, METHOD IN THEOLOGY, *supra* note 12, at 113.

247 EZZATI, *supra* note 6, at 90, n. 8.

248 AN-NA'IM, *supra* note 32, at 23-24.

249 *Id.* at 32.

250 *Id.* at 78-80.

251 MASUDUL ALAM CHOUDHURY, REFORMING THE MUSLIM WORLD 124 (Kegan Paul 1997).

252 *Id.*

253 *Id.*

ity is integrated.[254] There is no real distinction made between the state and the religious community.[255] In the classical Sunni caliphate, the caliph was the ultimate authority in faith and government.[256] Similarly, many modern Muslim nations have integrated *Shari'ah* into the law of the state.[257] *Tawhid* does not deny a role for natural law.[258] In fact it asserts that there must be universal standards established by God.[259] Furthermore, it avoids the problems, mentioned earlier, of dualism and division with which Christianity has struggled. *Tawhid* even has implications at the social and political levels. Socially, it requires a radical equality, which denies distinctions based on such things as class or race.[260] Politically, it implies that all people ought to reside within a single, unified and just community, which is the ideal of the *'umma* (the unified Muslim community) in Islam.[261]

Ijma', or social consensus, is a legitimate basis for legal principles in Islam that are not already clearly defined by the Quran and the sayings/traditions of the Prophet.[262] It acknowledges the importance of collective wisdom and can be considered an inherent basis for democratic institutions within Islamic tradition.[263] It acknowledges that some decisions are best made by the entire community.[264] Democratic process in the Islamic context can facilitate information flow and encourage broader support for decisions made with the consultation and participation of those affected.[265] Since governance is theoretically indistinguishable from the administration of the faith in Islam, any system of governance that could lead to un-Islamic notions would be unacceptable.[266] Although consensus is not in itself a reliable method for discerning natural law, it can be particularly helpful when it validates claims made on other bases.[267]

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254 *Id.*

255 LINDHOLM, supra note 122, at 78-82.

256 JOHN ESPOSITO & JOHN VOLL, ISLAM AND DEMOCRACY 26 (Oxford Univ. Press 1996). The caliph was not a prophet. Rather, he was a leader of the community, but not in any sense a messenger of God, he could not claim to be the spokesman of continuing revelations; but an aura of holiness and divine choice still lingered around the person and office of the early caliphs, and they did claim to have some kind of religious authority. ALBERT HOURANI, A HISTORY OF THE ARAB PEOPLES 22 (Warner Books 1991).

257 SCHULZE, *supra* note 3, at 1-14.

258 EZZATI, *supra* note 6, at 73-74.

259 *Id.*

260 ESPOSITO & VOLL, *supra* note 256, at 26.

261 AN-NA'IM, *supra* note 32, at 83-84.

262 Abdal-Haqq, *supra* note 125, at 54-55.

263 AN-NA'IM, *supra* note 32, at 23-24

264 *Id.*

265 *See generally* ESPOSITO & VOLL, *supra* note 256.

266 *Id.*

267 Abdal-Haqq, *supra* note 125, at 56.

Ahkam literally means rules.[268] They are the practical rules of civil governance that are based on human understanding of divine law.[269] Although the Quran and *Sunnah* constitute a negative norm for *ahkam*, there is a tremendous amount of flexibility within Islamic jurisprudence regarding those issues that are not addressed by these sources.[270] As a result, *ahkam* can be adapted to meet changing cultural and economic circumstances.[271] *Ahkam* are the laws of practical jurisprudence. They are analogous to human laws as understood by Aquinas and described above. So, while ideally they are rooted in the natural law (as a part of the *Shari'ah*), they are not necessarily natural law.

Shura, meaning consultation, refers to a cooperative process of human beings moving towards the good.[272] It also has a dialectical character in that it presumes that human consultation moves the community toward greater perfection and understanding of truth.[273] In this regard it may be understood as the process of moving closer to God; however, it might also be understood as a historical dialectic moving towards progress.[274] *Shura* can also refer to an advisory or governing council.[275] It is a mechanism for providing necessary information to those who make decisions and presumes that varied perspectives produce a truer portrait of reality on which to base decisions. Like *ijma'*, the principle of *shura* presumes that multiple standpoints are more likely to arrive at true legal interpretations, which is a possible basis for standpoint theory within Islamic thought.

VI. Components for Productive Dialogue

In order for inter-religious dialogue between Christians and Muslims to be productive, both groups must be faithful to their respective traditions.[276] Participants must then be able to communicate transculturally in a way that is truly bilateral. Dialogue fails if it becomes monologue.[277] Finally, there must be some degree of solidarity, which might form the basis for reconciliation.[278]

A. Faithfulness to the Traditions

A key component of dialogue is authenticity, which implies faithfulness to our own religious and cultural narratives defining our understanding of ultimate reality. That is not to say that horizons cannot change or that Christians and Muslims

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268 CHOUDHURY, *supra* note 251, at 32-34. Ahkam are civil rules (human law) that are valid to the extent that they do not conflict with Sharia. They are allowable as gap-fillers.

269 *Id.*

270 JOSEPH SCHACT, AN INTRODUCTION TO ISLAMIC LAW 54 (Clarendon Press 1964).

271 *Id.*

272 *See* CHOUDHURY, *supra* note 251, at 56-59.

273 *Id.*

274 *Id.*

275 AN-NA'IM, *supra* note 32, at 78-80.

276 LOCHHEAD, *supra* note 76, at 31-39.

277 PANIKKAR, *supra* note 34, at 35.

278 *See* Haughey, *Responsibility for Human Rights*, *supra* note 55, at 784-85.

might not adapt their understanding of our narratives. One criticism of Christians I have heard from Muslims is that dialogue is meaningless because conservative Christians use it as a pretext for proselytizing and for liberal Christians it is an exercise in validating their universalism.[279] Both of these motives are abhorrent to most Muslims[280] and doom efforts at meaningful dialogue before they even begin.

Dialogue cannot be conflated with proselytizing. True dialogue is a work of reconciliation, peacemaking and searching for truth. Christian biases and presumptions in this regard are at least as problematic as Muslim ones.[281] Faithful authenticity requires one to be honest about his or her goals and motivations for dialogue.

Muslims who are open to dialogue presumably have some interest in knowing what Christians think and believe. Although they expect that Christians will evince respect and sensitivity in dialogue, they become frustrated when they perceive that Christians are saying only what they believe Muslims want to hear.[282] Sometimes this way of speaking by Christians arises out of paternalism,[283] and at other times, it flows from an extreme relativism that refuses to make judgments about truth and may even be unfaithful to authentic subjectivity.[284]

B. Communicate Transculturally

Once individual Christians and Muslims are committed to dialogue rather than proselytizing[285] and have faithfully integrated their respective traditions, they still have to be able to communicate history and beliefs cross-culturally. They must be able to recognize the context of the different understandings represented in a particular dialogue, including their own. They can use the transcendental method to objectivize insights in order that they can be understood transculturally. Lonergan asserts that authentic subjectivity can lead to truth.[286] That truth might be relative in certain respects so that the goal is universality rather than unanimity (see the earlier discussion of relativism).

The most important tool for communicating transculturally is clear and well-defined language.[287] Ideas must be objectivized in a way that is intelligible so that meaning can be effectively conveyed. Since such terms as justice and mercy

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279 Based on the author's conversations with scholars in Egypt, Turkey and Jordan.

280 EZZATI, *supra* note 6, at 183-85.

281 SIDDIQUI, *supra* note 24, at 50-54.

282 *Id.* at 197-99.

283 *Id.* at 54-55.

284 LOCHHEAD, *supra* note 76, at 31-39.

285 While dialogue for the Christian may be understood within the broader category of evangelization, this particular expression of love and reconciliation must be clearly distinguished from proselytizing in terms of motivation, method and goals. Muslims have the same challenge, but institutionalized toleration of Christians and Jews as *Ahl al-Kitab* (People of the Book) provides a historical basis for distinguishing between missions and respectful discourse—whether civil or inter-religious.

286 LONERGAN, LONERGAN READER, *supra* note 12, at 548.

287 PANIKKAR, *supra* note 34, at 46.

have different meanings in different religious contexts, it makes little sense to adopt the definition of one group over that of the other. However, in discussing the differences, it might be helpful to use historical and textual interpretive methods developed in both traditions to the extent that they will provide clarity.

Since dialogue is a relatively new idea for Christians and since there remains a deep level of suspicion among Christians and Muslims generally, there has been a tendency for attempts at dialogue to begin as or quickly become monologues.[288] There is sometimes the perception that Christians not only speak authoritatively about their own faith tradition but claim to speak authoritatively for Muslims as well.[289] This attitude is often interpreted as an exclusive claim of access to truth and a desire to convert Muslims to Christianity.[290] These perceptions are not altogether inaccurate, and the consequence is alienation.[291]

C. Moving Toward Reconciliation

Although love (*agape* in Greek and *mohabbah* in Arabic) is a virtue in Islam, outside of some Sufi orders, it does not receive the same emphasis as in the Christian tradition.[292] According to the New Testament, the greatest commandments are to love God and to love neighbor.[293] The New Testament First Letter of John goes so far as to say that God is love.[294] As a logical consequence, God's work in the world is to reconcile people to Himself and to one another.[295] Aside from practical concerns for peace and intellectual pursuit, this is what motivates dialogue for Christians.[296] In order to be reconciled with and truly love others, one must know them.

VII. The Initial Content of Dialogue: Working for Common Justice Goals

Since there is such a significant overlap in natural law reasoning, Christians and Muslims should be able to arrive at commonly held principles of human rights. The Universal Declaration of Human Rights,[297] the Declaration of the Parliament of the World's Religions,[298] and the Universal Islamic Declaration of

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288 *Id.* at 35.

289 *See* ARKOUN, *supra* note 23, at 31-36.

290 SIDDIQUI, *supra* note 24, at 93.

291 *Id.*

292 WILLIAM C. CHITTICK, THE SUFI PATH OF LOVE 194-96 (SUNY Press 1983).

293 Matthew 22:36-40 (The New Revised Standard Version).

294 1 *John* 4:7-12 (The New Revised Standard Version).

295 Note that reconciliation with God is not considered necessary in Islam because there is no notion of fallenness or original sin that separates God from humanity. Ezzati, supra note 6, at 66-73. Submission, however, is essential for relationship with God in both traditions.

296 WATT, *supra* note 18, at 138-45.

297 Universal Declaration of Human Rights (Dec. 10, 1948).

298 The Parliament of the World's Religions Declaration Toward a Global Ethic (1993).

Human Rights[299] can serve as a guide for identifying such principles to the extent that they overlap. In the context of inter-religious dialogue, I am arguing that it is reasonable to begin with the points of greatest agreement. This is not to say that differences are irrelevant. But dialogue focused on differences is more likely to create conflict than dialogue with the potential for greater solidarity and deeper relationships that might make a discussion of differences in doctrine and personal faith journeys worthwhile.

A. Focus on Areas of Likely Cooperation First

One problem with inter-religious dialogue is that the very term implies that dialogue between people of different faiths must begin with religion. As mentioned before, there have been modestly successful experiments in Muslim-Christian dialogue. Even so, there is a perception (perhaps valid or perhaps created by the media) that the majority of public cross-cultural interchange is negative. For example, recent events in Iraq, Afghanistan, the Balkans and Palestine typify this perception. The roots of these tensions are found in a variety of places, including the early expansion of Islam, the Crusades and Western colonialism.[300] Given current conflicts and the history of conflict, I suggest that dialogue should begin with topics on which there is some likely agreement. There is nothing wrong with starting small. It creates the opportunity for forging meaningful relationships and could lead to cooperation.

It might be possible to enter dialogue regarding the sanctity of life and the dignity of the human person, since the principle is deeply-rooted in both Islam and Christianity. In a conference last year, representatives from all major faith communities, including Islam, gathered in Assisi at the invitation of Pope John Paul II to universally reject the notion that violence can be justified in the name of God.[301] This was an important step towards solidarity; however, I would propose something more concrete and grassroots.

Both Islam and Christianity have strong traditions of serving the poor. In Islam there are the *zakat*,[302] or alms, paid by all Muslims for the assistance of the poor, the practice of giving money and food to beggars and foundations established to meet the needs of the poor. Christians have similar values, although some of the institutionalized forms are not found in their texts as they are in Islam. If Christians and Muslims can be brought together for explicitly inter-religious, rather than political, dialogue surrounding their moral response to poverty, I believe that the process could deepen each group's convictions, empowering them to be more effective and lead to cooperation in efforts to fight poverty. Once a basis of trust and cooperation is established, the dialogue could expand to a more general consideration of human rights.

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299 Ratified by the Organization of Islamic Conferences on Sept. 9, 1991.

300 *See* LEWIS, *supra* note 4, at 3-18.

301 *See* THE CATHOLIC STANDARD, Jan. 24, 2002.

302 "Zakat is commonly translated as 'alms tax.' It is defined as a certain percentage of one's acquired property or profit for the year that is paid to the needy." SACHIKO MURATA & WILLIAM C. CHITTICK, THE VISION OF ISLAM 16 (Paragon House 1994) [hereinafter MURATA & CHITTICK].

B. Toward Universal Principles of Social Justice and Human Rights

Social justice and human rights constitute the most reasonable starting place for dialogue because both Christianity and Islam acknowledge the dignity and free will of human beings. Through their respective traditions, both have arrived at universal standards for justice even though these standards may not be identical. The reality is that this agreement on the value of human beings ascribed to God brings followers of both faiths to similar conclusions about the proper role of the religious community and the state (bearing in mind that there is no necessary distinction between the two in Islam) with regard to social justice and human rights. Dialogue on these issues might even allow Christians and Muslims to recognize their own scotosis[303] and be more faithful to the faith traditions in their respective religions. In his article, "A Revision of the Liberal Tradition", John Langan, S.J. derives economic rights from the liberal point of view using Hobbes, Locke, Mill, and Rawls.[304] Given the traditional liberal and libertarian suspicion of positive, economic rights, this presents a significant challenge. They are considered secondary to political rights and are usually described as goals rather than as rights. In the Western tradition, particularly in the U.S., there has been a resistance to the idea of economic rights at every step.[305] Although the U.S. supported the Universal Declaration of Human Rights, it has never fully embraced the idea that economic rights, such as education and health, are truly inalienable and enforceable.[306] Langan's article contains the powerful insight that economic rights can be derived from classical liberal understandings of political rights.[307]

As a result of its historical narrative, Christian culture, particularly in the U.S., has had difficulty accepting that a just government might have an obligation to provide social services to its subjects.[308] Islam has faced the opposite challenge. In Islam, it is clear that people have economic obligations to give and show mercy to the poor.[309] In many Arab homes, throwing out a few dry pieces of bread is considered an offense against God and the poor.[310] In much of Arab culture, bread, and more generally food, is sacred. If there is excess, one puts it in a bag and hangs it on a wall or post outside so that people can find food without begging. Even when people do beg, which is something more common in American cities than most Middle Eastern cities, Muslims are socialized to

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303 For a description of scotosis or blind spot, *see* LONERGAN, INSIGHT, *supra* note 7, at 191-203.

304 *See generally* John Langan, S.J., *A Revision of the Liberal Tradition in* HUMAN RIGHTS IN THE AMERICAS 69-70 (Georgetown Univ. Press 1982).

305 *Id.* at 91.

306 GLENDON, *supra* note 26, at 185-90.

307 *See generally* Langan, *supra* note 304.

308 See Langan for a detailed discussion of the challenge of economic rights within liberal societies.

309 *See generally* ADAM SABRA, POVERTY AND CHARITY IN MEDIEVAL ISLAM (Cambridge Univ. Press 2000); *see also* John Alterman & Shireen Hunter, *The Idea of Philanthropy in Muslim Contexts* (CSIS 2004), *at* http://www.csis.org/mideast/040222_philanthropy.pdf.

310 The author was actually scolded once in Amman for throwing away a few pieces of dry pita bread instead of saving it for the poor.

give even if it is very little.[311] The idea that one would walk past a beggar without giving something is offensive in traditional Islamic cultures.[312] Thus the obligation to give might seem to constitute a right of the poor to have their basic needs met.

There is solidarity with the poor throughout Muslim practice. One of the five pillars of Islam, *zakat*, is to give a percentage (usually 2.5%) of one's income to the poor – not for the maintenance of the mosque or the state – but to the poor.[313] Ramadan, too, is a radical identification with the poor in their struggles.[314] This ethic is so strong, that people risk ostracism if they publicly break the fast. So, unlike the Western liberal tradition, Islam has had an understanding of economic rights from its beginnings.

One challenge in Islam is to arrive at a justification for political rights. Since governance is indistinguishable from the administration of the faith, any system of rights that could lead to un-Islamic notions would be unacceptable. Within the context of an Islamic society, it is possible to conclude that ideas like democracy and individual liberties are helpful to the goals of Islam in practical justice. However, they also create the opportunity for error, especially when given to non-Muslims.

The debate on cultural rights is a relatively new phenomenon that has taken place in the U.S. and Europe, as they have become more multicultural and pluralistic societies.[315] Tolerance, integration, and autonomy continue to be challenges in the West. It might be even more difficult to derive cultural rights from a Muslim point of view. On the one hand, Muslims use cultural rights to reject conformity with outside forces of materialism and commercialization. On the other hand, modern Muslim cultures have not been consistent in allowing similar rights for minorities within their borders (e.g. Kurds, Christians, Muslim minorities, etc.).

Although there are challenges, I find it compelling and encouraging that Western liberals can discover the insight that economic justice is consistent with and may be derived from political rights and that Muslims might come to an acceptance of political rights as implicit within economic obligations and rights for the effective administration of the Islamic state. It gives me hope that the transcendental method may provide opportunities for dialogue and more such parallel insights.

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311 *See* Alterman & Hunter, *supra* note 309, at 3.

312 *See generally id.*

313 MURATA & CHITTICK, *supra* note 302, at 16; *see also* ISLAM: THE STRAIGHT PATH, JOHN L. ESPOSITO 90 (Oxford Univ. Press 1998).

314 *See* RAMADAN: MOTIVATING BELIEVERS TO ACTION (Laleh Bakhtiar ed., Kazi 1994).

315 Haughey, *Responsibility for Human Rights*, *supra* note 55, at 766-77.

C. Solidarity and Relationship

On some level, the *telos* of both dialogue and human rights is solidarity.[316] If we acknowledge basic human dignity and then work together to defend that dignity, a natural result is that understanding and empathy for others will be developed. Once this emotional intuition is attained, it will be easier to engage in dialogue on issues that are more personal and theological because a person will be able to put himself in the place of the other. Frankly, though, I wonder whether the exclusively theological aspects of the two faiths are essential to dialogue at all. The Christian is ideally characterized by love in action according to the scriptural tradition, while Islam is ideally characterized by submission to God. Doctrine is secondary. Jesus honored the gentiles who acted in love, faith, and repentance,[317] and Mohammad honored the pious non-Muslim over the unfaithful Muslim.[318] Perhaps by moving towards solidarity in the defense of social justice, followers express love and submission to the will of God more effectively than by confessing to the Trinitarian formula of the Nicene Creed or by reestablishing the Caliphate. These are important issues, but they would certainly be contextualized and understood better from a state of solidarity rather than one of distrust and enmity.

VIII. Conclusion

My hope is that this theoretical framework for dialogue can serve as a precursor to concrete dispute resolution. The overlap synthesis of Western and Islamic natural law traditions allows the flexibility of a rationalist view that is both deductive and inductive and considers the role of human behavior in making universal rights and social justice claims. Addressing these claims in meaningful ways necessitates a greater commitment to the poor and marginalized. Practically, it will require challenging colonialism and the exclusion of religious minorities, both in predominantly Christian and predominantly Muslim countries. Real cooperation in the service of the poor and in protecting human rights will create opportunities for more direct and constructive cross-cultural interaction that will foster solidarity and make intercommunal reconciliation more likely.

316 *Id.*

317 Jesus honors the faithful Roman centurion, *see Luke* 7:1-10. Jesus uses the story of the good Samaritan to highlight the importance of mercy over lineage, *see Luke* 10:25-37. Jesus heals the Canaanite woman because of her faith, *see Matthew* 15:21-28. *See* The Holy Quran 5:69 (Believing Jews, Christians and Sabeans may be saved). *See also* Hadith 3208 related by Sahih al-Bukhari (Those who live as Muslims and then turn to unrighteousness will be judged).

318 EZZATI, *supra* note 6, at 54-55.

PATENT PRACTICE IN LONDON - LOCAL INTERNATIONALISM: HOW PATENT LAW MAGNIFIES THE RELATIONSHIP OF THE UNITED KINGDOM WITH EUROPE, THE UNITED STATES, AND THE REST OF THE WORLD

Thomas K. McBride, Jr.*

Patent Practice in London: Local Internationalism

> "My, you ought to seen old Henry the Eighth when he was in bloom. He *was* a blossom. He used to marry a new wife every day, and chop off her head next morning. And he would do it just as indifferent as if he was ordering up eggs."[1]

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[1] MARK TWAIN, THE ADVENTURES OF HUCKLEBERRY FINN 153 (Bantam Dell 2003) (1965). Furthermore, Sir Boss, a character in Mark Twain's CONNECTICUT YANKEE IN KING ARTHUR'S COURT, also states that, "[A] country without a patent office and good patent laws was just a crab, and couldn't travel anyway but sideways and backways." MARK TWAIN, A CONNECTICUT YANKEE IN KING ARTHUR'S COURT 41 (Bantam Books 1981) (1889). Or consider the use of the phrase, "It's the economy stupid," popularized by James Carville, political strategist for the 1992 presidential campaign. This message reflects the importance of economy to the people's political good will, and that this importance is greatly affected by patent laws. Thus, international commerce is bolstered by good sound international patent

Henry the Eighth famously struggled with producing a male heir to settle the future legitimacy of his Kingdom.[2] Nonetheless, Elizabeth I subsequently proved that a female heir could magnificently succeed in expanding Great Britain in the sixteenth century.[3] Yet the rise of the divine right of monarchs was dramatically transformed in the seventeenth century, as abuses of royal prerogative and privilege were tempered by the rise of Parliament.[4] Such exemplary constitutional transformation occurred when the law of patent grants of sovereign monopolies moved from a gift by the Queen to an enterprise authorized by parliamentary act.[5]

Constitutional transformation continues to sweep through Europe today.[6] Although specialized patent lawyers practice in many jurisdictions, some areas in Europe are more fertile than others.[7] England today, under Elizabeth II, acts as a focal point for international trade and a gateway to broader European markets.[8]

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laws. *Cf.* Edward Walterscheid, *Conforming the General Welfare Clause and the Intellectual Property Clause*, 13 HARV. J.L. & TECH. 87 (1999) (generally discussing the harmonious relation between promotion of the welfare and promotion of intellectual property seen in the United States Constitution).

[2] *See, e.g.*, ERIC DELDERFIELD & D. V. COOK, KINGS AND QUEENS OF ENGLAND AND GREAT BRITAIN 68-70 (2d ed. 1970) (discussing the best known fact that Henry VIII had six wives and completed the religious Reformation of England with constitutional change making King the head of the Church of England).

[3] *See, e.g., id.* at 74-76 (discussing the significant transformations under Elizabeth I).

[4] *See, e.g.*, Malla Pollack, *Purveyance and Power, or Over-priced Free Lunch: The Intellectual Property Clause as an Ally of the Takings Clause in the Public's Control over of Government*, 30 SW. U. L. REV. 11, 20-80 43-45 (2000) (providing historical background on the financing of British government); Louise Halper, *Measure for Measure: Law, Prerogative, Subversion*, 13 CARDOZA STUD. L. & LIT. 221, 228-35 (2001) (discussing relations between monarch and parliaments and placing Shakespearean theater in a social context focused on economic monetary issues).

[5] English Statute of Monopolies, 1623, (21 Jac. 1, c. 3 (Eng.)). *See also*, the English Petition of Right, 1628 (reaffirming Parliament's long-familiar rights and complaining about royal usurpations, especially with respect to the mode of taxation). Charles the First contrived to rule from 1629 to 1640 without Parliament and managed to finance his rule in part by the sale of monopolies. This long rule without Parliament led to Civil War and the execution of the King in 1649. Charles II and James II took part in the Civil War, and Oliver Cromwell played regent, but ultimately Parliament would establish supremacy and abolish royal prerogative with the 'Glorious Revolution' when William and Mary accepted the English Bill of Rights in 1689. *See, e.g.*, GEORGE ANASTAPLO, THE AMENDMENTS TO THE CONSTITUTION 24-28 (John Hopkins University Press 1995) (discussing these events and setting out the documents of 1628 and 1689 in an appendix).

[6] This can be seen both internally to the United Kingdom with issues involving the reform of the House of Lords, and externally to the United Kingdom with issues involving ratification of the new European Union Constitution. On reform of the House of Lords, see "The House of Lords Completing the Reform: A Government White Paper Presented to Parliament by the Prime Minister By Command of Her Majesty 7 November 2001" *available at* http://www.dca.gov.uk/constitution/holref/holreform.htm. On ratification of the new EU Constitution the latest country by country information can be viewed online *at* http://www.unizar.es/euroconstitucion/Treaties/Treaty_Const_Rat.htm.

[7] *See, e.g.*, an excellent summary of the U.K. law and the English Court System *available at* http://www.eurolegal.org/british/UKcourtsys.htm stating:

> London has long been a world centre for international trade where businessmen from overseas make contracts. To this day more international trade contracts are negotiated in London, or through brokers dealing on London markets, or on the trade terms of London markets, than applies to any other single place in the world. The pre-eminence of London is of particular significance in aviation and shipping, banking, the international sale of goods, particularly commodities and insurance and reinsurance.

[8] *Id.*

Patent practice provides an illuminating example of how one specialized area of law acts as a microcosmic lens reflecting the broader legal culture in which it developed. Moreover, patent practice magnifies economic policies that impact commercial planning and licensing of intellectual property, all of which intimately relates to international and domestic trade contracts and sales of goods.[9] This article will discuss the basic similarities and differences between British (especially English) and European patent law systems, as well as reflect American patent perspectives, to better understand international intellectual property reforms and conflicts of law.[10]

The first section of this article will discuss the basics of patent law ranging from the international patent systems and how they compare to domestic patent systems, especially how the United Kingdom compares to other European countries and the United States.[11] The second section will discuss specific British practice systems and reflect on issues important to British patent attorneys with pending cases before the House of Lords.[12] The third section will bring in American references to the British and European systems, providing a bridge from the early common law of the United Kingdom to the present commercial world of the European Union.[13] The fourth section will conclude the article with a discussion looking towards the future, including European community patents and general constitutional trends in global commerce and international patent law.[14]

I. Patent Law Basics

> "Invention is the easy bit. Innovation, by contrast, is the genuinely difficult part."[15]

A review of some basics of patent law provides a background for analyzing the systems of practice in England. These basics include the laws governing patents in the relationships among England, the rest of Europe, and globally. These basics also include the retained national law in Europe, which governs the enforcement of European patents, and has led to dramatically different treatment of

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[9] *See generally* FRED WARSHOFSKY, THE PATENT WARS: THE BATTLE TO OWN THE WORLD'S TECHNOLOGY 3 (John Wiley & Sons, Inc. 1994) (noting the growth in economic importance of patents).

[10] Note that while Scotland has its own legal system, several treaties bind Scotland through the United Kingdom. However, the majority of patent cases have been under English law. Thus, British and English may be used interchangeably throughout this paper, while Scotland will not be discussed specifically. Although Northern Ireland may also be bound under a type of English law, but it will not be discussed in this paper either.

[11] *See infra* Section I and accompanying text (discussing patent law basics).

[12] *See infra* Section II and accompanying text (discussing British patent systems and practice).

[13] *See infra* Section III and accompanying text (discussing America's debt to the British system).

[14] *See infra* Section IV and accompanying text (discussing present and future European and international issues).

[15] *Invention is the Easy Bit,* THE ECONOMIST, (U.S. Edition) June 23, 2001. The magazine also includes a graphic warning, "Beware of new ideas. They can be 25 years ahead of their time." *Id.* Note that this implies that the present patent maximum term length of 20 years may create a timing problem.

the same European patent in an English court and in a separate German court.[16] Finally, this section discusses broader issues covering cross-border injunctions (popularly known as the Italian torpedo strategy) and movement toward harmonization on both a European and global scale.

To begin simply and generally following American law, a patent uses words in a specified format to provide groundwork protecting an otherwise abstract idea.[17] Patents include an invention specification section that generally contains: background information, figures, example data, and a detailed written description that fully transfers possession of all relevant inventors' ideas to the public domain.[18] Patents also include a claims section, which set out in precise detail the metes and bounds of the invention using a "poetically" precise selection of words.[19] These claims specify the point of novelty and show non-obviousness in light of any relevant prior art covering similar inventions that have been previously described in other patents or similar documents.[20] The "poetry" arises from the fact that the fewer words that are used in a claim, and the more apt description provided, the more unique the resulting patent claim reads.[21]

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16 *See infra* Section I.B.1 and accompanying text (discussing *Epilady* cases and illustrating how both German and English courts took opposite sides at trial and then both reversed and took opposites sides again after appeal).

17 *See* ENCYCLOPEDIA BRITANNICA 501 (11th ed). Letters Patent are generally defined as letters, addressed by the sovereign 'to all to whom these presents shall come' reciting the grant of some dignity, office, monopoly, franchise, or other privilege to the patentee. They are not sealed up, but are left open (hence the term 'patent') and are recorded in the patent rolls in the Record Office. . .so that all subjects of the realm may read and be bound by their contents; *see also* BLACK'S LAW DICTIONARY 1156 (7th ed. 1999) (specifically defining patent as "The exclusive right to exclude others from making, using, marketing, selling, offering for sale, or importing an invention for a specified period (20 years from the date of filing), granted by the federal government to the inventor if the device or process make, use, or sell an invention for a specified period granted by the federal government to the inventor if the device or process is novel, useful, and nonobvious"). Black's Dictionary goes further to quote from a primer on patents:

> What, exactly, is a patent and how does it operate to foster the 'progress of the useful arts'? In its simplest terms a patent is an agreement between the inventor and the public, represented by the federal government: in return for a full public disclosure of the invention the inventor is granted the right for a fixed period of time to exclude others from making, using, or selling the defined invention in the United States. It is a limited monopoly, designed not primarily to reward the inventor (this may or may not follow), but to encourage a public disclosure of inventions so that after the monopoly expires, the public is free to take unrestricted advantage of the invention. EARL W. KINTNER & JACK L. LAHR, AN INTELLECTUAL PROPERTY LAW PRIMER 7-11 (2d ed. 1982).

See also U.S. CONST., art. I, § 8, cl. 8. (Patent and Copyright Clause) (spelling out 'progress of the useful arts'), *reprinted in* GEORGE ANASTAPLO, THE CONSTITUTION of 1787 270 (John Hopkins University Press 1991) (1989).

18 *See, e.g.*, 35 U.S.C. §112; MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) § 601, *available at* http://www.uspto.gov/web/offices/pac/mpep/mpep.htm.

19 *Id.* "The name of the game is the claim." In re Hiniker Co., 150 F.3d 1362, 1369 (Fed. Cir. 1998).

20 *See, e.g.*, Manual OF PATENT EXAMINING PROCEDURE (MPEP) § 706 (discussing examination and rejection of claims).

21 Note that in some technology areas, words alone may completely fail to adequately describe an invention; thus an actual deposit of the invention may be necessary in a public depository. For example, in a case involving antibiotic compounds made by a microorganism, the Court of Customs and Patent Appeals accepted the public deposit because the patentee was not able to, sufficiently disclose by written word how to obtain the microorganism starting material from nature. In re Argoudelis, 434 F.2d 1390, 1392 (C.C.P.A. 1970).

A well-drafted claim will precisely describe an invention and protect the idea covered from both literal and equitable infringement.[22] Equitable infringement pertains to claims that cover similar aspects of the invention, but due to limitations of knowledge or drafting skill, do not expressly cover the patented invention.[23] Thus, courts will in some instances act equitably and provide a remedy permitting a patent to cover intellectual property outside the literally drafted boundary.[24]

Regardless of the specifics of a particular patent claim, the nature of a granted patent arises from a public *quid pro quo*[25] with the private inventor.[26] In exchange for the disclosure of the invention to the public, the patent is generally thought of as an incentive for the increase of the common good[27] by allowing a period of exclusivity for the inventor to reap the fruit of his or her ideas, generally about twenty years from patent application.[28] A commonly mistaken impression of patents relates to the mainly negative nature of the granted right, which is the right to exclude others from the claimed material.[29] But, there is no affirmative aid to the actual invention by grant; the patent only allows the inventor a time period to exploit the described idea free from competition in the relevant jurisdiction.[30] However, aid may become available in the form of remedies through court ordered injunctions or damages when actual or threatened infringement of the claims by others has been demonstrated with sufficient proof.[31]

Disclosure of the invention also provides an incentive to the general public to creatively design around the claims in the patent, and come up with innovative ideas outside the literal, equitable, and even geographic scope of the patent.[32]

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22 *See* Graver Tank & Mfg. Co. v. Linde Air Products Co., 339 U.S. 605, 607-09 (1950) (discussing the doctrine of equivalents in the United States). *See also* Westinghouse v. Boyden Power Brake Co., 170 U.S. 537 (1898); Scripps Clinic & Research Found. v. Genetech, Inc., 927 F.2d 1565 (Fed. Cir. 1991) (discussing the reverse doctrine of equivalents, which permits equity to find non-infringement even within the literal scope of claims for an article that is so far changed to perform in a substantially different way).

23 *See id.*

24 *See id.* The *Epilady* cases discussed in Section I.B.11 below also shed light on the extension of claims beyond the literal boundary of the words in the European context.

25 *Quid pro quo* is defined as, "an action or thing that is exchanged for another action or thing of more or less equal value; a substitute" BLACK'S LAW DICTIONARY 1282 (8th ed. 1999).

26 *See* Bonito Boats, Inc. v. Thunder Craft Boats, Inc. 489 U.S. 141, 150-51 (1989); Pfaff v. Wells Electronics, Inc., 525 U.S. 55, 63 (1998) ("[T]he patent system thus embodies a carefully crafted bargain for encouraging the creation and disclosure of new, useful, and nonobvious advances in technology and design in return for the exclusive right to practice the invention for a period of years").

27 Seymour *v.* Osborne, 78 U.S. 516, 533-34 (1870); *Pfaff*, 525 U.S. at 63-64.

28 35 U.S.C. §154(a)(2).

29 *Pfaff*, 525 U.S. at 64-65.

30 *Id.*

31 *See* 35 U.S.C. §283 (covering injunctions); 35 U.S.C. §284 (covering damages).

32 Geographic limitations arise where each nation can only enforce patent violations that touch that particular nation's jurisdiction. Designing around a patent should always be done with careful assistance from a skilled patent attorney who can interpret local issues on claim construction and render opinions on invalidity and on ways to avoid infringement.

Disclosed information enriches the public domain, while providing 'shoulders' for future inventors to 'stand' on.[33]

A. European Patent Convention for Patent Issuance

Patents arise in the United Kingdom in three ways: First, a domestic inventor can directly file a national patent application; second, a European patent application can enter the national phase in the United Kingdom after being examined and granted by the European Patent Office; or third, an international patent application filed under the Patent Cooperation Treaty ("PCT") can enter the national phase under terms of the treaty.[34]

WIPO is an international group that coordinates the filing, searching, and examination of applications for patents using the PCT system.[35] The PCT essentially provides a 'ticket' application for global inventors to apply to many countries simultaneously, and defer expenses associated with individual national office filings required for granting actual patents within each sovereign nation.[36] The 'ticket' application provides notice to PCT member countries that an applicant has a priority date, which later can be exercised in each country once an applicant proceeds with paying each selected office fee in a timely manner.[37] Thus, the PCT allows inventors a grace period to continue to evaluate the geographic and techno-commercial potential of their invention as well as evaluate any legal feedback from the search and examination reports before committing to expensive grant procedures in numerous and varied countries.[38]

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[33] Normally the aphorism, "Standing on the shoulders of giants" may be attributed to Sir Isaac Newton, whose work built upon the earlier work of many other inventors, and who also had a notorious conflict with the continental mathematician Gott-fried Wilhelm von Leibniz over the invention of calculus. However, the phrase appears to have been in common use during Newton's time, and has been explored in depth by ROBERT K. MERTON, ON THE SHOULDERS OF GIANTS: A SHANDEAN POSTSCRIPT NEW APPROACHES TO NUMERACY (Lynn Arthur Steen ed., Nat'l Acad. Press 1990) (1965). Note that the calculus dispute boiled down to a priority dispute, where Leibniz was the first to publish, while Newton claimed that he was the first to invent. Newton argued that he had been isolated and unable to communicate his discovery during an outbreak of the bubonic plague. Even today, the U.S. follows the first to invent system that would grant rights to Newton while the rest of the world generally follows the first to publish system that would favor Leibniz.

[34] The United Kingdom signed the PCT in 1970. Note that the terms of the PCT were extended to the Isle of Man in 1983. The PCT is an international treaty with over one hundred member states. The PCT is part of the World Trade Organization ("WTO") and a complete list of member states may be found *at* http://www.wipo.int/pct/en/access/legal_text.htm.

[35] *Id.* The PCT is coordinated through the group is called the World Intellectual Property Organization ("WIPO"), *available at* http://www.wipo.int/pct/en/treaty/about.htm.

[36] *Id.*

[37] *Id.* Under PCT Article 39, a request for international examination before the end of the 19-month time period following application will extend the 20-month (Chapter 1 period) to a 30-month (Chapter 2 period) time for deferral. Thus, 30 months may be the maximum time period that the application 'ticket' purchases in deferred filing, search, attorney, and office fees.

[38] Note further, that under PCT Article 8, an additional twelve-month time period can result from a claim in a PCT application to an earlier filed related national application in any member country. For more general information on various aspects of the PCT process see the WIPO website *at* http://www.wipo.org/pct/en/index.html.

Similarly, the Convention on the Grant of European Patents, better known as the European Patent Convention ("EPC"), enables inventors who wish to get a patent in a number of European countries to file a single application instead of a plurality of identical applications in each member's national office.[39] However, the EPC provides only one procedure leading to grant of a patent, unlike the PCT that allows as many parallel procedures of grant as there are countries involved in the filing.[40]

The EPC went into effect on October 7, 1977.[41] The European Patent Office began accepting filed applications on June 1, 1978. Presently, there are twenty-eight countries listed as contracting states to the EPC, with another five countries listed with extension status.[42] Extension states are not full members of the EPC, but are states that have concluded special bilateral agreements with the European Patent Office. Those states with extension status extend partial benefits of granted patents under special terms to such member states at additional costs.[43]

Finally, it should be noted that the European Union ("EU") is a separate organization different from the EPC. The EU has only twenty-five members, including the ten that recently were admitted in May. Although membership in the EU and EPC overlap, there are several countries in one of the organizations, but not the other.[44] But although they are separate organizations, both the EU and the EPC have a common goal of seeking ways to integrate member interests, which includes harmonizing member states' patent laws.[45] This harmonization of members' patent laws will be addressed in the following section.[46]

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[39] *See* EPC Art. 2. Note that the full European Patent Convention can be viewed online *at* http://www.european-patent-office.org/legal/epc.

[40] The EPC provides for grant of a unitary European patent via the central European Patent Office, in contrast to the PCT, where an application for patent only becomes a patent once it passes through a national countries individual patent office.

[41] The seven countries initially involved were: Belgium, France, West Germany, Luxembourg, Holland, Switzerland, and the United Kingdom.

[42] These twenty-eight countries presently include Austria, Belgium, Bulgaria, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Hellenic Republic, Hungary, Ireland, Italy, Liechtenstein, Luxembourg, Monaco, Netherlands, Poland, Portugal, Spain, Romania, Slovakia, Slovenia, Sweden, Switzerland, Turkey, and last but not least, the United Kingdom (known with the initials GB for Great Britain). A full list of EPC countries and additional links to each member states patent office, as well as to other related national offices, patent databases, and important legal documents can be found *at* http://www.european-patent-office.org/online/index.htm#Patent.

[43] These extension countries presently include Albania, Croatia, Lithuania, Latvia, and the Former Yugoslav Republic of Macedonia. The European Patent Office website projects that additional extension agreements may be concluded with Bosnia and Herzegovina, as well as with several Asian countries in the near future.

[44] Five extra countries to the EPC that are not members of the EU include Liechtenstein, Monaco, Romania, Switzerland, and Turkey. EU member Lithuania is an extension state of the EPC, while EU member Malta is not involved with the EPC. See EU member listing *at* http://www.europa.eu.int/abc/print_index_en.htm.

[45] *Id.*

[46] *See infra* Section I.B. A summary of the EU from their website *at* http://europa.eu.int/abc/index_en.htm# reads:

> The European Union is a family of democratic European countries, committed to working together for peace and prosperity. It is not a State intended to replace existing states, but it is more than any other international organization. The EU is, in fact, unique. Its Member States have set

The actual procedures of practice before the European Patent Office include the following steps: (1) submitting an application, (2) subsequently examining the application for formalities and (3) performing a search that is reported with a published application.[47] This practice is similar to the entire process of the PCT, which ends at this point.[48] The European Patent Office continues with a substantive examination and grant of any patent meeting all EPC requirements.[49] The European Patent Office provides an opposition period to allow others to oppose the granted patent on any grounds that the European Patent Office may have missed, but such oppositions are limited to the nine-month window immediately following the grant.[50] The grant of the EPC patent leads to national patents being granted in all applicant designated EPC countries, which can include the U.K., through a process called validation, and translations, if necessary, are provided along with appropriate fees.[51]

The procedures of the U.K. Patent Office are similar up to this point, but the opposition period is called revocation, and it can continue throughout the life of any patent instead of the nine-month window mandated by the EPC.[52] It should also be noted that any British national must seek written governmental permission for filing applications in other offices outside the U.K., unless an application has been pending at the U.K. national office for longer than six weeks with no prohibiting instructions having been issued.[53]

B. Retained National Law for Infringement and Licensing

In addition to receiving direct national and PCT patent applications, the U. K. Patent Office located in Newport, South Wales, also provides assistance with patent revocation and issues relating to entitlement, such as who can be properly termed an owner and/or an inventor.[54] However, once a patent has validly been granted in the U.K. using any of the above procedures, the specific national laws of the U.K. come into force and can be used to enforce the patent with infringe-

up common institutions to which they delegate some of their sovereignty so that decisions on specific matters of joint interest can be made democratically at the European level. This pooling of sovereignty is also called "European integration."

47 *See* Part IV of the EPC arts. 90-93 *available at* http://www.european-patent-office.org/legal/epc/e/ma1.html#CVN.

48 *See supra* note 38 (discussing PCT).

49 *See* Part IV of the EPC arts. 94-98 *available at* http://www.european-patent-office.org/legal/epc/e/ma1.html#CVN.

50 *See* Part V of the EPC arts. 99-105 *available at* http://www.european-patent-office.org/legal/epc/e/ma1.html#CVN.

51 Note that validation is generally automatic in each EPC member country once procedural and payment steps are properly performed. *See* EPC arts. 64-67 *available at* http://www.european-patent-office.org/legal/epc/e/ma1.html#CVN.

52 *Compare* Art. 72 of the United Kingdom Patent Act of 1977 (setting term as life of patent) *with* EPC art. 99 (setting term as 9 months).

53 *See* art. 23 of the United Kingdom Patent Act of 1977.

54 For more information on the U.K. Patent Office, including their London front office, overall organization, policies, and broader roles that include copyrights, design rights, and trademarks, please consult their website *at* http://www.patent.gov.UK/.

ment actions or licensing deals.[55] The enforcement of a patent in Europe is wholly a matter for domestic courts and laws.[56] Some of these laws have been harmonized with EPC and EU directives, yet this key step of patent practice is where many possible conflicts can develop between identical patents treated under differing European national laws and traditions.[57] For example, the common law tradition in England clearly contrasts with the civil law tradition on the continent in the use of expert evidence and with discovery procedures, which can greatly influence patent litigation.[58]

Licensing of patent rights presents both contractual and EU issues in terms of competition and fair trade. Express licensing of a European patent between private parties can be done under a private contract providing that the national laws of a particular country, such as the U.K., govern. Implied licensing arises under the doctrine of "Exhaustion-of-Rights" under the terms of the European Community ("EC") Treaty.[59] Permissible contractual licensing falls under the EC Articles 81 and 82 dealing with unfair competition and antitrust, while "Exhaustion-of-Rights" doctrine arises under the European Court of Justices interpretation of EC Articles 28, 29, and 30.[60] Questions of law under the EC can lead to transfer

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55 Licensing largely pertains to analogous local nation-state contract law independent of broader EU constraints. Licensing is similarly non-federalized in the United States such that federal courts will not take jurisdiction over licensing matters unless a federal patent right is directly implicated. Consequently, local state law generally governs licenses in the United States. Licenses also may act as contractual permission for limited infringement. Enforceability of license contract provisions may sometimes depend on the relevant nation-state local law as it applies to forum selection or choice-of-law provisions. *See, e.g.*, EUGENE F. SCOLES ET AL., CONFLICT OF LAWS § 18 (3d ed. 2000) (discussing contracts generally).

56 *See* EPC art. 2(2); EPC art. 64(1).

57 Infringement is simply an act that interferes with an exclusive right of a patent owner, which can include making, using, selling, offering for sale, or importing without the patent owner's permission a product covered by the claims of a valid patent. *See, e.g.*, Art. 60 of the United Kingdom Patent Act of 1977. Of course, the question of whether a patent is valid opens a kaleidoscope of litigation opportunities that shift from an opposition to a revocation procedure over time, as well as always surfacing in actual court actions or business planning strategies in dealing with invalid patents. *See, e.g., supra* note 52 (comparing revocation and opposition).

58 Discovery under a civil law system can be much more restricted than under a common law system. Such discovery differences clearly impact the evidence available for trial. *See generally* JOHN H. MERRYMAN, THE CIVIL LAW TRADITION , AN INTRODUCTION TO THE LEGAL SYSTEMS OF WESTERN EUROPE AND LATIN AMERICA 110-23 (2d ed. 1985) (discussing civil law tradition and comparing it to common law tradition). Note further that the rise of constitutionalism in Europe may diminish the emphasis on civil code systems. *See id.* at 156-57.

59 For detailed cites to EC Articles' text, see the Treaty Establishing the European Community (consolidated text) *at* http://europa.eu.int/eur-lex/en/search/search_treaties.html.

60 Note that EC Article 82 deals with monopolistic abuse of a dominant position, and EC Article 81 deals with collusive conduct such as partitioning patent rights by territorial allocation. Note that the extra-territorial jurisdictional reach of these articles may present problems to non-residents of the EU. Furthermore, the doctrine of "Exhaustion-of-Rights" parallels the U.K. concept of implied consent in determining when a marketed product becomes free from a patent restriction on free-trade and use, especially when transferred downstream third parties in commerce and/or across EU member borders with a different patent system. Express consent may also arise by action of the patentee, whereas implied consent more commonly arises by inaction of the patentee. For reference to antitrust laws in the United Kingdom, see Competition Act 1998, *available at* http://www.hmso.gov.uk/acts/acts1998/19980041.htm. In comparison and for reference to patent and antitrust laws in the United States, see Walker Process Equip., Inc. v. Food Mach. & Chem. Corp., 382 U.S. 172 (1965); see also Sherman Act of 1890, 15 U.S.C. §§ 1-7 (2002); Clayton Act of 1914, 15 U.S.C. §§ 12-19, 21-27 (2004).

from a national U.K. court to the European Court of Justice under default EC Article 234.[61] Thus, while the EPC governs issues related to patents themselves, the EC Treaty can come into play when those patents are later exploited and applied commercially.

1. Conflicts between U.K. and Germany

An exemplary conflict situation where substantive patent laws of member EPC countries diverged occurred with the *Epilady* cases, which pitted the U.K. against Germany.[62] Both British and German courts differed in their interpretations of the same European Patent claims under identical factual infringement proceedings. Inconsistent lower court opinions were both reversed upon appeal, resulting in inconsistent appellate opinions, although the courts of both countries were guided by Article 69 of the EPC.[63]

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[61] EC Article 234 reads in part as follows:

> Where such a question is raised before any court or tribunal of a Member State, that court or tribunal may, if it considers that a decision on the question is necessary to enable it to give judgment, request the Court of Justice to give a ruling thereon.
>
> Where any such question is raised in a case pending before a court or tribunal of a Member State against whose decisions there is no judicial remedy under national law, that court or tribunal shall bring the matter before the Court of Justice.

See http://europa.eu.int/eur-lex/lex/RECH_traites.do.

[62] *See, e.g.*, Improver Corp. v. Remington Consumer Prod. Ltd. [1990] 17 F.S.R. 181 (Ch. Pat. Ct. 1989) (discussing both English and German cases from trial to appeal). Generally, *Improver* applies to the English cases, while *Epilady* applies to the German cases. This paper will use *Epilady* to refer to both. *See generally*, John Hatter, *The Doctrine of Equivalents in Patent Litigation: An Analysis of the Epilady Controversy*, 5 IND. INT'L & COMP. L. REV. 461 (1995). Another exemplary conflict case that again involved claim interpretation was the Mabuchi Motors cases in London and Munich. *Compare* Mabuchi Motor K.K.'s Patents [1996] R.P.C. 1996, 387 *with* Johnson Elec. Indus. Mfg. Ltd. v. Mabuchi Motor Co. Ltd. [District Court of Munich] (1996) R.P.C. 411 (showing that U.K. and German courts differ on claim construction for infringement: where the German court broadly finds infringement and the U.K. narrowly finds no infringement).

[63] EPC Article 69 reads as follows:

> Extent of protection
>
> (1) The extent of the protection conferred by a European patent or a European patent application shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims.
>
> (2) For the period up to grant of the European patent, the extent of the protection conferred by the European patent application shall be determined by the latest filed claims contained in the publication under Article 93. However, the European patent as granted or as amended in opposition proceedings shall determine retroactively the protection conferred by the European patent application, in so far as such protection is not thereby extended.

at http://www.european-patent-office.org/legal/epc/e/ar65.html. Article 69 is also annotated with reference to see Protocol on the Interpretation of Article 69 of the Convention, adopted at the Munich Diplomatic Conference for the setting up of a European System for the Grant of Patents on October 5, 1973, as set out below:

> Article 69 should not be interpreted in the sense that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patentee with a reasonable degree of certainty for third parties.

See http://swpat.ffii.org/papers/muckonf73/muckonf73.en.pdf.

In the *Epilady* Cases, a small company named Improver invented a machine to remove leg hair, patented the machine, and licensed the rights to a start-up company.[64] However, the machine caused a certain amount of pain for the user, and another much bigger company, Remington, improved upon it.[65] The improved machine, which was less painful, was based on a more forgiving rubber hair removal process, rather than a steel spring hair removal process, and Remington began marketing it competitively. To defend the patent rights, Improver was forced to bring suit for infringement in several European countries, including Germany and the U.K. Previously, Improver's patents had been issued under the EPC and identically granted and validated under both countries' national laws after surviving opposition before the European Patent Board of Appeals.[66]

Due to substantive national law discrepancies, the infringement actions turned out dramatically different in the two countries. The jurisprudence of Germany treated patent claims like "guide-posts" that encompass the main ideas and central teachings of the patent.[67] Alternatively, the jurisprudence of England treated patent claims like "fence-posts" that mark the boundaries of the patent with specific words, and whatever is not claimed is considered "disclaimed."[68] The EPC had already recognized this potential conflict in Article 69, splitting the difference with an attempted compromise.[69] Article 69 states that the claims should neither be read literally nor as a guideline, but instead should be somewhere in between.[70]

After a lengthy appellate process, both appellate courts reversed their lower trial courts; German courts held that the patent was infringed while the English courts held that the patent was not infringed.[71] Both countries claimed that they had followed Article 69, while the other country had not.[72] Put simply, the difference in interpretation appears because the German courts apply the "idea" ap-

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The annotation reference to Article 69 tries to split the difference between U.K. and Germany positions by suggesting courts follow neither. In the U.S. this controversy in certainty has been partly mirrored in the *Festo* case. *See* Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722 (2002) (discussing application of prosecution history estoppel to claim interpretation and infringement by doctrine of equivalents); *see also* Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 21 (1997) (discussing claim scope under doctrine of equivalents).

[64] *See* European Patent No. 101,656 to a Depilatory Device. The patented claim called for a helical spring while the alleged infringement device made use of a cylindrical rod of elastomerised synthetic rubber for removing unflattering body hair.

[65] *See supra* note 62.

[66] *See* EPO Case Number T 0754/89 - 3.2.3, *available at* http://legal.european-patent-office.org/dg3/biblio/t890754eu1.htm (finding inventive step under EPC Article 56 covering non-obviousness of the device).

[67] *See supra* note 62.

[68] *Id.*

[69] *See supra* note 63 (setting out protocol developed as compromise).

[70] *See id.* (setting out annotated text of EPC Art. 69). *See also* David Cohen, *Comment Article 69 and European Patent Integration,* 92 NW. U. L. REV. 1082 (1998).

[71] *See* Improver Corp. v. Remington Consumer Prod. Ltd. [1990] 17 F.S.R. 181 (Pat. Ct. 1989) (discussing both English and German cases from trial to appeal). *See also* Cohen, *supra* note 70, at 1083-84.

[72] *Id.*

proach, protecting the idea of the patent against the idea of the infringing device.[73] In contrast, the English courts apply the "word" approach, literally protecting the words as components of the patent against the actual components of the infringing device in an atomistic manner.[74] Thus, in the U.K. the equivalents are not the similar ideas of the two items being compared as would be examined in Germany, but rather the equivalents represent tight variations on the actual technical disclosure itself.[75]

German practice generally accords a broader scope of patent protection than the English practice does. In the *Epilady* case, the claim element "helical spring" had been replaced in the accused infringement embodiment by a slitted rubber rod.[76] In the U.K., the Court of Appeal decided that the term "helical spring" could not cover a slitted rubber rod because there was no suggestion that the inventors of the Epilady device had considered using a rubber rod and there was no suggestion in the specification that a rubber rod might be the equivalent of a helical spring (a rubber rod would in a loop configuration, the plaintiff's preferred embodiment, lead to hysteresis problems).[77] Applying the *Catnic* test,[78] the U.K. court held that the alleged infringement satisfied the first two parts of the test, but not the third; a restricting intention was found because a wide generic claim would not have been accepted by the patent office and was therefore found to be a non-infringement of the patent. In Germany, however, the Düssel-

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[73] *See* Cohen, *supra* note 70, at 1120-21.

[74] *Id.*

[75] *Id.* Note that equivalents is a term of art used to read the claims broadly or narrowly onto an infringing device that does not appear clearly and literally inside the scope of the written claims as interpreted by judicial construction. *See* Catnic v. Hill & Smith, *Ltd.* [1982] R.P.C. 1982, 183 setting out a three-part "purposive construction" test later used in the *Epilady* cases. In *Catnic* the House of Lords considered a patent for galvanized steel lintels intended to span the spaces above window and door openings in brick walls. The patent claimed a lintel in the form of a box-girder having a rigid support "extending vertically" from the girder's top to its bottom. The accused device was almost identical, except that its support was tilted six to eight degrees from the vertical. The Lords criticized the historical practice of treating "textual" infringement and the doctrine of equivalents as separate and independent infringement actions. They held that only one test for infringement exists, and this test requires that the patent claim be given a "purposive construction" appropriate to those skilled in the art. When an accused device varies from a particular claim, the main issue becomes whether a person of skill in the art would understand that the patentee intended strict compliance with that term to be an essential requirement of the invention. The Lords concluded that any builder would find obvious, with reference to a component of a lintel, that the patentee could not have intended the phrase "extending vertically" to make exact verticality an essential feature of the invention. Accordingly, the House of Lords found infringement.

[76] *See* Hatter, *supra* note 62, at 475-76.

[77] *See* Improver Corp. v. Remington Consumer Prod. Ltd. [1990] 17 F.S.R. 181 (Pat. Ct. 1989).

[78] The three-part *Catnic* test asks the following questions: (i) Does the variant (i.e. the difference between the alleged infringing article and the expressly claimed article) have a material effect upon the way the invention works? If yes, the variant is outside the claim. If no: (ii) Would the fact that the variant has no material effect upon the way the invention works have been obvious at the date of the publication of the patent to a reader skilled in the art? If no, the variant is outside the claim. If yes: (iii) Would a reader skilled in the art nevertheless have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention? If yes, the variant is outside the claim. If no, the variant is an equivalent within the scope of the claim. *See* Catnic v. Hill & Smith [1982] R.P.C. 1982, 183. *See also supra* note 75 (discussing the facts of the *Catnic* case).

dorf Landgericht found for infringement.[79] The court interpreted the claims more functionally and concluded that the slitted rubber rod operated in essentially the same way as the helical spring and found that the substitution was disclosed in the claims when read in view of the description through the eye of man skilled in the art.[80]

2. *Conflicts between the U.K. and the EPC*

Two illustrative areas where the substantive laws of the EPC and the U.K. may differ include the amount of respect accorded to computer inventions and the procedures of patent revocation. The area of computer inventions represents a leading edge of technology relevant to the marketplace today and one that often crosses international borders quite readily. Patent revocation is of national interest in the U.K. for purely domestic reasons, but competitors may often wish to invalidate a European patent to practice it solely in the U.K. For convenience, this article will first discuss revocation and then will discuss excluded subject matter, such as computer software. Simply put, patent revocation can occur at any time during the life of the patent in the U.K., as a matter of law. Conversely, the EPC procedure for revoking and/or amending a granted patent ceases after only nine months from the grant date.[81] The use of EPC procedures results in a uniform change by amendment or cancellation to all the countries which have been designated, while the U.K. revocation applies only within the U.K. itself.[82]

A revocation in the U.K. is performed upon application to the Comptroller of the U.K. Patent Office or to the Patent Courts in the U.K.[83] The grounds for revocation include failure of disclosure (patent fails to enable the invention claimed or teach the public how to use it), entitlement (correction of patent inventorship or ownership within two-years from the patent grant), matter granted is broader than originally filed upon (improper amendment or other mistake), and that the invention was not patentable under domestic law.[84]

The standard for obviousness is also different under U.K. law than that applied by the European Patent Office.[85] An illustration of differences in U.K. and EPC

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[79] Oberlandesgericht [OLG] [Düsseldorf Court of Appeals] Düsseldorf, Gewerblicher Rechtsschutz und Urheberrecht Internationaler Teil [GRUR Int.] 1993, 242, translated in 24 Int'L Rev. of Indus. Prop. & Copyright L. [I. 1993, IC] 838 (1993).

[80] *See id.*

[81] *See* EPC art. 102.

[82] Other EPC member countries may of course find such U.K. actions persuasive in their respective countries, but each country is responsible for the enforcement of patent challenges within their respective borders during the course of a patent's life.

[83] *See* art. 72 of the United Kingdom Patent Act of 1977.

[84] *Id.*

[85] Note that the U.K. standard uses a four-part test based on the *Windsurfer* case (Windsurfing International Inc. v. Tabur Marine (Great Britain) Ltd. [1985] R.P.C. 1985,59), which is much more similar to the U.S. standard based on the *Graham* case (Graham v. John Deere Co., 383 U.S. 1 (1966)) than that of the 2-part "inventive step" standard applied by the EPC under article 56. Again, the primary differences appear to rely on the construction and use of the hypothetical person of ordinary skill in the art, which is an objective-reasonableness standard more easily addressed under the common law. Other key differences may arise from differences in the systems of evidence and use of experts.

patent law can be seen in computer inventions in the U.K. They are generally accorded narrower treatment in the U.K. Patent Office than in the European Patent Office. This is due, in part, to the U.K. Patent Office administrative deference to the U.K. Courts.[86] In the cases of *Raytheon's Application* [1993] R.P.C. 427 and *Wang's Application* [1991] R.P.C. 463, this narrow approach applied where the Patents Court held that claims to a computer program were unpatentable as a mere mental act.[87] In *Fujitsu's Application,* a method of modeling a chemical crystalline structure was even held unpatentable as being in reality no more than a computer program.[88] This narrow approach states that the computer program must be severed from the nature of any invention and not used as a basis for any patentability determination.[89]

In contrast, the European Patent Office has permitted computer programs to be patentable when they solve a technical problem as part of a product or process.[90] This is consistent with the modern trend under the general emerging law of sales, as seen in the UCC and the CISG, which treats software embedded within a good as a good itself, while software that is not embedded within a good is considered to be intangible.[91] Similarly, Article 52 of the EPC still strictly prohibits patent-

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[86] The U.K. Patent Office is administratively bound to follow and abide by the U.K. Courts interpretations of patentability. *Cf.* Art. 18 of the United Kingdom Patent Act of 1977.

[87] *Wang's Application* rejected software directed to a conventional computer programmed with a knowledge database. *Wang Lab. Inc.'s Application* R.P.C. 1991, 463, while *Raytheon's Application* rejected a digital imaging system for ships that compared silhouettes of known objects with the captured image in order to identify it. *Ratheon Co.*'s *Application* R.P.C. 1993, 427. Both patent applications were rejected as mere mental acts that were unpatentable subject matter. *Cf.* Article 1(2) of the United Kingdom Patent Act of 1977 that reads as follows:

> It is hereby declared that the following (among other things) are not inventions for the purposes of this Act, that is to say, anything which consists of – (a) a discovery, scientific theory or mathematical method; (b) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever; (c) a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer; (d) the presentation of information; but the foregoing provision shall prevent anything from being treated as an invention for the purposes of this Act only to the extent that a patent or application for a patent relates to that thing as such.

[88] *Fujitsu's Application* [1996] R.P.C. 1996, 511, Patents Court, [1997] R.P.C. 1997, 608 (App. Ct.), Court of Appeal. Mr. Justice Laddie stated that the excluded 'mental act' subject matter concerned substance and not software form. Thus, the U.K. court or U.K. patent office must direct its attention to what the computer is actually doing to the outside world and not to what the program is doing inside the computer world. In *Fujitsu's Application* the program depended upon the skill of the user in inputting, manipulating and interpreting the chemical data, and so was excluded as a mental act.

[89] *Id.*

[90] Under the EPC Article 52 mathematical methods and computer programs are generally not patentable by themselves, but their application may be patentable if it has technical character. *See, e.g.,* Vicom/ Computer-related invention [1987] 1 O.J.E.P.O. 14 (T208/84) (finding a mathematical method for digital image enhancement to be patentable based on a contribution to the field of art in a non-excluded area: image enhancement instead of software).

[91] *See, e.g.,* U.C.C. § 9-102 (44) (wherein the recently revised Article 9 defines 'goods' and refers to embedded computer programs); CISG art. 1 (1) & art. 7 (1) (wherein the United Nations Convention on Contracts for the International Sale of Goods ("CISG") refers to 'goods' but leaves open the definition as a gap-filling term to be determined under private international law or the rules under the governing jurisdiction under conflicts of law principles, which in the case of many contracts for goods would relate back to the U.C.C.).

ing of stand-alone computer programs.[92] The EPC also appears to permit patentability when that patent is attached to a process.[93]

Finally, it is important to note that computer program patent protection overlaps with copyright law in the U.K. The European Patent Office is not concerned with copyright issues at all, while the U.K. Patent Office has responsibility for copyright issues in the U.K.[94] Thus, the potentially narrower approach in the U.K. may be part of a procedure to channel cases into copyright protection and avoid issues of overlap. In contrast to both the U.K. and the rest of Europe, the United States Supreme Court has approved software patents.[95]

C. Other Issues in Patent Law: Italian Torpedoes and TRIPs

Interestingly, the English Patents Court has, on at least one occasion, followed the laws of the EPC in the face of contradictory U.K. law. In the case of address-

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[92] EPC art. 52, §§ 1-4 read as follows:

Patentable inventions

(1) European patents shall be granted for any inventions which are susceptible of industrial application, which are new and which involve an inventive step.

(2) The following in particular shall not be regarded as inventions within the meaning of paragraph 1:
   (a) discoveries, scientific theories and mathematical methods;
   (b) aesthetic creations;
   (c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;
   (d) presentations of information.

(3) The provisions of paragraph 2 shall exclude patentability of the subject-matter or activities referred to in that provision only to the extent to which a European patent application or European patent relates to such subject-matter or activities as such.

(4) Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practiced on the human or animal body shall not be regarded as inventions which are susceptible of industrial application within the meaning of paragraph 1. This provision shall not apply to products, in particular substances or compositions, for use in any of these methods.

Thus, EPC Article 52 (2) mirrors the language of U.K. Patent Act Article 1 (2), but the strength of the court system in the U.K. carries a more stringent interpretation. Note that both the U.K. and the E.P.C. also exclude inventions contrary to morality and public policy. *Compare* EPC Article 53 *with* U.K. Patent Act Article 1 (3). Note that corresponding PCT Article 33 (1) contains neither set of exclusions.

[93] *Compare* In re Sohei, 1995 O.J.E.P.O. 525, 538-39 (Tech. Bd. App. 1994), *available at* http://legal.european-patent-office.org/dg3/biblio/t920769ep1.htm (covering an inventory management system that was patentable as a whole despite software features that were excluded under EPC Article 52) *with* In re Pension Benefit Sys. P'ship, 2001 O.J.E.P.O. 441, 450 (Tech. Bd. App. 2000), *available at* http://legal.european-patent-office.org/dg3/biblio/t950931eu1.htm (rejecting a business method where the addition of a technical feature to an otherwise unpatentable method did not render the combination patentable).

[94] *See, e.g.*, the webpage of the U.K. patent office *available at* http://www.patent.gov.uk/copy/index.htm. Note that the United States Patent Office does not have responsibility for copyright, which is instead placed under the Library of Congress in the legislative branch of government. *See* http://www.copyright.gov/ for additional detail on the US Copyright Office.

[95] *See* Diamond v. Diehr, 450 U.S. 175 (1981); State Street Financial Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368 (Fed. Cir. 1998). Note that the extension of software patents into the controversial area of business-method patents seen in the U.S., such as with the Amazon.com one-click Internet shopping cart case, presently remains unique to the U.S. *Cf.* Amazon.com v. Barnesandnoble.com, 239 F.3d 1343 (Fed. Cir. 2001) (questioning U.S. Patent No. 5,960,411 and vacating preliminary injunction); James Gleick, *Patently Absurd*, N.Y.TIMES, Mar. 12, 2000, Mag. at 44 (reflecting popular criticism).

ing earlier filing priority, Article 87 of the EPC provides that priority can be lost if the subject matter claimed with an earlier priority document is invalid or outside the scope of the later issued claims. The decision of *Beloit Technologies, Inc. v. Valmet Paper Machinery Inc.* [1995] R.P.C. 705 case apparently disregarded the U.K. Patents Act of 1977, section 6 (1), stating that invalidity would not arise due to 'intervening acts' occurring during the priority period. Thus, this case suggests that on some matters relating to granting of patents, the EPC rules may be applied in lieu of U.K. laws on certain matters within judicial discretion.

Other issues of patent law include cross-border injunctions (popularly known as Italian torpedoes) and TRIPs harmonization under the WTO.[96] First, cross-border injunctions arise under the Brussels Enforcement Convention of 1968 dealing with recognition of judgments and jurisdiction.[97] Under Article 21 of the Brussels Convention, a defendant can force selection of an EU country forum by starting proceedings in one country, which causes any parallel proceedings in all other EU countries to cease.[98] This tactic developed the name 'Italian torpedo' in the face of Dutch patent courts which actively grant preliminary trans-national injunctions forbidding infringement.[99] The idea of the torpedo refers to a defendant who files under threat of infringement in a country far away from the Dutch court, or any other court that would grant such an injunction, and seeks to stay any other nation's proceedings.[100] Thus the defendant might avoid injunctive relief until litigation has been completed at some distantly future date (with the Italian court system being an example of generally very slow litigation).[101] The Brussels Convention has been criticized by an English judge, who held it inappropriate to judge infringement of foreign patents because infringement is entangled with invalidity.[102]

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[96] The Global Agreement on Tarrifs and Trade ("GATT"), completed in April 15,1994, includes specific provisions of Trade Related Aspects of Intellectual Property ("TRIPs")., Annex 1C, which is titled Agreement on Trade-Related Aspects of Intellectual Property Rights.

[97] Text of the treaty is *available at* http://www.curia.eu.int/common/recdoc/convention/en/c-textes/_brux-textes.htm.

[98] Article 21 reads as follows:

> Where proceedings involving the same cause of action and between the same parties are brought in the courts of different Contracting States, any court other than the court first seised shall of its own motion stay its proceedings until such time as the jurisdiction of the court first seised is established.
>
> Where the jurisdiction of the court first seised is established, any court other than the court first seised shall decline jurisdiction in favour of that court.

[99] Dutch courts use a *Kort geding* procedure that imposes penal fines in the local jurisdiction in Holland, but also requires posting of a bond related to the size of potential infringement trans-nationally. *See, e.g.*,Wolfgang Meibom and J. Pitz, *Cross-border Injunctions in International Patent Infringement Proceedings* [1997] E.I.P.R.E.I.P.R. 1997, 19(8), 469. Note that under the 'loser pays' rule in England, the defendant may face a risk of paying attorneys fees in addition to mere damages under the infringement.

[100] *See* art. 21, *supra* note 98.

[101] *See* Vincenzo Jandoli, *The Italian Torpedo*, 31 INT'L R. INDUS. PROP. & COPYRIGHT L. [I. 2000, 783IC] 783 (2000) (discussing, among other items, how joining an action with an Italian party makes Italy a favorable forum because of the slower legal system and general disfavor of rapid preliminary injunctions).

[102] *See, e.g.*, Fort Dodge Animal Health Ltd.v. Akzo Nobel NV E.I.P.R. 1998 20(2), 29 INTERNATIONAL REVIEW OF INDUSTRIAL PROPERTY & COPYRIGHT LAW .927, [1998] F.S.R. 222 (CA); Coin Con-

Another aspect of international patent law rests on the TRIPs agreements that came into force with the accession of many countries to the WTO in 1994. The Uruguay round of WTO negotiations introduced TRIPs into GATT and bravely attempted to harmonize global patent systems with uniform standards of protection.[103] However, TRIPs provisions are not directly enforceable by patentees; the provisions merely impose an obligation upon member nations to enact legislation enforcing required rights.[104] Both the U.S. and the U.K. have made changes to their laws in response to these provisions (e.g., on bringing the term of patents to twenty years from the time of filing of an application).[105]

II. British Patent Systems and Practice

> [T]hat we but teach Bloody instructions, which, being taught, return To plague the inventor. This even-handed justice Commends the ingredience of our poisoned chalice To our own lips.[106]

This section will discuss the respective roles of chartered patent attorneys, patent solicitors, and patent barristers. It will also examine recent reforms and rights of audience that these actors have in the B.ritish legal system, particularly in the courts of Chancery. Finally, a note on three recent substantive patent cases in the House of Lords will be provided.

A. Patent Attorneys, Solicitors, and Barristers

The British legal system is traditionally simplified to be comprised of solicitors and barristers, where barristers have the role of oral-advocates while solicitors deal with clients and written legal preparations.[107] Throughout history, there was little overlap but recently some solicitors have obtained rights of audience in their roles as solicitor-advocates. However, there is an oft-ignored third branch of specialized lawyers in the U.K. that practice as chartered patent attorneys and

trol Ltd. v. Suzo Int'l (UK) Ltd. [1997] F.S.R. 660, 19 E.I.P.R. D-187, 29 INTERNATIONAL REVIEW OF INDUSTRIAL PROPERTY & COPYRIGHT LAW [IC] 804.

[103] *See* Final Act Embodying the Results of the Uruguay Round of Multilateral Trade Negotiations, Annex 1C: AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS [hereinafter TRIPs], 33 I.L.M. 1125, 1197 (1994), *available at* http://www.wto.org/english/docs_e/legal_e/27-trips.pdf.

[104] *See* TRIPS §33. *See also* Brett Frischmann, *A Dynamic Institutional Theory of International Law*, 51 BUFF. L. REV. 679 (2003); Graeme Dinwoodie, *The Role of the National Courts: The Architecture of the International Intellectual Property System*, 77 CHI.-KENT L. REV 993 (2002) (both discussing ways in which the international intellectual property system is evolving and enforced).

[105] *Cf.* 35 U.S.C. § 154 (2002); E.P.C. §63(1). For amendment information in the United States see *Uruguay Round Agreements Act* [hereinafter URAA], Pub. L. No. 103-465 (1994), §532(a)(1) (amending 35 U.S.C. § 154 to include the new patent term). Note that the United Kingdom maintained a sixteen-year term before joining the EPC. *See* Patents Act of 1949, §22, *available at* http://www.jenkins-ip.com/patlaw/pa49.htm.

[106] WILLIAM SHAKESPEARE, MACBETH act 1, sc. 7 (Louis B. Wright & Virginia A. LaMar eds., Washington Square Press 1959).

[107] *Cf.* Maimon Schwarzschild, *The English Legal Professions: An Indeterminate Sentence*, 10 FED.SENT.R. 253 (1998); Maimon Schwarszchild, *Class, National Character, and the Bar Reforms in Britain: Will there always be an England?*, 9 CONN. J. INT'L L. REV. 185 (1994).

who also have obtained rights of audience to certain courts.[108] Patent attorneys are licensed separately from solicitors and thus are prevented under Law Society rules from becoming partners in a firm of solicitors.[109] The significance of this distinction cannot be underestimated in light of the practical economics of patent practice in the U.K. in relation to the specialized knowledge required for both British and European practice. A similar distinction exists in many American states for sharing partnership revenue with a patent agent registered before the U.S. Patent Office but who is not a lawyer registered with a state bar.

The Chartered Institute of Patent Agents acts as the licensing body in the U.K. and it generally requires about a four-year, in-house apprentice period before an applicant is qualified to sit for the examination certificate.[110] As part of the recent review of legal services in England and Wales, the role of patent attorneys may become even more prominent in the future depending on their consideration within any new regulatory scheme.[111] Expanding reform such as in the solicitor profession to allow rights of audience and the existence of ethical oversight institutions may also bleed over into regulation of patent attorneys and patent specialists who also practice as solicitors and/or barristers.[112]

B. Special Courts in Chancery

Since 1990, the Patents County Court has been available as an alternative to the more expensive and time-consuming Chancery Division of the High Court for actions related to and arising from patent matters.[113] The Patents County Court is presently housed in the Central London Courthouse. The jurisdiction of

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[108] Patent attorneys have litigation and advocacy rights both in the Patents County Court (under the Copyright, Designs and Patents Act, 1988, § 292 (Eng)) and in the Patents Court Division of Chancery on appeal from the Patent Office (under the Patents Act, 1977, §102 (Eng)). Patent attorneys also have litigation rights in the High Court under the Courts & Legal Services Act, 1990 (Eng).

[109] *See, e.g.*, Solicitors' Practice Rules 1990, 3.03 Practice Rule 7 (setting out partnership and fee sharing limitations) *available at* http://www.lawsociety.org.uk/professional/conduct/guideonline/view=chapter.law?PARENT=80&POLICYID=80#.

[110] See the website for more information at http://www.cipa.org.uk/pages/about-careers (last visited September 23, 2004). This time period is roughly equivalent to that needed to become an agent at the European Patent Office, with the training required to be under an attorney who is registered with the European Office. Formerly, the U.S. Patent Office had an apprentice time period but no longer requires it.

[111] The consultation paper on the review of the regulatory framework is available at http://www.legal-services-review.org.uk/content/consult/review.htm, and the response with commentary from the Intellectual Property profession including the Chartered Institute of Patent Agents, is available at http://www.itma.org/uk/pdf_downloads/official_response/ClementiReview-2004.pdf (last visited Sept. 23, 2004).

[112] Note that Gray's Inn is acknowledged as the center of many patent firms based in part on the location of the former U.K Patent Office, and based in part on where the barristers who specialized in patent practice set up chambers. Also note that one such barrister was Margaret Thatcher, who acted as a barrister in specialized tax matters, but with her chemical background was rumored to have handled some patent matters.

[113] Patent attorneys obtained direct litigation rights in the High Court under the Courts & Legal Services Act, 1990 (Eng), in contrast to rights in the Patents Court Division of Chancery on appeal from the Patent Office that were obtained in 1977.

the Patents County Court covers both England and Wales.[114] Proceedings can be transferred to the High Court or maintained in the Patents County Court even if an important question of fact or law is presented.[115] However, appeals from the Comptroller of the U.K. Patent Office must go to the High Court and are not considered within the scope of jurisdiction of the Patents County Court while appeals from the Patent County Court go to the Court of Appeal and not to the High Court.[116]

Finally, Chartered Patent Attorneys may act before the High Court when appealing decisions of the Patent Office, and otherwise may do anything a solicitor might do, other than prepare a deed.[117] The Patents Court can also appoint scientific or legal experts, as well as order the U.K. Patent Office to inquire into and report on any question of fact or opinion.[118] Senior lawyers are also appointed as deputy judges as needed.

C. Recent Cases in the House of Lords

The House of Lords has recently agreed to hear three cases involving substantial patent matters. This is an exceptional time for British Patent Practice because such dynamics in the law of patents are highly unusual. For comparison, the U.S. Supreme Court has only taken only about a dozen patent cases in the last twenty years.[119]

The three cases before the House of Lords cover the areas of patent law relating to infringement, obviousness, and novelty. First, the case of Kirin-Amgen Inc. v. Transkaryotic Therapies Inc. pertains to the infringement test developed under the *Epilady* cases discussed *supra*,[120] and also regards the issue of finding a gene-sequence for a blood protein to be *per se* unpatentable.[121] Lord Hoffman, who spoke the opinion for the appellate court in the *Epilady* case , updated and affirmed his reasoning while now sitting as a Law Lord using EPC Article 69 to find no infringement of the claimed blood protein due to its ability to be produced by methods outside the scope of the disputed patent claims.[122]

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114 *See* Copyright, Designs and Patents Act, 1988, § 287 (Eng).

115 *See id.* at § 289.

116 *See* Patents Act of 1977 § 102.

117 *See* Copyright, Designs and Patents Act, 1988, § 292 (Eng).

118 *See id.* at § 291.

119 In part this may be due to the creation of the specialized Courts of Appeal for the Federal Circuit ("CAFC") in the United States, which often acts as a smaller national court of last resort on patent matters, and the Supreme Court simply does not have the expertise or interest to deal with such patent matters. *See generally* ROBERT MERGES & JOHN DUFFY, PATENT LAW AND POLICY: CASES AND MATERIALS 1155-56 (3d ed. 2002). The Court has granted certiorari to a dozen patent and patent-related cases in the past twenty years, and half of those cases dealt with process issues while only two of the cases have dealt with substantive issues. *Id.* at 1158. CAFC will be discussed in more detail below in section III.C.

120 *See supra* notes 62 and accompanying text (discussing the *Epilady* case and further describing the *Catnic* test applied for infringement in *Epilady*).

121 *See* [2002] R.P.C. 31 (Eng. C.A.), [2002] EWCA Civ 1096, (Transcript: Smith Bernal), (available on Lexis); Chancery Patents Court (Transcript: Marten Walsh Cherer) 8 Aug. 2001 (available on Lexis).

122 Kirin-Amgen Inc v. Hoechst Marion Roussel Ltd., 21 October 2004 [2004] UKHL 46. The opinion has recently been published on the House of Lords website *at* http://www.parliament.the-stationery-of-

Second, the case of *Sabaf SpA* v. *MFI Furniture Centres Ltd.* and another (i.e. Meneghetti SpA) pertains to the *Windsurfer* test for obviousness, where the appellate court criticized the trial court for using the two-part 'inventive step' test under the EPC instead of using the four-part *Windsurfer* test under national U.K. law.[123] A determination of obviousness would render the patent invalid and thus unable to be infringed. Again, Lord Hoffman reconciled the EPC and U.K. tests to show that they rendered the same result in this case, thus overturning the appellate court in favor of the trial court.[124]

Third, the case of *Synthon BV* v. *Smithkline Beecham Plc.* pertains to the issue of novelty in a revocation procedure for a patent covering the anti-depressant Paxil.[125] The prior art impacting novelty of the drug may have been insufficient to act as an enabling disclosure to revoke the patent.[126] This case further appears interesting in light of a another case recently issued in the United States.[127] The Court of Appeals for the Federal Circuit reversed and affirmed on other grounds the holding of the lower court trial judge Richard Posner sitting by designation from the Court of Appeals for the Seventh Circuit to the Northern District of

fice.co.uk/pa/ld200304/ldjudgmt/jd041021/kirin-1.htm. Paragraphs 18 through 26 introduce the issue with Article 69. Paragraphs 27 through 35 review the English rules of construction. Paragraphs 36 through 44 discuss how the doctrine of equivalents was "born of despair" about the limitations of literalism. Paragraphs 45 through 52 reconcile the *Epilady* case based on the *Catnic* case as consistent with the intermediate position of EPC Article 69. Thus, Article 69's compromise over the English position of literalism is dealt with by pointing out the obsolescent view, and that the *Catnic* 'purposive construction' is the modern view consistent with the EPC Article 69 protocol. *See id. See also supra* note 63 (setting out EPC Article 69 protocol); *supra* note 78 (reviewing the *Catnic* test). Note further, in an oceanic split, a district court in the United States has found Amgen's EPO patents to indeed be valid. See the opinions of Judge William Young of the U.S. District Court of Massachusetts in Boston.

123 *See* [2003] R.P.C. 14 (Eng. C.A.), [2002] EWCA Civ 976, [2002] All E.R. (D) 160 (Jul.) (available on Lexis), Chancery Patents Court (Transcript) 31 July 2001 (available on Lexis). *See also* Windsurfing International Inc. v. Tabur Marine (Great Britain) Ltd. [1985] R.P.C. 59; *supra* note 85 and accompanying text (discussing different tests and citing to four-part *Graham* test used in U.S. – Graham not mentioned in case). Finally, please see interviews from Justice Laddie, who handled the lower Patents Court case *Windsurfing*, in the August 19, 2002 issue of THE LAWYER and in the November 2003 issue of EUROPEAN INTELLECTUAL PROPERTY REVIEW, suggesting Justice Laddie prefers quicker more efficient court systems. *See also, infra* Section III.B.

124 Sabaf SpA v. MFI Furniture Centres Ltd., 14 October 2004, [2004] UKHL 45, *available at* http://www.parliament.the-stationery-office.co.uk/pa/ld200304/ldjudgmt/jd041014/sabaf-1.htm. The two approached were reconciled by looking at the law of collocation, where the combination of two alleged inventions in forming a gas cooking device was found to be obvious because neither involved an inventive step, as consistent under the EPC and the UK Patents Act of 1977. *See id.*

125 *See* [2003] EWCA Civ 861, [2003] All ER (D) 326 (Jun) (available on Lexis), trial level reported sub nom E.N.P.R. 10, 2002 WL 31599701 (Pat Ct (2002)).

126 An enabling disclosure is a term of art that applies the documentary information available at the time of invention against the work of a hypothetical person of ordinary skill in the art who would practice the technology without reference to anything in the patent application. If the prior art is not enabling then the hypothetical person would not be able to practice the technology and the prior art would not be sufficiently enabling to defeat the patent application on novelty or obviousness grounds. Such a term of art is generally used when attacking references applied against a patent seeking to render it invalid or not infringed. In the U.S., the enablement requirement is generally met for a patent reference document because granted patents are presumed to be enabled under 35 U.S.C. § 112, which describes the statutory requirements for sufficient technical disclosure.

127 *See* SmithKline Beecham v. Apotex Corp., 247 F. Supp. 2d 1011 (N.D. Ill. 2003) (written by Judge Posner sitting by designation).

Illinois at a bench trial.[128] Judge Posner created an interesting infringement exception in equity for *de minimus*, or unavoidable infringement due to formation of contaminant chemical seed crystals that could not be properly cleaned from the manufacturing plant, but this creative use of equity was found to be unnecessary on appeal.[129]

All three cases will significantly resonate throughout Europe, as the House of Lords will take into account the views and impact upon the national courts in other EPC countries, in a similar manner to the *Epilady* cases.[130] The first two cases may be expected to impact the level of conflict harmonization for infringement between the U.K. and the rest of Europe, while the third case may greatly impact strategies for opposing a patent first in the European Patent Office and then later opposing the patent in a national forum such as in the U.K. Patent Office.

III. America's Debt to the British System

> "The Patent System added the fuel of interest to the fire of genius." Abraham Lincoln.[131] Note that a statue of Lincoln also graces Parliament Square in London.[132]

The United States of America has a patent system that is deeply indebted to English history and principles that developed in Great Britain dating back to protests[133] against royal abuses of privileges and monopolies under the Queen Eliza-

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[128] *See* SmithKline Beecham v. Apotex Corp., 365 F.3d 1306 (Fed. Cir. 2004) (reversing and affirming on other grounds by finding no infringement of the U.S. patent on the active ingredient in Paxil due to an invalidating public use).

[129] *Id.*

[130] *See infra* Section I.B.1 and accompanying text discussing *Epilady* cases and illustrating how both German and English courts took the other nationals courts into account under EPC Article 69 in reviewing the patent issue of infringement. *See supra* note 63 and accompanying text (setting out scope of patent protection).

[131] Abraham Lincoln spoke these words in 1858 at a lecture in Springfield, Illinois. Note that in 1849, then Congressman Abraham Lincoln was granted U.S. Patent No. 6469 for an improved manner for buoying vessels over shoals. The patent is available online at http://www.uspto.gov and more information on Lincoln as an inventor is available online *at* http://inventors.about.com/library/inventors/blkidprimer6_12pres.htm.

[132] Amazingly, the Lincoln statue is a replica of Augustus Saint-Gauden's original statue that sits in Chicago's Lincoln Park. An image of the statue is available online *at* http://goeurope.about.com/library/phot/bl_abe_lincoln.htm.

[133] *See* 1601 Parliamentary Debates Concerning Monopolies, *in* ELIZABETH I, COLLECTED WORKS at 346 (Leah S. Marcus et al. eds., 2000) ("And to what purpose is it to do anything by act of Parliament when the queen will undo the same by her prerogative? [T]here is no act of her that hath been or is more derogatory to her own majesty and more odious to the subject or more dangerous to the commonwealth than the granting of these monopolies"). Queen Elizabeth responded with her famous 'Golden Speech' before Commons proclaiming, "Of myself I must say this: I was never any greedy, scraping grasper, nor a strait fast-holding prince, nor yet a waster." Speech 23, Version 1 [Commons journal of Hayward Townshend, MP for Bishopcastle, Shropshire] *Id.* at 337-38. The Queen sought to absolve the monarchy from blame by using 'golden' words. "There is no jewel, be it never so rich a price, which I set before this jewel – I mean your loves." *Id.* at 337.

beth I near the turn of the sixteenth century.[134] American patent rights find their origin in Great Britain, which appears to be the first modern nation to issue patents, "literae patentes" or "open letters." These "literae patentes" were not sealed but were exposed to view with the Great Seal pendant at the bottom. The role of common law in Anglo-American jurisprudence continues to play a strong role to the present day, and there exist numerous points of commonality between both the U.S. and U.K. systems of patent issuance and court enforcement.

A. First Patent Act of James I

Both the U.S. and the U.K. patent systems trace their origin back to James I, who strongly believed in the divine right of monarchs and abused royal prerogatives in the tradition of Henry VIII and Elizabeth I, even through he had promised in the Book of Bounty in 1610 that his royal patent grants would only be used to reward inventions that were neither contrary to law nor "mischievous to the state in raising commodities at home, or hurt of trade, or otherwise inconvenient."[135] Finally, in 1623, James was forced by an exasperated Parliament to assent to the Statute of Monopolies and limit his royal abuses.[136] This statute has been described from a constitutional perspective as an incredible assertion of the power of Parliament and common law over the rule by royal prerogative.[137] Yet, the statute did not represent a big break from past policies in terms of substance, because patents were to be limited to fourteen years and disputes were to be tried at common law.[138] The First U.S. Patent Acts of 1790 and 1793 track the Statute of Monopolies of 1623 almost verbatim, in which they make void all monopolies and letters patent, except those patents which apply to inventions which make a new asset available to the public.[139]

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[134] A void patent was found to be granted by Queen Elizabeth to Edward Darcy, a groom of the privy chamber of the Queen, and was claimed to be infringed by a London haberdasher (sometimes called Allein or Allen or Allin) in 1602. The patent pertained to the sole making and merchandizing of playing cards within the realm and the sole importation thereof. Lord Coke reported this case in his Reports in 1602 as "The Case of the Monopolies," 77 Eng. Rep. 1260 (K.B. 1603), 11 Coke R. 84b. Another reporter states "[a]nd if the Queen cannot to maintain her war, take from her subject but by Parliament, much lesse may she take moderate recreation from all subjects, which hath continued so long. . .but to punish such abuse is necessary." 74 Eng. Rep. 1131, 1135 (court year). The court found the patent void as against "the law of God and man" suggesting that even acts of Parliament can be voided, thus providing one of the jurisprudential roots of judicial review. *Id.* at 1137. *See also* The Slaughter-House Cases, 83 U.S. 36, 47-48 (1873) (discussing *Darcy* years later). Interestingly, playing cards were invented during the reign of Henry VII, and the portrait of his wife, Elizabeth of York, has been said to have freely appeared eight times on every deck of cards for over 500 years. *See* KINGS AND QUEENS OF ENGLAND AND GREAT BRITAIN, *supra* note 2, at 68.

[135] Alex Mossoff, *Rethinking the Development of Patents: An Intellectual History, 1550-1800*, 52 HASTINGS L.J. 1255, 1271 (2001). A reference should also be made to the King James Version of the Bible which was also created during this time of shrinking 'divine right,' thus making biblical text available to all in the common tongue of English.

[136] English Statute of Monopolies of 1623, 21 Jac. 1, c. 3. The preamble of this act refers to the 1610 promise that was published in the Book of Bounty.

[137] Mossoff, *supra* note 135, at 1272.

[138] *Id.* at 1273.

[139] *Compare* English Statute of Monopolies (1623) *with* U.S. Patent Acts (1790/1793). *See also* Edward Walterscheid, *The Early Evolution of the United States Patent Law: Antecedents (Part 2)*, 76 J.

Interestingly, the English Civil War that eventually resulted in the English Bill of Rights of 1689, and the American Declaration of Independence in 1776 leading off the American Revolutionary War, both dealt similarly with breaking governmental monopolies of a monarchial 'divine' power by the rising power of the people to express themselves through a representative legislature acting in the greater public interest.[140] Thus, the constitutional change initiated by Henry VIII in breaking the Pope's monopoly on marriage and religious property, transformed into a constitutional principle informing the U.S. Constitution of 1787, which was enacted by the people and provided for breaking strong government power into components.[141]

B. Contrast U.K. Development with USPTO and Federal Circuit

The U.S. Constitution of 1787 provides for patents by giving Congress the power to grant them under statutory law.[142] Prior to the ratification of the Constitution, many states granted their own patents as part of their inherent sovereignty. But such patents were constrained to the boundaries of a particular state and were of limited value. An early state patent was John Fitch's New York patent for operating a steamboat in 1787. This patent was revoked and transferred to Robert Livingston for 20 years as of 1798. But Robert Fulton finally succeeded in making steamboats work commercially in 1803. This patent was enforced against James Van Ingen for operating a steamboat in the waters of New York State in 1811.[143] Afterwards, the right of New York State to grant patents was litigated, and the injunction enforcing the New York patent was invalidated based on the Commerce Clause and the regulatory power necessarily coming through the U.S. Congress, without resort to the Patent Clause.[144]

Moreover, the Constitution provides for a three-branch system, with the Patent Office in the Executive Branch. Originally, Thomas Jefferson acted as the first patent examiner, in addition to his duties as Secretary of State. Eventually, a separate office was formed, and today the U.S. Patent and Trademark Office ("USPTO") acts with delegated administrative authority under the Department of Commerce. In contrast, the U.K. Patent Office has moved over time from recording the monarch's grants to becoming an agency of Parliament. And in 2002, the

PAT. & TRADEMARK OFF. SOC'Y 849 (1994) (discussing the similarities in both English and American systems).

[140] *See* George Anastaplo, THE AMENDMENTS TO THE CONSTITUTION: A COMMENTARY (1995) (containing text of these documents and other early documents important in the development of Anglo-American constitutionalism).

[141] *See* U.S. CONST., preamble. *See also supra* note 2 (discussing Henry VIII). The components of the U.S. government included the legislative, executive, and judicial branches all of which play important roles in the patent process.

[142] *See* U.S. CONST., art. I, § 8, cl. 8. (Patent Clause).

[143] *See* Livingston & Fulton v. Van Ingen, 9 Johns 506 (NY, 1812).

[144] *See* Gibbons v. Ogden, 22 U.S. 1 (1824). Subsequently, a large part of federal domestic power in the U.S. has been exercised based on the precedential exercise of the Commerce power originally discerned judicially in *Gibbons*. *See, e.g.,* Wickard v. Filburn, 317 U.S. 111 (1942).

U.K. Patent Office was placed under the administrative authority of the Department of Trade and Industry.[145]

Specialized court structures also exist in both the U.S. and the U.K. The Court of Appeals for the Federal Circuit was established as a specialized patents court in the U.S. in 1982 with the goal of harmonizing patent law throughout the country.[146] In the U.K., a specialized Patent County Court was established under the Patents Act of 1977. Both court systems have strengthened and standardized the interpretation of patents under each country's national law. In fact, some commentators suggest that such specialized courts may have gone too far, and created a systematic law and technology imbalance that gives too much weight to weak patents.[147] Other commentators have found that the specialized courts may perhaps succeed in providing greater certainty to patent law but are presently in a state of transition.[148]

C. *Markman* Hearings Debt to Common Law

In *Markman v. Westview Instruments, Inc.*, the U.S. Supreme Court held that construction of a patent claim was exclusively a matter of law and in the exclusive province of the Court, while application of the claim to an infringing item was a matter of fact and subject to a Seventh Amendment guarantee to a jury trial.[149] Thus, a bifurcation is required for almost every patent trial, where the first step now consists of a *Markman* hearing in order to decide claim construction and validity, and the second step consists of a jury trial applying the con-

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145 Department of Trade and Industry information is *available at* http://www.dti.gov.uk.

146 *See* S. Rep. No. 97-275, at 14-16 (1981), *reprinted in* 1982 U.S.C.C.A.N. 11, 14-15 (discussing how a specialized court would promote uniformity and increase innovation).

147 Compare the articles of Rochelle Cooper Dreyfuss, *The Federal Circuit: A Case Study in Specialized Courts*, 64 N.Y.U. L. REV. 1 (1989); Chris J. Katopis, *The Federal Circuit's Forgotten Lessons?: Annealing New Forms of Intellectual Property Through Consolidated Appellate Jurisdiction*, 32 J. MARSHALL L. REV. 581, 600 (1999); Pauline Newmann, *The Federal Circuit: Judicial Stability or Judicial Activism*, 42 AM. U. L. REV. 683 (1993) (all discussing the U.S. system) with interviews from Justice Laddie in the U.K. Patents Court in the August 19, 2002 issue of THE LAWYER and the November 2003 issue of EUROPEAN INTELLECTUAL PROPERTY REVIEW (searching for ways to make the U.K. patent court system cheaper and more efficient in order to stop the flow of patents cases to other European jurisdictions, and emphasizing that the sophistication of the U.K. system presents a problem of high cost relative to other forums). Recently analogous systematic concerns have surfaced in the U.S. with regard to heavy patenting in the software industry and in more general business-method areas that may lead to congestion and a lack of innovation due to blocking patents that may appear stronger than they really are due to systematic pro-patentee bias in the Federal Circuit. *See supra* note 95 and accompanying text (discussing software and business methods in U.S.). *See also* the Federal Trade Commission report, To Promote Innovation: The Proper Balance of Competition and Patent Law and Policy *available at* http://www.ftc.gov/os/2003/10/innovationrpt.pdf. *See generally* Larry Lessig THE FUTURE OF IDEAS 208-10 (2001) (discussing patent threats to innovation).

148 *See, e.g.*, R. Polk Wagner and Lee Petherbridge, *Is the Federal Circuit Succeeding? An Empirical Assessment of Judicial Performance*, 152 U. PA. L. REV. 1105 (2004) (finding encouraging signs in the mixed performance of the specialized court).

149 *See* 517 U.S. 370 (1996). The infringement case trial by jury was recognized as descending from cases such as Bramah v. Hardcastle, 1 Carp. P.C. 168 (K.B. 1789). The issue in *Markman* was whether every issue on experts and evidence had to be before the jury, or whether bifurcation was possible in the face of the Seventh Amendment. *Cf.* Blakely v. Washington, 124 S. Ct. 2531 (2004) (discussing evidence that is required to be submitted to a jury in a criminal case).

structed claims after judicial interpretation to any relevant facts on infringing devices.

In *Markman*, the Supreme Court analyzed the history of the right to trial at common law in order to determine whether any disputed fact issues arose in a patent, especially given the admission of expert evidence.[150] Interestingly, the Court found that claim construction under the Seventh Amendment was not based on U.K. practice, because claims were only clearly made part of patents in 1836.[151] Next, the Supreme Court looked to the Statute of Monopolies of 1623, which provided that the validity of any monopoly should be determined under the common law and that patent litigation remained under the Privy Council until 1752 and hence, had no option of jury trial.[152] The Court also noted that the general construction and interpretation of ambiguous legal writings was generally kept from the jury.[153] The Court could find neither historical basis in history nor precedent to allow the jury interpretation of claims, so the Court rested on functional policy concerns that the Court of Appeals for the Federal Circuit could be relied upon to uniformly develop laws of claim construction; thus deciding the case somewhat arbitrarily.[154]

After *Markman*, the two-step hearing became an established part of patent practice in the United States, with the common law now uniformly applied under statutes and under the Seventh Amendment guarantee to a common law jury for infringement.[155] Note that the roles of the trial court, the appellate court, and the agency of the USPTO have not been fully clarified; the appellate court currently decides all issues *de novo* including apparently fact-based claim construction issues.[156] Recently, the Federal Circuit has agreed to hear a claim construction case *en banc* in order to address the issue of how to construct claims with evidence inside and outside the case file.[157] As Lord Hoffman has recently affirmed, both

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150 Markman, 517 U.S. at 372.

151 *Id.* at 376.

152 *See id.* (citing and discussing Edward Walterscheid, *The Early Evolution of the United States Patent Law: Antecedents (Part 3)*, 77 J. PAT. & TRADEMARK OFF. SOC'Y 771, 771-76 (1995)).

153 Markman, 517 U.S. at 383-84.

154 *See id.* at 388.

155 The common law also enters into federal patent law under statute, for such matters as defining 'offers for sales' that act as bars to patentability under 35 U.S.C. § 102 (b). In order to define what an 'offer' is, the courts look to the common law of contracts. *See* Timothy Holbrook, *Territoriality Waning? Patent Infringement for Offering in the United States to Sell an Invention Abroad*, 37 U.C. DAVIS L. REV. 701 (2004). There may be no federal common law under the *Erie* principles, but common law still returns under statutes. Under both federal and state jurisdictions (*e.g.* when infringement of patent licenses are in dispute) equitable remedies may also include common law concepts such as *quia timet* ('because he fears") where in the face of certain harm the court will grant an injunctive remedy, such that a mere offer could look exceedingly probative of harm when such offer is sufficient to form a contract. *Cf. Luke* 23:7 (discussing Herod's jurisdiction of Galilee).

156 *See* Cybor Corp. v. FAS Technologies, Inc., 138 F.3d 1448, 1456 (Fed. Cir. 1998), *en banc. See also* Wagner & Petherbridge, *supra* note 148, at 1111-12 (finding a sharp split in Federal Circuit claim construction jurisprudence between panels favoring a 'procedural' approach using rules based hierarchy with emphasis on plain claim language and panels favoring a 'holistic' approach using flexible rules in a case-specific fashion). Rule 10, 1, 4

157 *See* Phillips v. AWH Corp., Appeal No. 03-1269, 1286 (Fed. Cir.) *available at* http://www.fedcir.gov/opinions/03-1269o.doc (discussing questions to be deciding regarding claim construc-

the U.K. and the European approach would use evidence outside the case file, following a 'purposive construction' or 'holistic' approach that would consider how a person of ordinary skill in the art would understand the claims in context.[158]

D. 'Royalties' Continue as an Important Part of Patent Practice

The concept of royalties still plays an important role in patent practice and exploitation. Conceptually, the royal grant of a patent by the British monarch has been transformed into royalty terms that transmit licensing payments for contractual permission to access patented rights. Such royalties represent the goal of successful patent exploitation by negotiation and settlement via contract law among private parties without resort to the judicial legal system. It is always helpful for lawyers to remember the old apocryphal Chinese proverb; the best doctors have no patients (because they have already made everyone perfectly well). The most successful inventors either receive royalties or exploit their own inventions, and the lawyers are not needed in the ideal world.[159] An important note should be taken of the role of licensee estoppel, which might generally prevent a party to a contract from later challenging the underlying bargained for subject matter, but such estoppel is trumped in the United States by a stronger public policy favoring the challenge of invalid and worthless patents.[160]

IV. Looking Forward into the Global Future

> [F]or he had two favorite quotations, 'The unburied dead are covered by the sky' and 'You can get to heaven from anywhere' – an attitude which, but for the grace of God, might have led to serious trouble. Thomas More, UTOPIA, Book I.[161]

Two additional broad topic areas that illuminate the future of patent practice in England and throughout Europe include first, the movement for Community Patents and uniform Community Patent Courts;, and second, the broader movement toward constitutionalism and strengthening EU institutions such as those involved with antitrust and unfair competition. A strengthened EU can also be ex-

tion including using dictionaries, understanding the role of the *Markman* and *Cybor* cases, and applying standards of review to trial court fact issues).

158 *See* Kirin-Amgen Inc v. Hoechst Marion Roussel Ltd., 21 October 2004, [2004] UKHL 46. *See also supra* note 122 (discussing case and Lord Hoffman's opinion).

159 *See, e.g.*, Thomas More, UTOPIA. ("But in Utopia everyone's a legal expert, for the simple reason that there are, as I said, very few laws, and the crudest interpretation is always assumed to be the right one."); Alan Cohen, *Licensing's In and the Lawyer's Out*, IP Law & Business, Apr. 2004, *available at* http://www.ipww.com/texts/0404/lawyer0404.html; *Cf. Luke* 12:58 (counseling settlement is preferable over litigation).

160 *See, e.g.*, Lear v. Adkins, 395 U.S. 653 (1969).

161 For more on More, *see, e.g.* George Anastaplo, *Addendum: A Return to Thomas More's Petition to the King*, 40 BRANDEIS L.J. 312 (2001); Edward Gaffney, *The Principled Resignation of Thomas More*, 31 LOY. L.A. L. REV. 63 (1997).

pected to play an even more important role in the WTO and impact intellectual property issues through that harmonization forum as well.[162]

A. Uniform Community Patents and/or Courts for Europe?

Beginning in 1975, a community patent system was proposed to supplement the European Patent Office system under the EPC. As part of the proposed community patent system, a centralized patent promoted uniformity among member nations, such that a single community patent could be issued and be enforced in a single trans-national forum.[163] However, negotiations regarding this system have floundered and a draft convention has yet to be completed. In fact, recent reports indicate that the entire proposal has collapsed.[164] Objections focused on translation problems, including a requirement that patents be filed in twenty-different languages while applications would be filed in only three languages. The costs associated with translations often form the biggest hurdle with any international patent filing program, and such revenue may have been too tempting for each member country to forego in the face of a more efficient community system. Any visitor to Europe can plainly note that only a few languages are necessary to travel freely and transact business generally, but issues of national pride and preservation of linguistic identity apparently trumped improved patent uniformity and efficiency with the twenty plus language requirement. Nonetheless, at this time, the integration of EU patent law appears wholly irreconcilable, although some countries may informally agree to recognize each others' national laws on a more limited basis outside the scope of EU integration under the terms of a working protocol known as the London Agreement.[165] Under the Agreement, the major languages may suffice on a limited basis, but any unified community patent court will not exist at all, and issues of harmonization will fall to each national court system looking to bridge the gaps between national systems of jurisprudence.

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[162] The Global Agreement on Tariffs and Trade (GATT) includes specific provisions of Trade Related aspects of Intellectual Property (TRIPs). The provisions provide for greater recognition and respect of each WTO members patent laws, but also contain important exceptions allowing for patent-breaking by nations for necessities such as the AIDS epidemic. WTO negotiations and controversies continue on these and other matters. *See also* Section I.C *infra.*

[163] *See, e.g.,* Kara Bonitatilbus, *The Community Patent System Proposal and Patent Infringement Proceedings: An Eye Towards Greater Harmonization in European Intellectual Property Law*, 22 PACE L. REV. 201 (2001) (noting that a Community Patent Court might function like the U.S. Court of Appeals for the Federal Circuit). *See also* Vincenzo Di Cataldo, *From the European Patent to a Community Patent*, 8 COLUM J. EUR. L. 19 (2002) (sounding optimistic about the process); Christopher Heath, *Harmonizing Scope and Allocation of Patent Rights in Europe—Towards a New European Law*, 6 MARQ. INTELL PROP. L. REV. 11 (2001) (discussing differences among EU members in terms of contracts and ownership rights).

[164] *See* John Miller, *Europe Fails to Agree on EU-Wide Patents*, WALL ST. J., May 19, 2004 at A16.

[165] The London agreement with the U.K., France, and Germany may mean that certain EPC members will agree to some simplification of language requirements with translations outside the Community Patent Convention. For more information *see* http://www.patent.gov.uk/about/ippd/notices/london.htm.

B. EU Constitution, EU Antitrust, and Broader WTO issues

In addition to The United Kingdom's voting on a referendum in the U.K. regarding participation in the new EU constitutional process, other issues can be expected to impact patent practice in the U.K. as well. The EU constitutional process may provide a future avenue for harmonization, but faces distinct hurdles with acceptance of local national populations and with eventual implementation.[166] The EU antitrust regulatory authority powers have expanded, augmented by the addition of ten new members to the EU. As antitrust represents the converse side of patent practice, where many unfairly exploited patents lead to monopoly problems and other abuses, this expanded power will have to be considered by holders of patents when they make commercial decisions.[167] Recently, Microsoft has been involved with antitrust enforcement by the EU, and may have to disclaim some intellectual property as part of the remedy process.[168]

WTO harmonization issues will continue to persist as the global economy becomes increasingly more interconnected. WTO issues that place developed countries against developing ones may be more effectively addressed by the EU as the addition of eastern European members force older EU members to become more sensitive to the needs of their less developed counterparts. The United States first-to-invent system continues to dramatically contrast against the rest of the world's systems, including the U.K. system, which relies on first-to-file an application.[169]

Moreover, an updated Patents Bill is presently pending before the U.K. Parliament and is expected to bring U.K. Patent law further into conformity with the EPC, as well as bring reforms to the U.K. Patent Office, including several modernization proposals.[170] Technology issues related to patenting biological and liv-

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[166] For an excellent English guide to the EU Constitution agreed to in Brussels on 18 June, 2004, *see* http://news.bbc.co.uk/2/hi/europe/2950276.stm. The BBC has prepared an annotated summary of major issues and attached an embedded copy of the 325 page constitutional document for reference in English. Discussing the nuanced concept of 'subsidiarity' would be beyond the scope of the present paper.

[167] *See supra* note 60 and accompanying text (addressing EPC articles 81 and 82 and discussing antitrust issues).

[168] *See* U.S. Dept. of Justice press release, *On the European Commission's Decision in the Microsoft Investigation, available at* http://www.usdoj.gov/atr/public/press_releases/2004/202976.htm (criticizing the European fine and the intellectual property remedy to remove code and license Microsoft's media player to third parties as a potential harm to innovation).

[169] The difference in systems results from the U.S. granting the true inventor possession of his invention under the Constitution despite his later filing of a patent application. The rest of the world considers the filing of the application to be the date of invention. In contrast, the U.S. provides for the ability to prove an earlier date of invention and entitlement to the benefit of the patent right.

[170] *See* http://www.publications.parliament.uk/pa/ld200304/ldbills/018/2004018.htm for the text of the pending Patents Bill, and *see* http://www.patent.gov.uk/about/consultations/responses/patact/index.htm discussing the U.K. Patent Office's response to the Bill. The role of patents in the innovation process is crucial. The Department of Trade and Industry (which is the branch of government responsible for the administrative agency of the U.K. Patent Office) published its Innovation Report on 17 December 2003, *available at* http://www.dti.gov.uk./innovationreport/index.htm.

ing tissues will also require both national and international resolution in areas such as stem cell cloning.[171]

In conclusion, people may look into a mirror and see another system reflected, and learn a great deal about themselves and their reflections.[172] As the world marches towards interconnectedness, legal education in comparative systems provides great insight and inevitably leads to harmonization when one understands how others think. It has been said that the French are terse and gnomic, the Germans dry and academic, and the English (and Americans) discursive and poetic.[173] But all legal systems tend to converge in the face of shared experiences, and the future of the patent system may inevitably move closer together as global economies interact and various cultures learn more about each other's ideas, inventions, and innovations in the future. Patent practice in London, in the EU, and in the United States, all trace common roots back to Queen Elizabeth I; today under Queen Elizabeth II, global patent practice continues to reform, evolve, and harmonize with the passage of time and technology.[174]

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[171] While the U.K. government has decided to promote stem-cell research, the U.S. government has decided to restrict it to very narrow cell lines. Britain's Human Fertilization and Embryology Authority (HFEA) granted the country's first license to create human embryonic stem cells in August 2004 and noted in their press release that cloning of children remained illegal. *See* HFEA press release on Therapeutic Cloning for Research, *available at* http://www.hfea.gov.uk/PressOffice/Archive/1092233888. Interestingly, the U.S. Patent Office on August 24, 2004, issued Patent No. 6,781,030 claiming methods for cloning mammals which includes some claims directed to 'non-human mammals' and other claims directed to 'mammals' without qualification. The patent was issued notwithstanding language in the 2004 Patent Office appropriations legislation (H.R. 2673), stating the following: "None of the funds appropriated or otherwise made available under this Act may be used to issue patents on claims directed to or encompassing a human organism." (Division B, Title VI, Section 634). See Cong. Rec., 6/22/04, page H7274. The statement said that the amendment simply mirrors the current Patent Office prohibition against patenting humans, and stated that it "has no bearing on stem cell research or patenting genes, it only affects patent human organisms, human embryos, human fetuses, or human beings." It says nothing about method claims for cloning human organisms. *See generally* Cynthia Ho, *Splicing Morality and Patent Law: Issues Arising from Mixing Mice and Men*, 2 Wash U. J. L. & Pol'y 247 (2000) (discussing moral and ethical issues related to biological patenting).

[172] "Now we see indistinctly, as in a mirror; then we shall see face to face. My knowledge is imperfect now; then I shall know even as I am known." 1 *Corinthians* 13:11-12. Elizabeth the First referred to this epistle in her Final Speech to Parliament discussing her involvement with war and foreign affairs and using it to illustrate that the collected wisdom of the world was but folly in the eyes of God. *See* Speech 24, Version 1 *in* ELIZABETH I, COLLECTED WORKS, *supra* note 133, at 349-50. *Cf.* 1 *Corinthians* 1:21-25.

[173] B.S. Markesinis, *A Matter of Style* 110 LAW Q.R. 607 (1994).

[174] Patents may in some sense be seen as the literary servants of Elizabeth the First. In a famous play, The Archbishop of Canterbury speaks at the infant Elizabeth's christening and says that her servants would be "peace, plenty, love, truth, terror." *See* WILLIAM SHAKESPEARE, HENRY VIII act 5, sc. 5. *See also* Michael Wilson, *Essay: A View of Justice in Shakespeare's the Merchant of Venice and Measure for Measure*, 70 NOTRE DAME L. REV. 695, 699-705 (1995) (discussing the use of Elizabethan legal and religious metaphors in Shakespearean drama). Elizabeth I also represents the peak of English monarchial power that roughly occurred from Henry VIII to James I.

EUROPEAN NATIONAL IP LAWS UNDER THE EU UMBRELLA: FROM NATIONAL TO EUROPEAN COMMUNITY IP LAW

Jean-Luc Piotraut*

I. Introduction

In Europe, intellectual property ("IP") law combines copyright and other copyright-related rights laws and industrial property law (*i.e.* patent, trademark, and geographical indications laws).

Considering the sovereignty of states, intellectual property rights first had to comply with territoriality principles, which used to hinder economic and cultural exchanges. Some form of international protection, therefore, was quickly considered. In the field of IP, an international organization was established in the late 19th century to provide countries with an administrative framework and a permanent forum for discussion.[1] With its headquarters in Geneva, Switzerland, this intergovernmental organization is now known as the World Intellectual Property Organization ("WIPO"), initially named the Bureaux for the Protection of Intellectual Property (best known by its French acronym, BIRPI). Its main job is to administer the multinational intellectual property agreements signed under its aegis, with the purpose of establishing unions of all states that have adhered to the treaty in question (whether dealing with copyrights or related rights, patents, plant patents, etc.).[2]

Moreover, IP has become a focal point of the modern global trading system: it was addressed in 1994 at the creation of the World Trade Organization ("WTO") through the side agreement on Trade-Related Intellectual Property Rights ("TRIPs").

In Europe, the ongoing construction of an economic and political community has required the European Community ("EC") to address IP law as well. As a result, IP law in Europe seems to have evolved from resting solely on national laws into a partial European Community law, the importance of which continues to grow daily.

This article examines the ways in which such "*Europeanification*" of IP law has been brought about. Currently, there are five main approaches, which will be presented successively in Parts II to VI. Part II focuses on regional IP law treaties in the field of patent law. Part III describes the EC case law delimitation of national IP laws, in particular, the free movement of goods and free competition

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[1] *See* G. B. DINWOODIE, INTERNATIONAL INTELLECTUAL PROPERTY LAW AND POLICY (W. O. Hennessey & S. Perlmutter 2001).

[2] *Id.*

policy. Part IV examines Community statutory delimitations of national IP laws under provisions not exclusively limited to IP law. Part V discusses the different methods of ongoing harmonization of national IP laws in the European Union ("EU"). Part VI describes the current establishment of a Community IP law through the adoption of industrial property rights largely unbound and independent of national legal systems.

My assertion is that the methods of harmonizing IP law in Europe may contribute to a reappraisal of the fundamental international legal principle of territoriality based on the IP rights which should be governed only by national laws.

II. *"Europeanification"* Through Regional IP Law Treaties

Two regional treaties have been implemented to harmonize or unify the European national patent laws: the Strasbourg Convention[3] and the Munich Convention.[4] Both constitute an important source of European patent law.

As a matter of fact, an additional European treaty, the Luxembourg Convention of December 15, 1975 for the European patent for the common market ("Community Patent Convention")[5] created a unitary Community patent having equal effect throughout the whole EC territory. Such a Community patent would have been "granted, transferred, revoked or allowed to lapse"[6] only within this entire territory.

However, such a system would have been very costly because all patent documents would have to be translated into the languages of each Member State. For this reason, notwithstanding a Council agreement in 1989,[7] a sufficient number of countries did not ratify this treaty and it therefore never came into effect.

By now, despite the lasting success of the Strasbourg and Munich Conventions, the ongoing "*Europeanification*" of IP law does not seem to be brought about through regional treaties any longer.

A. The Strasbourg Convention on the Unification of Certain Points of Substantive Law on Patents for Inventions

The Strasbourg Convention was signed on November 27, 1963, under the Council of Europe, an international organization founded in 1949 which is independent of the European Union, and designed to encourage political cooperation between the countries of Europe. Its purpose is to harmonize the patentability requirements in European national laws. Article 1 of the convention provides:

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[3] Convention on the Unification of Certain Points of Substantive Law on Patents for Invention, Nov. 27, 1963, 1249 U.N.T.S. 369 [hereinafter Strasbourg Convention].

[4] Convention on the Grant of European Patents, Oct. 5, 1973, 1065 U.N.T.S. 199 [hereinafter Munich Convention].

[5] Convention for the European Patent for the Common Market, Dec. 15, 1975, 1976 O.J. (L 17) 1 [hereinafter Luxembourg Convention].

[6] Luxembourg Convention, *supra* note 5, art. 2(2).

[7] Council agreement (89/695/EEC) relating to Community patents, done at Luxembourg on December 15, 1989.

> In the Contracting States, patents shall be granted for any inventions which are susceptible of industrial application, which are new and which involve an inventive step. An invention which does not comply with these conditions shall not be the subject of a valid patent . . . .

This provision lays down four substantive conditions for the validity of a patent: an invention, an industrial application, novelty, and an inventive step.

Only 12 countries have formally joined the Strasbourg Convention; however, nearly every European country[8] has passed similar provisions through its own legislation. These provisions are also contained in the Munich Convention on the granting of European patents.[9]

In addition, each WTO member must comply with the requirements set forth in TRIPs agreement Article 27(1):

> Patents shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application . . . .

B. The Munich Convention on the Grant of European Patents

The Munich Convention on the Grant of European patents, also known as the European Patent Convention ("EPC"), was signed on October 5, 1973. Twenty-nine countries have already joined it, including countries that are not currently members of the European Community (*e.g.* Bulgaria, Switzerland and Turkey).[10] The impending adherence of several more countries is planned.[11]

The EPC sets up a centralized registration system in the European Patent Office ("EPO"), located in Munich, Germany.[12]

By this time, the grant of a European patent only allows the patentee to be protected under national patents in countries appointed in his/her application. This means that despite the administrative examination of the filings in the EPO, national courts are free to decide on both validity and infringement issues.

III. "*Europeanification*" Through EC Case Law: Delimitation of National IP Laws

At the beginning of the European construction, the Community only had very restricted power. Therefore, it seemed necessary to combine the purely national IP laws and the EC law, especially those related to the free movement of goods and free competition policy. The first step in the creation of European IP law has

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[8] Including those which are not Member States of the EC.

[9] Munich Convention art. 52, Patentable inventions: "(1) European patents shall be granted for any inventions which are susceptible of industrial application, which are new and which involve an inventive step."

[10] *See* 2004, O.J. EUROPEAN PATENT OFFICE, 479 (2004).

[11] *Id.*

[12] *See* M. SINGER & D. STAUDER, THE EUROPEAN PATENT CONVENTION: A COMMENTARY (Cologne, Germany, 2003).

been a Community delimitation of national laws made by the European Court of Justice ("ECJ"), and the Court of First Instance of the EC.

A. Respective Scopes of National IP Laws and Community Law

In the 1960's, European law included no IP provision except for former Article 36 EEC, currently Article 30 EC. This provision excuses Member States for respecting the policy favoring the free movement of goods, which prohibits quantitative restrictions on imports or exports and all measures having equivalent effect on different grounds such as:

> the protection of health and life of humans, animals or plants; the protection of national treasures possessing artistic, historic or archaeological value; or *the protection of industrial and commercial property.* (Emphasis added.)

This means that for more than 20 years after the beginning of the construction of the European Community, you could only find IP provisions in European national laws, and these provisions were sometimes very different from one country to another. Therefore, the first question the ECJ, seated in Luxembourg, had to solve consisted of specifying the respective scope of national IP laws and European Community law.

With this goal in mind, the ECJ delivered two main judgments: one in the field of patents, *Parke Davis*[13] and one in the field of trademarks, *Sirena.*[14] They both draw a very important distinction between the existence and exercise of national IP rights and the limits these may take in the EC: while the *existence* of IP rights granted by a Member State shall not be affected by the prohibitions contained in the EC Treaty, the *exercise* of such rights may fall under one of those prohibitions.

B. Application of the EC Treaty's Community General Principle of Non-Discrimination on Intellectual Property Rights

Although it was delivered before the beginning of the approximation of literary and artistic property laws in Europe, the *Phil Collins* case[15] gave the ECJ its first opportunity to apply the Community general principle of non-discrimination to copyright and related rights:

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[13] Case 24/67, Parke, Davis & Co. v. Prabel, Reese, Beintema-Interpharm and Centrafarm, 1968 E.C.R. 55, [1968] C.M.L.R. 47 (1968).

[14] Case 40/70, Sirena S.r.l. v. Eda S.r.l, 1971 E.C.R. 69, [1971] C.M.L.R. 260 (1971).

[15] Joined cases C-92/92 and C-326/92, Phil Collins v. Imtrat Handels GmbH, Patricia Im- und Export Verwaltungs GimbH and Leif Emanuel Kraul v. EMI Electrola GmbH, 1993 E.C.R. I-5145, [1993] 3 C.M.L.R. 773 (1993).

> Within the scope of application of this Treaty, and without prejudice to any special provisions contained therein, any discrimination on grounds of nationality shall be prohibited.[16]

This case involved an infringement suit brought in Germany by musician Phil Collins against a distributor who had marketed an unauthorized CD in Germany containing a recording of a U.S. concert.[17] However, at the time, the current German law only allowed German artists to prohibit the distribution of their foreign performances.[18]

Such a provision was condemned by the ECJ because it did not comply with the Community general principle of non-discrimination.[19] The Court stated that the requirements of this general principle:

> be interpreted as precluding the legislation of a Member State from denying to authors and performers from other Member States, and those claiming under them, the right, accorded by that legislation to the nationals of that State, to prohibit the marketing in its national territory of a phonogram manufactured without their consent, where the performance was given outside its national territory.[20]

C. Delimitation of National IP Laws Related to the Free Movement of Goods

Articles 24 to 30 of the EC treaty (formerly Articles 30 to 36, EEC) relate to the elimination of quantitative restrictions between Member States, especially on imports (Article 28 EC) and exports (Article 29 EC). However, according to Article 30 EC, those provisions "shall not preclude prohibitions or restrictions on imports, exports or goods in transit justified on. . . the protection of industrial and commercial property."[21]

This means that the "protection of industrial and commercial property" constitutes an exception to the free movement of goods policy implemented in the European Community.

The ECJ has been asked to construe such a provision and decide whether the use of legal national monopolies given by IP rights would violate the European policy on the free movement of goods. In other words, is the owner of an IP right entitled to bring an infringement suit to prevent goods from getting over internal borders inside the EC territory?

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[16] Treaty Establishing the European Community (Amsterdam Consolidated Version), October 2, 1997. [hereinafter EC TREATY] (Provision initially located in Article 7 of the EEC TREATY – which has become Article 6 after the Maastricht Agreement was signed in 1992 – and now written in Article 12).

[17] Cases C-92/92 and C-326/92, 1993 E.C.R. I-5145, [1993] 3 C.M.L.R. 773 (1993).

[18] *Id.*

[19] *Id.*

[20] *Id.*

[21] EC TREATY art. 30.

1. The Principle of Community Exhaustion of IP Rights

The ECJ has laid down a principle of IP rights exhaustion within the Community.[22] This principle essentially means that a product lawfully manufactured and marketed in a Member State, where it is protected under an IP right, is entitled to circulate freely in the entire EC territory. In other words, national IP rights shall not extend to acts done in the territory of a Member State after a product has already been placed in the market in the territory of any EC Member State by the owner of the IP right without his or her express consent.

a) Community Exhaustion in the Field of Copyright and Related Rights

The ECJ first formulated its exhaustion doctrine in the *Deutsche Grammophon* case, a case regarding a producer's sound recording right.[23] The court held that a German producer may not rely on its exclusive right of distribution to prohibit the marketing of records in Germany that it had previously supplied to its French subsidiary.[24]

The Community exhaustion doctrine was next applied to copyright in the *Musik-Vertrieb Membran* decision.[25] The dispute involved a German copyright management society and undertakings that, under the consent of the copyright owner, imported U.K. manufactured and U.K. marketed records into Germany but calculated royalties based only on U.K. distribution.[26] The ECJ first held that the statutory expression found in Article 30 EC, "*protection of industrial and commercial property*" was to be interpreted to include the protection of copyright.[27] Secondly, the ECJ found the policy concerning the free movement of goods prevailed over the protection of copyright, in spite of the requisite license, because putting the recordings in the British market led to an exhaustion of copyrights so that, subject to the payment of the due fees, anybody was entitled to exploit the works already put into circulation in the British market with the consent of their owners.[28]

b) Community Exhaustion in the Field of Industrial Property

In the field of industrial property, the ECJ has held that neither parallel *patents* nor parallel *trademarks* could prevent the importation of protected drugs by a third party from a Member State to another.

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[22] This principle is similar to the U.S. first-sale doctrine in copyright law. *See* 17 U.S.C. § 109.

[23] Case 78/70, Deutsche Grammophon GmbH v. Metro-SB- Großmärkte GmbH & Co. KG, 1971 E.C.R. 487, [1971] 1 C.M.L.R. 631 (1971).

[24] *Id.*

[25] Joined cases 55/80 and 57/80, Musik-Vertrieb Membran GmbH and K-tel International v. GEMA und Mechanische Vervielfältigungsrechte, 1981 E.C.R. 147.

[26] *Id.*

[27] *Id.*

[28] *Id.*

The leading cases here are the *Sterling Drug*[29] case, involving patents and the *Winthrop*[30] case, involving trademarks. In both cases, the Dutch firm, *Centrafarm,* bought lesser-priced pharmaceutical products in other European countries and then distributed them in the Netherlands. Since the owners of those industrial property rights were protected either with parallel patents or parallel trademarks, they brought infringement suits against *Centrafarm*, based on their Dutch IP rights.[31] Nevertheless, the ECJ rejected the actions as "incompatible with the rules of the EEC treaty concerning the free movement of goods within the common market."[32]

In *Sterling Drug*, the ECJ held:

> Whereas an obstacle to the free movement of goods of this kind may be justified on the ground of protection of industrial property where such protection is invoked against a product coming from a Member State where it is not patentable and has been manufactured by third parties without the consent of the patentee and in cases where there exist patents, the original proprietors of which are legally and economically independent, a derogation from the principle of the free movement of goods is not, however, justified where the product has been put onto the market in a legal manner, by the patentee himself or with his consent, in the Member State from which it has been imported, in particular in the case of a proprietor of parallel patents.[33]

The *Winthrop* decision states:

> In fact, if a trademark owner could prevent the import of protected products marketed by him or with his consent in another Member State, he would be able to partition off national markets and thereby restrict trade between Member States, in a situation where no such restriction was necessary to guarantee the essence of the exclusive right flowing from the trademark.[34]

2. *Exceptions to the Community Exhaustion of IP Rights*

The principle of Community exhaustion is not uncompromising; the ECJ has admitted that IP right protection can prevail over the policy favoring the free movement of goods, at least in certain situations.

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29 Case 15/74, Centrafarm BV and Adriaan de Peijper v. Sterling Drug Inc., 1974 E.C.R. 1147.

30 Case 16/74, Centrafarm BV and Adriaan de Peijper v. Wintrhop BV, 1974 E.C.R. 1183.

31 Cases 15/74 & 16/74.

32 *Id.*

33 Case 15/74, ¶ 11.

34 Case 16/74, ¶ 11.

a) As Regards to Remaining Differences between National Laws Inside the European Community

In its "*EMI 2*" decision,[35] made *before* European harmonization concerning the duration of copyright protection, the ECJ held that such a duration was "inseparably linked to the very existence of the exclusive rights."

As a result, the lawful distribution of Cliff Richard sound recordings into the Danish market, where they were already in the public domain, did not lead to any Community exhaustion of reproduction and distribution rights. The German distribution company, *EMI Electrola,* was consequently entitled to oppose, on the ground of its protected copyright, exports of those sound recordings in Germany by bringing an infringement suit.

b) As Regards to a Patent Compulsory License

The *Pharmon* case[36] was brought before the ECJ after the German company *Hoechst*, the proprietor of a pharmaceutical product patent in Germany and of parallel patents in the Netherlands and in the U.K., sought to prevent the Dutch company *Pharmon* from marketing in the Netherlands a consignment of those medicines bought by a British undertaking, which had obtained a compulsory license in the U.K. .

The ECJ emphasized that, in the case of a compulsory license, "the patentee cannot be deemed to have consented to the operation of that third party. Such a measure deprives the patent proprietor of his right to determine freely the conditions under which he markets his products."[37]

Therefore, "the theory of the exhaustion of patent rights which presupposes that the product in question has been marketed freely and voluntarily by the patent proprietor, or by a third party with the proprietor's consent, does not apply in the case of a compulsory license."[38]

c) As Regards to Repackaging and Re-Branding of a Pharmaceutical Product

The ECJ has admitted that trademark protection on a pharmaceutical product can prevail over the free movement of goods policy.

In the *Hoffmann La-Roche* case,[39] the Court considered the question of repackaging parallel imported products (*Valium* tablets) within the E.U. This issue arose from the difference between the prescribed pack size in the country of import, the U.K., and the country of export, Germany.[40] The court held that there

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[35] Case 341/87, EMI Electrola GmbH v. Firma Patricia Im– und Export Verwaltungs GmbH, 1989 E.C.R. 79.

[36] Case 19/84, Pharmon BV v. Hoechst AG, 1985 E.C.R. 2281, [1985] 3 C.M.L.R. 775 (1985).

[37] *Id.*

[38] *Id.*

[39] Case 102/77, Hoffman La-Roche & Co. AG v. Centrafarm ("*Valium*"), 1978 E.C.R. 1139.

[40] *Id.*

was no exhaustion of IP rights if the repackaging could adversely affect the original condition of the pharmaceutical product.[41]

The *Bristol-Myers Squibb* case[42] concerned not only repackaging, but also re-branding. Re-branding takes place where the owner of the right uses different marks in the country of export and country of import, and where the parallel importer applies to the trademark used for that product in the country of import. However, since the reputation of the trademark and its owner may suffer from the inappropriate presentation of a repackaged product, the ECJ decided that there would be no exhaustion of IP rights if the repackaging could damage the reputation of the trademark and its owner.[43] Paragraph 75 emphasizes that, in such a case:

> [T]he trademark owner has a legitimate interest, related to the specific subject matter of the trademark right, in being able to oppose the marketing of the product. In assessing whether the presentation of the repackaged product is liable to damage the reputation of the trademark, account must be taken of the nature of the product and the market for which it is intended.[44]

Consequently, "the packaging must not be defective, of poor quality, or untidy," and the importer must give "notice to the trademark owner before the repackaged product is put on sale," and, on demand, to supply "him with a specimen of the repackaged product."[45]

D. Delimitation of National IP Laws Related to Free Competition Policy

It arises from Articles 2 and 3 of the EC treaty that one of the tasks of the Community is to establish a common market by implementing common activities, such as "a system ensuring that competition in the internal market is not distorted."[46]

But since IP rights allow territorial monopolies, they are able to harm the EC free competition policy. That is why the European construction of IP rights has articulated concerns regarding both national IP rights exploitation and EC free competition policy, *i.e.* anti-competitive agreements regulations on the one hand and abuses of dominant position regulations on the other.

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41 *Id.*

42 Joined Cases C-427/93, C-429/93, and C-436/93, Bristol-Myers Squibb v. Paranova A/S; C. H. Boehringer Sohn, Boehringer Ingelheim KG and Boehringer Ingelheim A/S v. Paranova A/S; Bayer Aktiengesellschaft and Bayer Danmark A/S v. Paranova A/S, 1996 E.C.R. I-3457.

43 *Id.*

44 *Id.*

45 *Id.*

46 EC TREATY art. 3(g).

1. Compliance of IP Rights Exploitation with the Anti-Competitive Agreements (or Cartels) Regulations

To be effective, competition assumes that the market is made up of suppliers, working independently of each other. However, if certain companies agree among themselves to collude rather than compete, such agreements impair competition. This is why Article 81 (formerly Article 85) of the EC treaty prohibits, as incompatible with the common market:

> all agreements between undertakings, decisions by associations of undertakings and concerted practices which may affect trade between Member States and which have as their object or effect the prevention, restriction or distortion of competition within the common market, and in particular those which:
> (a) directly or indirectly fix purchase or selling prices or any other trading conditions;
> (b) limit or control production, markets, technical development, or investment;
> (c) share markets or sources of supply;
> (d) apply dissimilar conditions to equivalent transactions with other trading parties, thereby placing them at a competitive disadvantage;
> (e) make the conclusion of contracts subject to acceptance by the other parties of supplementary obligations which, by their nature or according to commercial usage, have no connection with the subject of such contracts.[47]

Alternatively, an agreement which restricts competition may still be accepted according to European competition law under the conditions provided in Article 81(3), as such an agreement "contributes to improving the production or distribution of goods or to promoting technical or economic progress, while allowing consumers a fair share of the resulting benefit,"[48] and does not:

> (a) impose on the undertakings concerned restrictions which are not indispensable to the attainment of these objectives;
> (b) afford such undertakings the possibility of eliminating competition in respect of a substantial part of the products in question.

Now, the ECJ must decide on the case of agreements on IP rights, which are likely to be used for anti-competitive practices.

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[47] EC TREATY art. 81(1).

[48] While free competition seems to be the only goal of US antitrust law (especially the Sherman Act of 1890, under which Congress prohibited agreements "in restraint of trade"). *See* 15 U.S.C. §§ 1-7. EC competition law has two stated goals, which are, first, to protect the competitive process from restraint and, second, to promote the European integration. This means, as a result, that although they restrict competition, some agreements or conducts may be accepted in Europe, in particular if they contribute to promote technical progress or to improve distribution.

a) Reciprocal Representation Contracts between Copyright Management Societies

The *Tournier* case[49] arose from a complaint of the high royalty rate demanded by *SACEM* (the society that manages copyright in musical works in France) of discotheque operators who had been prohibited to deal directly with copyright management societies in other countries; those societies asserted that they were bound by "reciprocal representation contracts" with *SACEM*, and accordingly refused to grant direct access to their repertoires.

The ECJ was to determine whether those reciprocal representation contracts specifically enabling a copyright management society to prevent users from selecting works from foreign authors without being obliged to pay royalties on these repertoires, constituted a concerted practice in breach of European competition law.[50]

The Court held that the reciprocal representation contracts in question are not in themselves restrictive of competition, but "the position might be different if the contracts established exclusive rights whereby copyright management societies undertook not to allow direct access to their repertoires by users of recorded music established abroad."[51] On the contrary, "concerted action by national copyright management societies with the effect of systematically refusing to grant direct access to their repertoires to foreign users must be regarded as amounting to a concerted practice restrictive of competition and capable of affecting trade between the Member States."[52]

b) Exclusive License of Breeders' Rights on New Plant Varieties

The *Nungesser* decision[53] is among the most important regarding compliance of an exclusive license in the field of antitrust law. The case actually dealt with the assignment of breeders' rights on new plant varieties, which formed part of a series of operations intended to organize the overall distribution of these seed varieties in Germany.

The judgment laid down an essential distinction between "open" exclusive licenses and exclusive licenses with "absolute territorial protection":

An open exclusive license, "whereby the owner merely undertakes not to grant other licenses in respect of the same territory and not to compete himself with the licensee on that territory," is accepted because it may be necessary, for instance to introduce a new and risky technology on the market.

On the other hand, an exclusive license with absolute territorial protection, under which the parties to the contract propose, as regards the products and the territory in question, to "eliminate all competition from third parties, such as parallel importers or licensees for other territories" is prohibited because it "man-

[49] Case 395/87, Ministère Public v. Jean-Louis Tournier ("*SACEM*"), 1997 E.C.R. II-2215.

[50] *Id.*

[51] *Id.*

[52] *Id.*

[53] Case 258/78, L.C. Nungesser KG and Kurt Eisele v. Commission, 1982 E.C.R. 2015.

ifestly goes beyond what is indispensable for the improvement of production or distribution or the promotion of technical progress."[54]

2. *Compliance of IP Rights Exploitation with the Abuses of Dominant Position Regulations*

Article 82 (formerly Article 86) of the EC treaty provides:

> Any abuse by one or more undertakings of a dominant position within the common market or in a substantial part of it shall be prohibited as incompatible with the common market in so far as it may affect trade between Member States.
> Such abuse may, in particular, consist in:
> (a) directly or indirectly imposing unfair purchase or selling prices or other unfair trading conditions;
> (b) limiting production, markets or technical development to the prejudice of consumers;
> (c) applying dissimilar conditions to equivalent transactions with other trading parties, thereby placing them at a competitive disadvantage;
> (d) making the conclusion of contracts subject to acceptance by the other parties of supplementary obligations which, by their nature or according to commercial usage, have no connection with the subject of such contracts.[55]

This means, according to European antitrust law, an undertaking is allowed to have a dominant position in its market. "Dominant position" here refers to the economic power that enables an undertaking to operate in the market without having account for the reaction of its competitors or of intermediate or final consumers: what is forbidden is only the abuse of such a dominant position, which may arise from IP rights uses.

The ECJ had to look into the very problem of copyright and industrial property rights uses likely to constitute an abuse of a dominant position.

a) Abuse of Copyright Exploitation

In the field of copyright, the abuses of dominant position regulations were first brought to the attention of the ECJ by copyright management societies' practices. The *SABAM* case[56] involved exorbitant provisions imposed on its members by a Belgian copyright management society, specifically its provision requiring for the global assignment of all present and future copyrights.

The Court held that this could constitute an abuse given that a copyright management society, which was entrusted with the exploitation of copyrights and occupied a dominant position, "impose(d) on its members obligations which are

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[54] *Id.*

[55] EC TREATY art. 82.

[56] Case 127/73, Belgische Radio & Televisie v. SV SABAM and NV Fonior, 1974 E.C.R. 313, [1974] 2 C.M.L.R. 238 (1974).

not absolutely necessary for the attainment of its object and which thus encroach unfairly upon a member's freedom to exercise his copyright."[57]

Later on, in the *Magill* case,[58] the ECJ had to apply the abuses of dominant position law to the exploitation of copyrights for a TV guide.

At the time, no comprehensive weekly television guide was available on the market in Ireland or in Northern Ireland.[59] Each television station published a guide listing only its own programs.[60] The stations also provided, based on their copyrights, free daily listings of their program schedules to newspapers on request; these listings were accompanied by a license setting out the conditions under which that information could be reproduced.[61]

However, it was found to be an abuse of a dominant position when the *BBC* and two Irish broadcasting stations refused to grant licenses to Irish newspapers for the publication in their respective weekly listings.[62]

b) Abuse of Industrial Property Rights Exploitation

European case law contains two key decisions on the abuse of industrial property rights exploitation: first, the *Renault* decision,[63] regarding a refusal to supply or to produce protected spare parts for motor vehicles and second, the *Tetra Pak* decision,[64] regarding the acquisition of an exclusive license.

The *Renault* case was brought by a trade association of a number of Italian undertakings which manufactured and marketed bodywork spare parts for motor vehicles. The ECJ was to determine, notwithstanding the abuse of dominant position regulations, whether the French car manufacturer, *Renault,* was entitled to secure the benefit of its exclusive industrial property rights to ornamental designs,[65] the effect of which would enable the manufacture to prevent the unauthorized sales of these protected products by third parties.

The ECJ did not condemn *Renault*'s refusal to supply spare parts to independent repairers, but it admitted that an abuse of a dominant position might result from an arbitrary refusal to supply spare parts to independent repairers, or from a decision to stop production of spare parts for a particular model even though many of that particular model are still in circulation.[66]

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57 *Id.*

58 Joined cases C-241/91P and C-242/91P, Radio Telefis Eireann (RTE) and Independent Television Publication Ltd (ITP) v. Commission, 1995 E.C.R. I-743, [1995] 4 C.M.L.R. 718 (1995).

59 *Id.*

60 *Id.*

61 *Id.*

62 *Id.*

63 Case 53/87, Consorzio Italiano della Componentistica di Ricambio per Autoveicoli and Maxicar v. Régie Nationale des Usines Renault, 1988 E.C.R. 6039.

64 Case T-51/89, Tetra Pak Rausing SA v. Commission, 1990 E.C.R. II-309.

65 While in the U.S., designs are protected either under copyright law or under patent law, in Europe, they usually can be protected under a *sui generis* legislation for industrial design, which relates to industrial property law.

66 Case 53/87, Renault, 1988 E.C.R. 6039.

In its *Tetra Pak* decision, the Court of First Instance of the EC noted, "the mere fact that an undertaking in a dominant position acquires an exclusive license does not *per se* constitute abuse."[67] It did, however, hold that there was abuse when Tetra Pak, already in a dominant position in the aseptic packaging of liquid foods (especially milk) in cartons, then acquired an exclusive patent license for a new UHT milk-packaging process.[68]

Actually, the acquisition of the exclusivity of the license not only "strengthened Tetra's very considerable dominance but also had the effect of preventing, or at the very least considerably delaying, the entry of a new competitor into a market where very little if any competition is found."[69]

IV. *"Europeanification"* Through an EC Statutory Delimitation of IP Law

European Community legislation has two main statutory schemes that focus on a delimitation of IP laws, although they are part of broader statutes that do not limit themselves to IP: first, there are several Commission "block exemption" regulations, and second, the Charter of Fundamental Rights of the EU.

A. "Block Exemption" Regulations

As early as the 1960's, the Commission has been empowered to apply Article 81(3) of the EC treaty by regulation[70] to certain categories of agreements and concerted practices falling within the scope of Article 81(1).

According to these Commission regulations, categories of agreements of the same nature, such as technology transfer agreements and agreements in research and development, may benefit from group exemptions, also called "block exemptions." As long as they comply with the exemptions,[71] agreements falling under such a block exemption are assumed to be compatible with European competition law.[72]

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67 Case T-51/89, Tetra Pak, 1990 E.C.R. II-309.

68 *Id.*

69 *Id.*

70 According to Article 249 of the EC TREATY, a regulation has "general application, and it is binding in its entirety and directly applicable in all Member States."

71 The first block exemption regulations used to detailed a list of provisions usually contained in the relevant category of agreement, and to distinguish the clauses which did not prevent exemption from the ones which prevented such an exemption. The more recent block exemptions place greater emphasis on defining the categories of agreements which are exempted up to a certain level of market power and on specifying the restrictions or clauses which are not to be contained in such agreements.

72 Under Council Regulation (EEC) No 17/62, 1962 O.J. (L 13) 204 (first regulation implementing Articles 81 and 82), undertakings had to notify their agreements to the Commission in order to know whether the latter were compatible with the European antitrust law (especially whether a possibly anticompetitive agreement may be approved thanks to its ultimately beneficial economic effect on the market). Such an obligation to notify does not exist anymore under Regulation (EC) No 1/2003, 2003 O.J. (L 1) 1, on the implementation of the rules on competition laid down in Articles 81 and 82 of the Treaty (which repealed Regulation No 17/62 on May 1, 2004).

Some of these exemption regulations relate to IP rights because they involve agreements that either include restrictions imposed on the acquisition or use of industrial property rights or the research and development of products or processes.

1. Exemption of categories of agreements that include restrictions imposed in relation to the acquisition or use of industrial property rights

Pursuant to Council Regulation (EEC) No 19/65 of March 2, 1965, the European Commission became entitled to pass exemption regulations for the benefit of certain categories of agreements and concerted practices which "include restrictions imposed in relation to the acquisition or use of industrial property," for example, patents, utility models, designs or trademarks.[73] Block exemption regulations of this kind have been adopted on such a basis, especially in the field of distribution agreements and agreements for the transfer of technology.

a) Supply and Distribution Block Exemption Regulation

Commission Regulation (EC) No 2790/1999 of December 22, 1999, on the application of Treaty Article 81(3) to categories of vertical agreements and concerted practices is aimed at undertakings that operate at a different level on the production or distribution chain, and relate to the conditions under which the parties may purchase, sell or resell certain goods or services.[74]

This Regulation replaces three previous regulations: one on exclusive distribution, one on exclusive purchasing, and one on franchise agreements.[75] This Regulation also reflects a shift from former EC policy, which relied largely on formalistic assessment criteria for vertical agreements, towards an approach focusing more on the economic effects of vertical agreements. The basic aim of this new approach is:

> to simplify the rules applicable to vertical restraints and to reduce the regulatory burden for companies, while ensuring a more effective control of agreements entered into by companies holding significant market power.[76]

According to Article 3 of EC 2790/1999, the exemption generally applies up to a market share threshold of 30% of the relevant market held either by the supplier on which it sells the contract goods or services or, in vertical agreements

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[73] Commission Regulation 19/65/EEC, 1965 O.J. (P 36).

[74] Subject to the car distribution, which is ruled by a specific regulation, *i.e.* Commission Regulation (EC) No 1400/2002 of July 31, 2002, on the Application of Article 81(3) to Certain Categories of Vertical Agreements and Concerted Practices in the Motor Vehicle Sector, 2002 O.J. (L 203) 30.

[75] Respectively, Regulations (EEC) No 1983/83, 1983 O.J. (L 173) 1, 1984/83, 1983 O.J. (L 173) 5, and 4087/88, 1988 O.J. (L 359) 46.

[76] European Commission, 34 EU Competition Policy, REPORT ON COMPETITION POLICY 1999, 17 (Luxembourg, 2000).

containing exclusive supply obligations, by the buyer on which it purchases the contract goods or services.[77]

The list of "hard-core" restrictions that cannot benefit from the block exemption codifies, to a large extent, current case law. It includes, in particular:

"the restriction of the buyer's ability to determine its sale price," whether in the form of fixed or minimum prices (Article 4(a));

"the restriction of active or passive sales to end users by members of a selective distribution system operating at the retail level of trade, without prejudice to the possibility of prohibiting a member of the system from operating out of an unauthorized place of establishment" (Article 4(c));

"Any direct or indirect non-compete obligation, the duration of which is indefinite or exceeds five years. A non-compete obligation which is tacitly renewable beyond a period of five years is to be deemed to have been concluded for an indefinite duration" (Article 5(a)).[78]

b) Technology Transfer Block Exemption Regulation ("TTBER")

Commission Regulation (EC) No 772/2004 of April 7, 2004, on the application of Article 81(3) of the Treaty to categories of technology transfer agreements replaces former regulation EC No 240/1996 of January 31, 1996.[79] It applies the new economic approach, which the Commission already applied to vertical agreements block exemption to technology transfer agreements.[80] The preamble of this Regulation reads:

> Technology transfer agreements concern the licensing of technology. Such agreements will usually improve economic efficiency and be pro-competitive as they can reduce duplication of research and development, strengthen the incentive for the initial research and development, spur incremental innovation, facilitate diffusion and generate product market competition.[81]

Accordingly, in Article 3 of this new legislation, such agreements are exempt on the condition that the market share of the parties on the relevant technology and product market does not exceed:

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[77] In pursuance of Article 2(2), it includes agreements concluded by retailer's associations, on condition that no member has a turnover of more than EUR 50 million.

[78] However, Article 5(a) adds that "the time limitation of five years shall not apply where the contract goods or services are sold by the buyer from premises and land owned by the supplier or leased by the supplier from third parties not connected with the buyer, provided that the duration of the non-compete obligation does not exceed the period of occupancy of the premises and land by the buyer."

[79] Which had itself replaced, on the one hand, Regulation (EEC) No 2349/84, 1984 O.J. (L 219) 15, on the application of Article 85(3) of the Treaty to certain categories of *patent* licensing agreements, and, on the other hand, Regulation (EEC) No 556/89, 1989 O.J. (L 61) 1, on the application of Article 85(3) of the Treaty to certain categories of *know-how* licensing agreements, in order for those two block exemptions to be combined into a simplified single regulation covering technology transfer agreements.

[80] *See* Regulation (EC) No 2790/1999, 1999 O.J. (L 336) 21.

[81] Regulation (EC) No 772/2004, pmbl. point (5), 2004 O.J. (L 123) 11.

20% of the combined market share, where the agreement has been concluded between competing undertakings;

30% of each party's market share, where the agreement has been concluded between not competing undertakings.

Articles 4 and 5 still specify the restrictions that are not to be contained in agreements, such as:

> The restriction of a party's ability to determine its prices when selling products to third parties. . .
> Any direct or indirect obligation on the licensee to grant an exclusive license to the licensor or to a third party designated by the licensor in respect of its own severable improvements to or its own new applications of the licensed technology. . .
> Any direct or indirect obligation on the licensee to assign, in whole or in part, to the licensor or to a third party designated by the licensor, rights to its own severable improvements to or its own new applications of the licensed technology. . .
> Any direct or indirect obligation on the licensee not to challenge the validity of intellectual property rights which the licensor holds in the common market, without prejudice to the possibility of providing for termination of the technology transfer agreement in the event that the licensee challenges the validity of one or more of the licensed intellectual property rights.. . .[82]

2. *Exemption of categories of agreements regarding the research and development of products or processes*

Council Regulation No 2821/71 empowers the Commission to apply Article 81(3), formerly Article 85(3), of the Treaty to certain agreements, decisions or concerted practices falling within the scope of Article 81(1), formerly Article 85(1); these agreements, decisions, and practices must "have as their objective the research and development of products or processes up to the stage of industrial application, and exploitation of the results, including provisions regarding intellectual property rights."

The Commission has made use of this power by adopting Regulation (EC) No 2659/2000 of November 29, 2000, on the application of Article 81(3) of the Treaty to categories of research and development agreements.[83] The underlying principle behind this legislation is to provide:

> [c]ooperation in research and development and in the exploitation of the results generally promotes technical and economic progress by increasing the dissemination of know-how between the parties and avoiding duplication of research and development work, by stimulating new advances

[82] *Id.*

[83] This regulation hands over former Regulation (EEC) No 418/85 of December 19, 1984, on the application of Article 85(3) of the Treaty to categories of research and development. 1984 O.J. (L 53) 5.

> through the exchange of complementary know-how, and by rationalizing the manufacture of the products or application of the processes arising out of the research and development.[84]

With this principle in mind, under certain conditions listed in Articles 3 and 4, this Regulation exempts agreements where two or more undertakings pursue joint research and development of products or processes and/or joint exploitation of the results of research and development.[85] For instance:

All the private undertakings who participate in such an agreement "must have access to the results of the joint research and development for the purposes of further research or exploitation" (Article 3(2)).

Where two or more of the participating undertakings are competing undertakings, "the combined market share of the participating undertakings does not exceed 25% of the relevant market for the products capable of being improved or replaced by the contract products" (Article 4(2)).[86]

But the exemption does not apply to certain agreements, specified in Article 5(1), such as:

> The restriction of the freedom of the participating undertakings to carry out research and development independently or in cooperation with third parties in a field unconnected with that to which the research and development relates or, after its completion, in the field to which it relates or in a connected field. . .
>
> The prohibition to challenge after completion of the research and development the validity of intellectual property rights which the parties hold in the common market and which are relevant to the research and development or, after the expiry of the research and development agreement, the validity of intellectual property rights which the parties hold in the common market and which protect the results of the research and development, without prejudice to the possibility to provide for termination of the research and development agreement in the event of one of the parties challenging the validity of such intellectual property rights. . .
>
> The fixing of prices when selling the contract product to third parties. . .
>
> The prohibition to make passive sales of the contract products in territories reserved for other parties. . . .[87]

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[84] Regulation (EC) No 2659/2000, pmbl. point (10), 2000 O.J. (L 304) 7. Moreover, Point (12) adds that "consumers can generally be expected to benefit from the increased volume and effectiveness of research and development through the introduction of new or improved products or services or the reduction of prices brought about by new or improved processes."

[85] *Id.* art. 1(1).

[86] On the contrary, where the participating undertakings are not competing undertakings, the exemption "shall apply for the duration of the research and development." *Id.* art. 4(1). And "where the results are jointly exploited, the exemption shall continue to apply for seven years from the time the contract products are first put on the market within the common market." *Id.* art. 4(2).

[87] *Id.* art. 5(1).

B. Charter of Fundamental Rights of the European Union

The Charter of Fundamental Rights of the EU[88] ("Charter") was adopted on December 7, 2000, in Nice, France, on the fringes of the European Council. Article 17 of the charter, dealing with the Right to Property, reads as follows:

> 1. Everyone has the right to own, use, dispose of and bequeath his or her lawfully acquired possessions. No one may be deprived of his or her possessions, except in the public interest and in the cases and under the conditions provided for by law, subject to fair compensation being paid in good time for their loss. The use of property may be regulated by law insofar as is necessary for the general interest.
> 2. Intellectual property shall be protected.
>
> Such a right to property is a fundamental right, common to all national European constitutions, and it has been recognized on numerous occasions by ECJ case law.[89]

According to the "official" explanations to the text of the draft Charter:

> Protection of intellectual property, one aspect of the right of property, is explicitly mentioned in paragraph 2 because of its growing importance and Community secondary legislation . . . . The guarantees laid down in paragraph 1 shall apply as appropriate to intellectual property.[90]

Paragraph 2 of the Charter may therefore be seen as an example of a brief statutory delimitation of IP law, in the sense that, in Europe, protection of intellectual property would relate to the protection of fundamental rights.

However, the legal effects of such a peremptory statement, – "*intellectual property shall be protected,*" – are uncertain, especially since no normative effect have been given to the Charter itself, which merely seems to reflect a will to mention the human rights protection in the EU legal system.[91] Actually, the stated purpose of the Charter, as stated in its preamble, is only:

> to strengthen the protection of fundamental rights in the light of changes in society, social progress and scientific and technological developments by making those rights more visible. . . .

But things might change if a treaty establishing a Constitution for Europe[92] is ultimately passed because the Charter of Fundamental Rights of the Union would be intended to become part of the European Constitution. The result is that protection of intellectual property would be of constitutional significance at the

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88 2000 O.J. (C 364) 1.

89 *See e.g.* Case 44/79, Liselotte Hauer v. Land Rheinland-Pfalz, 1979 E.C.R. 3727.

90 Text of the explanations to the complete text of the draft Charter of fundamental rights of the EU, prepared at the instigation of the Praesidium (Brussels, Belgium, 2000).

91 *See* A. Pécheul, *La Charte des droits fondamentaux de l'Union européenne*, REVUE FRANÇAISE DE DROIT ADMINISTRATIF, 688 (Paris, France, 2001).

92 As submitted to the President of the European Council in Rome on July 18, 2003.

Community level rather than handled variously through national laws and through Commission Regulations and Directives.[93]

V. "*Europeanification*" Through a Community Harmonization of National IP Laws[94]

The ongoing Community harmonization of national IP laws has been made by several means.

A. Harmonization with a View of Promoting the Establishment or Functioning of the Common Market

Article 94 (formerly Article 100) of the EC Treaty empowers the Council to issue "directives for the approximation of such laws, regulations or administrative provisions of the Member States as directly affect the establishment or functioning of the common market."[95]

According to Article 249, a European directive is "binding, as to the result to be achieved, upon each Member State to which it is addressed," but it leaves "to the national authorities the choice of form and methods," so that all EU Member States are obligated to conform their domestic laws to such directives.

However, it seems that, in IP law, only one harmonization directive has currently been passed on such a basis, namely Council Directive 87/54/EEC of December 16, 1986, on the legal protection of topographies of semiconductor products, which approximated European integrated circuits layout-designs laws with legal protection under a *sui generis* registered right.[96]

B. Harmonization with a View of Establishing the Internal Market

The European Community has, in particular, been allotted "the aim of progressively establishing the internal market,"[97] which comprises "an area without internal frontiers in which the free movement of goods, persons, services and capital is ensured."[98] With this view in mind, Article 95 (formerly Article 100A) especially enables the Council to:

> [a]dopt the measures for the approximation of the provisions laid down by law, regulation or administrative action in Member States which have as their object the establishment and functioning of the internal market.[99]

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[93] In pursuance of the (current draft) Treaty establishing the European Constitution, Part II (the Charter of Fundamental Rights of the Union), Title II (Freedoms), Article II-17(2).

[94] *See* V.L. Benabou, *Le processus d'harmonisation communautaire du droit d'auteur*, JURISCLASSEUR PROPRIÉTÉ LITTÉRAIRE ET ARTISTIQUE, pt. 1840 (Paris, 2003).

[95] EC TREATY art. 94.

[96] This legislation was inspired by the US Semiconductor Chip Protection Act of November 8, 1984 (Pub. L. No 98-620, 98 Stat. 3335, 3347).

[97] EC TREATY art. 14(1).

[98] *Id.* art. 14(2).

[99] *Id.* art. 95(1).

Such approximate measures may be taken either through regulations or through directives. Regarding IP law, they relate to both substantive law and enforcement law.

1. Substantive Law Harmonization

a) Harmonization through Regulations

In the field of patent law, two harmonization regulations have been passed in order to create supplementary protection certificates:
Council Regulation (EEC) No 1768/92 of June 18, 1992, concerning the creation of a supplementary protection certificate for medicinal products;
Regulation (EC) No 1610/96 of the European Parliament and of the Council of July 23, 1996, concerning the creation of a supplementary protection certificate for plant protection products.
A supplementary protection certificate is intended to prolong the duration of the patent protection on products for which marketing authorization is required, since such authorization is usually delivered after several years. So, in order to avoid penalties in relevant sectors, a supplementary protection certificate takes over for the patent as soon as the latter expires. Article 13 of those two Regulations state:

> 1. The certificate shall take effect at the end of the lawful term of the basic patent for a period equal to the period which elapsed between the date on which the application for a basic patent was lodged and the date of the first authorization to place the product on the market in the Community reduced by a period of five years.
> 2. Notwithstanding paragraph 1, the duration of the certificate may not exceed five years from the date on which it takes effect.[100]

According to their preambles, the creation of a supplementary protection certificate granted by each of the Member States actually provides for a uniform solution at Community level, "thereby preventing the heterogeneous development of national laws leading to further disparities which would be likely" to hinder the free movement of medicinal products and plant production within the Community "and thus directly affect the functioning of the internal market.[101]

b) Harmonization through Directives

Article 95 (formerly Article 100A) constitutes the legal basis for substantive law harmonization directives in the field of both copyright and related rights law and industrial property law.

At the moment, although such directives are a little more numerous in the field of copyright and related rights law than in the field of industrial property law, the latter has a greater approximated value because European construction was origi-

[100] Regulation (EEC) No 1768/92, art. 13, 1992 O.J. (L 182) 1; Regulation (EC) No 1610/96, art. 13, 1996 (L 198) 30.

[101] Regulation (EEC) No 1768/92, pmbl.; Regulation (EC) No 1610/96, pmbl.

nally purely economic and, in Europe, connected only with industrial property while copyright mainly corresponded with culture (for which the power of Community authorities is much more recent).

In the field of copyright and related rights law, seven harmonization directives have been passed thus far, with a goal of promoting the establishment and functioning of the common market:

Council Directive 91/250/EEC of May 14, 1991, on the legal protection of computer programs, which obliged EU members to expend specific statutory copyright protection to software;[102]

Council Directive 92/100/EEC of November 19, 1992, on rental right and lending right and on certain rights related to copyright in the field of intellectual property, which required European countries to enact legislation protecting the rental right for works protected under copyright and related rights regimes;

Council Directive 93/83/EEC of September 27, 1993, on the coordination of certain rules concerning copyright and rights related to copyright applicable to satellite broadcasting and cable retransmission, under which EU countries had to provide literary and artistic property right holders with a satellite broadcasting right and a cable retransmission right, both to be exercised under a principle of contractual freedom (the latter generally through collecting societies);

Council Directive 93/98/EEC of October 29, 1993 harmonizing the term of protection of copyright and certain related rights, which notably imposed EU countries to extend the copyright term to life plus 70 years;[103]

Directive 96/9/EC of the European Parliament and of the Council of March 11, 1996 on the legal protection of databases, which demanded Member States to enact legislation providing a *sui generis* right against unauthorized extraction and reutilization of a substantial part of a database;

Directive 2001/29/EC of the European Parliament and of the Council of May 22, 2001 on the harmonization of certain aspects of copyright and related rights in the information society, which required EU countries to adapt and supplement their current copyright and related rights law to the digital environment;

Directive 2001/84/EC of the European Parliament and of the Council of September 27, 2001 on the resale right for the benefit of the author of an original work of art, under which each Member State will soon be obliged to provide, for the benefit of authors of graphic and plastic works of art, a right to receive a royalty based on the sale price obtained for any resale of the work, subsequent to the first transfer of the work by the author, involving as sellers, buyers or intermediaries art market professionals.[104]

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[102] This legislation has been enacted under the influence of the amendment to the U.S. Copyright Act regarding computer programs of December 12, 1980 (Pub. L. No 96-517, § 10(b), 94 Stat. 3028), as well as the American leading case of Apple Computers, Inc. v. Franklin Computer Corp., 714 F.2d 1240 (3d Cir. 1983), *cert. denied*, 464 U.S. 1033 (1984).

[103] Such a duration has also been adopted in the U.S. under the Sony Bono Copyright Term Extension Act of October 27, 1998 (Pub. L. No 105-298, 112 Stat. 2827, codified as amended at 17 U.S.C. §§ 302-305).

[104] Such as salesrooms, art galleries and, in general, any dealers in works of art.

In the field of industrial property law, with the exception of national patents, which have already been harmonized through the European Patent Convention of 1973, three harmonization directives in the field of industrial property law have currently been passed on the basis of Article 95 (formerly Article 100A) of the EC Treaty:

Council Directive 89/104/EEC of December 21, 1988, to approximate the laws of the Member States relating to trademarks, which has contributed to harmonize aspects of substantive national laws concerning registered trademarks, apart from questions of procedure as regards registration, nullity, and invalidity;

Directive 98/44/EC of the European Parliament and of the Council of July 6, 1998, on the legal protection of biotechnological inventions, which has obliged EU countries to provide inventors of a biological invention with a patent protection because, "in particular in the field of genetic engineering, research and development require a considerable amount of high-risk investment and therefore only adequate legal protection can make them profitable";[105]

Directive 98/71/EC of the European Parliament and of the Council of October 13, 1998, on the legal protection of designs, which has harmonized EU national laws on registered designs, in particular as regards protection requirements, scope and term of protection, and rights conferred by the design right.

In addition, the European Parliament and the Council made, on February 2002, a proposal for a directive on the patentability of computer-implemented inventions,[106] under which a computer-implemented invention would be patentable on the condition that it makes "a technical contribution."[107]

2. *Enforcement Law Harmonization*

Since "the disparities between the systems of the Member States regarding the means of enforcing intellectual property rights are prejudicial to the proper functioning of the Internal Market,"[108] Article 95 has been chosen as the legal basis for Directive 2004/48/EC of the European Parliament and of the Council of April 29, 2004, for the enforcement of IP rights.

The Directive "does not aim to establish harmonized rules for judicial cooperation, jurisdiction, the recognition and enforcement of decisions in civil and commercial matters, or deal with applicable law";[109] its objective is just "to approximate legislative systems so as to ensure a high, equivalent and homogeneous level of protection in the Internal Market."[110]

For example, it encompasses measures for preserving evidence (Article 7), and it confers to IP rights holders the right to apply for an injunction against infring-

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[105] Directive 98/44/EC, pmbl. point (2), 1998 O.J. (L 16) 18.

[106] Proposal for a Directive of the European Parliament and of the Council on the Patentability of Computer-Implemented Inventions, 2002 O.J. (C 151E) 129.

[107] *Id.* art. 4(2).

[108] Directive 2004/48/EC, pmbl. point (8), 2004 O.J. (L 157) 45.

[109] *Id.*, *see* pmbl. point 11.

[110] *Id.*, *see* pmbl. point 10.

ers (Article 11) or the right to receive damages appropriate to the actual prejudice suffered by him as a result of the infringement (Article 13).

C. Harmonization with a View of Implementing the Common Commercial Policy

Article 133 (formerly Article 113) of the EC Treaty is "the key provision as regards common commercial policy. It lays down the scope thereof, the powers conferred, as well as the procedural rules which apply to the negotiation and conclusion of international agreements concluded by the Community."[111]

Now, even though IP rights do not relate specifically to international trade, there is an undeniable connection between intellectual property and trade in goods:

The power to prohibit the use of a trademark, the manufacture of a product, the copying of a design or the reproduction of a book, a disc or a videocassette inevitably has effects on trade.[112]

For this reason, the powers conferred to the Community by Article 133 may apply to the negotiation and conclusion of agreements on the commercial aspects of intellectual property.[113] Since "it relates to measures to be taken by the customs authorities at the external frontiers of the Community,"[114] Any EC regulation passed in pursuance of an international agreement concluded by the Community, concerning the prohibition of the release into free circulation of counterfeit goods, could therefore be rightly based on such Article 133.

At the moment, the only IP regulation based on Article 133 is the Council Regulation (EC) No 1383/2003 of July 22, 2003, concerning customs' action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights.[115] Its main purpose is to oblige Member States to have their custom authorities fight against infringement by harmonizing their powers.

According to its Article 1, this Regulation lays down both the conditions under which the national custom authorities have to act where goods suspected of infringing an intellectual property right "are entered for release for free circulation, export or re-export," or "are found during checks on goods entering or leaving the Community customs territory, . . . placed under a suspensive procedure, . . . in the process of being re-exported subject to notification, . . . or in a free zone or free warehouse"; and the "measures to be taken by the competent authorities

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[111] C. Schmitter, *Article 113*, in TRAITÉ SUR L'UNION EUROPÉENNE, COMMENTAIRE ARTICLE PAR ARTICLE 290 (Paris, 1995).

[112] Opinion 1/94 of the Court of November 15, 1994, Competence of the Community to conclude international agreements concerning services and the protection of intellectual property, Point (57), EUROPEAN COURT REPORT I-5267 (1994).

[113] EC TREATY art. 133(5).

[114] Opinion 1/94, supra, note 112, Point (55).

[115] This Regulation replaces former Council Regulation (EC) No 3295/94, 1994 O.J. (L 341) 8, laying down measures to prohibit the release for free circulation, export, re-export or entry for a suspensive procedure of counterfeit and pirated goods (which is repealed with effect from July 1st, 2004).

when the [above-mentioned] goods . . . are found to infringe intellectual property rights."[116]

As an example of substantive law provision, Article 13 reads:

> 1. If, within 10 working days of receipt of the notification of suspension of release or of detention, the customs office. . . has not been notified that proceedings have been initiated to determine whether an intellectual property right has been infringed under national law. . . or has not received the right-holder's agreement. . . where applicable, release of the goods shall be granted, or their detention shall be ended, as appropriate, subject to completion of all customs formalities.
>
> This period may be extended by a maximum of 10 working days in appropriate cases.
>
> 2. In the case of perishable goods suspected of infringing an intellectual property right, the period referred to in paragraph 1 shall be three working days. That period may not be extended.[117]

D. Encouragement of Member States to Adhere to the Same International Treaties

For a long time, all EU Member States have been adhering to the main WIPO-administrated international treaties in the field of industrial property law such as the Paris Convention[118] and the Patent Cooperation Treaty ("PCT"),[119] but this was not always the case in the field of copyright and related rights law.

That is why, on December 11, 1990, the Commission submitted a proposal[120] for a Council Decision concerning the accession of the Member States to the Berne Convention of September 9, 1886 for the protection of literary and artistic works and also the Rome Convention of October 16, 1961, for the protection of performers, producers of phonograms and broadcasting organizations.

Since such a decision would have been binding on all, EU Member States opposed it, and the Council instead adopted on May 14, 1992, a Resolution on increased protection for copyright and neighboring rights.[121] As a resolution, this merely *encourages* the Member States to become parties to those two Conventions.

Moreover, the ECJ admitted that, regarding IP law, the EU adherence to an International Convention should not be regarded as a sufficient legal basis for a Community harmonization since IP rights "affect internal trade just as much as, if not more than, international trade."[122]

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116 Regulation (EC) No 1383/2003, 2003 O.J. (L 196) 7.

117 *Id.*

118 Paris Convention for the Protection of Industrial Property, March 20, 1883, 21 U.S.T. 1583, 828 U.N.T.S. 305.

119 Patent Cooperation Treaty, June 19, 1970, I I.L.M, 978, 28 U.S.T. 7645, 1160 U.N.T.S. 231.

120 COM(90) 582 final.

121 1992 O.J. (C 138) 1.

122 Opinion 1/94 of the Court, supra, note 112, Point (57).

VI. *"Europeanification"* Through the Establishment of a Community IP Law

The current establishment of a Community IP law through the adoption of IP rights submitted solely under EC law, and therefore largely unbound to national legal systems, represents one further step on the road to European integration.

Since the Luxembourg Convention of 1975 on the Community Patent never came into force (because it has not been ratified by enough countries), European authorities have, since the 1990s, chosen to establish Community IP rights mostly by passing EC regulations in the field of industrial property law on both distinctive signs and industrial creations.

A. Community IP Rights on Distinctive Signs

1. Community Geographical Indications and Designations of Origin

The EU has enacted several separate and detailed regulations governing the use, among other things, of geographical designations for wines, spirit drinks, or agricultural products and foodstuffs.

a) Designations for Wines

As part of a common agricultural policy, Council Regulation (EC) No 1493/1999 of May 17, 1999, on the common organization of the market in wine encompasses measures for the adaptation of wine-growing potential and a quality policy. It includes, in particular, provisions on the use of a geographical indication for designating quality wines produced in specified regions ("QWPSR") and table wines.

b) Designations for Spirit Drinks

Council Regulation (EEC) No 1576/89 of May 29, 1989, sets down general rules on the definition, description and presentation of spirit drinks.[123] This Regulation was enacted in order to maintain a certain quality standard for the products in question, especially by securing the use of certain terms for the sole products of the same quality as traditional products.

Actually, some of those terms may constitute protected geographical indications "provided that the stages of production during which the finished product acquires its characteristics and definitive properties are completed in the geographical area in question."[124] For instance, the designations:

'Grappa' may be used solely for certain grape mark spirit drinks produced in Italy;[125]

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[123] As amended by Regulation (EC) No 3378/94 of the European Parliament and of the Council of December 22, 1994, 1994 O.J. (L 366) 1.

[124] Regulation (EEC) No 1576/89, pmbl, 1989 O.J. (L 160) 1.

[125] *Id.* art. 1.4.f(2).

'Pacharán' may be used solely for certain fruit spirit drinks manufactured in Spain;[126]

'Ouzo' may be used solely for certain aniseed-flavored spirit drinks produced in Greece.[127]

c) *Designations for Agricultural Products and Foodstuffs*

Council Regulation (EEC) No 2081/92 of July 14, 1992, on the protection of geographical indications and designations of origin for agricultural products and foodstuffs,[128] establishes a community-wide registration system for designations of origin in order to provide information to those involved in trade and to consumers. Such a system, which aims to encourage the diversification of agricultural production and to improve quality, applies to agricultural products intended for human consumption, including beers and spring waters.

The text especially distinguishes between designation of origin and geographical indication, although both refer to the name of a region or a specific place used to describe an agricultural product of a foodstuff, but the former relates to qualities or characteristics, "which are essentially of exclusively due to a particular geographical environment with its inherent natural and human factors, and the production, processing and preparation of which take place in the defined geographical area."[129]

The latter relates to "a specific quality, reputation or other characteristics attributable to that geographical origin and the production and/or processing and/or preparation of which take place in the defined geographical area."[130]

2. *Community Trademark*

Approximation of national trademark laws laid down by Council Directive of 1988[131] may sometimes be insufficient for products and services of undertakings to be distinguished by identical means throughout the entire EU territory. A Community trademark ("CTM") was therefore created pursuant to Council Regulation (EC) No 40/94 of December 20, 1993.[132]

According to Articles 7 and 8 of this regulation, which regime is very close to national ones since their approximation, the main substantive requirements of protection are that the trademark has a distinctive character; the trademark is not

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[126] *Id.* art. 1.4.l(2).

[127] *Id.* art. 1.4.o(3).

[128] Complemented by Commission Regulation (EEC) No 2037/93, 1993 O.J. (L 185) 5, laying down detailed rules of application of Council Regulation (EEC) No 2081/92, 1992 O.J. (L 208) 1, on the protection of geographical indications and designations of origin for agricultural products and foodstuffs.

[129] Council Regulation (EEC) No 2081/92, *supra* note 129, art. 2(2)(a).

[130] *Id.* art. 2(2)(b).

[131] *See* First Council Directive 89/104/EEC of December 21, 1988 to approximate the laws of the Member States relating to trademarks, *supra* note 105.

[132] Complemented by Commission Regulation (EC) No 2868/95 of December 1, 1995 implementing Council Regulation (EC) No 40/95 on the Community trademark, and (EC) No 2869/95 of December 13, 1995 on the fees payable to the Office for Harmonization in the Internal Market, 1995 O.J. (L 303) 1.

of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services; and the trademark is not identical with an earlier trademark protected for identical goods or services.[133]

Since the Community trademark can only be obtained by registration,[134] an Office for Harmonization in the Internal Market ("OHIM") for trademarks and designs was established,[135] with its headquarters in Alicante, Spain.

B. Community IP Rights on Industrial Creations

1. Community Designs

The OHIM has been given responsibility for registering Community designs since April 1st, 2003, under Council Regulation (EC) No 6/2002 of December 12, 2001,[136] which lays down the new EU Community system for designs protection with uniform effect throughout the entire territory of the Community.

The reasons for adopting Community designs are similar to those for adopting the Community trademark, but there is a supplementary reason:

Enhanced protection for industrial design not only promotes the contribution of individual designers to the sum of Community excellence in the field, but also encourages innovation and development of new products and investment in their production.[137]

The main substantive requirements of protection, which are very close to national requirements, considering the prior Directive 98/71/EC of October 13, 1998 on the legal protection of designs, are *novelty* and *individual character*:[138]

> A design shall be considered to be new if no identical design has been made available to the public;[139]
> A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public.[140]

Registered designs are protected in the whole Community for up to 25 years, but registrations need to be renewed every five years up to that maximum. Moreover, unregistered designs are also protected for three years from the date of their

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133 Regulation (EC) No 40/94, arts. 7 & 8, 1994 O.J. (L 11) 1.

134 *Id.* art. 6.

135 *Id.* art. 2.

136 Complemented by Commission Regulations (EC) No 2245/2002 of October 21, 2002 implementing Council Regulation (EC) No 6/2002 on Community designs, and (EC) No 2246/2002 of December 16, 2002 on the fees payable to the Office for Harmonization in the Internal Market (Trademarks and designs) in respect of the registration of Community designs, 2002 O.J. (L 341) 28.

137 Regulation (EC) No 6/2002, pmbl. point (7), 2002 O.J. (L 3) 1.

138 *Id.* art. 4(1).

139 *Id.* art. 5(1).

140 *Id.* art. 6(1).

disclosure to the public within the EU, which may occur through designs going on sale or through prior marketing or publicity.[141]

2. *Community Plant Variety Rights*

At the moment, contrary to other industrial property regimes, industrial property regimes for plant varieties have not been harmonized at the Community level. Nevertheless, Council Regulation (EC) No 2100/94 of July 27, 1994 on Community plant variety rights,[142] organized a uniform regime which, although co-existing with national ones, "allows for the grant of industrial property rights valid throughout the Community."[143]

According to this regulation, the main substantive requirements of protection are *distinctness*, *uniformity*, *stability* and *novelty* of a variety:[144]

Article 7(1) provides that "a variety shall be deemed to be distinct if it is clearly distinguishable by reference to the expression of the characteristics that results from a particular genotype or combination of genotypes, from any other variety whose existence is a matter of common knowledge on the date of application."

Article 8 provides that "a variety shall be deemed to be uniform if, subject to the variation that may be expected from the particular features of its propagation, it is sufficiently uniform in the expression of those characteristics which are included in the examination for distinctness, as well as any others used for the variety description."

Article 9 provides that "a variety shall be deemed to be stable if the expression of the characteristics which are included in the examination for distinctness as well as any others used for the variety description, remain unchanged after repeated propagation or, in the case of a particular cycle of propagation, at the end of each such cycle."

A Community Plant Variety Office, with headquarters in Angers, France, was also established because a Community plant variety right can be obtained only by registration. As to its effects, a Community plant variety right should, in principle, last 25 years or, in the case of varieties of vine and tree species, 30 years from the grant.[145]

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[141] *Id.* art. 11.

[142] Complemented by Commission Regulations (EC) No 1238/95, 1995 O.J. (L 121) 31, establishing implementing rules for the application of Council Regulation (EC) No 2100/94 as regards the fees payable to the Community Plant Variety Office, and (EC) No 1239/95 of May 31, 1995 establishing implementing rules for the application of Council Regulation (EC) No 2100/94 as regards proceedings before the Community Plant Variety Office, 1995 O.J. (L 121) 37.

[143] Regulation (EC) No 2100/94, pmbl, 1994 O.J. (L 227) 1.

[144] In addition, such a protectable variety has to be designated by a prescribed variety denomination.

[145] Regulation (EC) No 2100/94, art. 19(1).

3. *Forthcoming Community Patent*

In order to bypass the failure of the Luxembourg Convention on the Community patent,[146] the European Commission made a proposal in 2000 for a Council Regulation on Community patent.[147] Member States within the EU Council agreed to the proposal on March 3, 2003.[148]

Such a system would "be introduced by allowing the European Community, as a single entity, to become a member of the Munich Convention (which created the European Patent Organization). The Community would have the status equivalent to that of a member joining an international convention so that any applicant, whether based in the Community or not, could obtain a patent which would apply to the whole territory of the Community. Registration, examination of applications and the granting of patents would be handled by the European Patent Office."[149]

The main features of the planned legislation are as follows:

Upon grant of patent, applicants would only be required to translate the patent *claims* into all languages of the Union (to avoid excessive translation costs which would make the Community patent far less attractive);

A Community patent would be granted, transferred or voided only for the Union as a whole;

Community patent litigation would be concentrated at the Community Patent Court, under the aegis of the ECJ.

VII. Conclusion

This study and overview reveals that IP law in Europe has evolved from resting solely on European national laws to a partial EC law. However, considering the overlapping powers, it also obliges a reappraisal of the classical and fundamental doctrine of nationality or territoriality in IP rights.

Such an opinion arises from three characteristic examples, which hardly fit the principle of territoriality of IP rights.

First, the centralized registration system in the European Patent Office set up by the Munich Convention only allows the patentee to be protected under national IP rights. Domestic courts are consequently free to decide on the validity and infringement issues, which may lead to contradictory interpretations of the same legislation. The "*Epilady*" case (about an electric body hair shaver) illustrates how courts in different European jurisdictions adjudicating the same patent have come to conflicting conclusions about the alleged infringement: a British

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[146] *See* Luxembourg Convention, *supra* note 5.

[147] Proposal for a Council Regulation on the Community patent (COM(2000) 412 final), dated August 1, 2000, complemented by Proposal for a Council Decision conferring jurisdiction on the Court of Justice in disputes relating to the Community patent (COM(2003) 827 final) and Proposal for a Council Decision establishing the Community Patent Court and concerning appeals before the Court of First Instance (COM(2003) 828 final), both dated December 23, 2003.

[148] Memo 03/47, dated March 4, 2003.

[149] See Opinion of the Economic and Social Committee on the "Proposal for a Council Regulation on the Community patent" (2000/C155/15), done in Brussels (Belgium) on March 29, 2001, Point (4.2).

patent court held that there was no infringement[150] while a German court came to the opposite conclusion.[151]

Second, however legitimate it may be, the ECJ case law delimitation of national IP laws, notably as regards the principle of non-discrimination and the free movement of goods, constitutes a real restriction made by a supranational court in the exercise of national IP rights.

Finally, the unitary EC industrial property rights currently adopted are supposed to "have equal effect throughout the whole Community."[152] However, they are not totally unbound to national legal systems in certain respects such as:

The remaining competence of national courts regarding infringement suits, with differences in judicial procedures and sanctions from one country to another;

National authorities are required to actively participate in the implementation of EC regulations in the field of geographical indications;

A Community trademark application may be defeated because it would be descriptive in a single EU country or because of the existence of prior conflicting rights in this country.[153] Moreover, with the expansion of the EU to twenty-five countries on May 1, 2004, "holders of earlier rights in new member states can enforce their rights against extended CTMs as permitted by their legislation, provided that the earlier right was registered, applied for, or acquired in good faith in the new member state prior to the date of accession of that state."[154] Professor Dinwoodie is therefore right to mention that the CTM affects a "revision to the territoriality principle"[155] of IP rights.

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150 Improver Corp. v. Remington Consumer Prods. Ltd., 1990 F.S.R. 181 (Ch. D. 1989).

151 Improver Corp. v. Remington Consumer Prods., Case No 2 U 27/89, Düsseldorf Court of Appeals (Oberlandgericht) (1991), 24 I.I.C. 838-845 (1993).

152 Article 1(2) of the Trademark Regulation, Article 1(3) of the Designs Regulation and Article 2(1) of the Proposal for a Patent Regulation.

153 *See* G. B. Dinwoodie, *Trademarks and Territory: Detaching Trademark Law from the Nation-State*, 41 HOUSTON L. REV. 887, 948 (2004).

154 *Id.*

155 *Id.*

CONVENTIONAL WISDOM, DE-EMPTION AND UNCOOPERATIVE FEDERALISM IN INTERNATIONAL ENVIRONMENTAL AGREEMENTS

Kirk W. Junker*

"States should not dismiss the possibilities for creative initiatives at the international level, even if this does go against conventional wisdom."
—Robert C. Shinn and Matt Polsky, New Jersey Department of Environmental Protection[1]

Abstract:

What powers do the several states of the United States have individually to enter into environmental agreements with other sovereign nations? In this article, the author reviews the powers that states may have generally and then specifically regarding environmental agreements. Several traditional tools of analysis have historically been used including the constitutional doctrine of pre-emption, cooperative federalism and the foreign affairs doctrine. Some newer tools of analysis are also offered including the revival of the treaty-compact and the author's own concept of "de-emption." The United States Senate's explicit refusal to ratify the Kyoto Protocol, coupled with the consequent state initiatives to control greenhouse gases—especially the documents concluded between New Jersey and the Netherlands, provide rich examples of these tools in contemporary action.

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[1] Robert C. Shinn, Jr. and Matthew Polsky, *The New Jersey Department of Environmental Protection's Non-Traditional Role in Promoting Sustainable Development Internationally*, 3 SETON HALL J. DIPL. INT. REL. 93, 103 (2002).

Introduction—A Brief Review of Conventional Wisdom on State Treaty Powers

As conventional wisdom would have it, the several states of the United States of America have agreed that in constituting the sovereign United States, the several states would refrain from individually entering into treaties with foreign nations. Treaty power is a federal power. Article II, sec. 2 (2) of the United States' Constitution confers the treaty power on the President and the Senate,[2] and Article I, sec. 10 (1) prohibits states from "entering into any Treaty, Alliance or Confederation."[3] At first blush, one might conclude that this statement of the law is clear and exclusive, but the history of unchallenged state actions, as well as American court decisions in challenged state actions, have shown otherwise.[4]

The states and the courts in these actions and decisions have noted that neither Article I nor Article II declares that states have no foreign relations role to play, nor that they have no power to do so, as Edward T. Swaine and David R. Hodas have thoroughly catalogued this.[5] In reflection of this, recent years' scholarship has witnessed a progression from reviews of federalism and states' rights generally regarding treaty-making powers[6] to those specifically regarding such issues as state procurement[7] and environmental agreements with foreign powers.[8] The various types of agreements entered into by the several states with foreign countries has been most thoroughly catalogued by Edward T. Swaine.[9] Swaine's work covers a diverse and extensive range of areas but only touches lightly upon the natural environment. David R. Hodas extends the catalogue more recently to include the natural environment.[10] The recent interest in environmental agreements has blossomed largely, but not exclusively, in response to the United States Senate's explicit refusal to ratify the Kyoto Protocol.[11] The Senate and the Bush Administration have taken the position that the environmental benefits to be gained from the Kyoto Protocol do not outweigh the economic advantages for the United States to remain outside of its requirements.[12]

Swaine reminds us that although the United States Constitution prohibits states from entering into any treaty, alliance, or confederation, states may, *with the*

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2 U.S. CONST. art. II, § 2, cl. 2.

3 U.S. CONST. art. I, § 10.

4 Edward T. Swaine, *Negotiating Federalism: State Bargaining and the Dormant Treaty Power*, 49 DUKE L.J. 1127 (2000) [hereinafter Swaine, *Negotiating Federalism*].

5 *Id.* (providing a thorough catalogue of these decisions); Edward T. Swaine, *Does Federalism Constrain the Treaty Power?* 103 COLUM. L. REV. 403 (2003) [hereinafter Swaine, *Does Federalism*]; David R. Hodas, *State Law Responses to Global Warming: Is It Constitutional to Think Globally and Act Locally?* 21 PACE ENVTL. L. REV. 53, 81 (2003).

6 Swaine, *Negotiating Federalism*, *supra* note 5; Swaine, *Does Federalism*, *supra* note 6.

7 Robert J. Delahunty, *Federalism beyond the Water's Edge: State Procurement Sanctions and Foreign Affairs*, 37 STAN. J. INT'L L. 1 (2001).

8 Hodas, *supra* note 6.

9 Swaine, *Negotiating Federalism*, *supra* note 4.

10 Hodas, *supra* note 6.

11 S. Res. 98, 105th Cong., 143 CONG. REC. 8113 (enacted).

12 *Id.*

permission of Congress, enter into an "Agreement or Compact" with a foreign government.[13] If we rely upon the intentions of the Constitutional authors (usually known by the phrase "framers' intent"), the distinction between the permissible agreement, compact, the prohibited treaty, alliance, or confederation may be impossible to determine due to a lack of documentation in the records from the Constitutional Convention.[14] Recent sources assume that states may enter into foreign compacts prior to seeking consent from Congress, and may even conclude binding agreements without ever obtaining federal approval.[15] Louis Henkin punctuates this point when he notes that "no agreement between a state and a foreign power has been successfully challenged on the ground that it is a treaty which the state was forbidden to make."[16] Furthermore, "not only does international law require federal states to interpret their constitutions so as to permit adhering to treaties, but the new federalism doctrines show a sensitivity toward preserving adequate means to pursue national and international ends like the treaty power, especially where those means turn on state consent."[17]

In the following article, I briefly review and combine the work of Swaine and Hodas, and discuss the recent groundswell of states' agreements with foreign countries. In addition to the interpretations that are largely presented in cases, Swaine and Hodas have each offered new ideas on pre-emption and the dormant treaty power, and I now add a new principle with which to analyze co-operative federalism that I call "de-emption."[18]

Tools of States' Treaty Powers Analysis: Conventional Tools

1. Cooperative Federalism and States' Rights

Federal-state relations in the regulation of the environment have been as much a product of politics as of law and have generally yielded a functional, rather than a precisely legal working relationship known as "cooperative federalism." Cooperative federalism in environmental regulation is a term used to describe the political co-operation necessary between the federal government and state governments to execute the mandate of federal environmental statutes and regulations by state enforcement agencies through federal and state statutes and regu-

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[13] U.S. CONST. art. I § 10, cl. 3.

[14] Swaine, *Negotiating Federalism*, *supra* note 5, at 1194, *citing* United States Steel Corp. v. Multistate Tax Comm'n, 434 U.S. 452, 459-63 & n.12: "The records of the Constitutional Convention. . . are barren of any clue as to the precise contours of the agreements and compacts governed by the Compact Clause."). This provides a good example of why intentionality is dismissed as a mode of interpretation by philosophers and psychologists, and why an author's intent is not privileged by literary experts. *See* Kirk W. Junker, *Reading Attitude in the Constitutional Wish*, S. CAL. INTERDISC. L. J. (forthcoming Winter, 2005).

[15] Swaine, *Negotiating Federalism*, *supra* note 5, at n.337.

[16] LOUIS HENKIN, FOREIGN AFFAIRS AND THE UNITED STATES CONSTITUTION (2d ed. 1996).

[17] Swaine, *Does Federalism*, *supra* note 5, at 403.

[18] Regarding the need and appropriate use of neologisms *see* Kirk W. Junker, *De-diction*, 34 FUTURES 895 (2002).

lations.[19] In areas where state programs cover the full range of necessary laws, with an enforcement regime as strict as or stricter than that of the federal government, states, rather than the federal government, are said to have enforcement "primacy."[20] However there remains discretion within all enforcement regimes, and to the extent that states maintain their primacy by exercising discretion in conjunction with federal policy, a system of federal-state cooperation is necessary in order to maintain consistency. Cooperative federalism in environmental law works as a relationship of negotiated legal power, where federal and state legal power overlap in the quilt-work of federal statutes. The Clean Water Act, the Clean Air Act, and the Surface Mining Control and Reclamation Act,[21] the various states' counterparts to those statutes, and the work of the federal and state agencies who enforce them demonstrate cooperative federalism in practice.

In the case of climate change, one might well assume the federal government, or its agent, the Environmental Protection Agency ("E.P.A."), has taken a position regarding the United Nations Framework Convention on Climate Change ("U.N.F.C.C.C.") or Kyoto Protocol or both to drive cooperative federalism with the states.[22] If we extend cooperative federalism beyond its strictly legal nature to include a policy agenda, the principle of cooperative federalism might therefore suggest that states should also be uninterested in carrying out any compulsory climate change law or policy. To the extent that some states have at least signed documents like memoranda of understanding, declarations, agreements, and aide memoirs with foreign countries, we are witnessing instead what might be called "uncooperative federalism," certainly in regards to policy, and perhaps also in regards to law. Seen by its manifestations of simple legal mechanics, this situation begins to look very much like an extension of the trend in favor of states' rights by the United States Supreme Court and similar-minded theorists. The situation is a bit peculiar, however, when one considers that politically by putting environmental rights back into the hands of the states, in this case, the result in fact has been a more favorable national environmental policy. This is most apparent with greenhouse gas regulation, which will be discussed later in section III A.

2. *Preemption*

In addition to the cooperative federalism principle that outlines the relationship of the federal to the state governments regarding domestic environmental issues, there also exists the familiar principle designed to determine the relationship of the federal to state governments regarding international environmental

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[19] John C. Dernbach, *Pennsylvania's Implementation of the Surface Mining Control and Reclamation Act: An Assessment of How "Cooperative Federalism" Can Make State Regulatory Programs More Effective*, 19 U. MICH. J.L. REFORM 903 (1986).

[20] *Id.* at 904.

[21] 30 U.S.C. § 1201-1328 (1982). *See* Dernbach, *supra* note 20.

[22] Ann E. Carlson, *Preemption and Greenhouse Gas Emissions*, 37 U.C. DAVIS L. REV. 281 (2003); THE PEW FOUNDATION, *Pew Report on the Bush Administration's Response to Kyoto, in*, INTERNATIONAL ENVIRONMENTAL LAW (2003).

issues known as preemption.[23] From the language of the U. S. Constitution, one might well assume that the operation of the principle of preemption is clear regarding its application to state treaty powers. As the Supreme Court stated: "From the Supremacy Clause comes the preemption doctrine, which preempts state laws that Congress expressly preempts, when federal law occupies the field, or where the law, generally or as applied, obstructs a federal law from achieving its purpose."[24] Simply put, if a state law is in conflict with a federal law, including the law of treaties, then that state law is preempted. But what if there is an international law situation that is likely to be subject to the federal law of treaties and there is no ratified treaty? In other words, what does preemption mean when the source of law is international law?

Given that the natural environment knows no national borders, the regulation of the natural environment has become a recurrent theme internationally regarding questions of federalism.[25] Conventionally stated, "from the international law vantage, international law prevails over any domestic law."[26] At the same time, there are limits. As the Restatement makes clear: "But from the vantage of the United States legal system, international law has no bearing on the Constitution, which operates as an absolute constraint on how United States obligations may be observed."[27]

The United States Constitution in "Article VI expressly declares that the laws and treaties of the United States are the supreme law of the land."[28] Likewise, international agreements and federal determinations and interpretations of customary international law[29] are also considered supreme to state law and would preempt such law according to the courts.[30] State law is preempted when it is inconsistent with federal law or policy.[31] State law is also preempted if federal

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[23] Hodas, *supra* note 6, at 67.

[24] *Id.*, citing Gade v. Nat'l Solid Waste Mgmt. Ass'n, 505 U.S. 88, 98 (1992).

[25] *See, e.g.*, MICHAEL KLOEPFER, ed., UMWELTFÖDERALISMUS: FÖDERALISMUS DEUTSCHLAND: MOTOR: ODER BREMSE FUR DEN UMWELTSCHÜTZ? WISSENSCHAFTLICHE TAGUNG DES FORSCHUNGSZENTRUMS UMWELTRECH DER HUMBOLDT-UNIVERSITÄT ZU BERLIN (Duncker & Humblot, 2002).

[26] Swaine, *Does Federalism, supra,* note 6, at 449, *citing* Advisory Opinion, Applicability of the Obligation to Arbitrate Under Section 21 of the United Nations Headquarters Agreement of 26 June 1947, 1988 I.C.J. 12, 34, P57 (Apr. 26) (noting that it is a "fundamental principle of international law that international law prevails over domestic law"); MARTIN DIXON & ROBERT MCCORQUODALE, CASES AND MATERIALS ON INTERNATIONAL LAW (4th ed. 2003).

[27] *See* Swaine, *Does Federalism, supra,* note 6, at 449, *citing* RESTATEMENT (THIRD) OF THE FOREIGN RELATIONS LAW OF THE UNITED STATES § 115(3) (1987).

[28] RESTATEMENT (THIRD) OF THE FOREIGN RELATIONS LAW OF THE UNITED STATES § 1 Reporter's Note 5 (1987).

[29] Customary law is generally recognized as one of the three sources of international law. Article 38 of the Statute of the International Court of Justice explicitly directs the Court to use conventions, customs and general principles as primary sources of law in making its determinations. Statute of the International Court of Justice, June 26, 1945, art. 38, 59 Stat. 1055, 1060, 3 Bevans 1153, 1187.

[30] RESTATEMENT (THIRD) OF THE FOREIGN RELATIONS LAW OF THE UNITED STATES § 111 Reporters' notes 3 (1987) (referring to In Banco National de Cuba v. Sabbatino, 376 U.S. 398 (1964) for the modern view of customary international law.)

[31] *Id.* at § 115(3). For a discussion of how this view is in part an anomaly of U.S. legal thinking, see Detlev F. Vagts, *The United States and its Treaties: Observance and Breach,* 95 Am. J. Int'l L. 313, 329 (2001) *cited in* Swaine, *Does Federalism, supra* note 6 at n.188.

authority occupies the field even if the state law is not inconsistent with the federal law or policy.[32] As the Restatement clarifies: "In principle, a United States treaty or international agreement may also be held to occupy a field and preempt a subject, and supercede State law or policy even though that law or policy is not necessarily in conflict with the international agreement, or when the matter has apparently not been adjudicated."[33] In addition, "[a]s to international law, it has been authoritatively stated that even a subject that is strictly of domestic concern 'ceases to be one solely within the domestic jurisdiction of the State, [and] enters the domain governed by international law,' if states conclude an international agreement about it."[34]

In the United States, under the doctrine of non-self execution, treaties may lack preemptive force until implemented by domestic legislation.[35] In those situations, theorists in support of a strong federal government have historically espoused what they have termed a "dormant treaty power," that is the Treaty Clause's putative preemption of state authority even in the absence of any ratified treaty.[36] The assumption here would presumably be that if the United States has signed a treaty, it would intend to ratify it and indeed the international principle of *pacta sunt servanda* would require it.[37] Moreover, if the United States were to sign a treaty, one might well expect that the federal government intended to claim the substantive area of the treaty for itself.

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[32] RESTATEMENT (THIRD) OF THE FOREIGN RELATIONS LAW OF THE UNITED STATES § 115(3) (1987).

[33] *Id.* at § 115 cmt. e.

[34] *Id.* at § 302 Reporters' Note 2 (quoting Nationality Decrees in Tunis and Morocco (Great Britain v. France), P.C.I.J. ser. B, No. 4, p.26 (1923)).

[35] John H. Jackson, *Status of Treaties in Domestic Legal Systems: A Policy Analysis,* 86 AM. J. INT'L L. 310, 323-27 (1992) (describing functional arguments, most relating to legislative authority, for disfavoring direct application). To the extent that the non-self-execution doctrine concerns the Supremacy Clause it pertains directly to the federal government's authority relative to the states. *See* Foster v. Neilson, 27 U.S. 253, 314 (1829) (Marshall, C.J.) (concluding that, save where state parties agreed that a treaty would not be self-executing, the Supremacy Clause required that a treaty "be regarded in courts of justice as equivalent to an act of the legislature, whenever it operates of itself, without the aid of any legislative provision"), overruled in part, United States v. Percheman, 32 U.S. 51, 88-89 (1833) (modifying Foster, on its facts, where subsequently unearthed Spanish version of treaty suggested that it was self-executing); *see also infra* note 263 (discussing Foster). But the insistence in Foster v. Neilson on a strong presumption in favor of self-execution has arguably eroded, making reliance on the Supremacy Clause more attenuated. *Compare* Louis Henkin, *U.S. Ratification of Human Rights Treaties: The Ghost of Senator Bricker,* 89 AM. J. INT'L L. 341, 346-47 (1995) (arguing for self-execution based, in part, on Supremacy Clause), and Carlos Manuel Vázquez, *Laughing at Treaties,* 99 COLUM. L. Rev. 2154, 2157-58 (1999) (suggesting the Supremacy Clause, as interpreted by the Supreme Court, indicates a "default rule" of self-execution), with Curtis A. Bradley & Jack L. Goldsmith, *Treaties, Human Rights, and Conditional Consent,* 149 U. PA. L. REV. 399, 447-49 (2000) (arguing that the Supremacy Clause does not prohibit federal lawmakers from limiting the domestic application of treaties), and Swaine, *Does Federalism, supra,* note 6, at 413-14, *citing* John C. Yoo, *Treaties and Public Lawmaking: A Textual and Structural Defense of Non- Self-Execution,* 99 COLUM. L. REV. 2218, 2219-20 (1999) (arguing that the Constitution ". . .allow[s] the three branches to defer execution of a treaty until the President and Congress can determine how best to implement the nation's treaty obligations").

[36] Swaine, *Negotiating Federalism, supra* note 5, at 1138.

[37] The United States must perform in good faith all international agreements it has entered into and which are in force under the international principle of *pacta sunt servanda.* In addition, the principle implies "that international obligations survive restrictions imposed by domestic law." RESTATEMENT (THIRD) OF THE FOREIGN RELATIONS LAW OF THE UNITED STATES § 321 cmt. a (1987).

In the area of environmental law generally, but especially regarding greenhouse gas regulation, one can best analyze state-federal cooperation and pre-emption issues by applying a series of steps. First, at the clearest level of statutory law, one can observe that there is no federal statute that directly regulates greenhouse gas emissions and therefore, no states' laws are statutorily preempted in this area.[38] Second, no federal judicial decisions to date have found any federal constitutional statutory or regulatory pre-emption regarding greenhouse gases. Finally, if that were not enough, the E.P.A. went further. Rather than just leave legal scholars searching for an absence of evidence, the E.P.A. actively, explicitly, and affirmatively "announced that it does not have authority under the Clean Air Act to regulate carbon dioxide [the primary greenhouse gas] as a criteria pollutant[39] for which it would be obligated to establish a national ambient air quality standard."[40] One must keep in mind however, that ". . .even if the E.P.A. were to designate carbon dioxide to be a criteria pollutant, and were to promulgate national ambient air quality standards for carbon dioxide, that would not preclude a state from adopting and implementing a more stringent standard for that pollutant."[41]

3. *Foreign Affairs Doctrine*

Third in the list of conventional tools of analysis are the foreign affairs doctrine and the associated issue of whether state laws addressing greenhouse gas emissions violate this Constitutional doctrine.[42] In his consideration of environmental protection agreements entered into between states in the United States and foreign governments, David R. Hodas begins his analyses from the traditional position that state laws are preempted when they conflict with ratified treaties and the federal laws implementing them.[43] He goes on to note, however, that the current United States Supreme Court appears to be developing an uncertain foreign affairs doctrine, both in its specifics and in its boundaries of coverage.[44]

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38 Hodas, *supra* note 6, at 74.

39 Criteria pollutants are those air pollutants for which the Clean Air Act has established national numeric standards for emissions. *See* 42 U.S.C. § 7401.

40 Hodas, *supra* note 6, at 74, *citing Control of Emissions from New Highway Vehicles and Engines, Notice of Denial of Petition for Rulemaking*, 68 FR 52,922, 52,925-931 (Sept. 8, 2003).

41 Hodas, *supra* note 6, at 74; 42 U.S.C. § 7416.

42 Hodas, *supra* note 6, at 75-79.

43 *See* Missouri v. Holland, 252 U.S. 416 (1920); Hauenstein v. Lynham, 100 U.S. 483 (1879); Ware v. Hylton, 3 U.S. 199 (1796).

44 *See* Am. Ins. Ass'n v. Garamendi, 123 S. Ct. 2374, 2389, 2401 (2003) (compare Justice Souter for the majority, "[i]t is a fair question whether respect for the executive foreign relations power requires a categorical choice between the contrasting theories of field and conflict preemption . . . but the question requires no answer here [,]" with Justice Ginsburg, dissenting:

> . . .[W]e would reserve foreign affairs preemption for circumstances where the President, acting under statutory or constitutional authority, has spoken clearly to the issue at hand. '[T]he Framers did not make the judiciary the overseer of our government. . .' And judges should not be the expositors of the Nation's foreign policy, which is the role they play by acting when the President himself has not taken a clear stand. As I see it, courts step out of their proper role when they rely on no legislative or even executive text, but only on inference and implication, to preempt state laws on foreign affairs grounds. . .

The uncertainty is allowed in part because in the few foreign affairs cases that the Supreme Court has considered, it has not addressed the issue of whether the state greenhouse gas laws and initiatives offend foreign affairs powers of the President or Congress under the Constitution.[45] In these few cases, the Supreme Court has not seen fit to resolve this issue but, rather reminiscent of the political nature of cooperative federalism, has deemed it to be a political question better resolved by the President and Congress.[46]

Consequently, Hodas concludes that "no matter what theory of preemption is operative, be it traditional preemption, dormant foreign affairs preemption, or the recently proposed (and very attractive) approach of dormant Treaty Clause preemption, there is simply no federalism concern here."[47] This is because the state greenhouse gas control initiatives that he considers do not conflict with any treaties, federal laws, or executive agreements.[48] "They do not impose any obligation, limitation, or condition on foreign government, nor do they interfere with federal settlement of disputes and claims against foreign countries or businesses."[49] Hodas concludes that it is entirely constitutional for states to think globally and act locally, because the chief federal executive's administration views the states' efforts to be in the nation's interest.[50]

For more detailed analysis of the confusion in this area *see The Supreme Court, 2002 Term: Leading Cases: Constitutional Law,* 117 HARV. L. REV. 226, 235 (2003) (arguing that the dormant foreign affairs preemption concept is incoherent and deserves "burial"); Swaine, *Negotiating Federalism, supra* note 5; Hodas, *supra* note 6 at 77, *citing* Harold G. Maier, *Preemption of State Law: A Recommended Analysis,* 83 AM. J. INT'L L. 832 (1989).

[45] Hodas, *supra* note 6, at 77-78.

[46] The Supreme Court has a long history of ruling that matters related to foreign affairs are nonjusticiable political questions. *See e.g.*, Oetjen v. Central Leather Co., 246 U.S. 297 (1918). However, the Court has ruled on the merits with respect to whether the President has the power to enter into executive agreements instead of treaties. Dames & Moore v. Regan, 453 U.S. 654 (1981); *See also* Missouri v. Holland, 252 U.S. 416 (1920) (court decision as to whether the subject matter of a treaty is constitutional). The Supreme Court has held that political questions include disputes about: a) when a "war" begins or ends in Commercial Trust Co. v. Miller, 262 U.S. 51, 57 (1923); b) the recognition of foreign governments or Indian tribes, in United States v. Belmont, 301 U.S. 324 (1937) and United States v. Sandoval, 231 U.S. 28, 45-46 (1913); and c) the validity, ratification, and interpretation of treaties in Goldwater v. Carter, 444 U.S. 996 (1979).

The Supreme Court has not addressed the issue of the President's exercise of war powers, however federal courts have reasoned that disputes over the President's exercise of war powers are political questions. *See* Holtzman v. Schlesinger, 484 F.2d 1307, 1309 (2d Cir. 1973), cert. denied, 416 U.S. 936 (1974) (challenge to Vietnam War); Crockett v. Reagan, 720 F.2d 1355 (D.C. Cir. 1983), cert. denied, 467 U.S. 1251 (1984) (challenge to President's use of the military in El Salvador); Ange v. Bush, 752 F. Supp. 509 (D.D.C. 1990) (challenge to the first Iraq war). The application of the political question doctrine has been the subject of vigorous scholarly debate. *See, e.g.*, Martin Redish, *Judicial Review and the Political Question,* 79 Nw. U.L. REV. 1031 (1985); Hodas, *supra* note 6, at 78, *citing* Louis Henkin, *Vietnam in the Courts of the United States: Political Questions,* 63 AM. J. INT'L L. 284 (1969).

[47] Hodas, *supra* note 6, at 79 (Citations omitted).

[48] Prasad Sharma, *Comment: Restoring Participatory Democracy: Why the United States Should Listen to Citizen Voices While Engaging in International Environmental Lawmaking,* 12 EMORY INT'L L. REV. 1215, 1227 (Spring, 1998).

[49] Hodas, *supra* note 6, at 79.

[50] *Id.* at 81.

Tools of States' Treaty Powers Analysis: New and Unconventional Tools

1. Leaving the Dormant Treaty Power to Sleep

In his analysis of the dormant treaty power, Edward T. Swaine makes an excellent point as to why the dormant treaty power and other so-called "dormant" doctrines are precisely that: dormant.[51] The historical record shows that the federal government has not precluded all state activities affecting foreign relations but only those state activities that bargain with foreign powers on matters of national concern. As a result, states have authority to engage in ordinary contractual relations with foreign governments but cannot bargain with foreign governments to secure concessions.[52] Since this record is so well documented by Swaine and Hodas,[53] I shall not repeat its details here. However, the failure of the Constitution to make explicit what powers are included in foreign affairs has left it to the courts to decide. Swaine notes, "for as many allusions as one can find to the competence of states in the arena of foreign affairs, there may be just as many alluding to the incompetence of the judiciary."[54] Despite the position maintained by the Supreme Court in the seventy year range of cases thoroughly discussed by David R. Hodas, the branches of government have not fared any better in attempting politically to delineate the foreign affairs powers that are dormant.[55]

The dormant treaty power may be said to be over inclusive, because it condemns a wide range of arrangements that states seek to make with foreign governments.[56] Some bargaining between states and foreign governments may be unworthy of congressional attention, such as the negotiations between Virginia and the Kingdom of Belgium to open a foreign trade office in Brussels, for example.[57] "Similarly, whatever the scope of the Compact Clause [Article I, Section 10, clause 3], it does not appear to have been contemplated that it would extend to state activities of no national interest."[58] Therefore, Professor Swaine concludes that states may conclude binding agreements with foreign governments without federal approval, particularly if there is no national interest in the state activity.[59]

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51 Swaine, *Negotiating Federalism*, *supra* note 5, at 1150.

52 *Id.* at 1138.

53 Swaine, *Negotiating Federalism*, *supra* note 5; Hodas, *supra* note 6.

54 Swaine, *Negotiating Federalism*, *supra* note 5, at 1151.

55 *Id.* at 1154.

56 *Id.* at 1269.

57 Blaine Liner, *States and Localities in the Global Marketplace, Intergovernmental Persp.*, Spring 1990, at 11 (updating the impact of Virginia's choice to place an economic development office in Brussels); *see also,* Brenda S. Beerman, Comment, *State Involvement in the Promotion of Export Trade: Is It Time to Rethink the Concept of Federalism as It Pertains to Foreign Relations?*, 21 N.C.J. INT'L L. & COM. REG. 187, 206 (1995) (describing the state of North Carolina's activities), *cited in* Swaine, *Negotiating Federalism*, *supra* note 5, at 1269-70.

58 Swaine, *Negotiating Federalism*, *supra* note 5, at 1272.

59 *Id.* at 1273.

2. *Waking the Treaty-Compact*

To combat the dormant treaty power, Swaine applies a new sense of federalism to the little-used and now-resurrected concept of the "compact," which, like the "agreement" is permitted to be used by states in the United States Constitution, while treaties, alliances and confederations are not.[60] He notes that if consented-to compacts outside the scope of Congress's legislative authority are binding and enforceable compacts, but not federal law, it may seem natural to suppose that they are state law.[61] Yet they may be more. If federal action has failed, the states may make compacts to achieve the preferred solution.[62]

Of course state law pervades even those compacts within Congress' legislative competence regardless of whether the state law replicates federal obligations or concerns itself with matters only of interest to a participating state.[63] Swaine then shifts his emphasis laterally when he writes:

Such compacts may also be enforceable on the international plane. Consistent with its equivocal remove from constitutional matters, international law leaves to national constitutions in the first instance the question of whether subnational entities enjoy the capacity to enter into international agreements. . . . Due to the infrequency with which U.S. foreign compacts have been perfected, and to the nominal constitutional prohibition against state 'treaties,' there is no settled view as to their international consequence, but an important factor in conferring legitimacy is the consent and control of the national government—which is surely enhanced where the compact tracked terms negotiated and ratified by national representatives.[64] The likely result, then, is that state obligations under foreign compacts would be enforceable in international law.[65]

To illustrate how a treaty-compact device works, Swaine begins with two examples from the United States federal government that coincidentally concern themselves with the regulation of the natural environment: the Ross Dam Treaty[66] and the Pacific Salmon Treaty of 1985.[67] The United States and Canada entered into the Ross Dam Treaty to establish water levels behind the Ross

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[60] Swaine, *Does Federalism, supra* note 6, at 499.

[61] *Id.* at 518.

[62] The recently litigated 1998 Multistate Agreement on tobacco litigation (MSA) might fit either description. *See* Michael S. Greve, *Compacts, Cartels, and Congressional Consent*, 67 MO. L. REV. 83-90 (2003) (describing genesis of MSA); *see* Star Scientific, Inc. v. Beales, 278 F.3d 339, 359-60 (4th Cir. 2002) (concluding that MSA was not a compact requiring congressional consent); *see also* Jill Elaine Hasday, *Interstate Compacts in a Democratic Society: The Problem of Permanency*, 49 FLA. L. REV. 1, 10-11 (1997) (asserting that "threatened federal action spurs most compacts"), *cited in* Swaine, *Does Federalism, supra* note 6, at 502.

[63] Swaine, *Does Federalism, supra* note 6, at 518.

[64] *See* RESTATEMENT (THIRD) OF FOREIGN RELATIONS LAW OF THE UNITED STATES §§ 301 cmt. g & 302 cmt. f (1987) (indicating that some foreign compacts entered into by U.S. states may be international agreements within the meaning of international law, but excluding those not requiring congressional consent).

[65] Swaine, *Does Federalism, supra* note 6, at 520-21.

[66] Treaty Relating to the Skagit River and Ross Lake, and the Seven Mile Reservoir on the Pend d'Orielle River, Apr. 2, 1984, U.S.-Can., T.I.A.S. No. 11.088.

Dam.[68] "The Ross Dam Treaty merges a treaty with a compact-like device[69] as a means of asserting national control over a matter implicating subnational authority, with Seattle's incentive deriving from its own self-interest in the resolution and the pressure exerted by the ongoing International Joint Commission proceedings" on Seattle and British Columbia to reach agreement with respect to the water levels behind the Ross Dam.[70] For most federal preemption situations, these analyses will apply to the federal actions taken or omitted (in the case of dormant powers), but when the federal government goes further in its actions, the analysis must accommodate that further action.

3. De-emption as the Solution to Uncooperative Federalism in International Environmental Agreements

De-emption concerns the explicit withdrawal of the federal government from an area and whether it can be treated as an affirmative statement that the federal government will not be acting in this area, as opposed to an area left to question because the federal government has never acted in the area nor commented upon it.

The United States government's actions and statements against the Kyoto Protocol are best analyzed at three different levels: 1) those that are legal actions and statements of the government and its agencies in the province of their work, 2) those that are the policy actions and statements of the government and its agencies in the province of their work, and 3) those that are extraneous to the legal or policy provinces of the work of the government or its agencies.

Chronologically arranged, the first legal action in the chain of events came with the U.N.F.C.C.C.,[71] which sets a general framework for the goal of limiting greenhouse gases. Like all framework agreements, the U.N.F.C.C.C. lacked specific dates, amounts of reduction, or methods by which to achieve the reductions.[72] Indeed, while ratifying the U.N.F.C.C.C., "the Senate Committee on Foreign Relations noted that a decision to be bound by targets and timetables would require renewed Senate advice and consent."[73] The United States signed the U.N.F.C.C.C., President Bush submitted it to the United States Senate for Article II ratification, and the United States Senate ratified it, making it the "law of the United States."[74]

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[67] Treaty Concerning Pacific Salmon, Jan. 28, 1985, U.S.-Can., T.I.A.S. No. 11-091, amended by Agreement Relating to and Amending Annexes I and IV of the Treaty Concerning Pacific Salmon, June 30, 1999, U.S.-Can.

[68] Treaty Relating to the Skagit River and Ross Lake, and the Seven Mile Reservoir on the Pend d'Orielle River, Preamble, Apr. 2, 1984, U.S.-Can., T.I.A.S. No. 11.088.

[69] Swaine notes that "[n]o compact was necessary, presumably, because Seattle, rather than the state of Washington, was a party." Swaine, *Does Federalism, supra* note 6, at 512-13 n. 432.

[70] Swaine, *Does Federalism, supra* note 6, at 512-513.

[71] United Nations Framework Convention on Climate Change, May 9, 1992, New York.

[72] *Id.*

[73] S. Exec. Rept. 55, 102d Cong., 2d Sess, Oct. 1, 1992, at 14.

[74] U.S. CONST. art II.

When it came time to set dates, gas amounts, and methods of reduction, the U.N.F.C.C.C. nations, including the United States, met in Kyoto, Japan to agree upon and sign a protocol. Indeed it has become clear among experts in international public law today that rarely are treaties produced without bundles of annexes and protocols.[75] On November 12, 1998 the United States signed the Kyoto Protocol; however, the United States Senate never ratified it.[76]

In addition to the President having a constitutional role in treaty negotiation and submission to the Senate (or more direct negotiation in the case of an executive agreement), the President has the service of executive officers among the various executive agencies such as the E.P.A. Christine Whitman (then Administrator of the E.P.A.) stated on March 27, 2001, "We have no interest in implementing that treaty."[77]

One may ask how the Bush administration in effect could "unsign" the Protocol that the Clinton administration had signed.[78] Presidential spokesman Ari Fleischer at a press conference reiterated the Bush administration's position that signing the Kyoto Protocol did not bind the United States and therefore there was no reason to unsign the treaty.[79] Echoing the letter, but perhaps not the spirit of the international principle of *pacta sunt servanda*, Fleischer stated that *the signature only prohibits the United States from working against the treaty.*[80] This statement fails to address the President's clear act of legal discretion in not submitting the signed Protocol to the Senate for ratification, regardless of any prior statements by the Senate as to what it would do with a vote on the Protocol. Politically, that act of legal discretion can be interpreted to mean that the President regards submission to the Kyoto protocol as a waste of time or it can be interpreted to mean that he supports the Senate's stated position. The latter is more likely the case because if he did not agree with the Senate's position, he could still submit a protocol destined not to be ratified, and then make clear that he had done what he could, and that it was the Senate that blocked the measure. In this case, the Bush administration has stated it will not attempt to undermine the Kyoto Protocol.[81] In fact, on numerous occasions, President Bush has stated that he supports the U.N.F.C.C.C., which acts as the guiding principles behind

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[75] Lecture by Prof. Emer. Bernhard Schloh, University of Hamburg, Germany, and former counsel to the European Commission, Duquesne University School of Law (March 4, 2004).

[76] The United Nations Framework Convention on Climate Change Web Site (for a list of signatories to the the Kyoto Protocol), *available at* http://unfccc.int/resource/kpstats.pdf.

[77] *U.S. Won't Follow Climate Treaty Provisions, Whitman Says,* N. Y. TIMES, Mar. 28, 2001, at A 19, *cited in,* Greg Kahn, *Between Empire and Community: The United States and Multilateralism 2001-2003: A Mid-Term Assessment: Environment: The Fate of the Kyoto Protocol under the Bush Administration*, 21 BERKELEY J. INT'L L. 548, 551 (2003).

[78] Kahn, *supra* note 78, at 555.

[79] *Id.*

[80] *Id. See also,* RESTATEMENT (THIRD) OF THE FOREIGN RELATIONS LAW OF THE UNITED STATES § 312 (3) & cmt. i (1987) ("Prior to entry into force of an international agreement, a state that has signed the agreement or expressed its consent to be bound is obligated to refrain from acts that would defeat the object and purpose of the agreement").

[81] Kahn, *supra* note 78, at 555.

the Kyoto Protocol, but he has withdrawn from any negotiations dealing with the Protocol.[82]

What remains then, is to determine whether the several states of the United States can in fact be the legally responsible parties to carry out a sustainable development agenda for the twenty-first century by directly agreeing with foreign countries to do what the unratified Kyoto Protocol leaves undone. At the level of policy, between the environmental groups that pressured the United States to make specific commitments to limit greenhouse gases and the industry lobbyists, it was industry that won, as attested by the Senate's Byrd-Hagel Resolution, which passed by a vote of 95 to 0 on July 25, 1997.[83] The resolution conveyed that the United States should not sign the Kyoto agreement "unless the protocol or other agreement also mandated new specific scheduled commitments to limit or reduce green house gas emissions for developing country parties within the same compliance period" or it would "result in serious harm to the economy of the United States."[84] Through this resolution, the United States implicitly repudiated those principles of the U.N.F.C.C.C. that had already been ratified by the United States, which called for developed countries to take the lead in reducing greenhouse gas emissions.[85] As a result of the Byrd-Hagel Resolution, the Clinton administration announced that it would not submit the Kyoto Protocol for Senate ratification until it had secured agreements to participate in the Kyoto Protocol from developing nations.[86]

The Byrd-Hagel Resolution was not the only policy act by the federal government to indicate that it would not ratify, enforce, or otherwise approve the Kyoto Protocol. Congress, in an effort to make sure no "backdoor" ratification of the Kyoto Protocol would take place, attempted to prohibit executive branch agencies, including the E.P.A., from working on climate issues in the executive branch appropriations acts.[87] This atmosphere effectively hindered the state and local governments who voluntarily wished to take steps to reduce greenhouse emissions from working with the E.P.A.[88]

The Bush administration came into office in January 2001 and one of its first actions was to send a letter to four senators, including Nebraska Senator Chuck Hagel, to outline its environmental policy.[89] According to that letter, President

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[82] Kahn, *supra* note 78, at 559. *See also,* RESTATEMENT (THIRD) OF THE FOREIGN RELATIONS LAW OF THE UNITED STATES § 332 (1) & cmt. a (1987) (". . .withdrawal of a party from an agreement, may take place only (a) in conformity with the agreement. . ."). President Bush did withdraw from the Kyoto Protocol in conformity with its terms.

[83] S. Res. 98, 105th Cong., 1st Sess. (July 22, 1997), *Congressional Record,* 143 S8117, daily ed. (July 25, 1997), *cited in* DONALD A. BROWN, AMERICAN HEAT 26, 31 (Rowman & Littlefield, 2002).

[84] Morrissey, *Global Climate Change, cited in* DONALD A. BROWN, AMERICAN HEAT 31, (Rowman & Littlefield 2002).

[85] BROWN, *supra* note 85, at 31.

[86] *Id.* at 36.

[87] *See, e.g.,* Departments of Veterans Affairs and Housing and Urban Development and Independent Agencies Act, 1999, Public Law 105-279, 112 Stat. 2496, *cited in* BROWN *supra* note 85, at 37.

[88] BROWN, *supra* note 85, at 37.

[89] Kahn, *supra* note 78, at 551.

Bush agreed with the Senate in opposing the Kyoto Protocol because it exempted eighty percent of the world, including large population centers in China and India, which would seriously harm the United States' economy.[90] As support for this position, the Bush administration noted that only Romania had ratified the treaty and that this signaled that worldwide, others agree with the President's position on the treaty.[91] Since then, more than one hundred countries have ratified the Kyoto Protocol.[92] May one use this evidence to now assume that others "worldwide" disagree?

Extra icing may have been added to the de-emption cake when federal officials with no legal or policy-making capacity in matters of environmental regulation publicly recorded their opinions on the ratification of the Kyoto Protocol. As the *New York Times* noted: "Senator Chuck Hagel echoed the anger of other United States legislators with the Clinton administration's position when he said, 'any way you measure this, this is a bad deal for America.'"[93] Senator Hagel predicted that if the Kyoto Protocol ever appeared for ratification before the Senate it would be dead on arrival.[94] Condoleeza Rice, President Bush's national security advisor, has also publicly stated that "Kyoto is dead."[95]

Consequently, one could say that at best, it would appear that the United States federal government's approach supports existing and encourages future state and local innovations regarding global warming policy.[96] It has been suggested that this federalism approach has come about as a result of the international criticism the United States federal government has received for its failure to respond to global warming.[97] In order to deflect this criticism the federal government cites the state and local efforts as an approach to address global warming from the

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[90] *Letter to Members of the Senate on the Kyoto Protocol on Climate Change*, 37 WEEKLY COMP. PRES. DOC. 444 (Mar. 13, 2001), *cited in* Kahn *supra* note 78, at 551.

[91] *Excerpts: White House Briefing Comments on Kyoto Protocol,* U.S. DEP'T OF STATE, INT'L INFO. PROGRAMS, Mar. 28, 2001, *at* http://usinfo.state.gov/topical/global/climate/01032801.html (last visited Mar. 6, 2003), *cited in* Kahn *supra* note 78, at 551.

[92] UN Protocol on Substances that Deplete the Ozone Layer, Nov. 1987.

[93] William Stevens, *"Meeting Reaches Accord to Reduce Greenhouse Gases,"* NEW YORK TIMES, December 11, 1997, A10, International section, *cited in* BROWN *supra* note 85, at 37.

[94] BROWN *supra* note 85, at 37.

[95] Patrick J. Michaels, "The Kyoto Killers," August 8, 2001, The Cato Institute, *at* https://www.cato.org/dailys/08-08-01.html.

[96] Hodas, *supra* note 6, at 81.

[97] Andrew C. Revkin & Jennifer Lee, *White House Attacked for Letting States Lead on Climate Policy,* N.Y. TIMES, Dec. 11, 2003, at A32 [hereinafter *Climate Policy*] (paraphrasing Dr. Harlan L. Watson, the Bush Administration's chief negotiator at the Milan Conference of the Parties to the United Nations Framework Convention on Climate Change, held in December 2003). The EPA's global warming website takes a similar approach. On its website, EPA touts a range of state activities as important policy initiatives: "Action at the state level is a key component of the US response to the potential impacts posed by climate change." *See* http://yosemite.epa.gov/oar/globalwarming.nsf/content/ActionsState.html (last visited Jan. 10, 2004). The site reviews twenty-eight state plans, many case studies, and legislative efforts across the nation. As to local initiatives, EPA's position is that:

> Cities and towns across the U.S. are on the front lines of climate change and feel the effects of changes such as in precipitation, temperature, sea-level rise, and air quality. Cities and towns are also in the position to take a variety of energy efficiency and renewable energy actions that can have multiple benefits including saving money, creating jobs, promoting sustainable growth, and reducing criteria pollutants.

bottom (that is, local and state initiatives) up, rather than from the top (that is, federal initiatives) down.[98]

The conventional position that one might take regarding states' rights to enter into agreements with foreign nations is that the states are pre-empted from doing so in those areas of the law where the federal government has clearly taken action. Having done so, that area of the law is either explicitly or implicitly an area controlled by the federal government. But what happens if the federal government takes action and thereby presumably pre-empts the states from doing so, but then rescinds that action? In this case, I maintain that the federal jurisdictional claim has moved from pre-emption to "de-emption." That is to say, not only can the federal government no longer claim to be active in the field and therefore pre-emptive of state action, it cannot even claim to have been silent in the field. It has extinguished the possibility that this was an area for federal and not state action in which the federal government had simply not yet acted. In this case rather, the rescission of action (such as the explicit refusal even to submit the Kyoto Protocol to the United States Senate for ratification by Presidents Bill Clinton or George W. Bush) is tantamount to saying simply that the federal government will not be acting in this area, thereby relinquishing its pre-emptive jurisdictional claim and expressly handing the job back to the states. Furthermore, although the Supremacy Clause in Article VI of the United States Constitution provides that state law must yield to federal law "any Thing in the Constitution or Laws of any State to the Contrary notwithstanding,"[99] that does not prohibit states from acting in the field altogether. "When a state law or constitutional provision merely supplements a federal provision, it is not 'contrary' to that provision within the meaning of Article VI."[100]

This is precisely where de-emption enters the picture. Not only has the federal government not taken any legal action with which state initiatives conflict, the federal government, through its treaty-responsible organ, the United States Senate, has explicitly stated it will not ratify the current stock-in-trade of international greenhouse gas regulation—the Kyoto Protocol. This active step to declare that the federal government will not act is more than just not acting, it is an affirmative step that gives states a clear and unambiguous message that the federal government will not be acting in that area. Hence, the states are not pre-empted from acting; on the contrary, the federal government has de-empted itself and thereby released the power to the states.

So one turns to examine the nature of the various work agreements already in place in the bottom-up attempt by states to control greenhouse gas emissions. Pioneers Robert Shinn and Matt Polsky maintain that all of these agreements have the common goal of "sustainability."[101] Three factors make up this exami-

See http://yosemite.epa.gov/oar/globalwarming.nsf/content/ActionsLocal.html (last visited Jan. 10, 2004), *cited in* Hodas, *supra* note 6, at 80.

[98] *Climate Policy*, *supra* note 98, *as cited in* Hodas, *supra* note 6, at 80-81.

[99] U.S. CONST. art. VI, § 2.

[100] Ken Gormley, *Exploring A European Constitution: Unexpected Lessons from the American Experience*, 35 RUTGERS L. J. 69, 79 (2003).

[101] Shinn, *supra*, note 2, at 102.

nation: First, what agreements among these are binding?[102] Second, what function do non-binding "programs," "workshops" and "presentations" have? Third, to what degree is state-federal co-operative federalism practiced in these agreements?[103]

As an example, now it would seem that the federal government has withdrawn from the area of regulating carbon dioxide emissions.[104] Yet due to international criticism for its lack of effort, the United States has encouraged state efforts in addressing carbon dioxide emissions as a bottom up approach.[105] The current position of the United States at the national level is a hands-off approach as to regulation of additional pollutants not included as criteria pollutants under the Clean Air Act, due in large part to the lobbying efforts of fossil fuel interests.[106] This national position could last for an indefinite time period. So, at the present time the withdrawal by the federal government could be seen as an affirmative statement that the federal government will not be acting in this area and it is therefore left open to the states. However, the President and Congress have the power in the future to preempt the states in this area by enacting legislation or occupying the field. It is worth noting for application in international law that the principle of preemption has been instituted fundamentally in the *acquis communitaire* of European Union law in the related concepts of proportionality and subsidiarity.[107] Within that system of international preemption, it is clearer when member states may make treaties with third countries outside of the European Union.[108]

The Strange Bedfellows of States' Rights and Protection of the Natural Environment: New Compacts in Action

Conventional wisdom sets up our attitude toward international agreements as an enthymeme. The enthymeme works as follows: the United States Constitution tells us that if there is to be a treaty, then the federal government must conclude it, and that if the federal government concludes it, then it is binding.[109] Since we think of "federal" as a dialectic term paired with "state" in American legal think-

[102] A beginning guide to answer this question is the United Nations' Treaty Reference Guide, which provides guidance as to the binding nature of various international documents by category. One must remain aware, of course, that some documents use the categorical names differently, and that the names alone are not a certain test of the binding nature of the documents. *See*, http://untreaty.un.org/English/guide.asp.

[103] Shinn, *supra* note 2, at 102.

[104] *Climate Policy*, supra note 98.

[105] *Id.*

[106] Dernbach, *supra* note 20.

[107] In the celebrated Case 6/64, Costa v. ENEL, 1964 E.C.R. 1141 (1964), the European Court of Justice noted that "By creating a Community of unlimited duration, having its own institutions, its own personality and its (own) legal capacity . . . the Member States have limited their sovereign rights, albeit within limited fields, and have thus created a body of law which binds both their nationals and themselves."

[108] Rudolf Geiger, External Competences of the European Union Treaty-Making Power of Its Member States, 14 ARIZ. J. INT'L. & COMP. L. 319, 326 (1997).

[109] U.S. CONST. art. II, § 2, cl. 2.

ing, one cannot help but supply the unsaid terms regarding states when these pronouncements on federal power are made. Thinking in dialectic pairs, then, when the term "federal" is used, the dialectic counterpart "state" is assumed. When the federal is said to "have the power," the dialectic counterpart that one supplies by operation of the enthymeme is that the state does not possess the power. And finally, if the federal exercise of its international agreement power through treaties is "binding," then an additional enthymeme is constructed in which the term to characterize state power in international agreements is missing, but the dialectic comparison to "binding" will most easily be fulfilled by the term "non-binding."

With this enthymematic structure in place, we may unreflectively treat states as objects internal to the federation's subject. The historical-empirical evidence disputes this supplied term to the enthymeme, however. The historical-empirical record of public law does not give us a tidy catalogue of types of agreements and powers and levels of enforceability. It is perhaps because of this lack of clear categories and levels that the entire area is ignored. That ignorance is only due to the sloppiness of the catalogue, however, and not due to its existence.

In international co-operation in general, and in particular in international environmental co-operation, it is often the case that nations will enter into a framework convention or treaty that sets forth an outline of the problems to be addressed, the establishment of the institutions that will address it, the types of measures to be taken, the goals to be achieved through these institutions and measures. In this vein, one may look to the Chlorofluorocarbon ("C.F.C.") Treaty[110] and the U.N.F.C.C.C., for example. Thereafter, specialists will work to determine precisely how those institutions and organs will function, the methods by which the measures will be affected, and the assessment of the results. In this vein, one may look to the Montreal Protocol[111] or the Kyoto Protocol, for example, in their respective roles to give specificity to the C.F.C. Treaty or the U.N.F.C.C.C. Treaty, respectively.

While the United States participated in the U.N.F.C.C.C. and ratified the Treaty, when it came time to put some flesh on the bones of the Framework through the Kyoto Protocol, the United States balked.[112] The refusal of the United States to follow the Kyoto Protocol has ramifications far beyond the literal and figurative borders of the United States.[113] It is no secret that although the United States is only approximately six percent of the world's population, it consumes approximately twenty-five percent of the world's natural resources, including fossil fuels, the burning of which results in global warming and climate change.[114] Under the terms of the Kyoto Protocol, any signatory state's obliga-

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[110] Chloroflourocarbon Treaty, Montreal 1987.

[111] Montreal Protocol on Substances that Deplete the Ozone Layer, Sept. 16, 1987, 26 I.L.M. 1541 (entered into force Jan. 1, 1989). As amended up to 1999, *available at* http://hq.unep.org/ozone/pdfs/Montreal-Protocol2000.pdf.

[112] BROWN, *supra* note 85, at 35-36.

[113] *Id.* at 39-40.

[114] *See* CIA World Fact Book, *available at* http://www.odci.gov/cia/publications/factbook.

tions are only triggered after fifty-five states have ratified and when more then fifty-five percent of emissions are under control of the Protocol.[115] After most of the smaller states had approved the Protocol, it became clear that the fifty-five states and fity-five prercent needed cound not be met if neither the United States nor Russia agreed.[116] During an international trade show in Cologne, Germany on June 10, 2004, Russian acting chief executive Mikhail Rogankov of Kyoto Protocol implementation organization, the Carbon Energy Fund, announced that Russia would be certain to ratify the Protocol "within the next six months" and that "it is only a question of when,"[117] and on November 4, 2004, Russian President Vladimir Putin signed the federal law to ratify the Kyoto Protocol, making Russia the one hundred and twenty-sixth country to do so.[118] The U.S. refusal to follow the Kyoto Protocol is measurable not only in tons of carbon emitted into the atmosphere each day, or in the mean global temperature increases, but also in the signal that a world leader in industry, technology and economy sends when it practices such Machiavellian statehood.

1. New Jersey Practices De-Emption

What extra effects in the law or policy of environmental regulation might de-emption afford? A look at New Jersey's efforts provides an example. Given the similarities of population density and coastline resource dependency, New Jersey and the Netherlands found themselves in similar situations regarding greenhouse gases and global warming.[119] Since New Jersey is a coastal state, it is threatened directly by the rise in sea levels that would result from global warming.[120] The impact of higher sea levels could increase flooding and destroy ecosystems which in turn would decrease tourism.[121] In addition, global warming threatens public health in New Jersey by increasing air pollution.[122] Also, higher temperatures and the accompanying increased evaporation magnify the frequency and intensity of droughts and rainstorms.[123]

Recognizing that (i) the U.N.F.C.C.C. was written to be completed by a document like the Kyoto Protocol, (ii) that the United States would not be adopting

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[115] Steven Lee Myers, THE NEW YORK TIMES, *Russia's Lower House Approves Kyoto Treaty on Emissions*, A3.

[116] *Id.*

[117] *Id.*

[118] Steven Lee Myers, *Russia Sings Global Warming Pact,* THE NEW YORK TIMES, November 5, 2004. Putin's signature followed ratification of the Protocol by the State Duma (October 22, 2004) and the Federation Council (October 27, 2004). The final step in the ratification process will be the deposit of the formal instrument of ratification with the Secretary-General of the United Nations in New York. This is expected to occur int eh coming weeks. The Kyoto Protocol will enter into force ninety days after Russia's instrument of ratification has been received. *See* http://unfccc.int/ (last accessed November 29, 2004).

[119] Shinn, *supra* note 2.

[120] *Id.*

[121] *Id.*

[122] *Id.* at 97.

[123] *Id.*

the Kyoto Protocol any time soon, and (iii) that if Russia does ratify, the United States participation is not legally necessary, states like New Jersey took it upon themselves to negotiate an agreement with foreign partners that would reflect the goals of the U.N.F.C.C.C. Treaty and Kyoto Protocol through more specific documents designed to create institutions and methods for achieving the U.N.F.C.C.C. goal of slowing global warming.[124] To effect this end and in a manner not unlike the U.N.F.C.C.C., on June 5, 1998, the Department Environmental Protection of the State of New Jersey ("N.J.D.E.P") and The Ministry of Housing, Spatial Planning and the Environment of The Netherlands signed a Letter of Intent to convey "the understanding of the Signatories of their intention to cooperate in addressing the challenges posed by the prospect of climate change."[125]

Thereafter, on December 7, 1999, with both a purpose and a method not unlike the Kyoto Protocol, the same two parties signed a more specific agreement—an Aide Memoire[126]—that "summariz[ed] the main topics of discussion and agreed conclusions for further actions of the Technical meeting, held in Scheveningen, The Netherlands December 6 and 7, 1999."[127] The Commissioner of the N.J.D.E.P., Robert C. Shinn, Jr., together with Matt Polsky, later characterized their efforts by noting that "[s]tates should not dismiss the possibilities for creative initiatives at the international level, even if this does go against conventional wisdom."[128]

To take its greenhouse gas concerns yet further on the international scene, in 2000, the New Jersey Department of Environmental Protection signed the International Declaration on Cleaner Production, committing the agency to join with other states and nations to seek reductions in emissions to increase environmental and economic sustainability worldwide.[129] Granted, this declaration is neither a convention[130] nor a treaty and thus does not bind New Jersey in the "conven-

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[124] Laura Kosloff & Mark Trexler, *State Climate Change Initiatives: Think Locally, Act Globally*, 18 NAT. RESOURCES & ENV'T. 46, 47-48 (Winter, 2004), for a discussion on other states' initiatives.

[125] Shinn, *supra* note 2.

[126] *The United Nations Treaty Reference Guide* does not define "aide memoire." United Nations, *The United Nations Treaty Collection: Treaty Reference Guide*, 1999, at http://untreaty.un.org/English/guide.pdf [hereinafter *Treaty Reference Guide*].

[127] NJDEP Press Release Dec. 12, 1999, Commissioner Shinn Signs Historic Agreement to Develop Prototype for International Emissions Trade, *available at* http://www.state.nj.us/dep/newsrel/releases/99_0151.htm.

[128] Shinn, *supra* note 2.

[129] *Id.*

[130] *The United Nations Treaty Service Reference Guide* defines "convention":

> The term "convention" again can have both a generic and a specific meaning. (a) Convention as a generic term: Art.38 (1) (a) of the Statute of the International Court of Justice refers to "international conventions, whether general or particular" as a source of law, apart from international customary rules and general principles of international law and - as a secondary source - judicial decisions and the teachings of the most highly qualified publicists. This generic use of the term "convention" embraces all international agreements, in the same way as does the generic term "treaty". Black letter law is also regularly referred to as "conventional law", in order to distinguish it from the other sources of international law, such as customary law or the general principles of international law. The generic term "convention" thus is synonymous with the generic term "treaty". (b) Convention as a specific term: Whereas in the last century the term "conven-

tional" way. However, it is nevertheless an exercise of state power in foreign relations, and in this case, in a manner at odds with federal foreign relations on the issue of emissions reductions. Thus, while states typically work with the federal government to establish a relatively unified body of environmental law for domestic matters under the rubric of "cooperative federalism,"[131] when it comes to international matters, states may and have sought their own path. When the federal government, which has explicitly taken the regulation of the natural environment as a federal power, fails to protect the environment, states can and do take actions both domestically and internationally.

The "subsidiarity principle"[132] borrowed from European Union law "states that each problem is best addressed at the level most affected by the problem;" thus, the best way to solve a problem is to address it at the lowest level it can be solved.[133] Global warming is one of those issues that is global in scale but has local effects.[134] Yet local action is not common even though the Earth Summit back in 1992 called for action at the local level to address sustainability issues.[135]

Air pollution flows across political boundaries and the N.J.D.E.P. has therefore become active in national and international organizations which attempt to reduce air pollution.[136] These organizations include the Center for Clean Air Policy, the North American Research Strategy for Tropospheric Ozone, the Ozone Transport commission and the Ozone Transport Assessment Group.[137]

N.J.D.E.P. has focused on greenhouse gases, which contribute to global warming. Of primary concern are carbon dioxide emissions, the biggest contributor of all.[138] In 1998, in a first-of-its-kind action, the State of New Jersey signed an agreement with a foreign government, the Netherlands, to jointly work on global

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tion" was regularly employed for bilateral agreements, it now is generally used for formal multilateral treaties with a broad number of parties. Conventions are normally open for participation by the international community as a whole, or by a large number of states. Usually the instruments negotiated under the auspices of an international organization are entitled conventions (e.g. Convention on Biological Diversity of 1992, United Nations Convention on the Law of the Sea of 1982, Vienna Convention on the Law of Treaties of 1969). The same holds true for instruments adopted by an organ of an international organization (e.g. the 1951 ILO Convention concerning Equal Remuneration for Men and Women Workers for Work of Equal Value, adopted by the International Labour Conference or the 1989 Convention on the Rights of the Child, adopted by the General Assembly of the UN).

See Treaty Reference Guide, supra note 126.

131 *See,* Dernbach, *supra* note 20, at 904.

132 The often-cited Article 38 of the Statute of the International Court of Justice tells the International Court of Justice that it shall consider three sources of international law in making its determinations: customs, conventions, and general principles. Article 38 of the International Court of Justice, June 26,1945, Department of State publications 2349 and 2353, Conference Series 71 and 74, *available at* http http://www.icj-cij.org/icjwww/ibasicdocuments/ibasictext/ibasicstatute.htm. *See also* Shinn, *supra* note 2, n. 3.

133 Shinn, *supra* note 2, at 93.

134 *Id.*

135 Donald Brown, *Thinking Globally and Acting Locally: The Emergence of Global Environmental Problems and the Critical Need to Develop Sustainable Development Programs at the State and Local Levels in the United States,* 5 DICK. J. ENV. L. POL. 175, 177 (Summer 1996).

136 Shinn, *supra* note 2, at 97.

137 *Id.*

138 *Id.*

warming issues.[139] In an effort to control global warming, the agreement identifies strategies for developing pilot projects to trade carbon dioxide emission credits internationally.[140]

Shinn and Polsky relay in their article that "part of the purpose for each party [is] to gain experience in emissions trading for expanding use in the future if and when global trading becomes a more commonplace means of addressing global warming."[141] One such potential emission trade project involves the purchase by the Netherlands of carbon dioxide credits from a United States electric utility program which captures methane at a landfill in New Jersey.[142] The methane collection system that is employed by the electric utility program captures the methane and uses it as an energy source.[143] Prior to the collection systems implementation, the methane gas was vented into the atmosphere and contributed to global warming.[144]

The N.J.D.E.P in 2000 signed an international declaration involving other states and nations, which committed the agency to reduce emissions with the idea of increasing environmental and economic sustainability worldwide.[145] This declaration was called the International Declaration on Cleaner Production and was sponsored by the United Nations' Environmental Program ("U.N.E.P.").[146] Nearly forty countries and more than one thousand business entities have signed the declaration.[147]

New Jersey and the Netherlands signed two agreements: *Letter of Intent Between the Ministry of Housing, Spatial Planning and The Environment, The Netherlands and The Department of Environmental Protection, The State of New Jersey* (Letter of Intent) and *Aide Memoire* [Between] *The Department of Environmental Protection, The State of New Jersey and The Ministry of Housing, Spatial Planning and the Environment, The Netherlands* (Aide Memoire).[148] Neither the Letter of Intent nor the Aide Memoire is binding on either signatory. Although, the Commissioner for the Department of Environmental Protection (in this case Robert C. Shinn, Jr.) does have the authority to bind New Jersey to agreements.[149]

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139 *Id.* at 99.

140 *Id.*

141 *Id.*

142 *Id.*

143 *Id.*

144 *Id.*

145 *Id.* at 96.

146 *Id.*

147 *Id.*

148 *Letter of Intent Between the Ministry of Housing, Spatial Planning and The Environment, The Netherlands and The Department of Environmental Protection, The State of New Jersey, available at* http://www.state.nj.us/dep/dsr/Netherlands.PDF [Hereinafter *Letter of Intent*].

149 Telephone Interview with Marybeth Brenner, Director, Office of Constituent Relations & Customer Service with the N.J.D.E.P. (April, 2004).

As a general observation, the Letter of Intent is similar to the U.N.F.C.C.C. in that it conveys an understanding as to what the goals are.[150] Along the same lines, the Aide Memoire, like the Kyoto Protocol, is more specific in its language and provides the plan of action to accomplish those goals.[151] Indeed, the Letter of Intent makes multiple references to the U.N.F.C.C.C. and the Kyoto Protocol. Item B references the preamble to the U.N.F.C.C.C. and "calls for the widest possible cooperation by all countries and participation in an effective and appropriate international response" to climate change.[152] Item D references Article 3, paragraph 3 of the U.N.F.C.C.C. and mentions the policies and measures implemented to address climate change should be cost effective and ". . .carried out cooperatively by interested parties."[153] Item E references Article 4.2a of the UNFCCC acknowledging awareness that the Annex I parties committed themselves to "adopt national policies" and take appropriate action to mitigate climate changes which can be carried out through joint efforts.[154] Item F references Articles 2, 3, & 4 of the Kyoto Protocol acknowledging awareness that parties should cooperate with each other to promote sustainable development by sharing their experience and exchanging information.[155] Item G references Article 17 of the Kyoto Protocol allowing participation in emissions trading to fulfill commitments under Article 3 of the Kyoto Protocol.[156] Finally, Item H referencing the Kyoto Protocol expresses the need of the parties to gain practical experience in emissions trading.[157]

The Aide Memoire follows the Letter of Intent and lays out a plan of action for its implementation.[158] Item C mentions a need for a standing committee to facilitate the exchange of information and experiences.[159] This standing committee was later created.[160] Item G discusses implementing a pilot emissions trading project.[161] One trade did occur under this pilot emissions trading project.[162] However, no further emissions trading have taken place due to administration and policy changes in the Netherlands, New Jersey, and United States since implementation of the Aide Memoire.[163]

New Jersey's plan to promote the exchange of environmental technology and information has expanded to include international agreements with Canada, Thai-

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150 Kosloff & Trexler, *supra* note 124, at 46.

151 *Id.*

152 *Letter of Intent*, *supra* note 148.

153 *Id.*

154 *Id.*

155 *Id.*

156 *Id.*

157 *Id.*

158 *Id.*

159 *Id.*

160 Interview with Marybeth Brenner, *supra* note 149.

161 *Letter of Intent*, *supra* note 148.

162 Interview with Marybeth Brenner, *supra* note 149.

163 *Id.*

land, Brazil, Germany, Israel, and France.[164] Shinn and Polsky conclude that "[s]tates should take the initiative in addressing global level problems that have both an effect at the local level and for which effective local action can be taken."[165] However, the forging of international agreements by states may be the most effective means of addressing global environmental issues impacting states today.[166] Other states have since entered into discussions or agreements with foreign nations, including a regional greenhouse gas reduction plan circulated among the governors of New England states and the premiers of the provinces in eastern Canada that will be international in scope once it is finalized.[167]

Conclusions

We have before us a problem of climate change that is certainly and measurably already harmful to human life that yields long-term and deep changes to the atmosphere. All life depends upon it, therefore, this problem promises harm not yet realized. This is agreed by the world's scientific community to be man-made.

Much debate has occurred and continues to occur as to what the United States as a nation should do, can do and has done legally. In the meantime, what else is possible? Operating under the principle "think globally; act locally" the nations that signed the Climate Change Convention at Rio de Janeiro in 1992, agreed that in addition to the international Agenda 21 plan for sustainability worldwide, it was necessary for individual countries to adopt national Agenda 21, and depending upon the internal organization of the respective countries, they also agreed that it was necessary for states, provinces, counties, boroughs, cities, parishes and other forms of local municipal governments to adopt local Agenda 21 as well.[168] Against this conceptual understanding of the problem of global warming and at least one way forward, we have the notion of a sustainable plan for the twenty-first century — one that balances environmental, social and economic needs of the present without harming the needs of the future, where state and local initiatives are taken, and where state and local governments and citizens, who identify themselves as members of these communities, act within those local governments at some less-than-national level.

It is against the backdrop of this agenda and this manner of execution, that one must consider legal problems such as the United States' signing and ratification of the U.N.F.C.C.C., its' signing of the Kyoto Protocol but its refusal to ratify the same. In doing so, within the United States' domestic law, even having taken

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[164] Shinn, *supra* note 2 at 99.

[165] *Id.* at 103.

[166] *Id.*

[167] *See* Ken Colburn & Amy Royden, *New England States and Eastern Canadian Provinces Team Up to Tackle Climate Change,* 2003 ABA SEC. ENV'T, ENERGY & RES. 7, *available at* http://abanet.org/environ/committees/climatechange/newsletter/june03/newengland/home.html (last visited Oct. 18, 2004), *cited in* Hodas, *supra* note 6, at 55.

[168] United Nations Conference on Environment & Development, adopted Rio de Janeiro, June 14, 1992.

this opportunity to explore new and conventional tools of analysis for state treaty powers, one can never stray too far from the core issues concerning sovereignty.

These issues can be categorized by first asking what the general legal natures of "supremacy" and "sovereignty" are within the meaning of the United States Constitution. Second, one must then apply those general categories to the problems that arise in an actual situation as, for example, when New Jersey wishes to enter into a binding agreement with the Netherlands (whether it is called a "treaty" or not). Third, one must determine what the supremacy of the United States is when, for example a state wishes to enter into either non-treaty trade agreements recognized officially and historically as exceptions to federal supremacy, or other types of non-treaty agreements. It is at this point that the federal government's express actions in law and policy not to adopt the Kyoto Protocol, that is, its de-emption from the field, invites the states to make their own attempts at dealing with climate changes by invitation and with legal confidence.

Finally, however, one might find some insight into solutions by looking to other federalist situations. Agenda 21 and the principles contained therein suggest that sustainability needs to be addressed locally—states are more local than the federal government and in Europe, only when the federation is better suited is it to carry out a law. Second, the United States federal position has been to date to be uninterested in executing the needed detail of the U.N.F.C.C.C., even if the United States, as a federation, is better suited to carry out its agreed-upon duties under the U.N.F.C.C.C. and Agenda 21. Research could be advanced in alternative solutions by determining what preemptive effect a binding international agreement between a state and a foreign government would have internationally and domestically, if the federal government tried to re-enter the field and preempt the state's international agreement. Finally, shared international and domestic competence, in the form of an "open constitution," wherein states openly concede some of their sovereignty at the constitutional level, also dawns on the horizon as a possible solution in addressing climate changes.[169]

[169] STEPHAN HOBE, *Individuals and Groups as Global Actors: The Denationalization of International Transactions*, *in* NONSTATE ACTORS AS NEW SUBJECTS OF INTERNATIONAL LAW: PROCEEDINGS OF AN INTERNATIONAL SYMPOSIUM OF THE KIEL WALTHER-SCHUCKING INSTITUTE OF INTERNATIONAL LAW, 115-135 (Rainer Hofmann, ed., Duncker & Humblot 1999).

Opportunities and Obstacles — Screening the EU Enlargement Process from a Gender Perspective

Silke Roth*

Like any other social or political process, the EU enlargement is gendered. This article first describes gender mainstreaming as an instrument to achieve gender equity, then discusses how the EU Enlargement process both shapes and is shaped by gender relations and reproduces, challenges and modifies gender differences in both the private and public spheres.

Gender and Politics

To say that politics or any other social process is gendered means that "advantage and disadvantage, exploitation and control, action and emotion, meaning and identity, are patterned through and in terms of a distinction between male and female, masculine and feminine."[1] Although there might be little or no relationship between politics and gender, "in patriarchal cultures, masculinity is signified not only by possession of a penis and paternity, but (depending on time and place) by the statuses of soldier, property holder, scientist, and citizen; statuses from which women are necessarily excluded, because to include them would be to acknowledge that biological sex, on the one hand, and subjective identification with symbolic masculine or feminine positions, on the other, are not the same."[2] This genderedness of politics can be observed in discussions about women or openly gay men as candidates for high-profile political positions (such as the presidency). Although by no means restricted to politics, the gendered nature of political institutions is reflected in the gender distribution in national governmental cabinets and parliaments. As statistics established by the Inter-Parliamentary Union (IPU) show, in 2004, the gender distribution in the Arab states (94%) is closer to the World Average (85%) than the Nordic countries (60%) which have the lowest participation of men in national parliaments (see Table 1).[3]

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[1] Joan Acker, *Hierarchies, Jobs, Bodies*, 4 Gender & Soc'y 139, 167 (1990).

[2] Joan Scott, *Some Reflection on Gender and Politics, in* Revisioning Gender 70, 75 (Myra Marx Ferree et al. eds., 1998).

[3] Inter-Parliamentary Union, *at* http://www.ipu.org/english/home.htm.

Table 1. Men in National parliaments

	Single or Lower House	Upper House or Senate	Both Houses Combined
World Average	84%	86%	85%
Arab States	94%	93%	94%
Asia	85.%	86%	85%
Pacific	89%	80%	88%
Sub-Saharan Africa	85%	87%	86%
Europe OSCE (Nordic countries not included)	84%	85%	84%
Americas	81%	82%	82%
Europe OSCE (Nordic countries included)	82%	85%	82%
Nordic countries	60%	—	60%

Source: IPU on the basis of data provided by national parliaments in Regions are classified by the descending order of the percentage of men in the lower or single House

In the former Socialist countries, women's political participation was much higher than in Western Democracies.[4] Although women were well represented in state parliaments, those parliaments had little decision-making authority, while the Politburo and Central committees were almost exclusively male.[5] In her discussion of the gendered construction of the communist subject in state-Socialist Hungary, Fodor argues that women's participation in paid work and politics was characterized by the reproduction and reinforcement of women's segregation into inferior positions.[6] However, rather than considered as not-quite-perfect men, women were acknowledged as a group with gender-specific needs and abilities.[7] When the parliaments in the former Socialist countries gained real power during the democratization of Eastern Europe, the percentage of female members of parliament dropped: in Romania, from about one third to 4%, in Hungary, from 21% to 7%, and in the Czech and Slovak Republics, from 30% to 6%.[8]

Since the first election in 1979, the participation of women in the European parliament was on average higher than in the member countries.[9] The percentage of women in the European parliament increased in each election, especially since Sweden and Finland joined the EU in 1995.[10] Keep in mind that the influence of the European parliament was initially quite limited. The seats in parliament

[4] Peggy Watson, *Politics, Policy, and Identity: EU Eastern Enlargement and East-West Differences,* 7 J. EUR. PUB. POL'Y 369, 371 (2000).

[5] Watson, *supra* note 4, at 372.

[6] Eva Fodor, *Smiling Women and Fighting Men: The Gender of the Communist Subject in State Socialist Hungary,* 16 GENDER & SOC'Y 240, 248 (2002).

[7] *Id.* at 241.

[8] Watson *supra* note 4, at 375.

[9] *See* BEATE HOECKER, FRAUEN, MAENNER UND DIE POLITIK 184 (Bonn, Dietz 1998).

[10] *Id.* at 185.

lacked power and were not very attractive.[11] It remains to be seen whether, just as in the former Socialist countries, the percentage of men will increase once this institution gains power.

From Equal Pay to Gender Mainstreaming

Not only was the political participation of women higher in the European Union than in the member states (at least prior to the Northern Enlargement in 1995), but from the beginning the EU also provided a favorable venue for women's interests, as it was often more open to feminist demands than national governments.[12] In this regard Article 119 of the Treaty of Rome of 1958 which demanded equal pay for men and women was of crucial importance.[13] This article was introduced because France, which had introduced equal pay during World War II, was afraid to suffer disadvantages compared to the other member states.[14] As an unintended side effect, Article 119 became a starting point for further sex equality legislation.[15] In addition to workplace equality, the directives concerned tax and social security measures, child-care facilities, education and training opportunities, and were accompanied by positive-action programs on behalf of women.[16] However, because it is up to the member states to implement these measures, considerable differences between the legislation of each country can be noted.[17]

Depending on what the EU member states have already achieved with respect to gender-equality measures, there are great differences regarding the anticipated effects of EU membership.[18] For example, Scandinavian women were afraid that the EU could mean the "end of gender equality as [they] know it," and also the end of universal and more generous social rights than in other EU countries.[19] In contrast, feminists in countries with fewer social rights, a lower female labor force participation, and lower representation of women in political parties and parliaments hope that the European Court will contribute to ending discriminating practices and enabling women to exert stronger political influence.[20]

A good example of progress is the case of Tanja Kreil. In 2000, the European Court ruled that German constitutional law, which prohibits the use of weapons

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[11] *Id.*

[12] SONIA MAZEY, GENDER MAINSREAMING IN THE EU 21 (Kogan Page 2001) (2001) [hereinafter MAZEY].

[13] MAZEY *supra* note 12, at 21.

[14] *Id.*

[15] *Id.*

[16] *Id.* at 22-24.

[17] *See id.* at 51. *See also* Bozena Choluj and Claudia Neususs, Eu Enlargement in 2004: East-West Priorities and Perspectives from Women Inside and Outside the EU, Discussion Paper 7 (2004) *available at* http://www.frauenakademie.de/dokument/img/gender_equality_enlargedEU.pdf [hereinafter Choluj & Neususs].

[18] *Id.*

[19] *See* Barbara Hobson, *Economic Citizenship: Reflections through the European Union Policy Mirror, in* GENDER AND CITIZENSHIP IN TRANSITION 84 (Barbara Hobson ed., 2000).

[20] Hobson *supra* note 20, at 85.

by women in the army, violated EU policy and thus needed to be changed.[21] Similarly, in 1995 new political opportunities became available when Austria, Finland, and Sweden joined the EU in 1995.[22] Finland and Sweden in particular had a strong existing commitment to equal opportunities and considerable experience in mainstreaming gender in their national policies.[23]

The EU adopted gender mainstreaming in the Amsterdam Treaty of 1997.[24] "Gender mainstreaming" means the "(re)organization, improvement, development in all policies at all levels and at all stages by the actors normally involved in policy making[,]" and "openly taking into account at the planning stage their possible effect on the respective situation of men and women."[25] Thus, in contrast to earlier women's politics, gender mainstreaming declares all policy fields as relevant for women (and men). This also means that instead of helping women to adapt to structures that benefit men, the gendered structures shall be changed in order to become more women friendly.

The implementation of gender-mainstreamed regulations is monitored by the EU, but has to be carried out by the national governments. The EU-strategy is two-fold. It combines gender-specific policies with gender mainstreaming, a strategy which seeks to promote institutional change. This also affects states that want to join the European Union, and in order to do so, must bring their laws into accordance with EU-legislation.

Gender Relations and EU Enlargement

In many respects, women in Socialist European countries experienced greater gender equality than women in Western-European countries. Under socialism in countries such as East Germany, the Baltic States, and Russia, the employment rates of women were almost as high as the rate of men's labor force participation, much like Sweden at the time.[26] In other states (such as Poland, Hungary, and Romania), the gender gap was larger, but still compared favorably with the US, France, and West Germany.[27] Furthermore, women tended to work full-time, they were well represented in parliaments, had access to abortion, and reproductive work was publicly supported through public daycare, laundries, and canteens.[28]

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[21] Theresa Wobbe, *Institutionalisierung von Gleichberechtigungsnormen im supranationalen Kontext: Die EU-Gleichstellungspolitik, in* GESCHLECHTERSOZIOLOGIE at 332 (Bettina Heintz ed., Sonderheft Kölner Zeitschrift für Soziologie und Sozialpsychologie 41/2001, 2001).

[22] MARK A. POLLACK & EMILIE HAFNER-BURTON, MAINSTREAMING GENDER IN THE EUROPEAN UNION (Harvard Jean Monnet etd., Harvard Law School Working Paper No. 2, 2000) (2001) [hereinafter POLLACK].

[23] *Id.* at 9.

[24] MAZEY, *supra* note 12, at 19-20.

[25] Commission of the European Union, 2000:5, cited in MAZEY, *supra* note 12, at 1.

[26] BARBARA EINHORN, CINDERELLA GOES TO MARKET: CITIZENSHIP, GENDER AND WOMEN'S MOVEMENTS IN EAST CENTRAL Europe 116 (Verso 1993) [hereinafter EINHORN].

[27] *Id.* at 122.

[28] *Id.* at 29.

However, the high integration of women in the labor market was accompanied by unequal pay, occupational segregation, and a sharp domestic sexual division of labor resulting in women's excessive work burden and exhaustion.[29] Although public daycare was available, it did not necessarily satisfy the needs of parents and children.[30] Choluj refers to gender relations in Socialist Poland as a "forced feminism" characteristic of Stalinism, which did not lead to a change in attitudes toward gender equality.[31]

How did the enlargement process affect gender relations? Before the agreements were signed, the candidate countries had to meet the Copenhagen criteria from 1993 (*acquis communautaire*), which required political reforms and economic transformation, as well as legislative and social policy changes.[32] As Choluj and Neususs point out, the accession countries had "to adjust national legal and institutional frameworks so as to accelerate their transition to a market economy, but also to strengthen human- rights standards and democratic, civic, and political policies and practices."[33]

Gender equality came relatively late onto the agenda of negotiations for entry to the EU.[34] Much greater priority was placed on social and economic reforms based on neo-liberal principles that were lacking a gender perspective."[35]

In the first half of the nineties, in almost all transition countries, employment and revenues declined and the Gross National Product dropped.[36] Unemployment affected women more than it did men because women were strongly represented in shrinking sectors, particularly the public sector. As a result, many women shifted their work into the informal sector.[37] Yet, there are still significant differences in unemployment rates and the gender gap in unemployment from country to country differs drastically.[38]

Despite high education and extensive skill training, women face explicit discrimination in hiring, particularly age discrimination.[39] As Choluj and Neusüss point out, "[w]omen in accession countries have increasingly raised concerns over the disproportionate negative consequences for women in social security

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[29] *Id.* at 122.

[30] Bozena Choluj, EUROPAS TOCHTER, 203-23 (Ingrid Miethe and Silke Roth eds., Oplanden: Leske + Budrich 2003).

[31] *Id.*

[32] Konjit Gomer, *Gender Equality & Enlargement of the European Union* 1 *available at* http://www.womenlobby.org.

[33] Choluj & Neususs *supra* note 9, at 4.

[34] *Id.*

[35] *Id.*

[36] EINHORN, *supra* note 26 at 117-127. *See generally* Charlotte Bretherton, *Gender Mainstreaming and EU Enlargement: Swimming Against the Tide*, Journal of European Public Policy, (2001) at 60-81 [hereinafter Bretherton]. *See also* VALENTINE M. MOGHADAM, DEMOCRATIC REFORM AND THE POSITION OF WOMEN IN TRANSITIONAL ECONOMIES 327-334 (VALENTINE M MOGHADAM ed., Clarendon Press 1993).

[37] *Id.*

[38] Watson *supra* note 4, at 369-384.

[39] Choluj & Neususs *supra* note 9, at 4.

and pension systems, as well as other areas of exclusion or discrimination." They have pointed to the prevailing weakness of mechanisms needed to ensure effective implementation of EU gender-equality directives."[40] This means that from a gender perspective, the EU enlargement process is contradictory. On the one hand, the adaptation to political and economic standards of the EU leads to an exclusion of women from labor markets and the public sphere. On the other hand, because gender mainstreaming is an integral part of the EU policies, the enlargement process also provides some important policy instruments for increasing equality between men and women, and also fights against exclusion based on ethnic, geographical, and social origin.

Additionally, several questions need to be raised with respect to the role of gender mainstreaming in the enlargement process. The most critical is the question of whether it is possible or effective to apply policies and thinking that have developed in a liberal democratic setting to countries that are in transition from state socialism, given that gender relations – or power relations between men and women – are context specific.[41] As Choluj and Neusüss point out, "the [S]ocialist legacy has . . . instilled among women in the East and the public at large an aversion to the placing of quotas or other positive measures designed to achieve gender equality in politics" among men and women, as well as the public at large.[42]

The second concern is how to address the disparity of gender mainstreaming requirements for candidate countries. Candidate countries do not adhere equally to the political, economic, and social EU norms; nor does the EU hold them equally accountable to each of these considerations.[43] According to the European Women's lobby, the EU, including the governments of candidate countries do not counteract the increasing unemployment of women and the increasing problem of lack of daycare facilities.[44] Indeed, the European Women's lobby has argued that in order to achieve equality between women and men in the candidate countries, the EU must integrate gender equality in the negotiations and evaluation, thereby treating equality between women and men as an integral and necessary part of the enlargement process.[45]

In 2001, three years before the EU enlargement, gender mainstreaming was still notably absent from policies directed at Central and Eastern European countries.[46] The enlargement policy is therefore illustrative of a conflict between ideas and interests, which serves to inhibit the institutionalization of gender main-

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[40] *Id.*

[41] Watson, *supra* note 4 at 370-371.

[42] Choluj and Neususs *supra* note 9, at 4-5.

[43] Bretherton, *supra* note 36, at 69.

[44] Europeans Women's Lobby, *Gender Equality and Enlargement of the European Union*, at http://www.womenlobby.org/Document.aso?DocID=219&tod=53344 (last visited October 20, 2004).

[45] *Id.*

[46] Bretherton, *supra* note 36, at 69.

streaming principles and practices, not only in relation to enlargement, but also across EU policy areas and beyond.[47]

Further, opportunities to systematically integrate gender during the pre-accession period have not been pursued. For example, gender was not integrated into the assistance program *Phare* which could have been a requirement for project approval – a practice that is now established in development programs.[48] The progress report on gender mainstreaming thus identifies the enlargement as an area where greater effort is required.[49]

The EU has taken note of such criticism. In 2002, the EU introduced a gender equality action program aimed at increasing women's participation in politics in the accession countries.[50] One year later, in 2003, the Commission of the European Communities ("Commission") announced plans to concentrate its activities on the promotion of gender balance in decision-making and a series of local seminars to raise awareness about women's political participation.[51] Due to the advocacy of women's groups and networks, some improvement with respect to women's participation can be noted.[52]

However, much progress is still to be made. In 2002, a conference on Gender Mainstreaming in the Structural Funds identified a lack of clear targets and monitoring in terms of gender equality.[53] Conference members recommended specific measures aimed at the under-represented sex, visible and increased funding allocated to specific equality actions and gender mainstreaming, training for gender mainstreaming, and gender-disaggregated statistics.[54] Similarly, the Commission work program for 2003 encompassed gender impact assessment, gender-disaggregated data, the development of gender equality indicators, and gender mainstreaming modules in the staff training in all Directorates General ("DG") and services.[55]

So far, the literature on gender mainstreaming in the EU enlargement process is limited. The EU Commission monitors the progress of the accession countries and publishes annual reports. The latest reports identified that, with respect to gender equality measures, the accession countries have brought their legislation into accordance with the EU-directives.[56] However, concerning Poland, the Commission concluded that while some progress had been made with respect to

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47 Bretherton, *supra* note 36, at 73, 76.

48 *Id.* at 71.

49 *Id.* at 70.

50 Commission of the European Communities, *Report from the Commission to the Council, the European Parliamen, the European Economic and Social Committee and the Committee of the Regiions. Annual Report on Equal Opportunities for Women and Men in the European Union 2002* (May2003) *available at* http://europa.eu.int/comm/employment_social/news/2003/mar/com0398_en.pdf, at 6 [hereinafter Commission Report 2003].

51 *Id.*

52 Choluj and Neususs, *supra* note 9, at 5-6.

53 Commission Report, *supra* note 50, at 10-1.

54 *Id.*

55 *Id.* at 25.

56 POLLACK, *supra* note 22.

the legislative alignment, further efforts were required to ensure proper implementation of EU legislation in the fields of equal treatment for women and men.[57] Although gender equality is addressed in the Polish constitution of 1997, the state is not obligated to actively support the introduction of gender equality.[58]

Furthermore, it must be taken into consideration that in winter 2001, the Catholic Church promised to promote Poland's joining the EU in its rural areas under the condition that the polish government would not change its gender policies.[59] Consequently, the abortion law was not liberalized and the gender equality law has not been introduced.[60] This lead to protests against the exclusion of women from the political process.[61] Politically active Polish women turned to former EU Commissioner Diamantopoulou, who at that time was responsible for labor and social politics. They were disappointed when Diamantopoulou pointed out that the EU member countries have their right to "cultural differences" and that the EU could not help the Polish women in their struggle for the liberalization of abortion law.[62] Gender equality is further undermined by the image of *Matka Polka* (Mother Poland), which shapes the image of women in Polish society.[63]

In Hungary in 2002, the legislation concerning equal treatment between men and women was in line with the *acquis communautaire*, but required implementation. As Petö points out, however, formal adjustment to the EU legislation might lead to increasing discrimination.[64] This highlights the tensions between gender specific policies and gender equality policies.

Although the EU pursues a dual approach in which gender specific measures and gender mainstreaming are mutually supportive and supplementing of each other, gender equality legislation can be used to undermine gender specific measures. Consider, for example, equal opportunity legislation supporting women's entry into education and the labor market. Petö criticizes that "formal technical criteria were set up how to measure and how to achieve gender equality in these countries without explicitly considering the political implications, the consequences, and the costs of these attempts to alter historical patterns of discrimina-

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[57] Commission of the European Communities 2002 Regular Report on Poland's Progress Towards Accession, COM (2202) 700 final, SEC(2002) 1408, Brussels, Belgium, 87 (Oct. 9, 2002), *available at* http://europa.eu.int/comm/enlargement/report2002/hu_en.pdf.

[58] Claudia Neusüss, *Polen: Verfassungsnorm, Gleichstellungswirklichkeit und die Hoffnungen der Frauen auf die*, 13 Eu. Femina Politica, 67-74 (2004).

[59] *See* Bozena Choluj, *Die Situation der Frauen-NGOs in Polen an der Schwelle zum EU-Beitritt, in* Europas Töchter (Ingrid Miethe and Silke Roth eds., Opladen: Leske + Budrich (2003)), 203-223. *See also* Neusüss *supra* note 58, at 67-74.

[60] Choluj, *supra* note 59, at 218.

[61] *Id.*

[62] *Id.*

[63] *Id.*

[64] Andrea Petö, *Angebot ohne Nachfrage: Ungarische Frauen als Bürgerinnen eines EU-Beitrittslandes, in* Europas Töchter. Frauenbewegungen in Europa, 183-201 (Ingrid Miethe and Silke Roth, eds., Opladen: Leske + Budrich, 2003).

tion."[65] Furthermore, Petö argues that the fact that feminism in Hungary is "relational" rather than "individual" has been overlooked.[66]

With respect to Lithuania, the Commission reports that legislation and implementation concerning gender equality almost completely corresponds with EU norms.[67] In addition to anti-discrimination legislation, the Ministry for Social Security and Labor started an initiative to increase women's representation in local and national governments.[68] Furthermore, Lithuania participates in the Nordic-Baltic campaign against the traffic in women.[69] Lithuania's progress with respect to gender equality raises two questions. First, whether the proximity to the Scandinavian countries plays a role for this development, and second, whether Lithuania has a better record of gender equality than some of the current EU member states.

The transition countries experience trafficking in women and children as origin, transit, and destination countries, and also experience drug trafficking, arms trafficking and other criminal networks.[70] They have therefore developed national action plans and legislative measures to abolish traffic in women and children.[71] Their efforts are supported by the ministers for interior affairs and justice of the EU, who decided to undertake active steps against traffic in women.[72]

All the Eastern European candidate countries signed the Convention on the Elimination of all Forms of Discrimination Against Women (CEDAW). Some countries, like the Czech Republic, Hungary, and Slovakia, also signed the additional optional CEDAW protocol, which incorporates the features of existing UN complaints procedures and requires regular reports about the efforts to eliminate discrimination against women.[73]

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[65] *Id.* at 11.

[66] *Id.*

[67] COMM'N OF THE EUROPEAN COMMUNITIES, 2002 Regular Report on Lithuania's Progress Towards Accession, COMM (2002) 700 final, SEC (2002) 1406, 115 Brussels, Belgium (Oct. 21, 2002), *available at* http://europa.eu.int/comm/enlargement/report2002/lt_en.pdf.

[68] *Id.* at 29.

[69] *Id.*

[70] *See* Larysa Kobelyanska, *Violence and the Trafficking in Women in Ukraine,* 76-84, 82-84, World Bank Discussion Paper no. 411, (Marnia Lazreg, ed. World Bank 2000). *See also* Stanislava Buchowska, *Trafficking in Women : Breaking the Vicious Cycle,* 85-101, World Bank Discussion Paper No. 411, 75-101, 85-88 (Marnia Lazreg, ed. World Bank 2000).

[71] *Id.*

[72] *Id.*

[73] COMM'N OF THE EUROPEAN COMMUNITIES, Regular Report on Hungary's Progress toward Accession, COMM (2002) 700 final, Brussels, Belgium (Oct. 9, 2002), *available at* http://europa.eu.int/comm/enlargement/report2002/hu_en.pdf; COMM'N OF THE EUROPEAN COMMUNITIES. Regular Report on Czech Republics's Progress toward Accession. COMM (2002) 1402 final, Brussels, Belgium (Oct 9 2002) *available at* http://europa.eu.int/comm/enlargement/report2002/cz_en.pdf; COMM'N OF THE EUROPEAN COMMUNITIES. Regular Report on Slovakia's Progress toward Accession. COMM (2002) 1410 final, Brussels, Belgium (Oct. 9, 2002) *available at* http://europa.eu.int/comm/enlargement/report2002/sk_en.pdf (last visited November 12, 2004).

Conclusions and Outlook

In the past decade, the situation of women in Central and Eastern Europe, which was previously characterized by high labor force participation, has become more similar to the Western European situation, meaning that it has worsened. Thus from an Eastern European perspective, the question can be raised whether the member states themselves live up to the principle of gender mainstreaming.

The concept of gender mainstreaming could serve as a bridge between women in Eastern and Western Europe, allowing the formation of coalitions to benefit women in all European countries. In recent years, several women's networks such as the Eastern European Women Coalition Karat or the Network East West Women (NEWW) have been formed.[74] These networks, which receive support from the EU and other organizations, provide information, mutual support, and try to shape the European agenda.[75]

In May 2004, Cyprus, the Czech Republic, Estonia, Hungary, Latvia, Lithuania, Malta, Poland, Slovenia, and the Slovak Republic joined the EU.[76] This means the EU membership increased by about 20%, to approximately 450 million citizens.[77] One month later, in June 2004, the presidents of the 25 member states agreed upon the first EU constitution, which shall come into effect in 2007.[78] Until then, it needs to be approved by the member states, and in some cases in a plebiscite. Given the low participation in the election to the EU parliament in June 2004 and the success of the parties critical of the EU, the governments will have to fight for popular support for the EU constitution.

This constitution will bring the following changes: instead of a six month rotation, in the future, the presidency will last two years and be renewable.[79] The position of a foreign minister will be created in order to coordinate the foreign policy of the EU.[80] Until 2014 each member state will be represented in the Commission. Afterwards, the Commission will consist only of eighteen commissioners of the twenty-seven member states, taking the demographic and geographic size of the member states into consideration.[81] The composition of the parliament – which will have more influence – will change, giving more seats to smaller countries and taking some away from larger countries.[82]

How will these changes affect the participation of women in the political institution of the EU and the representation of their interests? Mateo Diaz and Millns

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[74] *See* http://www.karat.org/ (last visited Oct. 21, 2004).

[75] *Id.*

[76] In 2007, Bulgaria and Romania might join the EU as well. Currently, it is not clear if and when Turkey will become a member of the EU.

[77] *See* http://www.europa.admin.ch/eu/expl/staaten/e/ (last visited October 21, 2004).

[78] *See* http://european-convention.eu.int/docs/Treaty/cv00850.en03.pdf (last visited Oct. 21, 2004) for a draft of the EU Constitution.

[79] *Id.*

[80] *Id.*

[81] *Id.*

[82] *Id.*

conclude that women hardly benefit from these reform processes.[83] They are concerned by the under representation of women in EU institutions and therefore call for hard as well as soft legal measures to guarantee gender equality.

However, even if gender mainstreaming has not been yet implemented equally in the old and new member states of the European Union, it is an important strategy for achieving more gender equality. In the evaluation of this strategy, various levels and political actors need to be distinguished: on the European level, the various entities of the EU which differ with respect to the implementation of gender mainstreaming and transnational women's networks like the European Women's Lobby, KARAT, or NEWW; on the national level, we need to take into consideration the national governments as well as national women's movements.

Gender mainstreaming is a top-down strategy: the EU requires the implementation of gender mainstreaming from the member states and the government of the member states, in turn, demand the implementation in the administration and throughout society; however, it is important that there is grass roots demand and pressure on the governments. The EU as a transnational opportunity structure allows the formation of transnational feminist networks.[84] This means that women's movements which find themselves constrained at the national level, for example, by conservative governments or a political culture influenced by the (Catholic) Church which emphasizes a conventional gender division of labor, find allies in transnational and international networks and coalitions. The EU supports these networks financially and provides them with access and legitimacy. Keck and Sikkink refer to the strategy of influencing national politics by way of transnational opportunity structures as 'boomerang effect'.[85]

Support of gender mainstreaming through women in the candidate countries is important for women in both the old and new EU states. If gender mainstreaming is not taken seriously in the enlargement process, this could result in a worsening of the situation of women in the EU. Thus, women of the EU as well as women of the candidate countries hope that the EU enlargement will lead to a strengthening of gender equality.

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[83] Mercedes Mateo Diaz & Susan Millns, *Die Rolle der Frau und die konstitutionelle Zukunft der europäischen Union,* 13 FEMINA POLITICA 75-90 (2004).

[84] Silke Roth, *Gender, Globalization, and Social Movements, in* FEMINIST MOVEMENTS IN A GLOBALIZING WORLD: GERMAN AND AMERICAN PERSPECTIVES, 4-12 (Silke Roth & Sara Lennox eds., Johns Hopkins University 2002); Silke Roth *One Step Forwards, One Step Backwards, One Step Forwards – The Impact of EU Policy on Gender Relations in Central and Eastern Europe, in* TRANSITIONS, 15-28 (Jacqueline Heinen & Stéphane Portet eds., 2004).

[85] MARGARET E. KECK & KATHRYN SIKKINK, ACTIVISTS BEYOND BORDERS: ADVOCACY NETWORKS IN INTERNATIONAL POLITICS 12-13 (Cornell University Press, 1998).

INTERNATIONAL ANTITRUST: SUPREME COURT DECIDES THE MEANING OF "GIVES RISE TO A CLAIM" AND "FOREIGN TRIBUNAL"

Robert E. Draba*

I. Introduction

Since 1991, there has been tremendous growth in the number of countries that have antitrust laws and agencies.[1] In 1991, only a handful of nations had antitrust laws that were actively enforced. By 2001, more than 100 nations had such laws.[2] Perhaps, no other regulatory scheme has spread so far, so fast. Antitrust enforcement is now found throughout the world,[3] and "market principles, deregulation, and respect for competitive forces have been broadly embraced. . . ."[4]

Because business transactions are international in scope,[5] there are ongoing efforts to achieve greater substantive and procedural convergence in international antitrust policy.[6] Having antitrust laws everywhere at once is of little value if they do not work together to advance global competition. The failed Honeywell/GE merger illustrates this point.[7]

No doubt, the process of harmonizing antitrust laws on a worldwide basis will proceed incrementally for years to come.[8] For example, there remains uncertainty as to whether an existing global entity like the World Trade Organization

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1 Charles A. James, Assistant Attorney General, Antitrust Division, U.S. Department of Justice, *International Antitrust In The 21st Century: Cooperation and Convergence,* Address at the OECD Global Forum on Competition, Paris, France, October 17, 2001. U.S. Department of Justice, *Advanced Corporate Compliance Workshop 2002*, 1291 PLI/CORP 827, 860 (2002).

2 Abbott B. Lipsky, Jr., *The Global Antitrust Explosion: Safeguarding Trade And Commerce Or Runaway Regulation?*, 26-FALL FLETCHER F. WORLD AFF. 59, 60 (2002).

3 James, *supra* note 1, at 860.

4 *Id.*

5 John T. Soma & Eric K. Weingarten, *Multinational Economic Network Effects And The Need For An International Antitrust Response From The World Trade Organization:A Case Study In Broadcast-Media And News Corporation*, 21 U. PA. J. INT'L ECON. L. 41, 43 (2000); *see also*, Quaak v. Klynveld Peat Marwick Goerdeler Bedrijfsrevisoren, 361 F.3d 11, 19 (1st Cir. 2004) ("In an increasingly global economy, commercial transactions involving participants from many lands have become common fare.").

6 Roger Alan Boner & William E. Kovacic, *Antitrust Policy In Ukraine*, 31 GEO. WASH. J. INT'L L. & ECON. 1, 44 (1997) ("Some antitrust scholars have recently proposed that national antitrust laws should converge into a single, consistent, international antitrust law."); James, *supra* note 1, at 857-61.

7 Matt Murray et. al., *Oceans Apart: As Honeywell Deal Goes Awry for GE, Fallout May Be Global*, WALL ST. J., June 15, 2001, at A1, *available at* Westlaw, 6/15/01 WSJ A1.

8 Spencer Weber Waller, *The Internationalization Of Antitrust Enforcement*, 77 B.U. L. REV. 343, 404 (1997) ("Harmonization in the antitrust area continues more by way of accretion than design.").

should be the focus of promulgating international competition policy or whether a new and separate international agency should be established.[9]

Nonetheless, issues involving international antitrust emerge and require resolution, as exemplified this past term when the United States Supreme Court ("Court") decided two cases involving such issues. First, in *F. Hoffman-La Roche Ltd. v. Empagran S.A.*[10] ("Empagran"), the Court clarified the phrase, "gives rise to a claim," within the meaning of the Foreign Trade Antitrust Improvements Act of 1982 ("FTAIA"). Second, in *Intel Corporation v. Advanced Micro Devices*[11] ("Intel"), the Court clarified whether the Directorate General of the European Union is a "foreign tribunal" within the meaning of section 1782 of the Judicial Code.[12]

This note discusses both cases. Part II focuses on *Empagran*, which involves a question of subject matter jurisdiction and stands for the proposition that "where the defendant's conduct affects both domestic and foreign commerce, but the plaintiff's injury arises only from the conduct's foreign effect and not its domestic effect, the plaintiff's injury is independent from the domestic effect and the court has no jurisdiction."[13] This rule means that a global conspiracy's effect on domestic commerce must give rise to the plaintiff's claim.[14] Part III focuses on *Intel*, which involves the discovery of documents in the United States in connection with a proceeding in a "foreign tribunal" and stands for the proposition that Section 1782 of the Judicial Code "authorizes, but does not require, a federal district court to provide judicial assistance to foreign or international tribunals . . . in proceedings abroad."[15]

Part IV takes a closer look at cases that have been decided since the Court issued its opinions. They provide early indications of how trial courts and courts of appeal apply the rules announced in *Empagran* and *Intel*. In addition, Part IV takes a quick look at the issue of comity in these cases. Comity is a doctrine that takes into account "foreign interests, the interests of the United States, and the mutual interests of all nations in a smoothly functioning international legal regime."[16] In *Empagran*, the Court emphasized the importance of comity, but in *Intel*, the Court minimized its importance.

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[9] Andrew T. Guzman, *Antitrust And International Regulatory Federalism*, 76 N.Y.U. L. REV. 1142, 1143 (2001).

[10] 124 S. Ct. 2359 (2004) [hereinafter "Empagran II"].

[11] 124 S. Ct. 2466 (2004) [hereinafter "Intel II"].

[12] Assistance to Foreign and International Tribunals and to Litigants Before Such Tribunals, 28 U.S.C.A. § 1782 (1996); *see also* Intel II, 124 S. Ct. at 2473 ("Section 1782 is the product of congressional efforts, over the span of nearly 150 years, to provide federal-court assistance in gathering evidence for use in foreign tribunals.").

[13] MM Global Serv. v. Dow Chem., 2004 WL 1792461, *4 (D.Conn. Aug. 11, 2004) (summarizing the rule of Empagran II).

[14] *See* Sniado v. Bank Aus. AG, 378 F.3d 210, 212 (2d Cir. 2004) (discussing Empagran II).

[15] Intel II, 124 S. Ct. at 2473.

[16] Comity Société Nationale Industrielle Aérospatiale v. District Court, 482 U.S. 522, 555 (Blackmun, J., concurring in part and dissenting in part).

Part V concludes that both *Empagran* and *Intel* will help achieve greater procedural convergence in international antitrust policy, but also cautions that "[i]t's tough to make predictions, especially about the future."[17] The ramifications of domestic antitrust decisions can be difficult to anticipate at the time they are decided,[18] and there is no reason to believe that the ramifications of these international antitrust decisions would be any less difficult to anticipate. At the very least, though, the Supreme Court in *Empagran* and *Intel*, respectively, provided more clarity regarding subject matter jurisdiction and discovery in international antitrust matters.

II. *Empagran* Clarifies "Gives Rise to a Claim"

Empagran is an antitrust case brought by foreign purchasers of vitamins products against foreign and domestic companies that distribute and sell these vitamin products around the world.[19] The plaintiff-purchasers alleged that defendant-companies engaged

> [in] an over-arching worldwide conspiracy to raise, stabilize, and maintain the prices of vitamins; that this cartel operated on a global basis and affected virtually every market where [defendants] operated worldwide; and that [their] unlawful price-fixing conduct had adverse effects in the United States and in other nations that caused injury to appellants in connection with their foreign purchases of vitamin products.[20]

The District Court granted the defendants' motion to dismiss the case because "the injuries plaintiffs sought to redress were allegedly sustained in transactions that lack any direct connection to United States commerce."[21] The D.C. Circuit reversed,[22] holding that "FTAIA permits suits by foreign plaintiffs who are injured solely by that conduct's effect on foreign commerce.[23] But, "[t]he anticompetitive conduct itself must violate the Sherman Act and the conduct's harmful effect of United States commerce must give rise to 'a claim' by someone, even if not the foreign plaintiff who is before the court."[24] The Court granted certiorari essentially to clarify the meaning of the FTAIA phrase, "gives rise to a claim."

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[17] *See* William E. Lee, *Facts, Assumptions and American Pie*, 2000 L. REV. MICH. ST. U. DET. C.L. 239, 252 n.61 (2000) (stating that this comment is sometimes attributed to Yogi Berra).

[18] *See* Deborah A. Garza, *25 Years Later: Walking in the Footsteps of Brunswick, Illinois Brick, and Sylvania*, 17 ANTITRUST 7, 7 (2002).

[19] Empagran S.A. v. F. Hoffman-LaRoche, Ltd., 315 F.3d 338, 340-41 (D.C. Cir. 2003), *cert. granted*, 2003 WL 22734815 (U.S. Dec. 15, 2003) (No. 03-0724) [hereinafter "Empagran I"].

[20] *Id.* at 340.

[21] *Id.*

[22] *Id.* at 360.

[23] *Id.* at 350.

[24] *Id.*

A. Foreign Trade Antitrust Improvements Act

To help U.S. companies compete more effectively in foreign markets,[25] to reduce the potential antitrust liability of U.S. companies working together to compete in foreign markets,[26] and to clarify the extraterritorial reach of the antitrust laws of the United States,[27] Congress amended the Sherman Act[28] with the FTAIA of 1982.[29] It provides in pertinent part that the Sherman Act "shall not apply to conduct involving trade or commerce (except import trade or commerce) with foreign nations" unless (1) such foreign conduct "has a direct, substantial, and reasonably foreseeable effect" on U.S. commerce, and (2) the effect of such conduct on domestic conduct "gives rise to a claim" under the Sherman Act.[30]

The first prong of the two-pronged exception seen above requires a direct, substantial, and reasonably foreseeable effect on U.S. commerce. This requirement is not controversial. It is axiomatic that where there is no harm, there can be no foul. School boys in Indiana playing pick-up basketball have understood and applied this "rule of law" for generations with absolutely no guidance from the Court. Hence, the FTAIA shields a defendant who engages in anticompetitive conduct in foreign markets as long as that anticompetitive conduct does not have a direct, substantial, and reasonably foreseeable effect on U.S. commerce.[31] Conversely, the FTAIA provides an avenue of action for a U.S. plaintiff injured by a defendant engaged in anticompetitive conduct in foreign commerce that adversely affects U.S. commerce.

The origin of the requirement of an effect on U.S. commerce is found in *United States v. Aluminum Co. of America*.[32] In that case, Judge Learned Hand promulgated the so-called "effects test,"[33] thereby resolving whether Congress intended to impose liability for anticompetitive conduct outside the United States. Judge Hand announced that the Sherman Act was limited to acts intended to affect U.S. imports and did in fact affect them.[34] He pointedly rejected that the

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[25] Spencer Weber Waller, *The United States as Antitrust Courtroom to the World: Jurisdiction and Standing Issues in Transnational Litigation*, 14 LOY.CONSUMER L. REV. 523, 529-31 (2002).

[26] *See* United Phosphorus. Ltd. v. ANGUS Chem. Co., 322 F.3d 942, 951 (7th Cir. 2003) ("[T]he legislative history shows that jurisdiction stripping is what Congress had in mind in enacting the FTAIA.").

[27] James R. Atwood & Christopher D. Oatway, *Foreign-Market Claims*, 25 NAT'L L.J. 37 (2003), *available on Westlaw at* 5/5/03 NLJ B8, (col. 1).

[28] Section One of the Sherman Act is the foundation of American antitrust law. "It proscribes any contract or conspiracy to restrain trade or commerce among the states or with foreign nations." Liam D. Scully, *Antitrust Law—Section One Of The Sherman Act Extends Criminal Liability To Conduct Committed Wholly Outside Of The United States*, 31 SUFFOLK U. L. REV. 977, 977 (1998).

[29] 15 U.S.C. § 6a (1982).

[30] *Id.*

[31] Kareen O'Brien, *Giving Rise to a Claim: Is FTAIA's Section 6a(2) An Antitrust Plaintiff's Key To The Courthouse Door?*, 9 SW. J. L. & TRADE AM. 421, 422-23 (2002-03).

[32] 148 F.2d 416 (2d Cir. 1945); *see also* Hartford Fire Ins. Co. v. California, 509 U.S. 764, 798 n.24 (1993) ("Sherman Act covers foreign conduct producing a substantial intended effect in the United States. . . .").

[33] *United Phosphorus*, 322 F.3d at 946-47.

[34] *Id.*

Sherman Act applied to anticompetitive conduct that had no consequences within the United States.[35]

The second prong of the FTAIA requires that the effect of anticompetitive conduct in foreign markets on domestic commerce "gives rise to a claim" under the Sherman Act. By contrast with the first prong that involves no dispute, there was a Circuit split about the meaning of the phrase, "gives rise to a claim."[36]

B. A Split in the Circuits[37]

In *Den Norske*,[38] the Fifth Circuit held that "gives rise to a claim" refers specifically to the plaintiff's claim.[39] Consequently, only claims arising from the U.S. effect of the anti-competitive conduct are actionable. Injured consumers in U.S. commerce may state a claim that allows U.S. courts to have jurisdiction, but consumers in foreign markets may not state a claim even if they are affected by the very same anticompetitive conduct.[40]

Accordingly, the *Den Norske* court upheld the dismissal of a Norwegian oil company's claim that it paid inflated prices for heavy-lift barge services in non-U.S. waters (the North Sea), but it permitted claims of companies injured by the very same anticompetitive conduct in U.S. waters (Gulf of Mexico).[41] To the Fifth Circuit, a FTAIA claim requires that the "direct, substantial, and reasonably foreseeable effect" on U.S. commerce gives rise to "the" claim under the Sherman Act and not "a" claim unrelated to the effect on U.S. Commerce.[42]

In *Kruman*,[43] the Second Circuit reached a different conclusion. *Kruman* involved allegations of price fixing against two major auction houses, Christie's International and Sotheby's Holdings. It was a class action on behalf of persons who bought or sold items at auction outside the United States.[44] The District Court stated that "The fundamental question here is whether a transnational price fixing conspiracy that affects commerce both in the United States and in other countries inevitably gives persons injured abroad in transactions otherwise un-

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35 *Id.*

36 Ryan A. Haas, *Act Locally, Apply Globally: Protecting Consumers from International Cartels by Applying Domestic Antitrust Law Globally*, 15 LOY. CONSUMER L. REV. 99, 100-01 (2003).

37 *Id.* (discussing this circuit split succinctly and clearly).

38 Den Norske Stats Oljeselskap AS v. HeereMac v.o.f., 241 F.3d 420 (5th Cir. 2001), *cert. denied sub nom.* Statoil ASA v. HeereMac v.o.f., 534 U.S. 1127 (2002).

39 *See* Michael D. Blechman, *Relationships Among Competitors*, 1370 PLI/CORP 121, 161-64 (2003).

40 Atwood & Oatway, *supra* note 27.

41 *Id.*

42 Salil K. Mehra, *"A" Is For Anachronism: The FTAIA Meets the World Trading System*, 107 DICK. L. REV. 763, 765-66 (2003).

43 Kruman v. Christie's Int'l PLC, 284 F.3d 384 (2d Cir. 2002).

44 *Id.* at 389; *see also* Neal R. Stoll and Shepard Goldfein, *U.S. Antitrust Laws: Who Can Sue Whom?*, New York Law Journal, July 20, 2004, *available on Westlaw at* 7/20/2004 N.Y.L.J. 3, (col. 1) (succinctly summarizing Empagran II and its background); Ved P. Nanda & David K. Pansius, *Sherman Act, Section 7*, 1 LITIGATION OF INT'L DISPUTES IN U.S. COURTS § 5:13 (2004) ("U.S. plaintiffs settled their cases leaving only the foreign plaintiffs.").

connected with the United States a remedy under our antitrust laws."[45] In granting defendants' motion to dismiss, the District Court refused to "to impute to Congress an intention to establish an antitrust regimen to cover the world."[46]

On appeal, the Second Circuit reversed, rejecting the lower court's position that "plaintiffs injured abroad by anticompetitive conduct directed at foreign markets are barred from suit under the FTAIA. . . ."[47] According to the Second Circuit, the FTAIA grants wide jurisdiction over foreign parties.[48] The plaintiff only needs to show that the effect on U.S. commerce violated the Sherman Act to satisfy the "gives rise to a claim" requirement and to give U.S. courts jurisdiction.[49] Simply stated, the Second Circuit held that "a violation of the Sherman Act is not predicated on the existence of an injury to the plaintiff,"[50] a position which the Court decidedly rejected in *Empagran*.[51]

C. Opinion of the D.C. Circuit in *Empagran*

Landing somewhere in between *Den Norske* and *Kruman*,[52] the D.C. Circuit opined that "giving rise to a claim" simply means that "some private person or entity has suffered actual or threatened injury as a result of the United States effect of the defendant's violation of the Sherman Act."[53] Further, as long as another private party has a potential Sherman Act claim arising from an effect on domestic commerce, then the claim before the court need not arise from the domestic effect.[54] The FTAIA "allows a foreign plaintiff to bring suit in U.S. courts when a global conspiracy has effects in the United States that 'give rise' to a Sherman Act claim, even if the foreign plaintiff's injury cannot be attributed to the U.S. effect."[55] To the D.C. Circuit, "as long as someone has a claim based on the requisite effects on U.S. commerce, any injured party can sue in the United States."[56]

In her dissent, Judge Henderson of the D.C. Circuit stated that she would have adhered to the Fifth Circuit's holding in *Den Norske*, and she added that "[t]he

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45 Kruman v. Christie's Int'l PLC, 129 F. Supp. 2d 620, 623-24 (S.D.N.Y. 2001).

46 *Id.* at 624 ("There is no basis for imputing such an intent.").

47 Edward D. Cavanagh, *The FTAIA And Subject Matter Jurisdiction Over Foreign Transactions Under The Antitrust Laws: The New Frontier In Antitrust Litigation*, 56 SMU L. REV. 2151, 2172-73 (2003).

48 Andrew Stanger, *Analyzing U.S. Antitrust Jurisdiction Over Foreign Parties After Empagran S.A. V. F. Hoffman-Laroche, Ltd.*, 2003 B.Y.U. L. REV. 1453, 1467 (2003).

49 *Id.*

50 Kruman v. Christie's Int'l PLC, 284 F.3d at 399.

51 *See* Empagran II, 124 S. Ct. 2359, 2366 (2004) (holding that the Sherman Act does not apply when "the adverse foreign effect is independent of any adverse domestic effects").

52 Andrews Antitrust Litig. Reporter, *Foreign Trade Antitrust Improvements Act: D.C. Cir. Reinstates Foreign Vitamin Purchasers' Antitrust Lawsuit*, 10 No. 10 ANDREWS ANTITRUST LITIG. REP. 7 (2003).

53 Empagran I, 315 F.3d at 352.

54 Atwood & Oatway, *supra* note 27.

55 Andrews Antitrust Litig. Reporter, *supra* note 52.

56 Stoll & Goldfein, *supra* note 44.

majority decides whether a court has jurisdiction over claims asserted by a plaintiff in one action by reference to a hypothetical claim another party could, perhaps, raise in some other proceeding."[57] "This," she observed, "seems a peculiar notion."[58]

The D.C. Circuit asked the Solicitor General to express the views of the United States with respect to a rehearing en banc in *Empagran*.[59] In the Solicitor General's brief in support of a rehearing, the Solicitor General disagreed with the panel's ruling in *Empagran*, stating that the "most natural reading" of the FTAIA "is that the requisite anticompetitive effects on domestic commerce must give rise to the claim brought by the particular plaintiff before the court."[60] However, the D.C. Circuit denied a hearing en banc in *Empagran*, leaving the matter for the U.S. Supreme Court to resolve.

D. The U.S. Supreme Court's View

Writing for a unanimous Court,[61] Mr. Justice Breyer stated that a plaintiff must allege that the conspiracy's effect on domestic commerce gave rise to the plaintiff's claim.[62] Accordingly, the Court vacated the decision of the D.C. Circuit,[63] abrogated the decision of the Second Circuit in *Kruman*,[64] and announced that the FTAIA "does not apply where the plaintiff's claim rests solely on the independent foreign harm."[65] The Court made two points in its decision.[66] First, the holding avoids unreasonable interference with the sovereign interests of other countries.[67] Second, it comports with the legislative history of the FTAIA, which the Court opined was not intended "to expand in any significant way, the Sherman Act's scope as applied to foreign commerce."[68]

1. Sovereign interests of other countries

The Court "construes ambiguous statutes to avoid unreasonable interference with the sovereign authority of other nations."[69] Because the FTAIA is ambiguous, the Court applied a traditional rule of statutory construction: "legislation of

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[57] Empagran I, 315 F.3d at 360 (Henderson, J., dissenting).

[58] *Id.*

[59] *See* Hoffman-LaRoche, Ltd. v. Empagran S.A., Petition for a Writ of Certiorari, No. 03-724 2003 WL 22762741,at *7-8 (Nov. 13, 2003).

[60] *Id.*

[61] Justice Sandra Day O'Connor did not participate.

[62] *See* Sniado v. Bank Aus. AG, 378 F.3d 210, 212 (2d Cir. 2004) (discussing Empagran II).

[63] Empagran II, 124 S. Ct. at 2372.

[64] Sniado, 378 F.3d at 212 (stating that Empagran II abrogated the Second Circuit's decision in *Kruman*).

[65] Empagran II, 124 S. Ct. at 2363

[66] Stoll & Goldfein, *supra* note 44.

[67] Empagran II, 124 S. Ct. at 2369.

[68] *Id.*

[69] *Id.* at 2366.

Congress, unless a contrary intent appears, is meant to apply only within the territorial jurisdiction of the United States."[70] This rule of construction "cautions courts to assume that legislators take account of the legitimate sovereign interests of other nations when they write American laws. It thereby helps the potentially conflicting laws of different nations work together in harmony—a harmony particularly needed in today's highly interdependent commercial world."[71] To the Court, "if America's antitrust policies could not win their own way in the international marketplace for such ideas, Congress, we must assume, would not have tried to impose them, in an act of legal imperialism, through legislative fiat."[72]

2. *Comports with the legislative history*

The Court also reviewed the legislative history of the FTAIA, concluding that "Congress would not have intended the FTAIA's exception to bring independently caused foreign injury within the Sherman Act's reach."[73] Specifically, the Court could find "no significant indication that at the time Congress wrote this statute courts would have thought the Sherman Act applicable in these circumstances." Moreover, the Solicitor General who supported the petitioner could find no cases "in which any court applied the Sherman Act to redress foreign injury in such circumstances."[74]

Respondents, however, cited three cases decided by the Supreme Court and three others decided by lower courts, which the Court reviewed *seriatim*. Regarding the cases decided by the Supreme Court, the Court observed that none addressed whether "foreign private plaintiffs could have obtained foreign relief based solely upon such independently caused foreign injury."[75] As to cases decided by lower courts, the Court observed that none provided "significant authority for application of the Sherman Act in the circumstances we here assume."[76] In contrast, the Court cited "a leading contemporaneous lower court case" that emphasizes that the domestic effect of foreign conduct be "sufficiently large to present a cognizable injury to the plaintiffs."[77]

3. *Linguistic Sense*

In sum, the Court concluded that it "makes linguistic sense to read the words 'a claim' as if they refer to the 'plaintiff's claim' or 'the claim at issue.'" To the Court, this interpretation of the phrase, "a claim" is consistent with the basic

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[70] EEOC v. Arabian Am. Oil Co., 499 U.S. 244, 248 (1991) (quoting Foley Bros., Inc. v. Filardo, 336 U.S. 281, 285 (1949)).

[71] Empagran II, 124 S. Ct. at 2366.

[72] *Id.* at 2369; *see also* Stoll & Goldfein, *supra* note 44 ("Germany, Belgium, Canada, the United Kingdom, Ireland, the Netherlands and Japan all filed briefs in support of the defendants. . . .").

[73] Empagran II, 124 S. Ct. at 2371.

[74] *Id.* at 2369.

[75] *Id.* at 2370.

[76] *Id.* at 2372.

[77] *Id.* (quoting Timberlane Lumber Co. v. Bank of America, 549 F.2d 597, 613 (9th Cir. 1976).

intent of FTAIA as understood in the context of comity and history. Where "the statute's language reasonably permits an interpretation consistent with . . . intent," the Court opined that it "should adopt it."[78]

III. *Intel* Clarifies Whether the Directorate General Is a "Foreign Tribunal"

Advanced Micro Devices Inc. ("AMD") and Intel Corporation ("Intel") compete in the microprocessor industry.[79] AMD filed a complaint with the Directorate General ("DG") in Europe, claiming that Intel was abusing its dominant market position in violation of Article 82 of the Treaty of Rome of the European Union.[80] In connection with the investigation of the DG in Belgium, AMD filed a petition in a California federal district court under 28 U.S.C. 1782[81] to obtain transcripts and other documents from an antitrust case involving Intel being conducted in an Alabama federal district court. Section 1782 governs discovery within the United States of information to be used in foreign legal proceedings.[82] Hence, the field of play is Belgium to California to Alabama, which seems like the antitrust version of "Tinker to Evans to Chance."[83] The California District Court agreed with Intel that the investigation of the DG was not a "proceeding in a foreign or international tribunal" under section 1782,[84] but the Ninth Circuit reversed[85] and the Court granted Intel's petition for certiorari.[86]

A. The European Union

The origin of the twenty-five-member European Union ("EU") can be traced to a six-nation agreement reached in 1952 to establish the European Coal and

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[78] *Id.* at 2371-72.

[79] *See* Andrews Antitrust Litig. Reporter, *Discovery: 9th Cir. Says AMD Can Pursue Discovery Request for EC Proceeding*, 10 No. 1 ANDREWS ANTITRUST LITIG. REP. 7 (2002).

[80] Katherine Birmingham Wilmore, *International Legal Developments in Review: 2002 Business Transactions & Disputes*, 37 INT'L LAW. 479, 494-95 (2003). For more information on Article 82 of the Treaty of Rome, *see* Article 82 of the EC Treaty, *available at* http://europa.eu.int/comm/competition/legislation/treaties/ec/art82_en.html (last visited Oct. 28, 2004).

[81] Originally, AMD wanted the E.C.'s directorate-general for competition to petition the U.S. courts to obtain documents, but the directorate-general declined to do so. Gregory P. Joseph, *International Discovery*, 26 NAT'L L. J. 48 (2004) *available on Westlaw at* 8/2/04 NLJ 12, (col. 1).

[82] Wilmore, *supra* note 80, at 495 ("To support its complaint, AMD applied under 28 U.S.C. § 1782, to the district court in California for access to documents and transcripts from a proceeding pending in federal court in Alabama.").

[83] Joe Tinker (SS), Johnny Evers (2B), and Frank Chance (1B) were the famous double play team of the Chicago Cubs. They were elected to the Baseball Hall of Fame as a trio in 1946. Baseball Hall of Fame, *at* http://www.baseballhalloffame.org/hofers_and_honorees/extra/tinker_evers_chance.htm (last visited May 6, 2004).

[84] Advanced Micro Devices, Inc. v. Intel Corp., 292 F.3d 664, 669 (9th Cir. 2002) [hereinafter "Intel I"] (referencing the District Court's determination that the proceeding for which AMD seeks discovery does not qualify under 28 U.S.C. § 1782).

[85] *Id.*

[86] Advanced Micro Devices, Inc. v. Intel Corp., 292 F.3d 664 (9th Cir. 2002), *cert. granted*, 124 S. Ct. 531 (Nov. 10, 2003) (No. 02-0572).

Steel Community ("ECSC"), which focused in part on price and output controls and competition rules. Building on this agreement, the six nations formed the European Community in 1957 with the Treaty of Rome. One long-term goal of the Treaty of Rome was the establishment of a common market. After some "alarms and excursions," European leaders eventually negotiated and signed the Treaty on European Union or the Maastricht Treaty, which went into effect November 1, 1993. One important objective of the Treaty was the creation of a timetable for economic union. To this end, the Treaty of European Union established the European Commission ("EC"), which is the EU's competition law enforcement agency and one of five major institutions intended to advance the goals of the EU.[87] The EC is like the Antitrust Division, Federal Trade Commission ("FTC"), and state attorneys general wrapped into one.[88] In the context of this case, AMD brought its complaint about Intel to the DG, which is a subunit of the EC.[89]

B. Article 82

AMD complained that Intel abused its dominant position in Europe in violation of Article 82 of the Treaty of Rome.[90] Article 82 prevents an enterprise that occupies a dominant position within the EU market from abusing its dominance. Such abuse is prohibited because it is incompatible with the objective of integrating the economies of Europe, which is one important purpose of the EU.[91] To state a claim under Article 82 (formerly Article 86), the following elements must be present: (1) a dominant position of a relevant product and in a geographic market within the common market; (2) an abusive act; and (3) a potential appreciable effect on trade between Member States.[92]

Article 82 is often compared with Section 2 of the Sherman Act, which proscribes monopolization or attempts to monopolize.[93] However, the parallel is not

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[87] This paragraph is freely adapted from Jeffrey M. Peterson, *Unrest in the European Commission: The Changing Landscape and Politics of International Mergers for United States Companies*, 24 HOUS. J. INT'L L. 377, 381-84 (2002).

[88] *But see id.* at 400 ("In many ways, EU antitrust powers are lacking when compared to those of the Department of Justice and Federal Trade Commission.").

[89] Oliver Borgers et. al., *International Antitrust Law*, 37 INT'L LAW. 305, 323-24 (2003).

[90] *Id.*

[91] *See* Mercer H. Harz, *Dominance And Duty In The European Union: A Look Through Microsoft Windows At The Essential Facilities Doctrine*, 11 EMORY INT'L L. REV. 189, 194-95 (1996)(discussing Article 86 of the Treaty of Rome which is now Article 82 of the Treaty of Rome); James Kanter & Alexei Barrionuevo, *Airbus Rescinds Challenge to EU's Microsoft Order*, WALL ST. J., Sept. 24, 2004, at B3, *avaliable on Westlaw at* 9/24/04 WSJ B3 (reporting that in a prehearing filing related to the EU's antitrust ruling against Microsoft Corp., the EU purportedly stated, "[t]he concept of abuse of a dominant position does not exist in U.S. law").

[92] James S. Venit, *EU Competition Law—Enforcement and Compliance: An Overview*, 65 ANTITRUST L.J. 81, 83-84 (1996) (discussing Article 86 which is now Article 82).

[93] *See* Thomas J. Horton & Stefan Schmitz, *The Lessons of Covisint: Regulating B2Bs Under European and American Competition Laws*, 47 WAYNE L. REV. 1231, 1237 (2001-02) (stating Article 82 is roughly parallel to Section 2 of the Sherman Act); Romano Subiotto & Filippo Amato, *The Reform Of The European Competition Policy Concerning Vertical Restraints*, 69 ANTITRUST L.J. 147, 193 n.1 (2001) (stating Article 82 roughly corresponds to Section 2 of the Sherman Act); Moritz Ferdinand

direct. Section 2 of the Sherman Act requires a monopoly, but Article 82 only requires a dominant position.[94] Hence, a monopolization forbidden by the Sherman Act differs from the abuse of dominant position forbidden by Article 82 of the Treaty of Rome.[95] Under Article 82, for example, a company may be thought to have a dominant position with a market share of 40%, but under the Sherman Act a market share of 40% would not be construed as "monopoly power."[96]

One reason for the difference between the concept of dominant position and monopoly power involves the purpose of competition policy. The purpose of U.S. policy is the maximization of consumer welfare, but the purpose of EU policy is protecting competition by protecting competitors.[97] As Mario Monti[98] of the European Commission explained, the "goal of competition policy, in all its aspects, is to protect consumer welfare by maintaining a high degree of competition in the common market."[99]

The proposed $40 billion merger of General Electric and Honeywell illustrates the practical implications of this difference in approach. General Electric was prevented by the EC from acquiring Honeywell even though the Antitrust Division approved this merger.[100] A merger that was not a problem in the U.S. was a problem in the EU.[101]

C. Section 1782

To advance its Article 82 complaint in Belgium, where the EC is located, AMD wanted Intel documents from a case before a federal court in Alabama. AMD petitioned a federal court in California to obtain those documents from the Alabama court so it could use them to press its Article 82 complaint in Belgium.

Scharpenseel, *Consequences of E.U. Airline Deregulation in the Context of the Global Aviation Market*, 22 NW. J. INT'L L. & BUS. 91, 114 (2001) (stating Article 82 of the EC Treaty and Section 2 of the Sherman Act are similar).

94 Stefan Schmitz, *The European Commission's Decision In GE/Honeywell And The Question of the Goals of Antitrust Law*, 23 U. PA. J. INT'L ECON. L. 539, 595 n.82 (2002).

95 Lucio Lanucara, *The Globalization of Antitrust Enforcement: Governance Issues and Legal Responses*, 9 IND. J. GLOBAL LEGAL STUD. 433, 453-55 (2002).

96 ANDREW I. GAVIL, ET AL., ANTITRUST LAW IN PERSPECTIVE: CASES, CONCEPTS AND PROBLEMS IN COMPETITION POLICY 676-77 (2002).

97 Eric S. Hochstadt, *The Brown Shoe of European Union Competition Law*, 24 CARDOZO L. REV. 287, 295-96 (2002) ("Specifically, the goal of U.S. antitrust law is the maximization of consumer welfare, while the EC protects competition by protecting competitors.").

98 EU Competition Commissioner Mario Monti handed over his job to his successor, Neelie Kroes, at the end of October 2004. James Kanter, *EU, Coke Nearing Antitrust Pact To Give Rivals More Shelf Space*, WALL ST. J., Sept. 7, 2004, at B10 *available at* 2004 WL-WSJ 56939796.

99 John Deq. Briggs & Howard T. Rosenblatt , *GE/Honeywell—Live And Let Die: A Response to Kolasky & Greenfield*, 10 GEO. MASON L. REV. 459, 467 (2002).

100 John Deq. Briggs, Howard Rosenblatt, *A Bundle of Trouble: The Aftermath of GE/Honeywell*, 16 ANTITRUST 26, 26 (2001).

101 George Melloan, *GE-Honeywell Exposes Flaws in Antitrust Policy*, WALL. ST. J., June 26, 2001, at A23, *available at* 2001 WL-WSJ 2867701 (reporting that the main complaints came from competitors and not consumers). In the end, GE decided that it would rather not do this merger if it had to satisfy EU demands to sell off chunks of Honeywell's business. Carol Hymowitz, *IN THE LEAD: Jack Welch Confronts A Difficult Final Act To a Legendary Career*, WALL ST. J., June 19, 2001, at B1, *available at* 2001 WL-WSJ 2867000.

AMD petitioned the California court under Section 1782 of the Judicial Code, which allows the court to order discovery from a person within its jurisdiction for use in a foreign proceeding.[102] Entitled "Assistance to foreign and international tribunals and to litigants before such tribunals," section 1782 provides in pertinent part "[t]he district court of the district in which a person resides or is found may order him to give his testimony or statement or to produce a document or other thing for use in a proceeding in a foreign or international tribunal."[103]

Since 1855, federal law has permitted judicial assistance to foreign courts. At first such assistance was somewhat restrictive, but the 1964 amendments to section 1782 greatly liberalized U.S. procedures for obtaining documentary evidence in the United States. Drafted by the United States Commission on International Rules of Judicial Procedure, the amendments primarily (1) expanded the class of litigation by substituting the word "tribunal" for the word "court" and by adding international tribunals, (2) allowed private litigants to initiate the process, and (3) deleted the requirement that the foreign litigation actually be pending.[104]

However, the first requirement of section 1782 is that there is a "proceeding in a foreign or international tribunal." Undoubtedly, a traditional lawsuit in some court of law is a "proceeding,"[105] but there is doubt as to whether an inquiry conducted by an administrative body is a "proceeding."[106]

D. The Ninth Circuit's View

In simple terms, the District Court held that AMD's complaint before the DG was not a proceeding under section 1782. The Ninth Circuit disagreed and held that any proceeding that is "related to a quasi-judicial or judicial proceeding" qualifies under section 1782, stating that the "investigation being conducted by [EC's] Directorate is related to a quasi-judicial or judicial proceeding." Therefore, "AMD has the right to petition the EC to stop what it believes is conduct that violates the EC Treaty, to present evidence it believes support its allegations, to have the EC evaluate what it presents and to have the resulting action (or inaction) reviewed by the European courts." According to the Ninth Circuit, section 1782 is "intended to be read broadly to include quasi-judicial and administrative bodies and foreign investigating magistrates."[107]

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[102] Borgers, *supra* note 89, at 323-24.

[103] Assistance to Foreign and International Tribunals and to Litigants Before Such Tribunals 28 U.S.C. § 1782(a) (1996).

[104] *See* Application of Gianoli Aldunate, 3 F.3d 54, 57 (2d Cir. 1993).

[105] *See* John Fellas, *Obtaining Evidence Located in the U.S. for Use in Foreign Litigation: 28 USC §1782*, 688 PLI/LIT 63, 83 (2003) (stating that the word "tribunal" was substituted for "court" in the 1964 amendments in order to "make it clear that assistance is not confined to proceedings before conventional courts") (citing S. Rep. 88-1580, 1964 USCCAN at 3788.)

[106] Edward A. Klein, *Recent Court Decisions have Addressed the Uncertainties in the Federal Statute Permitting Foreign Discovery in the United States*, 26 L.A. LAW. 24, 26 (2003) ("However, it is less clear whether inquiries conducted by administrative bodies and other similar proceedings fall within the terms of the statute.").

[107] *Id.* (citing In re Letters Rogatory from Tokyo Dist. Prosecutor's Office, 16 F. 3d 1016, 1019 (9th Cir. 1994)).

In its amicus brief to the Supreme Court in support of Intel,[108] the EC stated that the "Ninth Circuit's holding fundamentally misconstrues the nature of the European Commission."[109] According to the EC, "Tribunals decide the merits of one party's claim against another. The Commission . . . never adjudicates disputes between parties."[110] Furthermore, "it does not adjudicate the rights of parties, as a tribunal would do. The parties to a complaint cannot be considered 'litigants' before a 'tribunal.'"[111] The EC pointed out that "[t]he Court of First Instance exercises judicial review of Commission decisions in the field of EC competition law, subject to a right of appeal to the Court of Justice on points of law."[112]

To ensure that the United States Supreme Court would not misapprehend how strongly the EC felt about this matter, the EC used unvarnished language to state flatly: "This is a very serious matter. If the United States court's conclusion undermines the effectiveness of the Commission's proceedings, for example through chilling its Leniency Program and complicating the Commission§'s ability to assert the law enforcement privilege, this would be a breach of the principle of international comity."[113]

The amicus brief of the EC seems somewhat overstated for three related reasons. First, the Ninth Circuit carefully analyzed the case law on section 1782 to prepare a foundation for its decision. It also carefully delineated the process followed by the DG to make the case that a DG investigation, albeit preliminary, does in fact lead to quasi-judicial proceedings, and therefore, it qualifies as a "proceeding before a tribunal" within the broad interpretation of section 1782.[114] Second, in the United States, antitrust cases are heard by an impartial judge, but in the EU antitrust proceedings are administrative proceedings conducted by the EC or the antitrust authorities and they may lead to restraint orders and fines.[115] An EC decision with respect to mergers, for example, has "the power of an administrative act, as it is the decision of a national European authority."[116] Third, it has been observed that at least respect to the EU merger review the "EC's Competition Directorate and its Competition Commissioner are effectively inves-

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[108] Brief of the Commission of the European Communities as Amicus Curiae in Support of Petitioner, 2002 WL 32157391, Advanced Micro Devices, Inc. v. Intel Corp., 292 F.3d 664 (9th Cir. 2002), *cert. granted*, 124 S. Ct. 531 (Nov. 10, 2003) (No. 02-0572).

[109] *Id.*

[110] *Id.*

[111] *Id.*

[112] *Id.*

[113] *Id.*

[114] Intel I, 292 F.3d at 666-67.

[115] Lucio Lanucara, *The Globalization of Antitrust Enforcement: Governance Issues and Legal Responses*, 9 IND. J. GLOBAL LEGAL STUD. 433, 453-54 (2002).

[116] Stefan Schmitz, *How Dare They? European Merger Control and the European Commission's Blocking Of The General Electric/Honeywell Merger*, 23 U. PA. J. INT'L ECON. L. 325, 352-53 (2002).

tigator, prosecutor, and judge in merger investigations and that due process checks and balances are inadequate."[117]

E. The U.S. Supreme Court's View[118]

The main holding of the Court in *Intel* is that there is no foreign discoverability requirement for section 1782 discovery.[119] Specifically, section 1782(a) "authorizes, but does not require, a federal district court to provide assistance to a complainant in a European Commission proceeding that leads to a dispositive ruling, *i.e.,* a final administrative action both responsive to the complaint and reviewable in court."[120] However, under section 1782, an applicant must show: "(1) that the person from whom discovery is sought reside (or be found) in the district of the district court to which the application is made, (2) that the discovery be for use in a proceeding before a foreign tribunal, and (3) that the application be made by a foreign or international tribunal or 'any interested person.'"[121]

In so holding, the Court in *Intel* systematically defined the limits of a court's section 1782 discretion.[122] The Court:

Rejected that an "interested person" means only litigants, foreign sovereigns, and a sovereign's designated agents,[123] stating "[t]he text of [section] 1782(a), 'upon the application of any interested person,' plainly reaches beyond the universe of persons designated 'litigant.'"[124]

Declared, contrary to the pleas of the EC,[125] that the EC is a "tribunal" within the meaning of section 1782 when it acts as a first-instance decision-maker,[126] reasoning that "AMD could 'use' evidence in the reviewing courts only by submitting it to the [EC] in the current, investigative stage."[127]

Opined that the proceeding for which discovery is sought need not be imminent or pending,[128] holding that section 1782(a) "requires only that a dispositive

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[117] Janet L. McDavid, *Proposed Reform of the EU Merger Regulation: A U.S. Perspective*, 17-FALL ANTITRUST 52, 52 (2002); Terry Calvani, *International Enforcement of Vertical Issues*, SJ075 ALI-ABA 207, 224 (2004) ("Hell would freeze over before Congress gave the FTC such powers, and they might be unconstitutional if they did.").

[118] *See* Gregory P. Joseph, *International Discovery*, 26 Nat'l L. J. 48 (2004) *available on Westlaw at* 8/2/04 NLJ 12, (col. 1) (discussing Intel II succinctly but completely).

[119] Schmitz v. Bernstein Liebhard & Lifshitz, LLP, 376 F.3d 79, 84 (2d Cir. 2004).

[120] Intel II, 124 S. Ct. at 2478.

[121] In re Application of Guy, 2004 WL 1857580, at *1 (S.D.N.Y. Aug. 19, 2004) (slip opinion) (citing Schmitz v. Bernstein Liebhard & Lifshitz, LLP, 376 F.3d 79 (2d Cir. 2004) and applying Intel II).

[122] Schmitz, 376 F.3d at 84.

[123] Wright & Miller Supplemental Service, *Foreign Discovery*, 8 FED. PRAC. & PROC. CIV.2d § 2005.1 (2004).

[124] Intel II, 124 S. Ct. at 2478.

[125] Brief of the Commission of the European Communities, *supra* note 108.

[126] Wright & Miller Supplemental Service, *supra* note 123.

[127] Intel II, 124 S. Ct. at 2479.

[128] Andrews Antitrust Litig. Reporter, *High Court Green-Lights Computer Chip Maker's Discovery Request*, 12 No. 4 ANDREWS ANTITRUST LITIG. REP. 10 (2004) [hereinafter "Andrews Antitrust Litg. Reporter, High Court"].

ruling by the Commission, reviewable by the European courts, be within reasonable contemplation."[129]

Reasoned that the information need not be discoverable under the law of the foreign jurisdiction,[130] observing that "[b]eyond shielding material safeguarded by an applicable privilege, . . . nothing in the text of [section] 1782 limits a district court's production-order authority to materials that could be discovered in the foreign jurisdiction if the materials were located there."[131]

The Court also brushed aside policy arguments made by Intel involving comity and parity.[132] With reference to parity, the Court made the commonsense observation that "[w]hen information is sought by an 'interested person,' a district court could condition relief upon that person's reciprocal exchange of information."[133] With reference to comity, it merely stated that "[w]e question whether foreign governments would in fact be offended by a domestic prescription permitting, but not requiring, judicial assistance."[134] However, in his dissent Mr. Justice Breyer observed that the EC is "entitled to deference." Citing to *Empagran*,[135] he concluded that "[i]n so ignoring the [EC], the majority undermines the comity interests [section] 1782 was designed to serve and disregards the maxim that we construe statutes so as to 'hel[p] the potentially conflicting laws of different nations work together in harmony. . . .'"[136]

In conclusion, the Court reiterated that "a district court is not required to grant a [section] 1782(a) discovery application simply because it has the authority to do so."[137] In this regard, "a court presented with a [section] 1782(a) request may take into account the nature of the foreign tribunal, the character of the foreign proceedings underway, and the receptivity of the foreign government or the court or agency to U.S. federal-court judicial assistance."[138] With this, the Court decided to allow "courts below to assure an airing adequate to determine what, if any, assistance is appropriate."[139]

IV. Lower Courts Apply the Rules of *Empagran* and *Intel*

Within weeks of the Court's decisions, trial courts and courts of appeal applied the rules of *Empagran* and *Intel* to decide cases before them. There are not many

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129 Intel II, 124 S. Ct. at 2480.

130 Andrews Antitrust Litig. Reporter, High Court, *supra* note 128.

131 Intel II, 124 S. Ct. at 2480.

132 *Id.* at 2481.

133 *Id.* at 2482

134 *Id.* at 2481

135 Empagran II, 124 S. Ct. at 2366 ("[This rule of statutory construction] thereby helps the potentially conflicting laws of different nations work together in harmony—a harmony particularly needed in today's highly interdependent commercial world.").

136 Intel II, 124 S. Ct. at 2487 (Breyer, J., dissenting).

137 *Id.* at 2482-83.

138 *Id.* at 2483.

139 *Id.* at 2484. The court below denied AMD's application for discovery "in full." *See* Advanced Micro Devices v. Intel Corp., 2004 WL 2282320, at *2 (N.D.Cal. Oct. 4, 2004).

cases, but those cases that have been decided provide an early indication of how lower courts apply the rules of *Empagran* and *Intel* to resolve international antitrust issues. This section takes a closer look at such cases.

The Court also addressed comity in *Empagran* and *Intel*. Comity is a doctrine that takes into account "foreign interests, the interests of the United States, and the mutual interests of all nations in a smoothly functioning international legal regime."[140] In *Empagran*, the Court emphasized the importance of comity, but in *Intel*, it minimized its importance. This section also takes a closer look at comity in *Empagran* and *Intel* and concludes that neither decision modified the Court's narrow rule of comity announced in *Hartford Fire Insurance v. California* ("Hartford Fire Insurance").[141]

A. Applying the Rule of *Empagran*

The rule of *Empagran* is that "where the defendant's conduct affects both domestic and foreign commerce, but the plaintiff's injury arises only from the conduct's foreign effect and not its domestic effect, the plaintiff's injury is independent from the domestic effect and the court has no jurisdiction."[142] Three cases, thus far, apply the rule of *Empagran*. In one case, the court dismissed the complaint because the plaintiff's injury stemmed from foreign conduct. In a second case, the court remanded it to the trial court for the purpose of discovery. In a third case, the court found that the plaintiff had stated a claim because the injury was not independent of the domestic conduct.

The Second Circuit in *Sniado* affirmed the District Court's dismissal of Sniado's complaint for lack of subject matter jurisdiction.[143] His original complaint alleged an injury from excessive currency exchange fees; the injury, though, occurred in Europe and stemmed from a price-fixing conspiracy between European banks.[144] Hence, Sniado's injury arose only from the conduct's foreign effect; consequently, the District Court in this case rightly decided that it had no jurisdiction.[145]

Sniado amended his complaint, alleging that his injury in Europe was somehow dependent (not independent) of the conspiracy's effect on United States commerce,[146] thereby hoping to bring his claim within the ambit of the *Empagran* rule. The Second Circuit brushed aside this argument on the merits, stat-

[140] Comity Société Nationale Industrielle Aérospatiale v. District Court, 482 U.S. 522, 555 (Blackmun, J., concurring in part and dissenting in part) (discussing a "tripartite" analysis).

[141] Hartford Fire Ins. Co. v. California, 509 U.S. 764 (1993).

[142] MM Global Serv. v. Dow Chem., 329 F. Supp. 2d 337, 341-42 (D.Conn. 2004) (citing Empagran II, 124 S. Ct. at 2363).

[143] Sniado v. Bank Austria AG, 378 F.3d 210, 213 (2d Cir. 2004) (stating that "the amended complaint is facially insufficient to establish jurisdiction").

[144] *Id.* at 212.

[145] *Id.*

[146] *Id.* at 213.

ing that "such an inference, even if reasonable, is too conclusory to avert dismissal."[147] It also declined to remand the case for discovery.

In contrast, the Third Circuit did remand a case for the purpose of discovery. *BHP New Zealand* involved allegations of a conspiracy "to artificially inflate graphite electrode prices by establishing a global cartel that fixed prices."[148] The court, *inter alia*, remanded this case to the trial court to "give the parties the opportunity to present evidence as to whether the alleged anticompetitive conduct's domestic effects were linked to the alleged foreign harm."[149] To state a claim under the rule of *Empagran*, plaintiffs must make a "preliminary showing . . . that the prices they paid for graphite electrodes were linked to, and not 'independent' from, the raising of prices in the United States by defendants' alleged global price-fixing cartel."[150]

A third case following *Empagran* involved an allegation that Union Carbide and Dow compelled the plaintiffs to engage in a price maintenance conspiracy with respect to the resale of Union Carbide products in India.[151] It is a complicated antitrust case that began in Bhopal, India, when lethal gas escaped from a chemical plant affiliated with Union Carbide, causing the death of 3,800 persons and injuries to an additional 200,000.[152] The trial court stated that "jurisdiction is authorized under the FTAIA only when the plaintiff has alleged that the defendants' conduct affected U.S. commerce and that the effect gave rise to the plaintiff's injury."[153] Applying this rule of *Empagran*, the trial court found that the "complaint properly alleges that the defendants' conduct had an effect on competition in and from the United States and the plaintiffs were injured as a result of that effect."[154]

In sum, these cases illustrate that courts will now exercise jurisdiction where the domestic effects of anticompetitive conduct are linked to the foreign harm. However, the rule of *Empagran* is not explicit about when a plaintiff's injury is independent from the domestic effect and when it is not. Hence, in the years ahead, the phrase "independent from the domestic effect," may prove to be as ambiguous to the courts as was the phrase, "gives rise to a claim."[155]

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147 *Id.*

148 BHP N.Z. v. Ucar Int'l, 2004 WL 1771436, at *1 (3d Cir. Aug. 9, 2004) (slip opinion).

149 *Id.* at *2.

150 *Id.*

151 MM Global Serv. v. Dow Chem., 329 F. Supp. 2d 337, 340 (D.Conn. 2004).

152 *Id.* at 339.

153 *Id.* at 341.

154 *Id.* at 342.

155 In this regard, it should be interesting to follow developments in *MM Global Services*, *supra* note 142, because this case (1) may be more about the law of contracts than antitrust; (2) may involve conduct that FTAIA intended to shield; and (3) may involve conduct that falls within the ambit of the *Colgate Doctrine*, which provides in pertinent part that a manufacturer can announce the prices it wants its dealers to charge and then refuse to sell to dealers who fail to adhere to those prices. United States v. Colgate & Co., 250 U.S. 300, 307 (1919).

B. Applying the Rule of *Intel*

The rule of *Intel* is that there is no foreign discoverability requirement. "[Section] 1782 (a) authorizes, but does not require, a federal district court to provide judicial assistance to foreign or international tribunals or to 'interested person[s]' in proceedings abroad."[156] Moreover, "a court presented with a [section] 1782(a) request may take into account the nature of the foreign tribunal, the character of the proceedings underway abroad, and the receptivity of the foreign government or the court or the agency abroad to federal-court judicial assistance."[157] Two cases, thus far, apply the rule of *Intel.* In one case, the court denied a request, in part, because the "German government was obviously unreceptive to the judicial assistance of an American federal court."[158] In another case, the court granted the request, because there was no "reason to suppose that the government of the United Kingdom would disfavor granting Applicants relief under [section] 1782."[159]

Schmitz involved a civil action in Germany.[160] The action of the petitioners in Germany alleged that the respondent Deutsche Telekom AG misled investors when it overstated the value of real estate assets. Concurrently, the Public Prosecutor in Bonn, Germany was conducting a criminal investigation of similar allegations against former Deutsche Telekom employees.[161] The District Court denied the request of petitioners for aid under section 1782(a), and the Second Circuit affirmed that decision.[162]

The District Court reasoned that "although petitioners had met the statutory requirements of [section] 1782, granting discovery in this case would run counter to the statute's aims of assisting foreign courts and litigants and encouraging foreign jurisdictions to provide reciprocal assistance to American courts."[163] Letters from the Bonn Prosecutor and the German Ministry of Justice opposed section 1782(a) aid, because "production to petitioners at this time would compromise the ongoing criminal investigation in Germany and violate the rights of potential criminal defendants there."[164] In addition, the State Secretary of the German Federal Ministry of Justice added that "[t]he Federal Government [of Germany] would respectfully like to submit that disclosure of the documents concerned may jeopardize German sovereign rights."[165]

Applying the rule of *Intel*, the Second Circuit found that the District Court had not abused its discretion in denying section 1782(a) aid. The court observed that

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156 Intel II, 124 S. Ct. at 2473.

157 *Id.* at 2483.

158 Schmitz v. Bernstein Liebhard & Lifshitz, LLP , 376 F.3d 79, 84 (2d Cir. 2004).

159 In re Application of Guy, 2004 WL 1857580, at *2 (S.D.N.Y. Aug. 19, 2004).

160 Schmitz, 376 F.3d at 81.

161 *Id.*

162 *Id.* at 85 ("Because we find no abuse of discretion, we affirm the judgment of the district court denying petitioners' request for discovery.").

163 *Id.* at 81.

164 *Id.* at 81-82.

165 *Id.* at 82 (citing a letter from State Secretary of the German Federal Ministry of Justice).

"the German government was obviously unreceptive to the judicial assistance of an American federal court."[166] In this context, the District Court concluded and the Second Circuit agreed that granting the request of petitioners would not promote the aims of section 1782. Granting such aid "would in fact encourage foreign countries to potentially disregard the sovereignty concerns of the United States and generally discourage future assistance to our courts."[167]

In contrast, the trial court in *In re application of Guy* granted section 1782(a) aid, largely on the grounds that there was no "reason to suppose that the government of the United Kingdom would disfavor granting Applicants relief under [section] 1782,"[168] and there was no "persuasive reason not to exercise its discretion in favor of allowing discovery to Applicants."[169]

In this case, applicants were residents of England and members of an accounting firm who had been appointed as administrators of the estate of a person who had died intestate.[170] The decedent had been in the antiques business that operated as a partnership and transacted business in the U.S.[171] The applicant-accounting firm simply wanted "to gather, preserve, account for, and distribute the estate of their decedent."[172] In this regard, it sought discovery aid with reference to transactions with nonparties in the U.S. Applying the rule of *Intel* the court had no difficulty granting this application, stating that "[r]espondents are not parties to the English Action, but that in no way exempts them from [section] 1782, which, the Supreme Court has pointed out, may be the only way in a foreign proceeding to obtain information from third-party witnesses in the United States."[173]

Finally, the Commission of European Communities ("Commission") argued, *inter alia*, that "characterizing the Commission as a 'tribunal' poses serious threats to its anti-cartel Leniency Program by jeopardizing the Commission's ability to maintain the confidentiality of documents submitted to it."[174] The Leniency Program involves cartel participants who confess their own wrongdoing, presumably, in exchange for lenient treatment.[175]

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166 *Id.* at 84.

167 *Id.* at 85 (citing In re Application of Schmitz, 259 F.Supp.2d 294, 300 (S.D.N.Y.2003)).

168 In re Application of Guy, 2004 WL 1857580 at *2.

169 *Id.* at *3.

170 *Id.* at *1.

171 *Id.*

172 *Id.*

173 *Id.* at *2 (citing Intel II, 124 S. Ct. at 2483).

174 Brief of the Commission of the European Communities as Amicus Curiae Supporting Reversal, 2003 WL 23138389, *4, Advanced Micro Devices, Inc. v. Intel Corporation, 292 F.3d 664 (9th Cir. 2002), *cert. granted*, 124 S. Ct. 531 (Nov. 10, 2003) (No. 02-0572) [hereinafter "Brief of the Commission of the European Communities, Reversal"].

175 "Amnesty and leniency programs are all based on creating sufficient positive incentives for the amnesty/leniency applicant to come forward and expose the cartel." Donald I. Baker, *Revisiting History—What Have We Learned About Private Antitrust Enforcement That We Would Recommend To Others?*, 16 LOY. CONSUMER L. REV. 379, 400 (2004). The European Union adopted its leniency policy in 1996. John Anthony Chavez & Harvey I. Saferstein, *International Cartels And Their Significance To Compliance Programs*, 1311 PLI/CORP 1031, 1039 (2002).

With respect to this program, the Commission opined that if the "Commission were deemed a 'tribunal' in the competition context, it could find itself no longer able to guarantee the confidentiality of those Leniency Program confessions by, *inter alia*, resort to the law enforcement privilege wherever necessary."[176] Whether the decision of the Court in *Intel* will have a chilling effect upon the Commission's Leniency Program is an empirical question, which will be answered in the fullness of time. However, the cases discussed above seem to indicate that federal courts would be attuned to the concerns of the Commission, as they consider section 1782(a) applications that may have implications for the Commission's Leniency Program.

C. Comity Is "A Blend of Courtesy and Expedience"[177]

Both *Empagran* and *Intel* reference comity. The Supreme Court provided a classic definition of comity in 1895:

> "Comity," in the legal sense, is neither a matter of absolute obligation, on the one hand, nor of mere courtesy and good will, upon the other. But it is the recognition which one nation allows within its territory to the legislative, executive, or judicial acts of another nation, having due regard both to international duty and convenience, and to the rights of its own citizens, or of other persons who are under the protection of its laws.[178]

In *Empagran* the Court relied on comity to support its decision, stating that "principles of prescriptive comity counsel against the Court of Appeals' interpretation of the FTAIA."[179] Conversely, in *Intel*, the Court brushed aside the argument of Intel and the Commission that considerations of comity should control the decision. The Court doubted that "foreign governments would be offended by a domestic prescription permitting, but not requiring, judicial assistance."[180] Mr. Justice Breyer—who wrote the Court's opinion in *Empagran* where he relied on comity—dissented in *Intel*, stating that the "majority undermines the comity interests [that] [section] 1782 was designed to serve," when it "disregards the Commission's opinion. . . ."[181]

Taken together, *Empagran* and *Intel* may have sent a mixed message about comity in antitrust. For at least three reasons, though, this "mixed message" (to the extent that one exists) should have no enduring implications for the Court's main rule of comity stated in *Hartford Fire Insurance*. First, the Court relied on comity in *Empagran* in connection with its application of a rule of construction

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[176] Brief of the Commission of the European Communities, Reversal, *supra* note 174, at *15.

[177] Canadian Filters (Harwich) Ltd. v. Lear-Siegler, Inc., 412 F.2d 577, 578 (1st Cir.1969); *see also* In re Maxwell Communication, 93 F.3d 1036, 1048 (2d Cir. 1996) (discussing legal standard associated with international comity).

[178] Hilton v. Guyot, 159 U.S. 113, 164 (1895).

[179] Empagran II, 124 S. Ct. at 2369.

[180] Intel II, 124 S. Ct. at 2481.

[181] *Id.* at 2487 (Breyer, J., dissenting) (quoting Empagran II, 124 S. Ct. at 2366).

for ambiguous legislation.[182] That rule provides "legislation of Congress, unless a contrary intent appears, is meant to apply only within the territorial jurisdiction of the United States."[183] Consistent with this rule and mindful of comity, the Court concluded that Congress did not intend to impose America's antitrust laws on the world.[184]

Second, as between the U.S. and Europe, there has been a narrowing of their consideration of international comity in antitrust matters.[185] Notwithstanding federal government guidelines providing that the Department of Justice and the FTC will consider international comity in enforcing the antitrust laws,[186] at this point, neither the U.S. nor Europe favor applying the principles of comity in antitrust law.[187]

Third, there has been a narrowing of comity consideration, in part, because the Supreme Court has actually "gutted" the doctrine of comity of "virtually all of its vitality" in its decision in *Hartford Fire Insurance*.[188] In *Hartford Fire Insurance*, the Court permitted extraterritorial extension of the Sherman Act in a case involving alleged violations of several foreign re-insurers, accused of conspiring with domestic insurers "to influence the availability of certain coverages in the American commercial insurance market."[189] In its holding, "the Supreme Court made clear . . . that no conflict exists for purposes of an international comity analysis in the courts if the person subject to regulation by two states can comply with the laws of both."[190] Hence, the "Court narrowed the comity inquiry to the sole question of whether U.S. law prohibits what foreign law requires."[191] This narrow rule necessarily limits a trial court's considerations of comity in deciding

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182 Telephone interview with Spencer Weber Waller, Professor of Law, Loyola University Chicago School of Law (Sept. 14, 2004).

183 EEOC v. Arabian Am. Oil Co., 499 U.S. 244, 248 (1991) (quoting Foley Bros., Inc. v. Filardo, 336 U.S. 281, 285 (1949)).

184 Empagran II, 124 S. Ct. at 2369.

185 William Sugden, *Global Antitrust And The Evolution Of An International Standard*, 35 VAND. J. TRANSNAT'L L. 989, 1015 (2002).

186 DOJ & FTC, Antitrust Enforcement Guidelines for International Operations, 3.2 Comity, April 1995, *available at* http://www.usdoj.gov/atr/public/guidelines/internat.htm.

187 Yeo Jin Chun, *The GE-Honeywell Merger Debacle: The Enforcement Of Antitrust/Competition Laws Across The Atlantic Pond*, 15 N.Y. INT'L L. REV. 61, 69 (2002) ("Both legal regimes do not favor applying the principles of comity in antitrust law."); *see also* Julian Epstein, *The Other Side Of Harmony: Can Trade And Competition Laws Work Together In The International Marketplace?*, 17 AM. U. INT'L L. REV. 343, 347-49 (2002) (discussing the history of comity).

188 Spencer Weber Waller, *Suing OPEC*, 64 U. PITT. L. REV. 105, 134-43 (2002) (discussing the "The Gutting of Comity"); *see also* Brian Peck, *Extraterritorial Application Of Antitrust Laws And The U.S.-EU Dispute Over The Boeing And McDonnell Douglas Merger: From Comity To Conflict? An Argument For A Binding International Agreement On Antitrust Enforcement And Dispute Resolution*, 35 SAN DIEGO L. REV. 1163, 1183 (1998) ("Several commentators believe that the Hartford Fire decision has "swept away" the concept of comity. . . .").

189 James S. McNeill, *Extraterritorial Antitrust Jurisdiction: Continuing The Confusion In Policy, Law, And Jurisdiction*, 28 CAL. W. INT'L L.J. 425, 426 (1998).

190 DOJ & FTC, *supra* note 186.

191 Salil K. Mehra, *Extraterritorial Antitrust Enforcement And The Myth Of International Consensus*, 10 DUKE J. COMP. & INT'L L. 191, 193 (1999).

whether to exercise its jurisdiction.[192] Neither *Empagran* nor *Intel* has any effect on this narrow rule.

IV. Conclusion: "It's Tough to Make Predictions, Especially About the Future."[193]

The convergence of competition policy is important to foster free trade, to investigate and prosecute global cartels, to regulate companies international in scope, and to eliminate duplicate and conflicting policies and procedures.[194] The EC's decision to block the merger of General Electric Co. and Honeywell International Inc. underscores the importance of convergence.[195]

Arguably, both *Empagran* and *Intel* facilitated the convergence of competition policy. First, *Empagran* reinforced the long-standing rule that conduct must have a domestic effect.[196] Otherwise, a federal court cannot exercise jurisdiction. This sends a signal once again to the international community that the federal courts are not open to anyone who has an antitrust claim somewhere in the world. In the long run, this should encourage the international community to work together to develop more global competition policies and mechanisms to enforce those policies. Second, *Intel* established that federal courts have the discretion to facilitate the discovery process in international proceedings. In the long run, this should enhance the capacity of parties in the international arena to obtain documents and pursue antitrust claims in their own courts or in multilateral tribunals.

Although *Empagran* and *Intel* will make contributions to the convergence of international competition policy, they may also have troublesome consequences. Both decisions give trial courts tremendous discretion to answer tough questions. With respect to *Empagran*, trial courts will likely be enmeshed like a cat in yarn deciding whether the domestic effect is independent of the foreign effect. Whatever a trial court decides, the case will surely be appealed. Soon, there may be a split in the Circuits regarding the substantive meaning of "independent." The Court will then have to revisit FTAIA and explain the meaning of the *Empagran* phrase, "independent of any adverse domestic effect."[197]

Similarly, *Intel* provides trial courts wide discretion in granting section 1782(a) aid: "[t]he statute authorizes, but does not require, a federal district court to provide assistance to a complainant. . . ."[198] In reaching their decisions, trial

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[192] Robert C. Reuland, *Hartford Fire Insurance Co., Comity, and the Extraterritorial Reach of United States Antitrust Laws*, 29 TEX. INT'L L.J. 159, 161 (1994).

[193] *See* William E. Lee, *Facts, Assumptions and American Pie*, 2000 L. REV. MICH. ST. U. DET. C.L. 239, 252 n.61 (2000) (quoting Yogi Berra).

[194] Anu Piilola, *Assessing Theories Of Global Governance: A Case Study Of International Antitrust Regulation*, 39 STAN. J. INT'L L. 207, 225 (2003) (discussing reasons for seeking convergence).

[195] Deborah A. Garza, *Transatlantic Antitrust: Convergence Or Divergence*, 16 ANTITRUST 5, 5 (2001).

[196] *See, e.g.*, Hartford Fire Ins. Co. v. California, 509 U.S. 764, 796 (1993) (holding that it is "well established by now that the Sherman Act applies to foreign conduct that was meant to produce and did in fact produce some substantial effect in the United States").

[197] Empagran II, 124 S. Ct. at 2366.

[198] Intel II, 124 S. Ct. at 2478.

courts will have to balance multiple considerations including questions of comity. Precisely how they will do this is uncertain. In the context of extraterritorial jurisdiction in antitrust cases, for example, the Court eventually rejected a balancing test[199] and announced a narrow, bright-line rule related to considerations of comity.[200] At some point, the Court may have to revisit its holding in *Intel* and narrow the discretion of trial courts to achieve more reliable, i.e. predictable, results under section 1782.

The rules of *Empagran* and *Intel* will advance long-term convergence in international antitrust. In the years ahead, they will be modified or supplemented in some way, simply because Supreme Court decisions of this type often answer some questions while simultaneously posing others. The Court, after all, is merely final, not infallible.[201] For now, however, the rules of *Empagran* and *Intel* provide lower courts conceptual tools to resolve tough questions in international antitrust, sure to come their way. How they use them should be fascinating to behold![202]

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[199] Minodora D. Vancea, *Exporting U.S. Corporate Governance Standards Through The Sarbanes-Oxley Act: Unilateralism Or Cooperation?*, 53 DUKE L.J. 833, 860 (2003).

[200] *See* Spencer Weber Waller, *The United States As Antitrust Courtroom To The World: Jurisdiction And Standing Issues In Transnational Litigation*, 14 LOY. CONSUMER L. REV. 523, 526-28 (discussing Hartford Fire Ins. Co. v. California., 509 U.S. 764 (1993)).

[201] Brown v. Allen, 344 U.S. 443, 540 (1953) ("We are not final because we are infallible, but we are infallible only because we are final.").

[202] Waller, *supra* note 200, at 528 ("Sometimes you have the lower courts engaged in what law professors have called guerilla warfare, where you have a rule that the Supreme Court enunciates that just doesn't take for some reason.").

HEARTBREAK IN DARFUR: WHEN DOES GENOCIDE BECOME GENOCIDE?

Konjit Gomar*

For more than a year now, the mass killings of black African civilians by pro-government, Arabized[1] militias known as the Janjaweed have plagued the western region of the Sudan.[2] Hostilities between the region's black peasant farmers and Arabized nomads have existed for decades as the two groups have long grappled with one another for control of the country's Darfur region.[3] However, the situation boiled over in or around February 2003 after two rebel groups, the Sudan Liberation Army/Movement and the Justice and Equality Movement began attacking government property in an attempt to end what they consider the economic and political suppression of Sudan's black African populations in favor of their pro-government, Arabized brethren.[4] Comprised of tribesmen belonging to

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[1] The author would like to note the racial similarities between the peoples involved in the present conflict. Undoubtedly African in racial make-up, the Sudanese people nevertheless insist on distinguishing themselves from one another with the use of the racial labels "black African" and "Arab." Such labels reflect the political history of Sudan's western region. *See* Reports: Peoples Darfur, *at* http://www.sudanupdate.org/REPORTS/PEOPLES/Darf.htm (last visited Aug. 24, 2004) (Similar in size to France, "Darfur was an independent sultanate until 1917, when it was the last region to be incorporated into the Anglo-Egyptian Sudan. The Arabic word Dar roughly means homeland, and its population of nearly four million is divided into several Dars; not only of the Fur people, as its name suggests, but also of several communities, determined by livelihood as much as ethnicity. These ecological and social distinctions are more meaningful then the administrative divisions imposed by government. Ethnicity is not itself clear-cut, given the long history of racial mixing between the indigenous "non-Arab" peoples and the "Arabs", who are now distinguished by cultural-linguistic attachment rather than race.").

[2] *See Q & A: Sudan's Darfur Conflict,* BBC NEWS UK Edition (2004) *at* http://news.bbc.co.uk/1/hi/world/africa/3496731.stm (last visited Oct. 19, 2004). [hereinafter BBC Q & A].

[3] Crippled by drought and desertifiction, Darfur has long been one of the most improvished regions in the Sudan. The evergrowing scarcity of arable lands has inspired inter-group hostilities between black peasant farmers and Arabized nomads. These hostilities were originally slight with low casuality numbers on both sides. However, as more automatic weapons entered the region from neighboring Chad, inter-group conflicts became more devestating at times resulting in the slaughter and destruction of entire communities. But it would be a mistake to characterize these conflicts as incidents resting solely upon a contest involving land. In addition to the struggle over Darfur's remaining natural resources there exist controversies touching upon political power, lifestyle and culture. Frustrated with their lack of representation in local politics, Arabized nomads—who make up a minority of the population— have fiercely fought (some say with Khartoum's support) to not only achieve representation but to also completely usurp political power from non-Arabized Darfurians. *See* Human Rights Watch, *Darfur in Flames: Atrocities in Western Sudan* Vol. 16, No.5(A),40-42 (Apr. 2004), *available at* http://hrw.org/reports/2004/sudan0404/index.htm (last visited Oct. 19, 2004) [hereinafter *Darfur in Flames*]; *See also* Human Rights Watch, *Darfur civil Conflict 1989-1990, at* http://www.globalsecurity.org/military/world/ para/darfur2.htm (last modified June 25, 2004); *See also* Human Rights Watch, *Darfur Liberation Front at* http://www.globalsecurity.org/military/world/para/darfur.htm (last modified September 5, 2004) [hereinafter Liberation Front].

[4] *See* Liberation Front *supra* note 3. Though many Darfurians are practicing Muslims, over forty percent are non-Arabs. *Id.* Even among those who practice Islam, many are against Sudan's arbabized

Darfur's Fur, Masalit, and Zaghawa ethnic groups, the rebels also sought protection from the Janjeweed who have a history of traversing the affected areas on horse back in armed militia groups.[5]

Sudan is accused of responding to the rebel attacks by further arming the Arab Janjaweed militia and giving it license to engage in a "scorched earth policy" which has entailed the systematic killings of unarmed civilians, the mass kidnapping and rape of young girls and women, and the looting of villages and farms which are subsequently burned to the ground.[6] Many survivors report that the Janjaweed used racial epithets during these attacks.[7] Although the Sudanese government has denied backing the Janjaweed[8], civilians who have escaped the onslaught report that government helicopters and planes usher in the Janjaweed militia with air raids and bombings of villages.[9] As a result, causality numbers are estimated between fifteen and fifty thousand and more than a million persons have been displaced as they seek refuge along the Chadian border.[10] But even there they are apparently not safe, as refugees have reported repeated Janjaweed attacks along the peripheries of the displacement camps.[11]

There would seem to be little reason—even if allowed—to return home. Most Darfurians are subsistence farmers, their very survival dependent upon activities initiated during the planting season.[12] The systematic destruction of farms and villages coupled with the fear of future attacks has more or less halted all planting activities, thereby dashing any hope of a successful October harvest.[13] Hu-

government accusing it of refusing to share economic and political power with the people of Darfur. *Id.* They furthermore accuse Sudan's government of turning a blind eye to Janjeweed abuses as a means to futher "Arabize" the Darfurians and maintain power in the region. *Id. See The Black Book History of Darfur's Darkest Chapter*, Sudan Tribune (Aug. 21, 2004) *at* http://www.sudantribune.com/article_impr.php3?id_article=4868 (last visited Nov. 22, 2004).

[5] Human Rights Watch, *DARFUR DESTROYED Ethnic Cleansing by Government and Militia Forces in Western Sudan* Vol. 16, No. 6(A) (May 2004), *at* http://www.hrw.org/reports/2004/sudan0504/ (last visited Oct. 19, 2004) [hereinafter *DARFUR DESTROYED*]

[6] *Id.*

[7] Marc Lacey, *U.S. Report on Violence in Sudan Finds a 'Pattern of Atrocities'*, N.Y.TIMES, August 24, 2004, *available at* http://www.nytimes.com/2004/08/25/international/africa/25darfur.html (last visited August 27, 2004). (In July 2004 the U.S. State Department conducted 257 interviews in displacement camps along the Chadian border. *Id.* The interviews were conducted to determine the truth behind claims the Sudanese government was engaged in a genocidal campaign against ethnic Darfurians. *Id.* Almost 50 percent of the refugees interviewed told of how they were attacked by government soliders and the Janjaweed. *Id.* Many also accused governement soliders and the Janjaweed of using racial epithets during these attacks including the phrases "Kill the slaves" and "We have orders to kill all blacks." The terms "slave" and "black" are pejorative terms leveled against non-Arab Darfurians and those belonging to the farming class.) .

[8] Koert Lindijer, *Analysis: Reigning in the Militia*, BBC NEWS UK Edition *at* http://news.bbc.co.uk/ /1/hi/world/africa/3540126.stm (last visited Oct. 19, 2004).

[9] *DARFUR DESTROYED, supra* note 5.

[10] BBC Q & A, *supra* note 2.

[11] *See* Alexis Masciarelli & Ilona Eveleens, *Sudanese Tell of Mass Rape*, BBC NEWS UK Edition *at* http://news.bbc.co.uk/1/hi/world/africa/3791713.stm (last visited Oct. 19, 2004). (Details plights of Sudanese women in their villages during an attack by the Janjaweed.)

[12] *See Darfur in Flames, supra* note 3.

[13] Id. *See also* Lindijer, *supra* note 8. There are also reports that after Janjaweed militia succeeded in running fthe farmers off their lands, the families of Janjaweed members moved in. *Id.* .

manitarian agencies have already noted severe malnutrition among the children within the displacement camps.[14] The lack of clean water has also contributed to a high mortality rate among children from curable diseases such as diarrhea.[15] Due to the rough terrain and lack of infrastructure in Darfur, relief agencies are unable to reach many of the displaced settlements.[16] Chadian communities playing host to the refugees also lack the financial resources and food stocks necessary to combat the crisis.[17] In May, the rainy season hit, further complicating matters as the refugees' only means of shelter is often times small structures made of twigs covered with torn plastic bags.[18] And many of the refugees are not even equipped with these.[19]

The great potential for immense human loss as a result of starvation and the spread of infectious diseases prompted the United Nations ("U.N.") in May 2004 to label the situation in Darfur, "the world's worst humanitarian crisis of the year."[20] The U.S. Congress assumed a more pessimistic view pronouncing in July that the conflict in Darfur amounts to "genocide."[21] However, during his trip to the Sudan this past June, US Secretary of State Colin Powell would only concede that there exists "indicators and elements that would start to move you toward a genocidal conclusion but we're not there yet."[22] U.N. Secretary General Kofi Annan has also shied away from applying the term genocide to define

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[14] *Darfur in Flames*, *supra* note 3.

[15] *Aiding Darfur: A Nurse's Story V*, BBC NEWS UK Edition (Oct. 22, 2004) *at* http://news.bbc.co.uk/1/hi/world/africa/3946079.stm (last visited Nov. 22, 2004)

[16] *Id.*

[17] *Id.*

[18] Hilary Andersson, *Sudan's Cruel and Slow Starvation*, BBC NEWS UK Edition, (2004), *at* http://news.bbc.co.uk/1/hi/world/africa/3922461.stm (last visited Oct. 19, 2004).

[19] *Id.*

[20] Muninni K. Mulers, *It's Genocide in Darfur*, (Aug. 9, 2004.), *at* http://allafrica.com/stories/200408090532.html.

[21] *US House call Darfur 'genocide,'* BBC NEWS UK Edition, July 23, 2004, *at* http://www.bbc.co.uk/1/hi/world/africa/3918765.stm; *see also Sudan Says Conflict is 'Not Genocide,'* CNN World, July 24, 2004, *at* http://www.cnn.com/2004/WORLD/africa/07/24/sudan [hereinafter *Not Genocide*].

[22] *Sudanese refugees welcome Powell*, BBC NEWS WORLD Edition, (2004), *at* http://news.bbc.co.uk/2/hi/africa/3849593.stm (last visited Oct. 19, 2004). After the U.S. States Department conducted an investigation into claims that genocide was occurring in Darfur, Colin Powell pronounced on September 9, 2004 that he believed the Sudanese government and Janjaweed militias were committing genocide on black African ethnic groups within the region. However, in spite of Powell's assessment outside of threatening economic sanctions and encouraging both sides in the conflict (Sudanese rebel groups and Sudan's central government) to reach a peace accord the international community has done nothing substantial to end the violence. World powers remains divided on whether genocide exists and on how best to address the crisis. Donor organizations have also been slow to provide adequate funds to finace an African Union led peace force in the region. Meanwhile reports of mass killings still flow into media outlets and some humanitarian organizations have pulled out of refugee areas. *See Powell declares genocide in Darfur* BBC NEWS WORLD Edition (Sept. 9, 2004) *at* http://news.bbc.co.uk/2/hi/africa/3641820.stm. ("Use of word genocide does not legally obligate the US to act); *see also* The Crisis in Darfur, U.S. Department of State (Sept. 9, 2004) *at* http://www.state.gov/secretary/rm/36042.htm; *see also Aid Groups Flee New Darfur Fighting*, at CNN WORLD NEWS (Nov. 5, 2004) *at* http://www.cnn.com/2004/WORLD/africa/11/05/sudan.darfur.reut/index.html; *See also Why Washington Won't Save Darfur Villagers*, Sudan Tribune (Oct. 6, 2004) at http://www.sudantribune.com/article.php3?id_article=5837.

the Darfur conflict[23] as have many international human rights groups and member states of the U.N. Security Counsel.[24] Most observers appear to take comfort in labeling the Janjaweed attacks a program of "ethnic cleansing," knowing full well that a cry of genocide would obligate the international community to become militarily involved under the Genocide Convention of 1948.[25] With public and political fallout still raging over the war and continued military presence in Iraq, many nations seem reluctant to become entangled in yet another foreign military campaign. The tightrope Western leaders now walk in their relations with Arab states has no doubt also colored their interpretation and commitment to the Darfur situation.[26]

Although on July 30th the U.N. threatened economic sanctions if the Sudanese government did not disarm the Janjaweed by August 31,[27] many observers argue that even if the Sudanese government wanted to disarm the militia—which many doubt[28]— it is unrealistic to believe that the government can do so within the thirty day time frame handed down by the U.N.[29] Given the numerous reports and accusations concerning the Sudanese government's endorsement of the Janjaweed attacks, many also question how safe the refugees would be upon returning to their villages under the guard of the government's military personnel.[30] As the world's great powers struggle with how best to label and react to the conflict, human lives are still being lost as reports of mass killings continue to flow into media outlets.[31] Whatever one calls it, the debate over how to label the Janjaweed attacks has raised important questions on the meaning of genocide, its occurrence, and what evidence is needed to trigger its application as well as the international community's resolve to crush it.

This Article asserts that the UN's Convention on the Prevention and Punishment of the Crime of Genocide (hereinafter the Convention) is patently flawed. By limiting its application to anti-group atrocities directed at ethnic, racial, national, and religious groups, the Convention's drafters have failed to provide protection to the most vulnerable groups today—political and economic groups. In light of this flaw this Article also asserts that the Convention is essentially impo-

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[23] *Not Genocide, supra* note 21.

[24] *Id.*

[25] Convention on the Prevention and Punishment of the Crime of Genocide, Dec. 9, 1948, 78 U.N.T.S. 277 *available at* http://www.unhchr.ch/html/menu3/b/p_genoci.htm (last visited Oct. 19, 2004) [hereinafter *Genocide Convention*].

[26] *See* Ed O'Keefe and Jeffrey Marcus, *Crisis in Sudan,* washingtonpost.com (Sept. 9, 2004) *at* http://www.washington post.com/ac2/wp-dyn/A20765-2004Jul1?language=printer.

[27] The author is aware that by the time this article is published, the August 31 deadline will have come and past. For historical purposes the date was included. *See Powell declares genocide in Darfur* BBC NEWS WORLD Edition (Sept. 9, 2004) *at* http://news.bbc.co.uk/2/hi/africa/3641820.stm (last visited Nov. 22, 2004).

[28] *See U.N. envoy pessimistic on Sudan,* CNN WORLD (Aug. 11, 2004) *at* http://www.cnn.com/2004/WORLD/Africa/08/11/Sudan/index.html.

[29] Lindijer, *supra* note 8.

[30] *Id.*

[31] *See Thousands Flee New Darfur Clashes,* BBC NEWS WORLD Edition *at* http://news.bbc.co.uk/2/hi/africa/3630582.stm (last visited Oct. 19, 2004).

tent, and must undergo a revision if it is to have any real deterrent effect in the world today.

The Evolution and Interpretation of Genocide

Coined in 1944 by Ralph Lemkin, the term "genocide" is a combination of the ancient Greek word *genos,* which means race or tribe, and the Latin word *cide*, which means killing.[32] For Lemkin "genocide" referred to discriminatory activities directed at targeted national and ethnic groups.[33] He based his definition on the atrocities Germany committed against European Jews during World War II.[34] The term was therefore all encompassing as it signified not only "the immediate destruction of a nation. . .by the mass killings of all members of a nation" but more importantly "a coordinated plan of different actions aiming at the destruction of essential foundations of the life of national groups, with the aim of annihilating the groups themselves."[35] Thus according to Alexander Greenawalt, the confiscation or destruction of a targeted group's cultural property, the forced cultural and religious assimilation of group members, as well as the imposition of "'morally debasing" policies' aimed at eradicating the group's moral habits, all constituted genocidal acts under Lemkin's definition.[36] Members of the targeted group were therefore victimized "not in their individual capacity, but as members of the [targeted] national group."[37]

The U.N. General Assembly ultimately narrowed such a broad definition when it formally adopted the Convention in1948.[38] Borrowing from Lemkin, Article 1 of the Convention pronounced genocide an international crime, "whether committed in time of peace or in time of war," which "[the Contracting Parties] undertake to prevent and punish."[39] Genocide is further defined in Article 2 as:

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[32] Alexander K.A. Greenawalt, Note, *Rethinking Genocidal Intent: The Case For A Knowledge-Based Interpretation,* 99 COLUM. L. REV. 2259, 2270 (1999).

[33] *Id.* at 2270-272.

[34] *Id.* at 2270-272.

[35] *Id.*

[36] *Id.* ("If Lemkin's understanding of genocide is elusive, this may be explained in part by the context in which he was writing. At the time when he published Axis Rule in Occupied Europe, World War II was still in progress and, as a result, the specific policies of the Axis powers were his immediate subject. In this light, his definition reads not so much as an attempt to clearly delineate a form of individual criminal liability, but rather, as an indictment of the Axis Powers' general treatment of the populations that they subjected. In addition, the breadth of Lemkin's concept may be explained in light of the threat he perceived genocide as posing. Lemkin was ultimately less concerned with the evil motivations of genocidal acts themselves than with the preservation of the rich array of nations and cultures that constituted the world community." *Id.* According to Greenawalt, Lemkin's concern with preserving the cultural contributions of human groups was shared by the U.N. General Assembly and was a motivating factor in its adoption of Resolution 96 (1) which formerly pronounced genocide an international crime and required U.N. member states to incorporate in their criminal codes laws aimed at preventing and punishing genocidal acts.) *Id.* at 2272-273.

[37] Greenawalt, *supra* note 32, at 2271.

[38] *Id.*

[39] *Genocide Convention, supra* note 25, Article 1.

> Any of the following acts committed with intent to destroy, in whole or in part, a national, ethnical, racial, or religious group, as such:
> a) killing members of the group;
> b) causing serious bodily or mental harm to members of the group;
> c) deliberately inflicting on the group conditions of life calculated to bring about its physical destruction in whole or in part;
> d) imposing measures intended to prevent births within the group;
> e) forcibly transferring children of the group to another group.[40]

Therefore to properly trigger a finding of genocide there must exists three elements: (1) the destruction or attempted destruction of a human group in whole or in part; (2) the victimization of the group because of its national, racial, ethnical, or religious status; and (3) the specific perpetration of the destructive act(s) as a means to annihilate the targeted group as a group.[41]

Critics have long complained that the Convention's definition of genocide is too narrow and therefore cannot aptly apply to more recent acts of violence directed at targeted human populations.[42] Their dissatisfaction stems in part, from the fact that the definition only makes reference to violence perpetrated against national, ethnical, racial, or religious groups.[43] As a result, they argue, human groups that are attacked because of political affiliation, socio-economic status, or sexuality are left with no legal recourse on the international stage.[44] Critics likewise find it troubling that the Convention's definition provides no number or standard by which to determine how many deaths must occur to properly trigger a genocide finding.[45] Other dissenters insist that the definition should embrace not only the direct physical destruction of members within a targeted group but also the purposeful destruction of that group's cultural and environmental property[46]

By far, the most universal complaint seems to lie with the intent element of the definition. By requiring proof that an alleged perpetrator specifically intended his destructive act(s) to further an underlying campaign of group annihilation, prosecutors are asked to do what is seemingly impossible—determine the mental state of the accused during the commission of the act.[47] Not only does such a

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[40] *Id,* at Article 2.

[41] *See* Sonali B. Shah, Comments, *The Oversight of the Last Great International Institution of the Twentieth Century: The International Criminal Courts Definition of Genocide,* 16 EMORY INT'L. L. REV. 356 (2002).

[42] LEO KUPER, GENOCIDE: ITS POLITICAL USE IN THE TWENTIETH CENTURY 39 (1981) [hereinafter ITS POLITICAL USE].

[43] *See* Shah, *supra* note 41, at 381-90.

[44] *Id.*

[45] *Analysis: Defining Genocide,* BBC NEWS, (2001) *at* http://news.bbc.co.uk/1/hi/world/europe/1701562.stm (last visited Oct. 19, 2004).

[46] *Id. See also* KURT JONASSOHN ET AL., GENOCIDE AND GROSS HUMAN RIGHTS VIOLATIONS 25-6 (Transaction Publishers 1998); *see also* David Marcus, Article, *Famine Crimes in International Law,* 97 A.J.I.L. 245, 262-64 (2003) (arguing that international law should extend to man made famines because "famines are often functionally equivalent to genocide"). *Id.* at 248.

[47] *See generally* Shah, *supra* note 41 at 351; *See also* Greenawalt, *supra* note 32 at 2281-2282.

high standard allow for some alleged perpetrators to possibly escape liability by feigning their acts were motivated by non-genocidal sentiments, but the specific intent standard also raises questions regarding the scope of liability.[48] Should liability extend to those persons who, following the directives of another, commit acts that further the other's genocidal campaign?[49] Or should liability simply rest with those who instigate a genocidal plot even when he or she has not personally inflicted the fatal blow?[50] The Convention appears to answer these questions when it list as punishable the following five acts: (1) genocide; (2) conspiracy to commit genocide; (3) direct and public incitement to commit genocide; (4) attempt to commit genocide; and (5) complicity in genocide.[51] Article 4 of the Convention further establishes that persons are punishable for genocidal acts "whether they are constitutionally responsible rulers, public officials, or private individuals."[52] However the specific genocidal intent is still a threshold prosecutors must meet when bringing such persons to trial. It is in fact the element of specific intent within the genocide definition that has resulted in a haphazard application of the Convention on post-World War II anti-group atrocities.

20th Century Genocides

There is continual debate amongst critics as to how much genocide has occurred during the 20th century. Some commentators limit the number to three: the mass killings of Armenians by the Turks in the early 1900's, the German massacre of six millions Jews during the Holocaust, and the slaughter of 800,000 Rwandan Tutsis by their Hutu countrymen in 1994.[53] Other commentators have been more "generous" in their application of genocide, adding to the anti-group atrocities enumerated above the near annihilation of the Hereros tribe in Southwest Africa by the Germans[54]; the starvation of three million Ukrainians from the Kulaks class by Stalin's man-made famine[55]; the 1970's slaughter of 1.7 million Cambodians by Pol Pot's Khmer Rouge[56]; the mass killings of the Ache Indian

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48 *See generally* Greenawalt, *supra* note 32.

49 *Id.* at 2265-2289.

50 *See generally* Greenawalt, *supra* note 32 (arguing that intent should be knowledge based. Thus liability would flow to persons who not only specifically intend to commit genocide, but also to persons who were aware of the consequences of their actions).

51 Genocide Convention, *supra* 25, art. 3

52 Genocide Convention, *supra* 25, art. 4

53 *See* Karyn Becker, *Genocide and Ethnic Cleansing, available at* http://www.munfw.org – /archive/50th/4th 1htm (last visited August 12, 2004); *See also* Genocide Watch *End Genocide at* http://www.genocidewatch.org/internationalcampaign.htm (last visited Aug. 9, 2004) [hereinafter Genocide Watch].

54 *See Germany Regrets Namibia 'genocide,'* BBC NEWS World Edition (2004) *at* http://news.bbc.co.uk/2/hi/afrihttp://news.bbc.co.uk/2/hi/africa/3388901.stm

55 *See* Genocide Watch, *supra* note 53. (There is a variation in the number of Ukrainans who died in 1932 during Stalin's rule. Some commentors list the figure at three million while others list it as "at least five million.") *See* David Marcus, Article, *Familne Crimes in International Law,* 97 A.J.I.L. 245, 245 (2003).

56 *See* Genocide Watch, *supra* note 53.

population by the Paraguarian government from 1962-1972;[57] the mass killings of Timorese during the 1975 Indonesian invasion of East Timor[58]; and the systematic killings of ethnic Kurds by Iraq's former dictator Saddam Hussein.[59]

And yet despite this expansive list of anti-group atrocities, it was not until the slaughter of Tutsis in Rwanda that an international tribunal tried and convicted a defendant for genocide.[60] At The Hague, former Yugoslavian leader Slobodan Milosevic is currently charged with war crimes, crimes against humanity, and genocide for the slaughter of Bosnian Muslims during the Bosnian-Serbian war of 1992-1995.[61] Though many commentators argue that "genocidal patterns" are evident in the mass killings of which Milosevic is charged, they doubt the trial court will hand down a genocide conviction.[62] They concede that in light of the Convention's specific intent element, there exists insufficient evidence to prove genocidal intent.[63]

This has been a common pattern throughout the history of the Genocide Convention—perpetrators of anti-group atrocities evading liability thanks to the legal loopholes punctuating the Convention's genocide definition. Participants in anti-group atrocities are aware of such loopholes and unabashedly use them not only to escape punishment but seemingly to minimize the horror of their actions.[64] Alexander Greenawalt noted such brashness in the response of Paraguay's Defense Minister when questioned about his government's military campaign against the country's Ache Indian population.[65] Though half of the Ache population was slaughtered during the ten-year campaign, the Defense Minister dismissed the idea that his government had committed genocide, pointing out that the campaign's purpose was purely economical, as it sought to clear for economic development, the area inhabited by the Aches.[66] Thus, because Paraguay's military campaign was motivated by economics and not by the desire to annihilate the Aches as a group, Paraguay's actions were permissible— in the eyes of the defense minister. They were also apparently permissible in the eyes

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[57] Greenawalt, *supra* note 32, at 2285. *See also* ITS POLITICAL USE, *supra* note 42 at 34.

[58] *See* Genocide Watch, *supra* note 54.

[59] *See* Greenawalt, *supra* note 33, at 2291.

[60] Shah, *supra* note 41, at 370-71.

[61] ERIC. D. WEITZ, A CENTURY OF GENOCIDE: UTOPIAS OF RACE AND NATION 191 (Princeton University Press 2003).

[62] Analysis: Defining Genocide, *supra* note 45.

[63] *Id.*

[64] *See* ITS POLITICAL USE, *supra* note 42, at 34. (Discusses Brazil's and Paraguay's manipulation of the Convention's intent element when addressing allegations of genocide against the countries' indigenous populations.) *See generally* Richard Arens, *The Ache of Paraguay, in* GENOCIDE AND HUMAN RIGHTS 218 (Jack Nusan Porter ed., University Press of America, 1982) (providing detailed account of the plight of Paraguay's Ache population during and after Paraguay's military campaign).

[65] Greenawalt, *supra* note 32, at 2285 (The campaign started in 1962 and ended ten years later); *see also* ITS POLITICAL USE, *supra* note 42, at 34.

[66] *Id.*

of the international community, as no legal sanctions have been levied against the South American country.[67]

The mass killings of a human group due to their political affiliation is also apparently permissible as evident by the massacre of 1.7 million Cambodians during a three year period starting in 1975.[68] Desiring to create a homogenous society replete with communist ideology, Pol Pot waged a murderous campaign against those persons and elements that did not fit neatly into his social plan.[69] He therefore attacked members belonging to the elite and middle classes, intellectuals, ethnic and national minorities, Muslim Khmers, as well as those who remained affiliated with past political regimes.[70]

Witnesses to the atrocities reported the mass deportations of urban citizens into the countryside,[71] the kidnappings of young children who were subsequently placed in labor camps,[72] the closing of monasteries and schools,[73] as well as the torture and disembowelment of unarmed civilians.[74] The slaughter did not end until 1979 when Vietnam invaded Cambodia and deposed Pol Pot's Khmer Rouge.[75] By then Pol Pot and the Khmer Rouge had killed off an estimated 20 percent of Cambodia's population.[76]

Though the U.N. has labeled the atrocities "the worst crimes against humanity since Nazism," Pol Pot was never brought before an international tribunal and tried for his crimes.[77] Nor have any surviving members of the Khmer Rouge faced legal actions for their participation in the carnage.[78] As Sonali Shah noted, even if an international tribunal was set up to try and convict members of the Khmer Rouge, under the Convention only the killings of ethnic and Muslim Khmers would be actionable.[79] The political killings and murders of persons

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67 LEO KUPER, THE PREVENTION OF GENOCIDE 162 (Yale University Press 1985) [hereinafter LEO KUPER].

68 WEITZ, *supra* note 61, at 186.

69 *Id.* at 145.

70 *See generally* WEITZ, *supra* note 61 (providing detailed history of the Cambodian conflict).

71 *Id.* at 166-67

72 *Id.* at 151.

73 *Id.*

74 *Id.* at 178. Much of Cambodia's cultural history was lost during Pol Pot's reign. The Khmer Rouge destroyed Buddhist Temples and Catholic churches all over the country. "[K]nowledge of longstanding agricultural practices, and also of Cambodia's traditional art forms, especially in dance and music" were forgotten by the people. *Id.* at 186.

75 *Id.* at 187.

76 *Id.* at 186. Experts differ on the number of lives lost during the Cambodian crisis. *Id.* Some experts list the number as "low" as 800,000 and as high as 1.7 million. *Id.* One expert insists that anywhere between 1.17 to 3.42 million people dies under Pol Pot's regime. *Id.* However, most experts believe the figure was between 1.5 and 1.7 million. *Id.*

77 Shah, *supra* note 41, at 361-65. In fairness to the UN, there have been continual discussions with the current Cambodian government for the establishment of a tribunal to try those responsible for the carnage. However there is disagreement between the UN and Cambodia's government on how much control the later will have over the proceedings. *Id.* at 363-65.

78 Pol Pot died in April 1998 without ever facing legal actions for his crimes.

79 Shah, *supra* note 41, at 361-65.

who belonged to the intellectual and disfavored economic classes would therefore go without legal redress.[80]

The Politicization of Genocide

The error in not including political and economic groups as one of the protected parties under the Convention has rendered it impotent in a world in which domestic conflicts are often ignited because of the real or imagined political and/or economic "contradictions" emanating from a disfavored group or class. In Leo Kuper's book, *The Prevention of Genocide*, he notes that genocidal campaigns, past and present, often times consist of a combination of political, ethnic, and religious mass killings.[81] Such "interweaving," as he terms it, is most apparent in pluralistic societies where there exists an array of racial, ethnic, and religious populations with a history of inter-group conflict.[82] According to Kuper, in these polarized societies, "internal divisions become politicized, and political division tends more and more to coincide with ethnic (or racial or religious) origin. Thus political mass murders and the ethnic factor become interwoven, raising difficult problems of classification."[83]

Such interweaving was evident in Cambodia during Pol Pot's reign of terror, which resulted in the mass killings of persons who were disfavored either because of their ethnic or racial make-up, class status, or political affiliation. The crisis in the Sudan also appears to represent a melding of political and racial issues, all of which retain characteristics of interweaving. A vast region comprised of Muslims, Animists (persons who adhere to indigenous African religious beliefs), and Christians who are further divided into a veritable smorgasbord of racial and ethnic groups, the Sudanese government has found it difficult to impose its Islamic Fundamentalism on the Sudanese populace.[84] In its effort to gain control of a people overwhelmingly African in sentiment and culture who have grown weary of the government's unwillingness to address the needs of all Sudanese, the government has fanned the fires of decades long hostilities.[85] The current conflict is at once about race, religion, and politics.[86]

However, the failure of the Convention to serve as a formidable deterrent to anti-group atrocities has to do not only with the flawed definition of genocide but also with the political and economic self-interests of nation-states within the international community. At the time of the Convention's drafting there was initial agreement amongst participating countries that the Convention would include po-

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[80] *Id.*

[81] LEO KUPER, *supra* note 67, at126.

[82] *Id.* at 126-7.

[83] *Id.*

[84] *See The Black Book History of Darfur's Darkest Chapter*, Sudan Tribune (Aug. 21, 2004) *at* http://www.sudantribune.com/article_impr.php3?id_article=4868; *see also Darfur In Flames*, *supra* note 3.

[85] *See Darfur In Flames*, *supra* note 3.

[86] *Id.*

litical groups as one of the protected parties.[87] However delegates from Russia, in an obvious reference to Lemkin and the Jewish Holocaust, soon expressed concern that such an inclusion would compromise the "'scientific definition of genocide and would, in practice, distort the perspective in which the crime should be viewed.'"[88] Iranian delegates supported Russia's argument by noting the involuntary membership of persons belonging to a specific racial, ethnic, national, or religious group as opposed to the voluntary membership of persons belonging to political parties.[89] Such a distinction, the delegates remarked, rendered "the destruction of the first type (involuntary members in a group). . .most heinous in the light of the conscience of humanity, since it was directed against human beings whom chance alone had grouped together."[90]

As Leo Kuper notes, it was not that nations believed political groups should have no protection whatsoever, but rather that such protection should come more appropriately from governments and national assemblies.[91] Nations have historically demanded the right to suppress rebellious political groups on their own terms.[92] Many drafters therefore perceived a Convention affording protection to political organizations as inimical to the principle of territorial sovereignty.[93] They feared such a Convention might be used as a tool to spurn government resistance during times of domestic discord.[94] It might also invite interference from "outsiders" seeking to establish their own influence or hegemony.[95] Thus in spite of counter-arguments and predictions that future genocides would more than likely be waged primarily on political grounds, the fear that the Convention would not receive the requisite number of votes for ratification prompted an agreement among the drafters to exclude political groups from the genocide definition.[96]

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87 ITS POLITICAL USE, *supra* note 42, at 24. Before the actual Genocide Convention was drafted, in December 1946, the United Nations passed a resolution in which instances of genocide included those anti-group atrocities directed at "racial, religious, [and] political" groups. Therefore under the 1946 resolution genocide was declared a crime under international law "whether committed on religious, racial, political or any other grounds." *Id.*

88 *Id.* at 25. Following the 1946 resolution, Ad Hoc Committees were set up for deliberations on the exact wording of the Genocide Convention. Russian first raised its argument against the inclusion of political groups under the Convention during the Ad Hoc Committee of 1948.

89 *Id.* at 26

90 *Id.*

91 *Id.* Kuper also notes that the representatives believed the then incomplete Human Rights Commission would provide political groups sufficient protection from governmental abuses.

92 *Id* at 26-30.

93 *Id.*

94 *Id.*

95 *Id.*

96 *Id.* at 27-9. During the Ad Hoc Committee meeting on October 14, 1948 delegates from Haiti argued against the exclusion of political groups from the Convention, on the grounds that "those who committed the crime of genocide might use the pretext of the political opinions of a racial or religious group to persecute and destroy it, without becoming liable to international sanctions." *Id.* at 28. As Kuper notes, the Haitian delegates "developed the argument further: 'since it was established that genocide always implied the participation or complicity of Governments, that crime would never be suppressed: the Government which was responsible would always be able to allege that the extermination of

The horrible error in not affording protection to political groups is most evident in the 1972 Hutu-Tutsi conflict in Burundi. Situated in the Great Lakes region, this small Central African country, which is similar in size to Maryland, is one of the most densely populated areas on the African continent.[97] Its people consists of ethnic Hutus, Tutsi, and the Twa "pygmies" of the forest.[98] Though the Hutus dominate in population figures, historically the minority Tutsi class has always ruled the country.[99] Prior to Germany's colonization of Burundi in 1899, a fierce power struggle existed between two rival Tutsi clans—the Bezi and the Batare—both of whom were members of the country's royal family.[100] Their support bases consisted of both Hutus and Tutsi resulting in clan loyalties.[101] However once Burundi obtained independence in 1962 such loyalties gave way to "a rapid ethnicing of political competition."[102]

Under Tutsi rule the Hutus—even the elite—had always felt economically and politically marginalized.[103] Such sentiments and the political achievements of Hutus in neighboring Rwanda planted seeds of self-determination in the minds of the politically frustrated Burundi Hutus.[104] In response, the ruling Tutsis took measures to strengthen their power in order to ensure that the political shifts occurring in Rwanda did not appear in Burundi as well.[105] In April of 1972, following a brief insurgence by Hutu elites, which resulted in the deaths of approximately 2,000 Tutsis, the Tutsi ruled government responded with a fierce and systematic counter-attack.[106] Military forces summarily and indiscriminately executed Hutu civilians along with those implicated in the insurgence.[107] Educated Hutus were specifically targeted, as military personnel yanked university students from class, priests from churches, and medical personnel from local hospitals, killing anyone who had the misfortune to be Hutu.[108] Many Hutus simply "disappeared," their bodies never recovered.[109] There was talk of mass graves and the killings of moderate Tutsis.[110] When the violence ended the Tutsi ruled gov-

any group has been dictated by political considerations, such as the necessity for quelling an insurrection or maintaining public order.'" *Id.* at 28-9.

97 Burundi, CIA World Fact Book, *at* http://www.cia.gov/cia/publications/factbook/geos/by.html (last updated May 11, 2004).

98 Rene Lemarchand, *The Hutu-Tutsi Conflict in Burundi, in* GENOCIDE AND HUMAN RIGHTS 195, 196 (Jack Nusan Porter ed., University Press of America, 1982).

99 *Id.*

100 *Id. See also* Gregory Mthembu-Salter, *Burundi,* Self-Determination in Focus *at* http://wwww.selfdetermine.org/conflicts/brundi_bodt.html (last modified June 17, 2002).

101 *Id.*

102 *Id.*

103 Lemarchand, *supra* note 98, at 199-200.

104 Mthembu-Salter, *supra* note 100.

105 *Id.*

106 Lemarchand, *supra* note 98, at 203-04.

107 *Id.* at 204.

108 *Id.* at 204-05. "The repression took on the qualities of a selective genocide directed at all the educated or semi educated strata of Hutu society." *Id.*

109 *Id.*

110 *Id.*

ernment had slaughtered an estimated 100,000 persons out of 3.5 million, nearly 3.5 percent of Burundi's total population.[111]

Nontheless, the U.N. has done very little to stop the violence. In Rene Lemarchand's article, "The Hutu-Tutsi Conflict in Burundi", he remarks upon the timidity of the U.N. and the failure of the world's nations to get involved.[112] Though there had been talk of establishing "a foreign presence" in the region to try and quell the violence, the U.N. only sent in two–five person missions, seemingly indicating its level of commitment to the conflict.[113] Lemarchand attributes such inaction to the fact that the crisis only involved the killings of Hutu and Tutsi, thus making it, in the eyes of the U.N., a domestic matter with no real threat to international security.[114] The conflict in Burundi therefore "ranked too far low in the scale of international priorities to justify anything more than a pro forma intervention."[115] Lemarchand notes that even the theft of UNICEF Land Rovers for the purpose of transporting Hutus to their deaths, did not raise the ire of the U.N.[116]

African nations were no more helpful in trying to stem the violence. Despite the presence of Hutu and Tutsi exiles and sympathizers in neighboring Rwanda, Tanzania, and Zaire, member states belonging to the Organization of African Unity (OAU) argued that the Burundi conflict was essentially a domestic one and therefore any outside involvement would be improper.[117] Yet Lemarchand hypothesizes an alternative motive for the OAU's inaction. Believing that many African nations saw parallels between their own internal socio-political problems and those plaguing Burundi, Lemarchand asserts that the African nations did not want to do anything that would "establish a precedent that might prevent . . .[them] . . . from dealing with such crises by means of . . .[their] . . . own choosing."[118] Therefore the OAU adopted a resolution which more or less left peace efforts in the hands of the Tutsi government.[119]

As for the West, according to Lemarchand, "key figures in the Western diplomatic corps were not even on speaking terms with each other[,]" therefore making it difficult for Western nations to reach any real agreement on how to handle the crisis.[120] The absence of a political or economic interest in Burundi also apparently influenced their decision to not get involved in the crisis:

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[111] *Id.* at 195.

[112] *Id.* at 215.

[113] *Id.* at 216.

[114] *Id.*

[115] *Id.*

[116] *Id.*

[117] *Id.* at 215.

[118] *Id.* at 217.

[119] *Id.* at 216. ("[T]he wording of the resolution adopted at the OAU Summit in Rabat in late June 1972 strikes one as little short of astounding, amounting in effect to a message of support for Micombere: 'The Council of Ministries is convinced that, thanks to your saving action, peace will be rapidly reestablished, national unity consolidated and territorial integrity preserved.'") *Id.*

[120] *Id.* at 215. ("Whereas North Korea and China were the only powers outside Africa to officially support the [government] regime, the Soviets showed no compunctions about signing the Western note of

> Reflecting on the appalling events of 1972 one journalist was prompted to ask: "does an international conscience exist?" The answer given by a Western diplomat sums up the dilemma: 'Nobody wants to start up another fuss in a faraway country if personal interests are not involved.'. . .The sad truth is that Burundi is too far away, too exotic, too small, in short too marginal in terms of the priorities set by international diplomacy to elicit concern or compassion among Westerns.[121]

When confronted with accusations that its counter-attack during the political uprising constituted genocide, the Burundi government justified its actions on political grounds.[122] The government argued that such a counter-attack was necessary to quell the insurrection and suppress political opposition.[123] Again the Genocide Convention was used not to protect targeted human populations unjustly slaughtered but instead to insure that their murderers would not face liability.[124]

This is not to suggest that sovereign nations should be denied the right to determine how best to handle their own domestic affairs. It is a commonly accepted principle, that sovereign territories have the "duty to maintain law and order."[125] However when governments, in their quest to maintain law and order, employ methods that create more turmoil than not; when governments aim to achieve peace through violence, death and intimidation; when governments expect unarmed civilians to bear the brunt of political uprisings for no other reason than their political, familial, ethnical, and/or economic affiliation with; when governments move beyond the realm of governance and into the realm of mass slaughter; it raises the question of whether such governments should be left to their own devices.

Yet, as Kuper asserts, the exclusion of political groups under the Convention, has done exactly that. By honoring the principle of territorial sovereignty, Kuper argues that the Convention has inadvertently upheld a sovereign state's perceived right to commit genocide on its own people, albeit on political grounds—"to maintain law and order. . . to preserve the territorial integrity of the state."[126] Such a—hopefully—unintended endorsement has colored the reaction and commitment of the U.N. to domestic conflicts gone amok:

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protest, in part because differences of opinion among Western diplomats made the note sound platitudinous, if not downright hypocritical. With the exception of Belgium, the dominant impression one gains of Western diplomacy during the crisis is one of almost total indifference in the face of an unrelieved tragedy.") *Id.*

121 *Id.* at 217.

122 ITS POLITICAL USE, *supra* note 42, at 29.

123 *Id.*

124 *Id.* ("At meetings in 1973, the Sub-Commission on Prevention of Discrimination and Protections of Minorities forwarded to the Commission on Human Rights a complaint against Burundi of consistent patterns of gross violations of human rights. But when the Commission met in 1974, it effectively shelved the matter by appointing a new working party to communicate with the government by Burundi, and to report back to the next annual meeting of the Commission.") *Id.* at 164.

125 *Id.* at 161.

126 *Id.*

> And though the norm for the United Nations is to sit by, and watch, like a grandstand spectator, the unfolding of the genocidal conflict in the domestic arena right through to the final massacres, there would generally be concern, and action to provide humanitarian relief for the refugees, and direct intercession by the Secretary-General.[127]

Such action is inadequate in dealing with today's domestic conflicts, especially when governments seem to resort more and more to mass carnage in their quest to retain power. Yet, as Kuper so eloquently put it, humanity is too often sacrificed for the benefit of the Territorial State.[128] Given the diverse realities of human life where ethnic issues can quickly become political and political ones can just as easily take on an ethnic, racial, or religious slant, such a sacrifice is all too pervasive and too great.

Conclusion

The failure of the Convention to afford protection to political and economic groups renders it an empty gesture providing false hope for today's victims of anti-group atrocities. By leaning too heavily on the particulars of the Jewish Holocaust and Ralph Lemkin's definition of genocide, the Convention has left millions of people vulnerable to governmental abuses. Conversely, by neglecting to apply the Convention even in those circumstances where application is by law proper, many are left wondering if the commitment "to prevent and punish genocide" is fact or pure fiction.

Therefore, if the Convention is to have any force it must apply to the realities and character of anti-group atrocities as they exist today. The "rules" of genocide have changed. No longer will perpetrators of genocidal crimes be as ostentatious and industrial in their genocidal designs as in the case of Hitler, and the Hutus of Rwanda. No longer will they publicly admit to harboring ethnic, racial, or religious resentments to the point of murderous insanity. And no longer will they kill on ethnic, racial, or religious grounds alone. Perpetrators of genocidal acts have become more sophisticated, more cognizant of how far they can go in their domestic affairs before raising the suspicions and outrage of the international community. Therefore if the Convention is to have any real force and act as an effective deterrent for anti-group atrocities, four principles must be applied: (1) members of the U.N. General Assembly must realistically evaluate their own goals, whether they be political or economic, domestic or international, and determine if they mesh well with basic human decency and the humanitarian principles they themselves extol; (2) the definition of genocide must be expanded to include political groups as one of the protected parties under the Convention; (3) as Alexander Greenawalt argues, the intent element must also undergo a revision, extending liability to "those who may personally lack a specific genocidal purpose but who commit genocidal acts while understanding the destructive conse-

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[127] *Id.*

[128] *Id.* at 183.

quences of their actions;"[129] and (4) the international community must affirm and not fear the famous question, "Am I my brother's keeper?"[130]

This final admonishment is perhaps the most important in light of the rise in incidents of domestic and international terrorism. Long dead are the days of sapping the strength of others for self-interested purposes. The fear and threat of reprisal is real and devastating. If the international community truly desires to maintain international security and domestic peace, each nation and government must ensure that it is not itself committing acts which compromise such security and peace. It is very noble to enact laws aimed at holding communities to a higher standard, however if such laws fail to register in the reality, they become little more than empty promises.

[129] Greenawalt, *supra* note 32, at 2259.

[130] *Genesis* 4:9.