

Appendix A Case Selection and Coding

This appendix describes the data collection process undertaken for the bird's-eye view of US law in chapter 2 and the additional analysis in chapters 5 and 6. It provides details on the case population that I term the *Steele* progeny—that is, US court opinions between 1952 and 2014.

1 Case Selection

The initial group of opinions was retrieved by searches in the Westlaw and LEXIS databases. Searching legal databases does not always uncover all of the disputes or court decisions on a given topic. Most problematic is the fact that not all decisions are published and thus may not be included in the databases. In addition, many disputes are settled prior to the stage of actual decision making. Limitations of this kind are not easily overcome.¹ Yet this should not make an inquiry into the empirical realities futile. On the contrary, as long as one is aware of the limitations, a closer look at “existing” case law can yield results that help critically analyze and challenge a purely doctrinally or economically founded theory of the law. In addition, a more subtle but no less pressing problem is that of the database search query itself. First, there may have been cases where neither the court nor the parties expounded on the problem of extraterritoriality despite the existence of such an issue.² A second challenge that must be overcome is the courts' use of terminology. A court may discuss

¹ For a discussion of the inherent defects and biases in database searches, see, e.g., Kimberly D. Krawiec & Kathryn Zeller, *Common-Law Disclosure Duties and the Sin of Omission: Testing the Meta-Theories*, 91 Va. L. Rev. 1795, 1884 *et seq.* (2005); Ahmed E. Taha, *Data and Selection Bias: A Case Study*, 75 UMKC L. Rev. 171 (2006).

² Concerning the courts' “blind eye” in respect of extraterritoriality, the final research population actually contains Circuit Court decisions where the lower court did not discuss the issue. See, e.g., *Fun-Damental Too, Ltd. v. Gemmy Industries Corp.*, 111 F.3d 993, 1006 (2nd Cir. 1997). See also, e.g., *Sterling Drug, Inc. v. Bayer AG*, 792 F.Supp. 1357 (S.D.N.Y. 1992); *Scotch Whiskey Ass'n v. Barton Distilling Co.*, 338 F.Supp. 595 (N.D. Ill. 1971); *Scanvec Amiable Limited v. Chang*, No. Civ.A. 02–6950, 2002 WL 32341772 (E.D. Pa., 1 November 2002).

the issue of extraterritoriality without using the word “extraterritorial” or related vocabulary. Even though such a dispute may fit squarely into the research population, a database search that is limited to “extraterritorial” or other iterations would miss it.

As to the first problem, if a court overlooked the issue, or if it was only implicitly handled, the corresponding decision would not appear in the database search results. This deficit, however, is not detrimental to the research results. Again, since my study is intended to analyze how courts have actually handled the issue of Lanham Act subject-matter jurisdiction when confronted with it, my primary interest is in cases where the court has expressly dealt with the problem. With respect to the second problem, I used search methods and terms designed to capture all decisions included in the two databases that made any reference to Lanham Act subject-matter jurisdiction. A search in the Westlaw ALLCASES database with the connectors (trademark! trade-mark! “unfair competition” “lanham act”) and (extraterritorial! extraterritorial! bulova) yielded a total of 1,312 decisions. A search in the LEXIS Federal & State Cases, Combined, database (with identical search terms) yielded a total of 1,328 decisions. To produce the relevant population, I combined both lists. Each court opinion—in other words, majority, concurring, or dissenting—contained in this combined list was then reviewed in order to determine its eligibility for the final research population.

As to the time frame occupied by the research population, I excluded cases that were decided prior to the Fifth Circuit’s and the Supreme Court’s decisions in *Steele v. Bulova*.³ This limits the population of opinions to those made between January 1952 and November 2014 (the latter date being when I conducted the database research). With respect to the subject matter, I further reduced the number of cases. Not unexpectedly, the search brought up a number of cases where the courts dealt with extraterritoriality in a context different from or unrelated to trademark or unfair competition law. These cases were excluded.⁴ Also in this category are decisions not directly dealing with the issue of subject-matter

³ The District Court’s decision in the dispute was not available.

⁴ This notably concerned cases on international copyright, patent, securities, or bankruptcy law. See, e.g., *Litecubes, LLC v. Northern Light Products, Inc.*, 523 F.3d 1353 (Fed. Cir. 2008) (copyright); *In re Maxwell Communication Corp. plc*, 186 B.R. 807, 821 (S.D.N.Y. 1995) (bankruptcy); *Oceanic Exploration Co. v. ConocoPhillips, Inc.*, No. 04–332 (EGS), 2006 WL 2711527 (D.D.C., 21 September 2006) (RICO); *U.S. v. International Broth. of Teamsters*, 945 F.Supp. 609 (S.D.N.Y. 1996) (labor law); *Consolidated Gold Fields PLC v. Minorco, S.A.*, 871 F.2d 252 (2nd Cir. 1989) (securities regulation); *Williams & Humbert, Ltd. v. Ruiz-Mateos*, 18 U.S.P.Q.2d (BNA) 2041 (D.D.C. 1991) (expropriation of trademark rights by foreign government).

jurisdiction, but with *forum non conveniens* or personal jurisdiction.⁵ A different line of cases in this group concerns the issue of holding a party in contempt for violating court orders—for example, a temporary restraining order or an injunction issued in a preceding trademark dispute.⁶ Likewise excluded were scenarios presenting the “reverse, or perhaps the mirror image”⁷ of the *Steele* and *Vanity Fair* constellations. In these cases, the court was concerned not with the extraterritorial scope of US laws but with the ability to gain protection for trademarks *within* the United States.⁸ In addition, the final population does not include cases brought under the Anticybersquatting Consumer Protection Act (ACPA) concerning domain names and websites registered with a US registrar. Even though these cases sometimes smack of extraterritoriality, they are subject to the special rules of the 1999 ACPA and accordingly irrelevant for my inquiry.⁹ Finally, I excluded all cases where the court did not make *substantial* use of the *Bulova*, *Vanity Fair*, or other test factors. I defined “substantial” as including an analysis beyond the mere mention of the issue of subject-matter jurisdiction, the mere citation to the issue, or the mere restatement of another court’s finding on the issue.¹⁰

⁵ See, e.g., *Del Monte Fresh Produce Co. v. Dole Food Co., Inc.*, 136 F.Supp.2d 1271, 1278 (S.D. Fla. 2001); *Royal Gist-Brocades N.V. v. Sierra Prods., Ltd.*, No. CIV. A. 97-1147, 1997 WL 792905 (E.D. Pa., 22 December 1999).

⁶ See, e.g., *Reebok Intern. Ltd. v. McLaughlin*, 49 F.3d 1387 (9th Cir. 1995); *A.V. by Versace, Inc. v. Gianni Versace, S.p.A.*, 87 F.Supp.2d 281 (S.D.N.Y. 2000). Similarly, decisions affirming a preceding court order or adhering to an original decision with mere repetition of the prior court’s reasoning have been excluded. See, e.g., *Tommy Hilfiger Licensing, Inc. v. Costco Companies, Inc.*, No. 99 Civ. 3894(LMM), 2001 WL 262590 (S.D.N.Y., 14 March 2001).

⁷ *Buti v. Perosa, S.R.L.*, 139 F.3d 98, 102 (2nd Cir. 1998).

⁸ One line of cases where this problem comes up is where a court must decide whether certain activities abroad are sufficient to constitute use in commerce and thereby receive US trademark protection. See, e.g., *Buti v. Perosa, S.R.L.*, 139 F.3d 98, 102 (2nd Cir. 1998); *International Bancorp, LLC v. Societe des Bains de Mer et du Cercle des Etrangers a Monaco*, 329 F.3d 359 (4th Cir. 2003); *General Healthcare Ltd. v. Qashat*, 364 F.3d 332 (1st Cir. 2004).

⁹ See, e.g., *Barcelona.com, Inc. v. Excelentísimo Ayuntamiento de Barcelona*, 330 F.3d 617 (4th Cir. 2003); *Harrods Ltd. v. Sixty Internet Domain Names*, 302 F.3d 214 (4th Cir. 2002); *Cable News Network, LP, LLLP v. CNNNews.com*, 56 Fed.Appx. 599 (4th Cir. 2003); *America Online, Inc. v. Aol.Org*, 259 F.Supp.2d 449 (E.D. Va. 2003).

¹⁰ See, e.g., *Commodore Import Corp. v. Hiraoka & Co., Ltd.*, 422 F.Supp. 628, 632 (S.D.N.Y. 1976) (“Having found that no violation of [the Lanham Act] exists, I need not reach the jurisdictional defense raised by defendant . . . that the extraterritorial application of the Lanham Act is inappropriate as to it [citation to *Vanity Fair*]”). For further examples of insubstantial analysis see, e.g., *Toys “R” Us, Inc. v. Abir*, No. 97 Civ. 8673 (JGK), 1997 WL 857229 (S.D.N.Y., 19 December 1997); *Liberty Toy Co. v. Fred Silber Co.*, 149 F.3d 1183 (6th Cir. 1998); *Kashlan v. TCBY Systems, LLC*, No. 4:06-CV-00497 GTE, 2006 WL 2460616 (E.D. Ark., 23 August 2006); *Kolbe v. Trudel*, 945 F. Supp. 1268 (D. Ariz. 1996); *Internet Billions Domains, Inc. v. Venetian Casino Resort, LLC*, No. 01CV5417, 2002 WL 1610032 (E.D. Pa., 31 May 2002).

2 Coding

After the database search and the manual screening and selection, a list of 140 opinions remained to be analyzed. I started by coding all opinions into an Excel spreadsheet. Once the initial case coding (consisting of three rounds) was complete, all of the coding was double-checked by research assistants who had not been involved in my earlier coding.¹¹ The coding instrument's categories—as far as the bird's-eye view undertaken here is concerned—were designed to include (1) general information about each opinion, such as its caption, date, and court level, and (2) specific data regarding both the relations between the *Bulova* factors and the courts' adherence to the common law goodwill paradigm. In this regard, the coding categories include, among other things, the result of the court's analysis with respect to the application or nonapplication of the Lanham Act, the parties' nationalities, and the courts' definition and determination of the three *Bulova* (or *Vanity Fair*) factors. In addition, I coded the definition and finding of certain peculiarities, such as “constructive citizenship.” With respect to the analysis of the common law goodwill paradigm—notably in the form of the effects factor's subfactors—I coded the different categories of subfactors and whether the courts found the respective subfactors (e.g., consumer confusion) to exist within or outside the United States. The final statistical processing was conducted using Stata 14.1. The coding instrument, Excel spreadsheet, and Stata file are available upon request.

¹¹ For problems of data collection and bias in general and with respect to the fact that the data were primarily coded by the author, see, e.g., Robert M. Lawless, Jennifer K. Robbenolt & Thomas S. Ulen, *Empirical Methods in Law* ch. 7 and *passim* (2010); Lee Epstein & Gary King, *The Rules of Inference*, 69 U. Chi. L. Rev. 1 (2002).