

Professor Graeme B. Dinwoodie

The Scholarly Landscape of a Leading International IP Academic

September 2017

[Professor Graeme Dinwoodie](#) is one of the leading global scholars in the field of international intellectual property law, trademark law, design law and copyright law. He has an almost unique expertise in both the U.S. and European aspects of the discipline, and his work has had an influence on scholars and policymakers worldwide (and on students through publication of leading casebooks, including popular works on [trademark and unfair competition law](#), [international intellectual property law](#), and [trade dress and design law](#)).

International IP

He is perhaps best known for his work in international intellectual property law and has written on all aspects of that field. In a series of articles and books over two decades, he has addressed the means by which international intellectual property law norms do and should develop. In particular, he has highlighted the range of institutions that create transnational law, arguing for greater attention to the role of national institutions and private ordering. (See e.g., [A New Copyright Order: Why National Courts Should Create Global Norms](#), 149 U. Pa. L. Rev. 469 (2000); [Private Ordering and the Creation of International Copyright Norms: The Role of Public Structuring](#), 160 Journal of Inst. & Theor. Econ. 161-180 (2004)).

As a result of his scholarship on these questions of private international law (including his innovative advocacy of the substantive law method in transnational copyright litigation), Professor Dinwoodie has been intimately involved in the scholarly and policy debates that have taken place internationally about transnational IP litigation, organizing and editing the [2001 symposium](#) showcasing the draft treaty on that topic proposed by Professors Dreyfuss and Ginsburg, and

serving as an Adviser to the [American Law Institute Project](#) on that topic, which resulted in a set of Principles approved in 2007. He was also one of the 12 scholars who published the European counterpart to the ALI project, the so-called [CLIP Principles](#), in 2012, and before that served as a consultant to the World Intellectual Property Organisation (WIPO) on matters of private international law, producing an [often-cited report](#) on trademark aspects of the question. This policy-based work was accompanied by a number of scholarly pieces, including [Developing a Private International Intellectual Property Law: The Demise of Territoriality?](#), 51 Wm. & Mary L. Rev. 711 (2009), [described](#) by a leading IP judge as an illuminating *magnum opus*.

Professor Dinwoodie has also been a leading figure in the critical treatment of the public international law of intellectual property, outlining the complex architecture of the system and analyzing a range of developments in a number of scholarly articles and a [foundational casebook](#) (written with Bill Hennessey and Shira Perlmutter). Several of those articles were written with Rochelle Dreyfuss, a collaboration that led in 2012 to the publication of [A Neofederalist Vision](#).

[of TRIPS \(Oxford University Press 2012\)](#), [described](#) by other prominent scholars as “the crowning achievement of more than a decade of incisive scholarly analysis by two leading scholars of intellectual property law and policy” and “a uniquely insightful and illuminating book on the meaning of the TRIPS Agreement.” As Professor Jerry Reichman [commented](#) on its publication, “their Neo-Federalist approach could become the key to the long-term stability and success of [the TRIPS Agreement]. It should be required reading for everyone working in this field, especially for judges sitting on WTO dispute-settlement panels and the Appellate Body.” Most recently, Professor Dinwoodie has again collaborated with Professor Dreyfuss on analysis of the [significance of Brexit](#) in light of the international IP system.

Design Protection

Professor Dinwoodie has made vital contributions to scholarly and policy debates about domestic IP regimes on both sides of the Atlantic, and these have often had a comparative flavor. His 1996 book-length article, [Federalized Functionalism](#), was one of the earliest critical and comprehensive treatments of the newly enacted EU design protection regime and was published almost simultaneously with two substantial and well-received articles on U.S. trade dress law. ([Reconceptualizing the Inherent Distinctiveness of Product Design Trade Dress](#), 75 N.C. L. Rev. 471 (1997) and [The Death of Ontology: A Teleological Approach to Trademark Law](#), 84 Iowa L. Rev. 611 (1999)). The latter article, [described by Annette Kur](#) as a “seminal article advocating a teleological approach to trade mark law,” has influenced scholarship on both sides of the Atlantic. Professor Dinwoodie has continued to be a prominent voice on design law matters, writing the [first U.S. casebook on design law](#) (with Mark Janis) in 2010 and more recently contributing (with Lionel Bently) to public debates about design reform in the UK.

Trademark Law

On trademark law, in addition to his work above on distinctiveness and functionality of design marks, Professor Dinwoodie is best known in the United States for his articulation of the distinction between a “proactive” and a “reactive” approach to the development of trademark law, first highlighted in his article [Trademarks and Territory: Detaching Trademark Law from the Nation State](#), 41 Hous. L. Rev. 885 (2004), and later in his 2004 Helen Wilson Nies Lecture [The Trademark Jurisprudence of the Rehnquist Court](#) and in his 2008 Herchel Smith International Intellectual Property Lecture [Ensuring Consumers “Get What They Want” and The Role of Trademark Law](#) at the University of Cambridge. *Trademarks and Territory* also illuminated what he called the different “intrinsic” and “political” conceptions of territoriality embedded in trademark law. He recently returned to the importance of these conceptions of territoriality in the EU context ([Territorial Overlaps in Trademark Law: The Evolving European Model](#), 92 N.D. L. Rev. 1669 (2017)) and, in a book to be published by Oxford University Press in 2018, in the broader international system as a whole. That book, [International Trademark Protection: Territoriality in a Post-National Age](#), also highlights the importance of non-national norms in trademark law, a theme Professor Dinwoodie first explored with Larry Helfer in their article [Designing Non-National Systems: The Case of the Uniform Domain Name Dispute Resolution Policy](#), 43 Wm. & Mary L. Rev. 14 (2001). The book will also draw on the distinction between “proactive” and “reactive” lawmaking and the distinct role of trademark registration schemes first noted in *Trademarks and Territory*; and he will further develop the proactive/reactive distinction in a forthcoming book, *Trade Mark Values*, to be published by Cambridge University Press in 2019.

Professor Dinwoodie’s scholarship (with Mark Janis) on the trademark use doctrine

(see, e.g., [Confusion Over Use: Contextualism in Trademark Law](#), 92 Iowa L. Rev. 1597 (2007)) not only won the [Ladas Award](#) for the Best Article on Trade Mark Law in 2007 but helped frame (along with work by [Stacey Dogan & Mark Lemley](#)) an important debate that arguably still rumbles in contemporary trademark law. That work has been cited extensively as the same issue has been fought out, especially in the context of keyword advertising, on a worldwide basis. That scholarship argued against a threshold trademark use requirement for trademark infringement. Instead, Professor Dinwoodie argued for the development of greater affirmative defenses in trademark law in his 2008 Lewis & Clark College of Law Distinguished IP Lecture, [Developing Defenses in Trademark Law](#) (13 Lewis & Clark L. Rev. (2009)).

Since taking up the Oxford Chair, Professor Dinwoodie has intensified his exploration of similar issues in European trademark law, publishing important scholarship on the [Europeanisation of trademark law](#), [submerged notions of unfair competition](#) in European trademark law, and (with Dev Gangjee) critical analysis of the construction of the [consumer in EU trademark law](#). This last work highlighted the different normative and empirical dimensions to the fiction of the average consumer, thus paralleling the distinction between proactive and reactive lawmaking first developed by Professor Dinwoodie in the U.S. context. This essentially transatlantic character is found in much of Professor Dinwoodie's scholarship, which always draws heavily on comparative analysis. His most recent book, [Secondary Liability of Internet Service Providers](#), 25 Global Studies in Comparative Law (Springer 2017), is an edited collection growing out of his role as a General Reporter at the Annual Congress of the International Academy of Comparative Law in Vienna, and includes [his own chapter](#), *A Comparative Analysis of the Secondary Liability of Online Service Providers*.

Copyright Law

The international and comparative dimension is also present in Professor Dinwoodie's work on copyright law. In addition to his articulation of a radical approach to choice of law in transnational copyright litigation in [A New Copyright Order: Why National Courts Should Create Global Norms](#), 149 U. Pa. L. Rev. 469 (2000), Professor Dinwoodie has authored important critiques of WTO decisions on copyright law ([Incorporating International Norms in the Development of Contemporary Copyright Law](#), 62 Ohio St. L.J. 733 (2001)) and new international copyright lawmaking dynamics that too closely resemble domestic processes ([The WIPO Copyright Treaties: A Transition to the Future of International Copyright Lawmaking?](#) 57 Case W. Res. L. Rev. 751 (2007)). He has argued for a more expansive scope of copyright lawmaking under the Treaty Clause than commonly accepted ([Copyright Lawmaking Authority: An \(Inter\)nationalist Perspective on The Treaty Clause](#), 30 Colum. J.L. & Arts (2007)). That international and comparative dimension is also a feature of his important collaboration with Jerry Reichman and Pam Samuelson in [A Reverse Notice and Takedown Regime To Enable Fair Uses of Technically Protected Copyrighted Works](#), 22 Berkeley Tech. L.J. 981 (2007).

Policy Work

Professor Dinwoodie has always used his scholarship as a way of engaging with policy deliberations, whether at WIPO, the WTO, ICANN, [UNCTAD](#), the USPTO, the ALI, or (more recently) at European institutions such as the European Union Intellectual Property Office, the UK Intellectual Property Office, the European Parliament, and the European Commission. In his time as the IP Chair at Oxford, he has participated in submissions to these European bodies by groups of leading [trademark](#) and [copyright academics](#) (the latter under the aegis of the [European Copyright Society](#)). But he has maintained

his strong connections with the United States, not only teaching and speaking at numerous U.S. institutions, but in continuing to host the annual Trademark Scholars Roundtable he founded with Mark Janis in 2008.

Bridging Scholarly Communities Worldwide

Bridging gaps between different scholarly communities has been a defining feature not only of Professor Dinwoodie's scholarship but also his institutional leadership. In his first stint at Chicago-Kent College of Law, Professor Dinwoodie edited two symposium issues of the law review that brought together scholars of [IP and Conflicts](#), and [IP and Trade Law](#). And, as only the second UK-based president (after Bill Cornish) of [ATRIP](#), the leading global association of IP scholars, from 2011–2013, he brought the Annual [ATRIP Congress](#) to the United States for only the second time. Likewise, the annual [Trade Mark Scholars Roundtable](#) mentioned above met, along with additional colleagues from the European Union and Australia, at Oxford in 2013. The global reach of Professor Dinwoodie's reputation is highlighted not only by his teaching affiliations and speaking engagements, but also by his membership on advisory boards at educational institutions and IP journals in the United States, the United Kingdom, Canada, Germany, the Netherlands, Australia, and France.