# Topicality

### Notes

This file contains two distinct topicality arguments – one to read against PERA, and one to read against Shop Safe.

While all three affirmatives in the packet are very topical, these violations exist so that you can learn what topicality is and practice it. The arguments in this file lean very heavily in favor of the affirmative.

#### Topicality Strengthen

This argument says that PERA includes more than just reversing Supreme Court decisions that limited patent eligibility. It says that PERA includes new exclusions to eligibility that don’t exist under current law. While overall the PERA affirmative increases eligibility, this argument says that the inclusion of restrictions on eligibility makes the affirmative **extra-topical** (the notion that all parts of the plan must be topical, and that it’s unfair to include things that don’t fit into the topic).

While the 1nc evidence for this violation is good, the affirmative responses are very strong. The affirmative has two main approaches:

1. The 1nc is based on a mischaracterization of PERA. While PERA does codify some eligibility exclusions, those exclusions exist now under current Supreme Court doctrine. The affirmative will say “we meet” the violation, because they only increase eligibility for patents that are not currently eligible. No part of PERA reduces eligibility – it just clarifies that some patents that are currently ineligible will remain ineligible.
2. The affirmative also has a counterdefinition of ‘strengthen’ that says that it refers to the “net effect” on protection. While there is not extension evidence for this, it is a better definition than what the negative can read (and the more accurate reading of the resolution).

#### Topicality Domestic

This argument can only be read against the SHOP SAFE affirmative. It argues that “domestic” means that the plan can only apply in the United States only, and says that the affirmative violates this because there are parts of the SHOP SAFE that are applied **extraterritorially** (outside of US borders).

The 1nc evidence for this violation is also very good. However, the affirmative responses are very strong.

1. The affirmative only applies domestically, even if there are international aspects of e-commerce. It’s only enforced against US service providers, so the affirmative will argue that they meet the violation.
2. The affirmative has a counter-interpretation that says that ‘domestic’ in the context of trademark law means that “the use in commerce” is what had to occur domestically. Even if infringement occurs overseas, if the products are sold or used in the United States, it still counts as ‘domestic’ under the Lanham Act. While the negative has good responses to this, the affirmative cards are from an authoritative Supreme Court decision that settled the issue.

# Topicality vs. Patents

## Negative

### 1NC – Topicality “Strengthen” (PERA)

#### The [first/next] off-case is Topicality “Strengthen”

#### A. Interpretation – strengthen protection means to expand subject matter eligibility

Chrysa K. Kazakou and Walter G. Park, 2021 - \*attorney and \*\*Professor of Economics, College of Arts and Sciences, American University. INTERNATIONAL TRADEMARK AND PATENT INDEX, <https://www.propertyrightsalliance.org/wp-content/uploads/Trademarks-and-Patent-Index.pdf> //DH

Throughout the unprecedented pandemic crisis, there has been a continuing debate about patents for medicines. The right balance provides early access to affordable medicines with sufficient flexibility to protect intellectual property (IP). Patents are a part of the solution for the COVID-19 vaccine. Dismantling patent protection is not correlated with IP. In fact, scientists developed vaccines in record time because of the security and resources provided by IP systems.

A trademark recognizes the company's ownership of the brand and legally differentiates it from all other products of its kind. It is an efficient commercial communication tool to capture custom- er attention and make businesses, products, and services stand out. Trademarks safeguard the reputation of businesses and consumers, making them an important part of running a successful company. With a trademark, a business retains exclusive rights to mark its products, with no one

else being allowed to use its symbol, name, or slogan in that region. Trademarks are used as a way of protecting consumers because trademarked companies often work harder to provide quality services and products in order to protect their brand.

Patents provide protection against competitive assets in the business field, giving the right to exclude others from exploiting the patented technology. The inventor must disclose the invention in return for obtaining a time-limited exclusivity so that others may know how to replicate it. Effective patent protection stimulates research and is a key requirement to overall economic growth. Patents have long been considered essential incentives to foster innovation. For both industry and small businesses, patents can convey their innovative spirit as concrete assets of value. The data of the International Trademark and Patent Index 2021 give insight to the protection of intellectual property in each country.

2. STRUCTURE-METHODOLOGY

An index of intellectual property rights (IPR) is based on whether various features of IPR systems exist in the laws or regulations. The level of IPR protection in country n at time t could equal:

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Description automatically generated with medium confidence

Where ☐^1, . . ., ☐^J are the different categories of an IP system, and ωi’s the weights of each category.

Such an approach is developed in Ginarte and Park (1997) and Park (2008) which examine six major categories ((1) duration of protection, (2) coverage (e.g., what is patentable), (3) membership in international treaties, (4) enforcement mechanisms, (5) restrictions on patent scope, such as compulsory licensing and (6) patent applications). They assign equal weights to each of these categories (ωi = 1), but other researchers or practitioners may want to assign different weights. Reynolds (2003) and Park (2005) further develop indices of trademark protection using similar methodologies.

2.1 General Principles

First, the ITI and IPI indices are designed to capture the strength of national IPR laws, not the quality or efficiency of IPR protection. From a social welfare point of view, stronger IPRs create both costs and benefits. Thus, the Index is composed of features measuring the strength of intellectual property rights rather than factors that contribute to the quality or efficiency of IPR systems.

Second, a guiding principle in choosing legal features is not to be exhaustive but selective: that is, to choose those legal features that yield maximum variability across countries. Adding information to the Index that marginally adds variability also dilutes the contribution of the rest of the features in the Index. The marginal value of adding such a factor needs to be weighed against the marginal reduction in value of the previous factors. Furthermore, the information must be widely available across countries. A legal factor may be an important element in the strength of IPR laws (e.g. doc- trine of equivalents), but information about it may only be available for a few countries. Including it will make it difficult to make the Index comparable across countries.

Lastly, it is important to avoid making biased judgements about whether a country’s measured protection level is too low or too high according to the country’s level of economic development; the a priori assumption being that richer countries should have stronger levels of IP protection. In general, this is the case, but there are instances where it is not (i.e. some rich countries have IP weak systems, and some poor economies have strong systems). In such cases, other factors are not held constant (for example, richer economies with weak IP systems may have good educational systems to compensate, or poorer economies with strong IP systems may follow poor fiscal and monetary policies which offset the effects of IPRs). In all these cases, it should be understood that the IPR indices are not measures of economic development. They may be important determinants of development but are not themselves indicators of it.

2.2 The International Trademark and Patent Index 2021

As an overview, the Trademark Index consists of four clusters: (1) coverage; (2) membership in treaties, and (3) procedures (which aggregate duration, restrictions, and enforcement mechanisms) and (4) Trademark applications. Each of the clusters contains a combination of variables that will then be averaged to come up with a cluster score. These clusters can then be combined to create the overall Index. The procedures cluster represents how procedural elements affect the strength of trademark laws from country to country. The cluster contains nine variables that each represents a different aspect of trademark law. In general, procedures in the cluster should strengthen a trademark holder’s position.

The International Patent Index 2021 follows the same methodology – the unweighted sum of six separate scores for: coverage (inventions that are patentable), membership in international treaties, duration of protection (0 to 20 years), enforcement mechanisms, restrictions (for example, compulsory licensing if a patented invention is not sufficiently exploited) and patent applications. This Index measures the strength of patent protection around the countries involved and not the quality of patent systems. The overall grading scale of the International Trademark Index and Patent Index is [0-1], where 1 is the highest value for each cluster and 0 is the lowest value. The variables for the Indices are extracted from all relevant laws published in WIPO’s journal, Intellectual Property, between 1960 and 2021.

Duration

For this category, the statutory duration of protection (in years) is compared to an international standard, namely that of TRIPS. Under TRIPS, the minimum standard duration is 20 years for pat- ents (from the date of patent application) and 7 years for trademarks. Thus, for each of these IPR, a score is obtained (ranging from zero to one) which equals the statutory duration of protection as a fraction of the international standard.

Coverage

IP regimes are stronger if they provide protection for a wider range of subject matter, such as computer programs, genetic innovations, and shapes of symbols. For each IPR – patents and trademarks – a score will be derived which indicates the fraction of a list of subject matter that can be protected. The coverage cluster measures the range of trademarks and patents that can be registered and protected. In general, the more items protected in a law, the stronger the law is for trademark holders.

#### B. Violation. The plan is extra-topical. PERA introduces new exceptions to patent eligibility – that’s the opposite of strengthen

US Inventor, 2023 – US Inventor is a pro-patent interest group “US INVENTOR OPPOSES PERA AS WRITTEN, DEMANDS PUBLIC POLICY JUSTIFICATION” 8/17, <https://usinventor.org/wp-content/uploads/USI-Position-PERA.pdf> //DH **italics in original**

PERA abrogates all judge-made exceptions, including the abstract idea in its preamble (however, not in the law), yet it introduces new exceptions disqualifying entire swaths of technology as ineligible for patent protection. An invention is ineligible if: ‘

*‘(B)(i) Subject to clause (ii), a process that is substantially economic, financial, business, social, cultural, or artistic, even though not less than 1 step in the process refers to a machine or manufacture.”*

Nearly any invention can be categorized as *economic, financial, business, social, cultural, or artistic*. Most inventions implemented in software are claimed as a process. This extraordinarily broad language means that inventions implemented in software are ineligible for patent protection right from the starting gate.

#### C. Prefer our interpretation –

#### Extra Topicality lets the affirmative generate unpredictable advantages from non-topical mechanisms and overcome solvency deficits. All disadvantage ground assumes the affirmative expands patent eligibility, not reduce it – they make it impossible to be negative

#### D. Topicality is a voting issue for fairness and education.

### 2NC – They Say “We Meet”

#### The codification of the abstract ideas exception makes all software inventions ineligible – it’s a net decrease because 50% are approved now

US Inventor, 2023 - US Inventor is a pro-patent interest group “US INVENTOR OPPOSES PERA - DEMANDS PUBLIC POLICY JUSTIFICATION” <https://usinventor.org/wp-content/uploads/USI-Position-PERA-Markup_Final.pdf> //DH

In 2014, the Supreme Court invented an exception to patent eligible subject matter called the abstract idea. This decision made many software inventions ineligible for patent protection. No other country, including China, has a similar exception. In a 2017 study, ~1700 inventions were not granted patents in the US, but their companion applications were granted patents in Germany or China, and ~50% of patents challenged as abstract ideas are invalidated in the US. Investment that once fueled US startups has fled to startups in China, and Big Tech monopolized by stealing the inventions of startups. China now leads the world in 37 of 44 technologies critical to our national security and economic growth. 60% of those 37 technologies are directly related to the abstract idea that handicapped US innovation in fields of artificial intelligence, cybersecurity, 5G/6G, quantum computing, fintech and many other critical software related technologies.

While the PERA claims to abrogate the abstract idea exception, it does not. In fact, it codifies it, enshrining this national security disaster in black letter law. What is the public policy justification for handicapping US innovation in ways no other country does?

The Abstract Idea

The abstract idea test removes the computer from the patent and then looks at what is left. Once the computer is removed, only math or logic remain so the invention is deemed an abstract idea.

A method of evaluating claims called insignificant extra solution activity is used to determine if an inventor is just taking an abstract idea and adding a computer to make it eligible for patenting. The evaluation removes conventional and routine computer activities from the claim language, which are things like sending, receiving, printing, saving, etc. What’s left is math or logic that can be performed with a pencil and paper, or in your mind, and the invention is deemed an abstract idea.

PERA’s New Exception

The first step of PERA’s exception declares all software inventions ineligible to patent if it “is substantially economic, financial, business, social, cultural, or artistic, even though not less than 1 step in the process refers to a machine or manufacture.” [(3)(b)(1)(B)(i)]. PERA explicitly disregards conventional and routine computer activities in the same way as insignificant extra solution activity testing does for the abstract idea.

The second part can return the invention to eligibility “if the process cannot practically be performed without the use of a machine or manufacture.” [(3)(b)(1)(B)(ii)] Since it is impossible to prove a negative, the inverse must be proven – can the invention be performed without computer (a machine)? To do that, conventional and routine computer activities must be removed from the claims to see what is left. Just like the abstract idea test, all that is left is math or logic. Math or logic can be performed with pencil and paper, or in your mind, which is a way in which the invention can be performed without a computer, thus the invention cannot be returned to eligibility. It is effectively the same test as the abstract idea, and it will bring the same results.

### 2NC – They Say “Counterinterpretation: Net Effect”

#### Strengthen doesn’t imply net effect – restrictions on eligibility weaken IPR

Chrysa K. Kazakou and Walter G. Park, 2021 - \*attorney and \*\*Professor of Economics, College of Arts and Sciences, American University. INTERNATIONAL TRADEMARK AND PATENT INDEX, <https://www.propertyrightsalliance.org/wp-content/uploads/Trademarks-and-Patent-Index.pdf> //DH

In many IP systems, intellectual property laws create rights and obligations. In certain cases, IP laws impose conditions or limitations which restrict the exercise of IPRs. This category measures the extent to which IP laws do not impose certain restrictions. That is, IP laws are stronger if they do not impose such restrictions (or weaker if they do). These conditions or limitations may well improve social welfare or economic efficiency, or they may not; but from the point of view of the rights holders, these conditions, limitations, or restrictions reduce the strength or level of protection.

## Affirmative

### 2AC – “Topicality Strengthen” vs. PERA

#### 1. We meet. PERA expands patent eligibility. The exceptions it codifies exist now

Philip S. Johnson, 2024 - Chair of the Steering Committee of the Coalition for 21st Century Patent Reform, JD from Harvard. Answers to Questions for the Record from Senator Alex Padilla, before the Intellectual Property Subcommittee of the Judiciary Committee of the United States Senate on “The Patent Eligibility Restoration Act – Restoring Clarity, Certainty, and Predictability to the U.S. Patent System,” January 23, <https://www.judiciary.senate.gov/imo/media/doc/2024-01-23_-_qfr_responses_-_johnson.pdf> //DH

As explained in my written testimony, the Eligibility Exclusions of Subsection 101(b) have been added to PERA to reassure its critics that items that never would have been eligible for patenting under prior to the recent Supreme Court’s activity will still be ineligible for patenting. Subsection 101(b) codifies five eligibility exclusions.

#### 2. Counter-interpretation. Strengthen means looking at the net effect of a law

Gregory N. Mandel, 17 - Dean & Peter J. Liacouras Professor of Law, Temple University. “Institutional Fracture in Intellectual Property Law: The Supreme Court Versus Congress” Minnesota Law Review, 102:803 <https://www.minnesotalawreview.org/wp-content/uploads/2018/01/Mandel_MLR.pdf> //DH

I constructed a database of every Supreme Court opinion implicating patent, copyright, trademark, or trade secret issues from July 1, 2002 through June 30, 2016. The database entries are the Supreme Court’s final decision in each matter; certiorari dispositions are not included. I removed from the database any cases that, though referring to intellectual property law, did not actually decide any intellectual property issue. For example, Illinois Tool Works, Inc. v. Independent Ink, Inc. concerned whether there should be a presumption of market power under antitrust law where the product in question is subject to patent protection.7 Though this case bears a relation to patent protection, its result did not turn on or affect patent law. The final Supreme Court database includes forty-four intellectual property decisions and is summarized in Appendix A. Using similar methods, I developed a database of every federal statute concerning patent, copyright, trademark, or trade secret rights during the same time period. As with the Supreme Court data, I removed statutes that did not actually affect patent, copyright, trademark, or trade secret doctrine. For example, the Lanham Act is the primary statute providing for Federal trademark protection in the United States.8 Portions of the Lanham Act regulate nontrademark activities, such as false advertising.9 Legislation that affected only the false advertising portions of the Lanham Act was excluded from the database. The final dataset includes forty-three legislative entries for the pertinent period and is summarized in Appendix B.10 The following sections analyze the contours of intellectual property activity in these Supreme Court and congressional datasets.

A. SUPREME COURT DECISIONS

The primary variable for analysis is whether a given Supreme Court decision or legislative action strengthened or weakened intellectual property protection. Consistent with prior research in this context, strengthened versus weakened refers to the extent of protection afforded to the intellectual property rights owner.11 Accordingly, Supreme Court decisions that make it easier to acquire intellectual property rights; broaden the scope of intellectual property protection; make it easier to prove infringement; or strengthen remedies for infringement are all considered to strengthen intellectual property protection. Decisions that have the opposite effects weaken protection.12

**(footnote 12)**

12. Consistent with the standard approach applied in analyzing the ideological direction of Supreme Court decisions, whether a given decision strengthened or weakened intellectual property rights was determined based on the net effect on intellectual property law with respect to the issue at hand, not based simply on whether there was a change from the status quo. See, e.g., Lee Epstein & Andrew D. Martin, Does Public Opinion Influence the Supreme Court? Possibly Yes (But We’re Not Sure Why), 13 U. PA. J. CONST. L. 263, 272 (2010) (applying this methodology to code decisions as liberal versus conservative); Isaac Unah et al., U.S. Supreme Court Justices and Public Mood, 30 J.L. & POL. 293, 307–10 (2015) (same); The Supreme Court Database, WASH. U. L. SCH., supremecourtdatabase.org (last visited Nov. 5, 2017) (same). Thus, Eldred v. Ashcroft, 537 U.S. 186 (2003), is coded as strengthening intellectual property rights because it upheld the Copyright Term Extension Act against a constitutional challenge. As the statutory name implies, the Copyright Term Extension Act extended owner’s copyright terms. Though upholding the law effectively maintained the status quo, the Court’s decision on the issue before it favored greater protection.

#### 3. Predictability – Mandel is a comprehensive study of all IP protection in the US – their interpretation of ‘strengthen’ is arbitrary with no intent to define

#### 4. No ground loss – if the net effect is to strengthen, they get every disadvantage link

#### 5. Topic education – PERA is the biggest patent reform law in the literature, it’s the core controversy

#### 6. Extra topicality is good. It increases ground; PICs check topic irrelevant offense.

#### 7. Prefer reasonability. Competing interpretation encourage a race to the bottom of the most self-serving definitions, which crowds out substance.

### 1AR – “We Meet”

#### US Inventor is wrong – these exceptions exist now, PERA just codifies them in addition to expanding eligibility

Judge Paul Michel (Ret.), 2023 – former Chief Judge of the US Court of Appeals for the Federal Circuit “Passing PERA Assures Patent Eligibility for All Useful Inventions” 9/5, <https://ipwatchdog.com/2023/09/05/passing-pera-assures-patent-eligibility-useful-inventions/id=166270/> //DH

Four years ago, the Senators’ initial reform effort stalled because of internal disagreements among pro-invention stakeholders. This dynamic reappeared with the August announcement by one organization in the independent inventor community, US Inventor, of its opposition to the bill as written.

Arguments that the bill codifies the Supreme Court case law, such as Mayo and Alice, are clearly incorrect. It does the opposite. In fact, it bars all courts from defining categories of eligibility or ineligibility.

These inventors also complain that the bill excludes “wide swaths” of important technology. But any such conclusion depends on a gross misreading of the bill’s operative terms.

PERA Does Not Exclude All AI Inventions

Their claims that it excludes all artificial intelligence inventions are similarly incorrect. The bill clearly includes them. The bill merely excludes bare algorithms unattached to computers or other devices. But they were never eligible under the old case law anyway, because they lacked what the U.S. Patent and Trademark Office (USPTO) calls “utility.” Section 101 of the Patent Act, the eligibility section, always requires that claimed inventions be “useful”, which courts have long defined as having specific, present, practical application. How could they do less when the Constitution authorizes patents for the “useful arts?”

In any event, a “bare algorithm”, like a mathematical formula, was never eligible as not amounting to an actual “invention” or protectable “discovery.” Therefore, there is no need to restore eligibility.

To be eligible, a “process”, the word in section 101—that is, a method of doing something—cannot include those that speculatively might someday find a practical use, but which cannot be described today. The practical use must be known and discernable from reading the patent.

The Bill Draws a Sensible Line on Business Method Patents

Another criticism concerns so-called “methods of doing business,” a hopelessly ambiguous category. The bill does not exclude all of what might be considered business methods. But neither does it include them all. Instead, it draws a sensible and enforceable line, as follows: If a particular business method depends for its practical implementation on a computer or other device, it is eligible. If, however, as a practical matter it can be implemented solely in the human mind or by a person using only pencil and paper, or otherwise unaided by tangible technology, it is not.

If the complaining inventors want pure algorithms and mathematical formulas to be eligible, that is precluded by sound precedents of long and settled lineage. The primary reason is they inherently lack specific, present, practical uses. Accordingly, Congress certainly will not, nor should it try to alter that rule. Moreover, these inventors have not defined specific algorithms or other creations they consider properly eligible under historic understandings of patent law but that would be excluded under the language of the bill. I suggest that is because they cannot.

#### PERA codifies some current exclusions to eligibility, but eliminates most of them

Kia Freeman and Ian Sterlin, 2023 – patent attorneys at McCarter & English “Senators Kick off Bipartisan Patent Reform Effort” 6/29, <https://www.mccarter.com/insights/senators-kick-off-bipartisan-patent-reform-effort/> //DH

PERA would effectively scrap most of the Supreme Court’s decisions on patent eligibility. First, PERA eliminates court-created exceptions to eligibility for patent protection. PERA nonetheless retains a few exceptions—including mathematical formulas, mental processes, and unmodified natural materials, which cannot be patented—by codifying them. Second, PERA reinforces the distinction of statutory patent requirements by barring consideration of other grounds for invalidity (namely, novelty, obviousness, and enablement) as part of an eligibility analysis. Third, PERA requires technology to be considered as a whole. In sum, PERA seeks to expand the technology that is eligible for patent protection and improve the certainty that the Patent Office’s determination that a technology is eligible for patent will hold up in litigation.

# Topicality vs. Trademarks

## Negative

### 1NC – Topicality “Domestic” vs. SHOP SAFE

#### The [first/next] off-case is Topicality “Domestic”

#### A. Domestic means the plan must exclusively create protection within the United States

Kellie Kunkle, 2023 – “Understanding The Difference Between Domestic And International Intellectual Property Law” Intellectual Property Law, 8/31, <https://www.intipsa.com/what-is-the-difference-between-domestic-and-international-intellectual-property-law> //DH

Intellectual property (IP) law is a complex and ever-evolving field, with different rules and regulations governing different countries. It is essential to comprehend the distinction between domestic and international IP law to guarantee that your IP rights are secured. Domestic IP law is the set of laws that control intellectual property inside a particular nation. These laws are typically set up by the legislature of that nation and are intended to secure the privileges of people and organizations to their intellectual property.

This incorporates patents, trademarks, copyrights, trade secrets, and other forms of IP. Domestic IP law is usually enforced by the courts of that country, although some countries may have international agreements in place that allow for enforcement of IP rights in other countries as well. International IP law, then again, is a set of laws that control intellectual property across multiple countries. These laws are typically established through international treaties or agreements between countries.

International IP law is intended to give a uniform set of rules for protecting IP rights across multiple countries. This incorporates giving assurance for patents, trademarks, copyrights, trade secrets, and other forms of IP. International IP law is usually enforced by international courts or tribunals. The primary contrast between domestic and international IP law is that domestic IP law applies just inside a particular nation, while international IP law applies across multiple countries. Domestic IP law is typically more prohibitive than international IP law, as it is intended to secure the privileges of people and organizations within a particular country.

#### B. Violation - Enforcement against trademark counterfeiting is extraterritorial, not domestic

Kari Kammel, et al, 2023 – Director of the Center for Anti-Counterfeiting and Product Protection at Michigan State University and an adjunct professor of law at MSU College of Law“Trademark Counterfeiting Enforcement Beyond Borders: The Complexities of Enforcing Trademark Rights Extraterritorially in a Global Marketplace with Territorial-Based Enforcement,” 33 Fordham Intell. Prop. Media & Ent. L.J. 595 (2023). https://ir.lawnet.fordham.edu/iplj/vol33/iss3/3 //DH

Today, e-commerce and the sale of products occurs on a global scale. Whereas commerce and the trade of goods used to be done almost entirely within a territory or through goods moving across borders, the global supply chain now has many different forms and can cross many borders, jurisdictions, and the online space. While reaching consumers has become easier for sellers, protecting intellectual property has become increasingly complex. Globalization is prompting a reevaluation of this field as the Internet reduces the importance of national borders. Trademarks are particularly susceptible to the effects of globalization because, unlike copyrights and patents, trademark law is perceived, at least in the United States, to “extend across national borders.”1 In this paper, we focus on the enforcement of trademark rights, particularly those used against counterfeiters. We examine the concept of extraterritorial enforcement of trademark rights—the extending of enforcement across national borders—and review how different countries and jurisdictions approach this practice. In order to examine extraterritoriality in this context, we need to review the history and basis of jurisdiction. In the global enforcement of intellectual property rights, a general principle of territoriality exists.2 This principle exists beyond the scope of intellectual property and goes to the root of international law, noting that countries, or nation-states, can only enact and enforce laws within their own territory.3 This concept originates in public international law and can be found in international intellectual property conventions and treaties, such as the Agreement on Trade-Related Aspects of Intellectual Property Rights,4 the Madrid Agreement Concerning the International Registration of Marks,5 and the Protocol Relating to the Madrid Agreement.6 However, while spelling out details of enforcement in intellectual property, these international agreements contain only minimum standards,7 and each individual country must have domestic implementing legislation to enforce that law and fulfill their treaty obligations.8 Once a country creates and implements domestic legislation, the executive, judiciary, or other appropriate government body interprets the laws, which is often where we see the doctrine of extraterritoriality arise.9

#### C. Prefer our interpretation –

#### 1. Limits – allowing teams to act internationally explodes the research base by including extraterritoriality, international law, and harmonization with other countries

#### 2. Ground – their interpretation artificially expands aff ground to include unpredictable advantages like international money laundering enforcement – they could claim specific country advantages or treaties

#### D. Topicality is a voting issue for fairness and education.

### They Say: “Counterinterpretation – Used in Commerce”

#### Domestic means the plan can only apply to actual harm in US commerce. Their interpretation means anything that could potentially affect commerce would be topical

JEFFREY A. LAMKEN, 2022 – Counsel of Record for Arbitron. Brief for Petitioners in the case ABITRON AUSTRIA GMBH, ET AL., Petitioners, v. HETRONIC INTERNATIONAL, INC. Respondent.

<https://www.supremecourt.gov/DocketPDF/21/21-1043/250394/20221219183705310_Abitron%20-%20Brief%20for%20Petitioners.pdf> //DH

II.A-B. The government agrees the Lanham Act does not apply extraterritorially. It suggests that applying the Act to a foreign sale represents a “domestic” application if the “effect” of that sale might be U.S. consumer confusion. That argument is waived and without merit. The Lanham Act requires “use in commerce.” Because the Act’s definition of “commerce” does not extend to foreign conduct, the “use in commerce” must be *in the United States.*

Likewise, the Act’s text and structure make clear that its “focus” is trademarks’ “use in commerce.” It is that “use” that must be domestic. The government suggests that the statute’s “focus” is consumer confusion, such that the Act is applied “domestically” to foreign conduct if that conduct has the potential “effect” of confusing U.S. consumers. But extraterritoriality is primarily concerned with *conduct*, not *effects*. The government’s standard is a test for determining when an *extraterritorial law* should cover foreign conduct—not distinguishing extraterritorial from domestic application. The government’s test gives the statutory term “use in commerce” inconsistent meanings. It is unpredictable, threatens international friction, and serves little practical purpose.

III.A. The Tenth Circuit’s diversion-of-foreign-sales theory—that the Lanham Act applies extraterritorially whenever *U.S.* plaintiffs claim lost *foreign* sales—distorts the Act beyond recognition. It is divorced from statutory text; exceeds the commerce power; and would impose a protectionist regime in breach of treaty obligations.

#### E-Commerce by definition has a cross-border application

Kari Kammel, et al, 2023 – Director of the Center for Anti-Counterfeiting and Product Protection at Michigan State University and an adjunct professor of law at MSU College of Law“Trademark Counterfeiting Enforcement Beyond Borders: The Complexities of Enforcing Trademark Rights Extraterritorially in a Global Marketplace with Territorial-Based Enforcement,” 33 Fordham Intell. Prop. Media & Ent. L.J. 595 (2023). https://ir.lawnet.fordham.edu/iplj/vol33/iss3/3 //DH

Despite the seemingly territorial nature of trademarks, the sale of trademarked goods on e-commerce and social media have exponentially increased the amount of cross-border transactions, and therefore also the amount of infringing goods sold online across multiple jurisdictions. Because infringers can reach potential consumers of goods and services anywhere in the world, a tension now exists between the territorial nature of a trademark and the global nature of the potential consumer. The basis for extraterritorial reach is mainly “to either prevent spillovers from extraterritorial activities into the local market (inbound regulation) or to protect and enforce the interests of the rightsholders also in other territories by implementing the local IP regime (outbound regulation).”19

## Affirmative

### 2AC – “Topicality Domestic” vs. SHOP SAFE

#### 1. We meet – the plan only holds platforms liable for infringing activity. These are companies with US addresses

#### 2. Counterinterpretation – “Domestic” means “used in commerce domestically.” Infringement in other countries is “domestic” if counterfeits are sold to US consumers.

Ketanji Brown Jackson, 2023 – justice of the US Supreme Court, concurring opinion in a 9-0 decision. ABITRON AUSTRIA GMBH ET AL. v. HETRONIC INTERNATIONAL, INC. 6/29, <https://www.supremecourt.gov/opinions/22pdf/21-1043_7648.pdf> //DH

Because it is “use in commerce”—as Congress has defined it—that “provides the dividing line between foreign and domestic applications of ” these provisions, ante, at 14, the permissible-domestic-application inquiry ought to be straightforward. If a marked good is in domestic commerce, and the mark is serving a source-identifying function in the way Congress described, §1114(1)(a) and §1125(a)(1) may reach the “person,” §1127, who is “us[ing that m]ark as a trademark,” Jack Daniel’s, 599 U. S., at \_\_\_ (slip op., at 14). But if the mark is not serving that function in domestic commerce, then the conduct Congress cared about is not occurring domestically, and these provisions’ purely domestic sweep cannot touch that person.

Consider an example. Imagine that a German company begins making and selling handbags in Germany marked “Coache” (the owner’s family name). Next, imagine that American students buy the bags while on spring break overseas, and upon their return home employ those bags to carry personal items. Imagine finally that a representative of Coach (the United States company) sees the students with the bags and persuades Coach to sue the German company for Lanham Act infringement, fearing that the “Coache” mark will cause consumer confusion. Absent additional facts, such a claim seeks an impermissibly extraterritorial application of the Act. The mark affixed to the students’ bags is not being “use[d] in commerce” domestically as the Act understands that phrase: to serve a source-identifying function “in the ordinary course of trade,” §1127.

Now change the facts in just one respect: The American students tire of the bags six weeks after returning home, and resell them in this country, confusing consumers and damaging Coach’s brand. *Now*, the marked bags are in domestic commerce; the marks that the German company affixed to them overseas continue “to identify and distinguish” the goods from others in the (now domestic) marketplace and to “indicate the source of the goods.” Ibid. So the German company continues to “use [the mark] in commerce” within the meaning of the Act, thus triggering potential liability under §1114(1)(a) and §1125(a)(1). This result makes eminent sense given the source-identifying function of a trademark.1

In brief, once the marks on its bags are serving their core source-identifying function in commerce in the United States, this German company is doing—domestically—exactly what Congress sought to proscribe. Accordingly, the German company may be subject to liability for this domestic conduct—i.e., it cannot successfully obtain dismissal of the lawsuit on extraterritoriality grounds—even though it never sold the bags in, or directly into, the United States.2

**(footnote 2)**

2I will not attempt to discuss every way in which a marked item might be “in commerce” such that the trademark is being used “in the ordinary course of trade” domestically. §1127. But, in the internet age, one could imagine a mark serving its critical source-identifying function in domestic commerce even absent the domestic physical presence of the items whose source it identifies. See, e.g., 5 J. McCarthy, Trademarks and Unfair Competition §29:56 (5th ed. Supp. 2023) (“The use of an infringing mark as part of an Internet site available for use in the United States may constitute an infringement of the mark in the United States”); 4 id., §25:54.50 (“When an alleged infringing mark is used on the internet, the use is clearly a ‘use in commerce’ ”); 1 id., §3:7 (discussing “evidence of use as a trademark” where “a designation is prominently displayed in a way easily recognized by web users as an indicator of origin”; accord, In re Sones, 590 F. 3d 1282, 1288 (CA Fed. 2009) (observing, with respect to the use-in-commerce requirement, that a “ ‘website [can be] an electronic retail store, and the web page [can be] a shelf-talker or banner which encourages the consumer to buy the product’ ”).

#### 3. Most predictable – it’s from the US Supreme Court interpreting the scope of trademark law. That outweighs limits and ground because it reflects current US law – other interpretations are arbitrary and penalize affirmative research

#### 4. No limits and ground explosion – the “use in commerce” rule limits out treaties and international law. Topical plans must act through US law and US courts

#### 5. Topic education – our affirmative is the core controversy in trademark law and the SHOP SAFE Act is the only trademark law Congress has even considered in the last 4 years

#### 6. Prefer reasonability. Competing interpretation encourage a race to the bottom of the most self-serving definitions, which crowds out substance.

### 1AR – “Topicality Domestic”

#### The infringing activity occurred in the United States and the plan can only be enforced within US territory

Samuel Alito, 2023 – justice of the US Supreme Court, writing the majority opinion in a 9-0 decision. ABITRON AUSTRIA GMBH ET AL. v. HETRONIC INTERNATIONAL, INC. 6/29, <https://www.supremecourt.gov/opinions/22pdf/21-1043_7648.pdf> //DH

“It is a ‘longstanding principle of American law “that legislation of Congress, unless a contrary intent appears, is meant to apply only within the territorial jurisdiction of the United States.”’” Morrison v. National Australia Bank Ltd., 561 U. S. 247, 255 (2010). We have repeatedly explained that this principle, which we call the presumption against extraterritoriality, refers to a “presumption against application to conduct in the territory of another sovereign.” Kiobel v. Royal Dutch Petroleum Co., 569 U. S. 108, 119 (2013) (citing Morrison, 561 U. S., at 265). In other words, exclusively “‘[f]oreign conduct is generally the domain of foreign law.’” Microsoft Corp. v. AT&T Corp., 550 U. S. 437, 455 (2007) (alteration omitted). The presumption “serves to avoid the international discord that can result when U. S. law is applied to conduct in foreign countries” and reflects the “‘commonsense notion that Congress generally legislates with domestic concerns in mind.’” RJR Nabisco, Inc. v. European Community, 579 U. S. 325, 335–336 (2016).

Applying the presumption against extraterritoriality involves “a two-step framework.” Id., at 337. At step one, we determine whether a provision is extraterritorial, and that determination turns on whether “Congress has affirmatively and unmistakably instructed that” the provision at issue should “apply to foreign conduct.” Id., at 335, 337; accord, Kiobel, 569 U. S., at 117 (asking whether Congress “intends federal law to apply to conduct occurring abroad”); Nestlé USA, Inc. v. Doe, 593 U. S. \_\_\_, \_\_\_ (2021) (slip op., at 3). If Congress has provided an unmistakable instruction that the provision is extraterritorial, then claims alleging exclusively foreign conduct may proceed, subject to “the limits Congress has (or has not) imposed on the statute’s foreign application.” RJR Nabisco, 579 U. S., at 337–338.

Step two does not end with identifying statutory focus. We have repeatedly and explicitly held that courts must “identif[y] ‘the statute’s “focus”’ and as[k] whether the conduct relevant to that focus occurred in United States territory.” Id., at \_\_\_ (slip op., at 5) (emphasis added); accord, e.g., RJR Nabisco, 579 U. S., at 337. Thus, to prove that a claim involves a domestic application of a statute, “plaintiffs must establish that ‘the conduct relevant to the statute’s focus occurred in the United States.’” Nestlé, 593 U. S., at \_\_\_–\_\_\_ (slip op., at 3–4) (emphasis added); see, e.g., WesternGeco, 585 U. S., at \_\_\_–\_\_\_ (slip op., at 6–8) (holding that a claim was a domestic application of the Patent Act because the infringing acts—the conduct relevant to the focus of the provisions at issue—were committed in the United States); Morrison, 561 U. S., at 266–267, 271–273 (concluding that a claim was a foreign application of the Securities and Exchange Act because the “purchase-and-sale transactions” at issue occurred outside of the United States).

#### The harm of infringement occurred to domestic companies – that means the plan’s a domestic protection

LAWRENCE K. NODINE, 2022 – counsel of record for the International Trademark Association. “BRIEF OF THE INTERNATIONAL TRADEMARK ASSOCIATION AS AMICUS CURIAE IN SUPPORT OF NEITHER PARTY” in the case of ABITRON AUSTRIA GMBH, ET AL., Petitioners, v. HETRONIC INTERNATIONAL, INC. Respondent.

<https://www.supremecourt.gov/DocketPDF/21/21-1043/250905/20221227154119470_21-1043%20Brief.pdf> //DH

Importantly, the Lanham Act’s focus is not limited to point-of-sale consumer confusion. It is broader, and provides remedies against pre-sale and post-sale confusion, injury to reputation, mistaken affiliation or sponsorship, and dilution. If a foreign actor causes substantial injury in the U.S. in these ways, then it would be a permissible domestic application of the Lanham Act to enjoin or provide compensation for these injuries.

#### Because the harm occurs domestically, the plan’s a domestic application of the Lanham Act

LAWRENCE K. NODINE, 2022 – counsel of record for the International Trademark Association. “BRIEF OF THE INTERNATIONAL TRADEMARK ASSOCIATION AS AMICUS CURIAE IN SUPPORT OF NEITHER PARTY” in the case of ABITRON AUSTRIA GMBH, ET AL., Petitioners, v. HETRONIC INTERNATIONAL, INC. Respondent.

<https://www.supremecourt.gov/DocketPDF/21/21-1043/250905/20221227154119470_21-1043%20Brief.pdf> //DH

THE LANHAM ACT PASSES THE SECOND STEP OF THE RJR NABISCO TEST BECAUSE PREVENTING FOREIGN CONDUCT THAT CAUSES DOMESTIC CONFUSION OR INJURES DOMESTIC REPUTATION IS A PERMISSIBLE DOMESTIC APPLICATION OF THE LANHAM ACT.

Alternatively, if in deciding step one of the RJR Nabisco test the Court rules that the Lanham Act does not rebut the presumption against extraterritoriality, then it proceeds to step two and asks:

[W]hether the case involves a domestic application of the statute, and we do this by looking to the statute’s “focus.” If the conduct relevant to the statute’s focus occurred in the United States, then the case involves a permissible domestic application even if other conduct occurred abroad; but if the conduct relevant to the focus occurred in a foreign country, then impermissible the case extraterritorial involves an application regardless of any other conduct that occurred in U.S. territory.

RJR Nabisco, 579 U.S. at 337. This rubric raises two component questions: first, what is the relevant conduct, and second, what is the focus of the Lanham Act.

2.1 Because Steele was based on reputational injury in the U.S., it reflects permissible domestic application of the Lanham Act.

Importantly, although Steele is widely cited as supporting “extraterritorial” application of the Lanham Act, the Court relied heavily on the domestic impact of Steele’s foreign conduct. The counterfeit watches filtered back into the U.S., causing injury to Bulova’s reputation in the U.S. Moreover, the Steele Court did not make a broad pronouncement that the Lanham Act has extraterritorial effect in all circumstances. Instead, it held that “[i]n the light of the broad jurisdictional grant in the Lanham Act, we deem its scope to encompass petitioner’s activities here.” Id. at 286. (Emphasis added).

Accordingly, Steele may be interpreted in the light of the RJR Nabisco rubric either as a limited extraterritorial application, or as an example of “permissible domestic application” of the Lanham Act without contradicting Steele’s precise holding. Compare WesternGeco LLC v. ION Geophysical Corp., 138 S. Ct. 2129, 2137-38 (2018) (finding, based on the Patent Act’s focus on domestic conduct of exporting from the U.S. certain non-staple components, that a recovery of profits from the resulting foreign sales was a “permissible domestic application” under RJR Nabisco). The requirement of cases such as Vanity Fair and its variants that the foreign conduct must have a substantial impact on U.S. commerce, see Section 2.4, infra, is sufficient to confine the Lanham Act to “permissible domestic applications,” and thereby allow the Court to preserve seventy years of jurisprudence interpreting Steele.

2.2 Preventing domestic consumer confusion and reputational injury is a “permissible domestic application” of the Lanham Act.

Both the cause and the effect of confusion are “conduct relevant to the focus” of the Lanham Act. RJR Nabisco, 579 U.S. at 337. A statute’s focus “is the object of its solicitude, which can include the conduct it seeks to regulate, as well as the parties and interests it seeks to protect or vindicate.” WesternGeco, 138 S. Ct. at 2137 (internal quotation marks omitted) (quoting Morrison, 561 U.S. at 267) (emphasis added). The “object of the [Lanham Act’s] solicitude” is the prevention of various harmful effects, including consumer confusion and injury to the trademark owner’s goodwill. Therefore the “relevant conduct” within the RJR Nabisco formulation is not only the cause of the injury, but also its effect, i.e., the injury (such as confusion or injury to reputation).3

It follows that if foreign conduct causes an effect within the U.S., “then the case involves a permissible domestic application even if other conduct occurred abroad.” RJR Nabisco, 579 U.S. at 337. However, when foreign conduct causes only foreign injury, e.g., only confusion of foreign consumers, then there is no “relevant conduct” in the U.S. and application of the Lanham Act would be

impermissible.

Consequently, a ruling by this Court that the Lanham Act does not rebut RJR Nabisco’s step one presumption against extraterritoriality would not undermine the vast majority of Lanham Act decisions that grant an extraterritorial remedy where foreign conduct caused substantial trademark injury in the U.S. If a Lanham Act claim is brought to prevent domestic trademark-related injury, then it would be a “permissible domestic application” of the statute. And this would be true even if the Lanham Act does not qualify under step one of the RJR Nabisco test.