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## A BRIEF ESSAY ON THE IMPORTANCE OF TIME IN INTERNATIONAL CONVENTIONS OF INTELLECTUAL PROPERTY RIGHTS <sup>1</sup>

*Vincenzo Vinciguerra*\*

Time has an unusual limitation. It must begin and end at some real points or it must be conceived of as cyclical in nature, endlessly allowing the repetition of patterns of possibilities.<sup>2</sup>

### I. INTRODUCTION

This essay will briefly address the issue of time in some fundamental international conventions on Intellectual Property Rights (IPRs). Primarily, this article concentrates on four current international conventions and discusses the importance and international relevance of the time factor in each convention.

The first part introduces two characteristic ideas of time inherited from philosophical thought.<sup>3</sup> It also describes how “linearity,” one characteristic time can assume, might be a way to think of the legal system.<sup>4</sup> This article does not delve into philosophical aspects of this issue; they are merely a cue to analyze the issue of time in the context of intellectual property.

The second part details some of the more important international

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<sup>1</sup> I give heartfelt thanks to Prof. Achille de Nitto, to whom I owe, among countless other precepts, all the ideas behind this essay. My deepest thanks go also to Prof. Thomas Cotter - in whom I found a priceless guidance - for his precious insights to this article.

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2. ROBERT ALLEN WARRIOR, TRIBAL SECRETS, RECOVERING AMERICAN INDIAN INTELLECTUAL TRADITION 72 (University of Minnesota Press 2001) (1995) (quoting Vine Deloria, Jr. Yankton Sioux, inscription at the entrance of the “Pearsall Collection of American Indian Art,” Florida Museum of Natural History, Gainesville, Florida (last visited October 2004)).

3. See *infra* notes 6-15 and accompanying text.

4. See *infra* notes 16-32 and accompanying text.

conventions on IPRs regarding the relevant time-related aspects. Other aspects and details of these conventions are left to the existing literature.<sup>5</sup>

The third, and final, section asks if time, as implemented in the IPR conventions, might be construed as circular rather than as a unidirectional straight line.<sup>6</sup> It suggests that time, in any form carved out by these conventions, is a fundamental part of IPRs and not merely an ancillary element. All IPRs are deeply embedded in the time factor. Because an inventor's rights and the concept of time are so interrelated, underestimating time's role may result in the abridgement of the inventor's rights.

## II. TIME AND LAW

### A. *Lightness and Heaviness of Time*

The concept of time always has been central in human thought, and different ideas and conceptions of time have been developed in the fields of philosophy, science and literature. For example, in the philosophical field, time has been considered a gauge of movement: "Time is the numeration of continuous movement"<sup>7</sup> according to what comes before and to what comes later.<sup>8</sup> On the other hand, St. Augustine described time as being "*distensio animi*," which means the internal flow of the conscience.<sup>9</sup> In literature, M. Proust viewed time, in the wake of the French Philosopher H. Bergson, as an internal experience that can be grasped only by intuitive memory. In science, the concept of time is dominated by the contra position between Newton's theory of Universal Time and Einstein's Theory of Relativity.<sup>10</sup>

It is common to employ metaphors, such as "linearity" and "circularity," to describe time. Time can be thought of as running ahead in a straight line, or time can be conceived as a bent line that turns in a

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5. See *infra* notes 50-93.

6. See *infra* notes 94-95 and accompanying text.

7. See Aristotle, PHYSICS, BOOK 4 223b:1 (Robin Waterfield trans., Oxford University Press 1996). See generally Aristotle's Spacetime, available at <http://www.phy.syr.edu/courses/modules/LIGHTCONE/aristotle.html> (last visited May 14, 2006).

8. See SERGIO PERONCINI, "La Formula 'ora per allora' nel Diritto Pubblico: le diverse tipologie di provvedimenti 'ora per allora'" [Nunc pro tunc' Doctrine in Public Law I: Different Kind of 'Nunc pro tunc' Judgements] Collana problemi attuali di diritto Amministrativo, 11 Ed. Scientifiche Italiane, 1995.

9. *Id.* at 11.

10. *Id.* at 11-12.

circle.

Milan Kundera referred to this dichotomy using the metaphors of lightness and heaviness.<sup>11</sup> Circular time is heavy because if

every second of our lives recurs an infinite number of times, we are nailed to eternity as Jesus Christ was nailed to the cross. It is a terrifying prospect. In the world of eternal return the weight of unbearable responsibility lies heavy on every move we make. That is why Nietzsche called the idea of eternal return the heaviest of burdens.<sup>12</sup>

Every action a person takes is destined to recur endlessly, and since the event repeats inexorably, the moment in which a choice must be made bears a “heavy” responsibility.

Alternatively, time may be thought to run ahead in a straight line, without looping onto itself.

Putting it negatively, the myth of eternal return states that a life which disappears once and for all, which does not return, is like a shadow, *without weight*, dead in advance, and whether it was horrible, beautiful, or sublime, its horror, sublimity, and beauty mean nothing. We need take no more note of it than of a war between two African kingdoms in the fourteenth century, a war that altered nothing in the destiny of the world, even if a hundred thousand blacks perished in excruciating torment.<sup>13</sup>

This means that, as in the above quote, since the stupidity of a war will not be repeated, it can be conscientiously forgiven and forgotten. It is never going to happen again.<sup>14</sup>

“[I]s heaviness truly deplorable and lightness splendid?”<sup>15</sup> Giansanti continues that “the only certainty is the lightness/weight opposition is the most mysterious, most ambiguous of all.”<sup>16</sup>

### B. *The System of Law and Its Time*

Is it possible to apply the metaphor of the opposition

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11. See Andrea Giansanti, *Tempo Leggero / Tempo Pesante. Tempo dell'economia, tempo della fisica: irreversibilità, omogeneizzazione*, Feb. 11, 2003, unpublished hand out for ISUFI's PhD classes.

12. See MILAN KUNDERA, *THE UNBEARABLE LIGHTNESS OF BEING 5* (Michael Henry Heim trans., Perennial Classic ed. 1984).

13. *Id.* at 3.

14. See Giansanti, *supra* note 11, at 2.

15. *Id.* at 5.

16. *Id.* at 6.

lightness/heaviness to the legal system?<sup>17</sup> If so, is the legal system itself linear or nonlinear and how does it deal with time?<sup>18</sup>

A *system of law* is a possible group and arrangement consisting of bodies of law, rules and prescriptions.<sup>19</sup> The “system of law” is an ideal, rational, and ordered group of laws.<sup>20</sup> Of course, one may envisage different orders for each different system of law.

One possible order of a system of law is a linear conception.<sup>21</sup> The basic idea is to conceive the law as a science in the same manner that Physics is deemed to be a natural science. To accomplish this goal, the legal system is (thought of and) arranged *more geometrico* – a complete, ordered system, within a taxonomic order.<sup>22</sup> According to Professor Langdell, Dean of Harvard University Law School at the end of the nineteenth century, “it is indispensable to establish at least two things: first, the law is a science. Secondly, that all the available materials of that science are contained in the printed books.”<sup>23</sup> In others words, law is “a complete, formal, and conceptually ordered system that satisfies the legal norms of objectivity and consistency.”<sup>24</sup> This same idea underpins all the civil law codes (which have their roots in the French illuministic civil code); these codes claim completeness and no flaws, gaps or lacunas whatsoever. All the answers to every practical problem and cases are, as Professor Langdell would say, in the civil code.

One way to think about a nonlinear order may be through this metaphor employed by the economist Fredrick von Hayek.<sup>25</sup> A contra position exists between the systems von Hayek calls “Taxis” and the

17. See ACHILLE DE NITTO, DIRITTO DEI GIUDICI E DIRITTO DEI LEGISLATORI 127 (Argo 2002).

18. See Achille de Nitto, address at a PhD class held at ISUFI, Lecce, Italy (Mar. 11, 2003). See also LORENZO CARNELLI, Tempo e Diritto [TIME AND LAW], (Erico Maciel trans., José Konfino ed., 1960).

19. See, e.g., BLACK’S LAW DICTIONARY 914 (8th ed. 2004) (defining legal order).

20. See, e.g., Norberto Bobbio, Il Positivismo Giuridico; Lezioni di Filosofia del Diritto Raccolte dal Dott. Nello Morra 153 (Giappichelli, ed. 1979).

21. See DE NITTO, *supra* note 17, at 132-37 (“il comando si presume chiaro, ed il flusso prescrittivo ininterrotto, rapido e, soprattutto, lineare”).

22. See CH. PERELMAN, L. OLBRECHTS-TYTECA, THE NEW RHETORIC: A TREATISE ON ARGUMENTATION 1-2 (John Wilkinson & Purcell Weaver trans., Univ. of Notre Dame Press 1958) (1969) (“Reasoning *more geometrico* was the model proposed to philosophers desirous of constructing a system of thought which might attain to the dignity of a science.”).

23. See GARY MINDA, POSTMODERN LEGAL MOVEMENTS: LAW AND JURISPRUDENCE AT CENTURY’S END 13 (N.Y. Univ. Press 1995), for an accurate account of the main American jurisprudential school in the twentieth century.

24. *Id.*

25. See de Nitto, *supra* note 18, at 130.

ones he calls “Cosmos.”<sup>26</sup> The former is a system with a specific aim; all the components of the system are coordinated to contribute to that aim. Conversely, the latter is a *spontaneous order*, a “humoured” system.<sup>27</sup> It is not a system geometrically or rigidly regimented by strict rules with specific aims.<sup>28</sup> It is an order in which – because of its nature – non rational elements find a proper arrangement therein, such as the trust of the market<sup>29</sup> and the goodwill of businesses.

The idea of a *reasonable* system, as opposed to a *rational* system<sup>30</sup> has been sustained by other schools of thoughts, in both Europe and in the United States. For example, the American Realist Movement in the 1920’s and 1930’s<sup>31</sup> strongly opposed the formalist conception of law. More recently, the Legal Feminist Movement, among others, proposed a *contextual* and *subjective* approach for construing law.<sup>32</sup>

In sum, it seems that the contra position formal *versus* non-formal system of law (linear/non-linear) has always been important<sup>33</sup> and it continues to remain relevant.<sup>34</sup>

### C. Law and Metaphors

Apart from the contraposition of thoughts within all the possible variations,<sup>35</sup> the idea of a linear, straightforward system has been “absorbed” and implemented in the *language* of law, the legal jargon.<sup>36</sup> If one looks at the legal *words* used everyday, they might find that these words express purposes of *perfection*, and taxonomic order previously mentioned, as part of an ancient legal tradition.

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26. See F. A. VON HAYEK, LEGGE, LEGISLAZIONE E LIBERTÀ [LAW, LEGISLATION AND LIBERTY] (Il Saggiatore ed., Routledge & Kegan Paul trans., London 1973-1979) (1986). For the English version, see F.A. VON HAYEK, LAW, LEGISLATION, AND LIBERTY 35-41 (University of Chicago Press 1973).

27. See DE NITTO, *supra* note 17, at 130. See VON HAYEK, *supra* note 26 (According to Von Hayek spontaneous orders, such as a legal order as well as an economic system, can only be generated and efficiently run by “abstract norms” of interaction among the “aimed systems”).

28. See DE NITTO, *supra* note 17, at 130 (the author distinguishes between a “rational” positive order as opposed to a “reasonable” positive order).

29. *Id.* at 141.

30. *Id.* at 130.

31. See MINDA, *supra* note 23, at 25.

32. *Id.* at 132.

33. See Michael Steven Green, *Hans Kelsen and the Logic of Legal Systems*, 54 ALA. L. REV. 365 (2003) (testifying to the topicality of the problem).

34. It is interesting that in the same period of time as the Legal Realist Movement, Hans Kelsen wrote his “Reine Rechtslehr,” one of the powerful theories upholding a “tough” legal formalism.

35. See generally MINDA, *supra* note 23.

36. See DE NITTO, *supra* note 18, at 127.

- The word *right*, as used in the law schools and courts, means “a legal entitlement to have or obtain something or to act in a certain way.”<sup>37</sup> However, *right* also means “conformity with justice or morality.”<sup>38</sup> *Right* is defined as “in accordance with fact, reason, or true, correct” and “in a *straight line*; directly.”<sup>39</sup>
- The word *rule*, as used in law schools, means “an authoritative direction for conduct or procedure”<sup>40</sup> (eventually given by law). However, it also means “a statement that describes what is *true* in most or all cases.”<sup>41</sup>
- *Ruler* not only means “one that rules or governs” (presumably by making laws and bestowing rights), but also a “straightened strip for drawing *straight lines* and measuring lengths.”<sup>42</sup>
- *Standard* is used in legal jargon to mean “a level of quality or attainment” and “an idea of thing used as a measure, norm or model. . . .”<sup>43</sup> However, *standard* also means “a principle of conduct informed by notions of *honour* and *decency*” or “an object that is supported in an *upright* way.”<sup>44</sup>

These lemmas are used in the legal jargon as metaphors. *Metaphor* in Greek means “to transport, or “to convey.”<sup>45</sup> The meaning that *right* (in the legal sense) conveys is given by the other meaning referred to above: conformity with justice, true, correct. Right sustained by the State power is a “rule,” “edge,” something that neatly divides the right from the awry, the right from the *wrong*.<sup>46</sup>

Interestingly, the same use of the word *right* as a metaphor can be found in the French word “droit,” the Spanish word “derecho,”<sup>47</sup> the

37. THE NEW OXFORD AMERICAN DICTIONARY 1467 (Oxford Univ. Press 2001).

38. THE AMERICAN HERITAGE DICTIONARY 719 (Dell Publ’g 2001).

39. *Id.* (emphasis added).

40. *Id.* at 728.

41. *Id.* (emphasis added).

42. *Id.* (emphasis added).

43. THE NEW OXFORD AMERICAN DICTIONARY 1660 (Oxford Univ. Press 2001).

44. *Id.* (emphasis added).

45. See William Crightor, NEW GREEK-ENGLISH DICTIONARY (Zeno 1966) (defining “metaphor”).

46. See Federico Spantigati, “Analisi del diritto dell’economia” [Analysis of the Economic Law] 3 (forthcoming).

47. Interesting, in Spanish the word “derecho” means both “straight” and, with a slight

German word “reicht” and the Italian word “diritto.”<sup>48</sup> It is not a coincidence. All the terms share the same idea of linearity, and all of them share the metaphorical meaning carried by the original Latin word *directum*.<sup>49</sup>

Thus, “right” is the opposite of *wrong, false, bent, askew, awry*. Using a mathematical metaphor, a straight line is the shortest way to link two points on a plane, the rule of law is thought to solve a practical case in the easiest and most straightforward way.<sup>50</sup> This would be possible so long as the legal order is construed as a systematic, flawless order. Given a hypothetical case in point and knowing the *rule* to apply, one and only one answer will be possible. Accordingly, time must also be thought to be as linear as the legal system itself. Such an ordered and coherent system leaves no room for other interferences. Therefore, time in the legal system is thought of as an irreversible flow from the past to the present and from the present to the future, a unidirectional temporal sequence that cannot return.<sup>51</sup>

### III. TIME IN INTERNATIONAL CONVENTIONS

#### A. *The Paris Convention for the Protection of Industrial Property*

The Paris convention of March 20, 1883 came into effect on July 7, 1884. Since then, it has been revised many times, most recently at Stockholm in 1967.<sup>52</sup> As its title suggests, the purpose of the convention was to formulate principles to accord protection of *Industrial Property*.<sup>53</sup>

A major achievement of the convention was the establishment of an

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correction, “right” (derecha). See THE OXFORD-DUDEN PICTORIAL SPANISH-ENGLISH DICTIONARY 508 (Oxford University Press, 1985).

48. See DE NITTO, *supra* note 18, at 137 (quoting W.Cesarini Sforza, Principio e Concetto, Enciclopedia del diritto, 630 ss., Milano 1964).

49. *Id.*

50. *Id.* at 138.

51. See Francesco La Valle, Nss. Dig. It., *successione*, 635, 1971.

52. See Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, 21 U.S.T. 1583 (as revised on July 14, 1967 in Stockholm) [hereinafter Paris Convention]. See, e.g., George Hendrick Christian Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property, as revised at Stockholm in 1967*, UNITED INTERNATIONAL BUREAU FOR THE PROTECTION OF INTELLECTUAL PROPERTY (1968).

53. See Paris Convention, *supra* note 52, art. 1(2). “Industrial Property” is a label that encompasses some legal institutions: patent, utility model, industrial design, trademarks, service marks, trade names, indication of source or appellation of origin. Since the patent may be considered the archetype of industrial property I will employ it as the main example in examining all the international conventions regarding industrial property.



international priority system for the registration of industrial property.<sup>54</sup> Before the Paris convention was implemented, finding patent protection outside the boundaries of the country in which the patent was first filed was almost impossible. In fact, it was very difficult and expensive to apply for a patent in two or more different countries at the same time. Moreover, failure to file a patent simultaneously in all the countries where protection was sought could (and often did) deprive the invention of its required novelty<sup>55</sup> in countries other than the one in which the initial application was made.<sup>56</sup>

The Paris Convention solved this problem by establishing the “right of priority:” “Any person who has duly filed an application for a patent . . . in one of the countries of the union . . . shall enjoy, for the purpose of filing in the other countries, a *right of priority* during the periods hereinafter fixed.”<sup>57</sup> As a consequence,

any subsequent filing in any of the other countries of the Union *before the expiration of the periods referred to above* shall not be invalidated by reason of any acts accomplished in the *interval*, in particular, another filing, the publication or exploitation of the invention, the putting on sale of copies of the design . . . .<sup>58</sup>

These provisions mean that, for example, if X applies for a patent in country (A), she will retain, for one year, her right to apply for a patent on the same invention in all the other countries of the Union, despite what might happen after the first date of application in country (A), such as the publication or the exploitation of the work. This means that all the activities that would normally defeat the novelty of the invention, in the absence of any agreements, are irrelevant.

The filing of the first application, the one that triggers the process, establishes the date of filing. The effect of the application is retained “*whatever* may be the *subsequent fate* of the application.”<sup>59</sup> This means

54. See, e.g., STEPHEN P. LADAS, PATENTS, TRADEMARKS, AND RELATED RIGHTS: NATIONAL AND INTERNATIONAL PROTECTION (Harvard Univ. Press 1975).

55. “Novelty” is, along with “utility” and “non-obviousness,” one of requirements for patentability. See ROBERT P. MERGES, PETER S. MENELL, MARK A. LEMLEY, THOMAS M. JORDE, INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE 112 (Aspen Publishers 2003). “The novelty test determines whether the claimed invention is unpatentable because it was made before, sold before . . . or otherwise disqualified by prior use or knowledge.” *Id.*

56. See PAUL GOLDSTEIN, INTERNATIONAL INTELLECTUAL PROPERTY LAW 333 (Foundation Press 2001).

57. See Paris Convention, *supra* note 52, art. 4 (a, 1), (emphasis added) (the period of priority is fixed, for the patent, at twelve months).

58. *Id.* at art. 4 (b) (emphasis added).

59. *Id.* at art. 4(a)3.

that when a new application is completed in a different country within the Union, it is treated *as if* it had been filed on the date the first application was filed, even if the original application had been withdrawn or cancelled.

Is this an example of circular time or, instead, is a *fictio juris* being implemented here?<sup>60</sup> A *fictio juris* is an assumption that considers as true something that cannot be true.<sup>61</sup> Is it here implemented to assure coherency to the linear idea of time? Or is it the idea of linearity that forces us to think in term of *fictiones*?

### B. Patent Cooperation Treaty

In the mid 1960's, improving and strengthening the international patent system was one of the goals of President Johnson's administration. President Johnson appointed a special commission to study the United States's patent system and the commission came up with the recommendation that, *inter alia*, "the United States [should] promote direct interim steps toward the ultimate goal: a universal patent including harmonization of patent practices."<sup>62</sup> That was the starting point that led to the diplomatic conference in June of 1970 where the Patent Cooperation Treaty (PCT) came to light.<sup>63</sup> Once again, the time factor plays a fundamental role.<sup>64</sup>

In Professor Paul Goldstein's words: "The most significant advantage [of the PCT] is the *additional time* provided before a final decision has to be made on the filing of individual application in different countries."<sup>65</sup> Hence, there is here no particular or original application of a *time factor*; however, time remains one of the most

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60. See La Valle, *supra* note 51, at 637 (quoting K. Helwig and S. Pugliatti).

61. See BLACK'S LAW DICTIONARY 657 (8th ed. 2004).

62. Interestingly, but not surprisingly, the same interest has prevailed in the international arena leading, years later, to the worldwide harmonization of IPRs through the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS), available at [http://www.wto.org/english/docs\\_e/legal\\_e/legal\\_e.htm#TRIPS](http://www.wto.org/english/docs_e/legal_e/legal_e.htm#TRIPS) (last visited May 14, 2006). See GOLDSTEIN, *supra* note 56, at 353.

63. See Patent Cooperation Treaty, with Regulations, June 19, 1970, 28 U.S.T. 7645 [hereinafter PCT].

64. The PCT sets forth in art. 4 that the applicant, beyond the year provided for by the Paris Convention, has bestowed with eight additional months (plus a preliminary search report) upon which grounding the decision on whether or not complete the filing in the designated countries. Because art. 27(7) and rule 4(7) do not compel to appoint a national attorney or agent until processing of the international application has started in the designate national patent office, the monetary savings is huge. A lot has been written about the PCT. See, e.g., GOLDSTEIN, *supra* note 56, at 353.

65. *Id.* at 356 (emphasis added).

important features “manipulated” in the treaty, which acknowledges that time is a key element greatly affecting the holder’s interest.

*C. The “Madrid Agreement” and “Madrid Protocol”*

The purpose of the “Madrid Agreement Concerning the International Registration of Marks” (Madrid Agreement)<sup>66</sup> is to simplify the international registration process of Trade Marks (TM).<sup>67</sup> This pact enables a trademark owner, in any of the contracting countries, to secure trademark protection by filing “an application for international registration”<sup>68</sup> in the original country’s trademark court.<sup>69</sup> The international application is received by the World Intellectual Property Organization (WIPO)<sup>70</sup> which issues an international registration and transmits it to the designated countries for examination.<sup>71</sup>

The United States did not adhere to the Madrid Agreement<sup>72</sup> partially because of the “central attack” provision, which provides that if the home country registration is cancelled (or otherwise invalidated), registrations in all designated foreign countries will fall with it.<sup>73</sup>

The Protocol relating to the Madrid Agreement (Madrid Protocol),<sup>74</sup> adopted in 1989, has modified the most objectionable features of the original agreement. The protocol now allows a TM owner, whose registration has been cancelled in the country of origin, to retain her international application and, thus, to file a registration application in the designated countries, *as if* it had been filed on the date of the international registration.

As in the Paris Convention, the question becomes whether a *fictio*

66. See Madrid Agreement Concerning the International Registration of Marks, April 14, 1891, (as revised at Stockholm, July 14, 1967), available at [http://www.wipo.int/madrid/en/legal\\_texts/trtdocs\\_wo015.html](http://www.wipo.int/madrid/en/legal_texts/trtdocs_wo015.html) [hereinafter Madrid Agreement] (last visited May 14, 2006).

67. The term Trade Mark includes any word, name, symbol, or device, or any combination thereof, the producers use to identify and distinguish her goods, including a unique product, from those manufactured or sold by other and to indicate the source of the goods. For a definition of “service mark” the definition of TM must be applied, *mutatis mutandis*, to a service. See MERGES, MENELL, LEMLEY, JORDE, *supra* note 55, at 537.

68. See Madrid Agreement, *supra* note 66, art 1(2).

69. *Id.*

70. *Id.* To be sure, the application is received by the International Bureau of Intellectual Property.

71. *Id.* art. 3(4).

72. See GOLDSTEIN, *supra* note 56, at 471.

73. See Madrid Agreement, *supra* note 66, art. 6 (3).

74. See Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, June 28, 1989, available at [http://www.wipo.int/madrid/en/legal\\_texts/trtdocs\\_wo016.html](http://www.wipo.int/madrid/en/legal_texts/trtdocs_wo016.html) (last visited May 14, 2006).

*juris* is employed, or is it an example of circular time?

#### D. *The Nunc Pro Tunc and Relation Back Doctrines*

Both in the Paris Convention and in the Madrid Protocol, something that had ceased to exist (the first application or the international registration, respectively)<sup>75</sup> is a point of reference for the new application in the designated countries. Both the Paris Convention and the Madrid Protocol use a no-longer-existent act as a point of reference for the validity of a subsequent act.<sup>76</sup>

A different process happens with the *nunc pro tunc* and the *relation back* doctrine. The *nunc pro tunc judgment* means “a procedural device by which the record of a judgment is amended to accord with what the judge actually said and did, so that the record will be accurate.”<sup>77</sup> Something similar happens with the doctrine of relation back. “[A]n act done at a later time is, under certain circumstances, treated as though it occurred at an earlier time. In federal civil procedure, an amended pleading may relate back, for purposes of the statute of limitations, to the time when the original pleading was filed.”<sup>78</sup> These two doctrines are employed only if there is a mistake in a pre-existent document and this document is still legally existent.

According to these two doctrines, those past events, through a *fiction juris*, are considered *as if* they were effective and qualified in the way the present judgment does. Therefore, the problem of the effect of a past act is surmounted, again, by a *mental construction*. However, a characteristic of the *nunc pro tunc judgment* seems to be that it “applies only when there is a past legal fact to which to apply the present judgment.”<sup>79</sup> It seems that it is impossible to produce this result out of

75. See *id.* at art. 9 quinquies (first sentence).

76. But see PERONCINI, *supra* note 8, at 144 ff.

77. BLACK'S LAW DICTIONARY 1100 (8th ed. 2004). See also 49 C.J.S. *Judgments* § 123 (2005) (the purpose of the ‘nunc pro tunc’ judgement is “to alter a judgment actually rendered, or to correct an erroneous decision or judgment; and, generally speaking, the object or office of the entry is only to supply matters of evidence or to correct clerical misprisions, and not to supply omitted judicial action”).

78. See FED. R. CIV. P. 15(c). Even though it's possible the first document was void, I would argue that it would be *partially* void, only in regard of the mistake that the doctrine wants to correct. In the Paris convention, on the contrary, the application is considered totally void. For an explanation of the rule, see Steven S. Sparling, *Relation Back of 'John Doe' Complaints in Federal Court: What you don't Know can Hurt You*, 19 CARDOZO L. REV. 1235 (1997). Even though it's possible the first document was void, I would argue that it would be *partially* void, only in regard of the mistake that the doctrine wants to correct. In the Paris convention, on the contrary, the application is considered totally void.

79. The *nunc pro tunc* doctrine permits courts to enter orders having retroactive effect for the

thin air, without the existence of previous fact,<sup>80</sup> a *nunc pro tunc judgment*. The same conclusion is reached regarding the relation back doctrine.

By way of contrast, pursuant to Article 9 quinquies of Madrid Protocol (and, *mutatis mutandis*, pursuant article 4 of Paris Convention) there are no past legal events, because they have been cancelled, that refer to the new effect. Thinking about it in terms of *fictiones*, perhaps a “stronger” one is implemented here.<sup>81</sup>

Again, is it possible to think of these provisions as inverting the flow of time? Maybe it is just a fascination, such as the *fictio juris*, and it is possible to qualify these events, as hypothetical fact situations – with facts proceeding *in a progressive order* – to which the rule attaches legal consequences.<sup>82</sup> In this event, another “tool” is employed to adapt the system to the idea of linearity. As usual, it is a matter of the premises chosen and the goals set.<sup>83</sup>

#### *E. Berne Convention for the Protection of Literary and Artistic Works and its Application*

The time factor also plays a fundamental role in the conventions protecting literary and artistic works.

The Berne Convention was the first agreement protecting literary and artistic works. Signed in Berne, Switzerland, on September 9, 1886, the Convention has often been revised, most recently in the 1979.<sup>84</sup>

The Berne Convention protects “every production in the literary, scientific and artistic domain, whatever may be the mode or form of its

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limited purpose of correcting a *previously entered order* which contained an error, omission, or a mistake. See *Gagnon v. United States*, 193 U.S. 451 (1904); *Brignardello v. Gray*, 68 U.S. 627 (1864). See also *Matthias v. R.R. Ret. Bd.*, 341 F.2d 243 (8th Cir. 1965). The Supreme Court of Nebraska held that “proper function of a *nunc pro tunc* order is not to correct some affirmative action which court ought to have taken but is to correct the record *which has been made*, so that it will truly record action which was really had but which through some inadvertence or mistake has not been truly recorded.” *Andrews v. Neb. State Ry. Comm’n*, 121 N.W.2d 32, (Neb. 1963) (emphasis added).

80. *But see* PERONCINI, *supra* note 8, at 144 ff.

81. In fact, this provision pegs the new effect not to the past event (the original application no longer existing) but to a certain point in the past (that only corresponds with the time period of the old application).

82. This means that all of the elements that must be met in order to trigger legal protection are straight in the time, one after the other progressively. See DIZIONARIO GIURIDICO Francesco De Franchis, *fattispecie*.

83. See DE NITTO, *supra* note 18, at 142.

84. See Berne Convention for the Protection of Literary and Artistic Works, September 9, 1886 (as amended September 28, 1979), available at [http://www.wipo.int/treaties/en/ip/berne/tt\\_docs\\_wo001.html](http://www.wipo.int/treaties/en/ip/berne/tt_docs_wo001.html) [hereinafter Berne Convention] (last visited May 14, 2006).

expression, such as books, pamphlet and other writing. . . .”<sup>85</sup> The Berne Convention (as developed over time) vests the authors with an array of substantial rights such as the national treatment, the right of translation, reproduction, certain moral rights, etc.<sup>86</sup> Moreover, the convention sets forth the minimum period of protection for artistic and literary works.<sup>87</sup>

Generally, a country does not have any obligations, absent international agreements, to protect a work by a foreign national or a work first published in another country.<sup>88</sup> The protection consists in recognizing to the author of an artistic or literary work a bundle of rights that expands its effects over a certain span of time. No protection is granted if the terms of protection will not be recognized in the country where protection is sought. Here, the Berne Convention steps in. According to Article 18, the Convention shall apply to the works of authorship that have not yet fallen into the public domain at the time of its enactment. Conversely, no protection is granted to works that have fallen into the public domain in the country where protection is claimed, even though the work is still protected in the country of origin.<sup>89</sup>

This provision is important, despite being the source of many problems.<sup>90</sup> One can facilitate an understanding of this provision and the time factor in the copyright arena by referring to a judicial case. This case was heard before the German Federal Supreme Court in the 1978.<sup>91</sup> The issue was whether, within the legal framework given by the interference of the Berne Convention along with other international

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85. *Id.* at art. 2(1).

86. *Id.* at art. 5, art. 8, art. 9, art. 6bis.

87. In fact, copyright protection is limited in time. *Id.* at art. 7.

88. *But see* the French and German systems of law where, because of the philosophical premises underpinning IPRs, protection for at least some “moral rights” are unconditionally and universally extended. *See, e.g.,* GOLDSTEIN, *supra* note 56.

89. *See* Berne Convention, *supra* note 84, art. 18(1-2) (“This Convention shall apply to all works which, at the moment of its coming into force, have not yet fallen into the public domain in the country of origin through the expiry of the term of protection . . . . If, however, through the expiry of the term of protection which was previously granted, a work has fallen into the public domain of the country where protection is claimed, that work shall not be protected anew”).

90. *See* GOLDSTEIN, *supra* note 56, at 193 (pointing out that the retroactive protection is accorded by the convention to foreign works existent at the time the convention came into effect between the protecting country and the work’s country of origin so long as the requirements set forth by Art. 18 are met). It is also worthwhile to mention the “Copyright in Restored Works,” pursuant to 17 U.S.C. § 104A, which solves the problem of the protection of foreign works, when the Berne Convention entered into force in the United States in 1989, that had lost their United States copyrights because the copyright owner had failed to comply with renewal formalities.

91. Atlas Film & AV GmbH & Co. Verleih u. Vertrieb v. Janus Film u. Fernsehens Vertriebsgesellschaft mbH. Case n. I ZR 97/76, 10 INTERNATIONAL REVIEW OF INDUSTRIAL PROPERTY AND COPYRIGHT LAW 358 (1979).

agreements,<sup>92</sup> the petitioner's work still had copyright protection in Germany.<sup>93</sup> The German Supreme Court, holding in favour of the petitioner, recognized the significance of the term of protection in the copyright law as a critical issue.<sup>94</sup> The Court held that "the term of protection [constitutes] a right in a work"<sup>95</sup> and that the term of protection is *not* "merely a durational limitation of a right."<sup>96</sup>

According to the Court, the substantial right conferred by the copyright would be deeply "affected" if the period of protection is miscounted and underestimated in its scope and duration.<sup>97</sup>

#### IV. CONCLUSION

Both the Paris Convention and the Madrid Protocol employ a *fiction juris*. The question remains whether a *fiction* is merely an "intellectual tool" used to explain something otherwise not explainable, an *escamotage* that must be used in order to reckon with the idea of linear time because time in the legal system usually defines time as an irreversible flow of time, from the past to the present and vice versa, or as a unidirectional temporal sequence.<sup>98</sup>

Notwithstanding the suggestive imagery of the linear/circular time, and in light of the aforementioned provisions as well as the decision of the German Supreme Court, the time-factor is a fundamental element of intellectual property rights. The matter at hand is substantial. The time factor does not concern *how long* the time of protection ought to be. The time factor (whatever the length) underpins the interest of the IPRs holder, and it shapes the scope of protection given by law. Since the particular interest of the rights holder is the starting point for the process that leads to the creation of the *rule of law*,<sup>99</sup> the time factor is the essence of the "intellectual bundle of rights."

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92. *Id.*; see also Universal Copyright Convention, Paris text, 1971, art XIX, available at <http://www.cni.org/docs/infopols/US.Universal.Copyright.Conv.html> (last visited May 14, 2006).

93. For a detailed comment on this case, see GOLDSTEIN, *supra* note 56, at 188.

94. See GOLDSTEIN, *supra* note 56, at 188.

95. See GOLDSTEIN, *supra* note 56, at 191.

96. *Id.*

97. *Id.*

98. See La Valle, *supra* note 51, at 635.

99. Bigliuzzi Geri, Breccia, Busnelli, Natoli, I, 1, "Diritto Civile" [Civil Law] 288 (Utet ed. 1986).