

Intellectual property law

DIRECTIONS

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General introduction

Learning objectives

Upon completion of this chapter, you should have acquired:

- an overview of the family of rights called 'intellectual property';
- an appreciation of the debate whether further protection through the action for unfair competition would be desirable;
- an understanding of the common characteristics of intellectual property rights;
- knowledge of some of the theoretical justifications advanced in support of intellectual property rights; and
- an ability to identify the sources which have influenced the current law of intellectual property in the United Kingdom.

Introduction

- The purpose of this chapter is to provide a general introduction to the material which follows. We begin with an overview of the various types of right recognised under United Kingdom law, with a brief account of the principal criteria for the protection and infringement of each one. The overview should be seen as a prelude to the more detailed discussion in subsequent chapters. The opportunity is also taken to debate whether there is a gap in the scheme of protection, as United Kingdom law does not give redress against unfair competition. We then proceed to identify the common characteristics of intellectual property rights and to consider the theoretical justifications which are advanced for them (we shall look further at the theories underpinning each type of right in the chapters dealing with the individual rights). Last, there is an account of the sources of United Kingdom intellectual property law, with particular emphasis on the external forces which have played a major part in shaping domestic law over the last four decades.

1.1

Overview of the different types of right

In *Phillips v Mulcaire* [2012] UKSC 28 at [21] Lord Walker declared that there was no particular potency to the term 'intellectual property'. There was general consensus as to its core content but not as to its limits. The core can be said to consist of the following:

1.1.1 Patents

A patent is concerned with *applied technology*, with how things work, not with abstract ideas. The subject matter of a patent, called an *invention*, can be either a product (a tangible item or thing) or a process (a method of making something or using something or doing something). Whether a patent relates to a product or a process is determined by reference to the wording of its **claims**. Thus, a claim to a product might relate to a new chemical compound, whilst a claim to a process would relate to how to make that compound, or how to use it. A patent might have only a few claims (if it is a relatively simple mechanical invention) or tens of claims. In turn, these claims might be product claims only, or process claims. More complex inventions will have separate product and process claims.

cross reference

Novelty is explained in section 5.5, inventive step in section 5.6.

cross reference

Industrial applicability is explained in section 5.7, the exclusions from and exceptions to patentability in sections 5.3 to 5.4.

The four criteria for patentability are that the invention must be new, contain an inventive step, be capable of industrial application and not fall within the statutory list of **excluded subject matter**. In relation to the first two (sometimes called 'external' criteria), the invention as set out in the patent document (the specification) is compared with all information made available to the public at the date the patent was filed (the **priority date**). Such information is called 'the **prior art**'. The other two so-called 'internal' characteristics of patentability, namely whether the invention is susceptible of industrial application (ie, is useful) or falls outside the

statutory list of exclusions and exceptions, do not involve a comparison with what has been known or used before. Instead they involve an examination of the way in which the claims have been drafted by the **patentee**, and whether these meet the relevant statutory conditions.

A patent can be granted either by the **United Kingdom Intellectual Property Office ('UKIPO')** under the Patents Act 1977, as amended, or by the European Patent Office ('EPO') under the European Patent Convention 1973 ('EPC') as amended in 2000. If the EPO route is chosen, a **European patent**, once granted, is treated as a bundle of national patents. Whether the national or European route is taken, the patent's maximum duration will be 20 years, calculated from the application date, subject to the payment of annual renewal fees from the fifth year onwards. A patent confers on its owner (the **patentee**) the exclusive right to make, offer, dispose of, keep or use the product, or to use or offer the process which is the subject matter of the patent. If another person infringes a patent, the fact that they created the same invention independently is not a defence. A patent is an absolute monopoly.

1.1.2 Copyright

Copyright is the right to stop the copying and distribution of different categories of work. Under the Copyright, Designs and Patents Act 1988 ('CDPA'), works include books, plays, music, paintings, films, sound recordings and broadcasts.

It should not be assumed, however, that United Kingdom copyright law protects only those works resulting from great creativity. Traditionally, the threshold for protection has been very low, so that everyday items (such as lists of TV programmes) are protected. To qualify for protection, the work must be original (meaning 'not copied'), be recorded in a permanent form, and the **author** must be a **'qualifying person'**. Unlike other statute-based forms of intellectual property, copyright protection does not depend on registration, but arises automatically once the work is created and recorded. Copyright protection lasts for a long time, generally speaking the lifetime of the author plus 70 years. The copyright owner has the exclusive right to stop anyone else from reproducing the work (that is, copying it); issuing (that is, distributing) *tangible* copies of the work (including renting out copies); performing the work in public; communicating the work to the public by *intangible* means (either by broadcast or the internet); or adapting the work. They also have the right to stop secondary infringers, such as retailers, dealing in infringing copies of the work by way of trade. However, to succeed in a copyright infringement action, the owner has to prove their work has been copied. Independent creation is therefore always a defence to copyright infringement.

1.1.3 Designs

The law of designs is concerned with the appearance of **products**, that is, with *how things look*. In design law, what is protected is not the underlying **article**, which could be an everyday item such as a teapot (*Ocular Sciences Ltd v Aspect Vision Care Ltd* [1997] RPC 289 at p. 422) but the design features applied to it. Under United Kingdom law, a designer has three potential means of protecting their design, namely registered design protection, unregistered design right or copyright. Under EU law, a designer has two further options, namely an EU registered or unregistered design right. We shall, however, be concerned only with the United Kingdom system of protection.

cross reference

Originality and qualification for protection are explained in sections 8.2 and 8.3. Section 8.2 also considers whether the traditionally low threshold for United Kingdom copyright protection can continue in the light of EU developments.

cross reference

Registered designs are explained in section 11.2.

In the case of registered designs, the criteria for protection under both the Registered Designs Act 1949 ('RDA'), as amended, and EU law, are that the design must be new and have 'individual character'. The latter phrase means that the design must produce on the **informed user** (a potential customer but not necessarily a consumer of the product) an overall impression which is different from that of previous designs. A United Kingdom registered design is granted by the Designs Registry (part of UKIPO) whilst an **EU design** is granted by the **Office for Harmonisation in the Internal Market (Trade Marks and Designs) ('OHIM')**. Each lasts for a maximum of 25 years, calculated from the application date, subject to the payment of renewal fees every five years. A registered design confers on its owner the exclusive right to prevent anyone else from using the design on *any* product, ie, from making, offering, putting on the market, importing, exporting, using or stocking a *product* in which the design is incorporated or to which it is applied. Like patents, independent creation is not a defence to an action for registered design infringement, so a registered design is also an absolute monopoly.

For some industries, especially those in which the design of products changes rapidly, the formality and delays inherent in a registration system are felt to be inappropriate. The alternative means of protection is the **unregistered design right**. Under United Kingdom law, this is a copyright-type right to protect *the shape or configuration of the whole or part of an article*. The right arises automatically, without the need for registration, once the design has been created and recorded. The criteria for protection under Part III of the CDPA are that the design must be **original** (in the copyright sense), not **commonplace**, and recorded in a design document. The duration of protection is, however, much shorter than copyright, with a maximum period of protection of 15 years from creation, reduced further to 10 years from first marketing if articles bearing the design are sold anywhere in the world within five years of the design having been created. The design right owner has the exclusive right to stop anyone else from reproducing the design (ie, copying it) by making articles for commercial purposes, and the right to stop anyone else dealing in infringing copies by way of trade. To succeed in a design right infringement action, the owner has to prove that their design was copied, so that independent creation is a defence to design right infringement, just as it is to copyright infringement.

cross reference

The unregistered design right is explained in section 11.4.

cross reference

Copyright protection for designs is explained at section 11.3.

Lastly, under United Kingdom law, a designer may be able to claim copyright protection (just as they could before the CDPA) for the appearance of an article. The CDPA curtails the availability of copyright as a matter of public policy, echoing the decision in *British Leyland v Armstrong Patents* [1986] AC 577. Copyright may be claimed where the article is an artistic work in its own right, for example, a sculpture or a work of artistic craftsmanship, such as hand-carved furniture. The criteria for and scope of protection are the same as for copyright.

1.1.4 Trade marks

A **trade mark** is a **sign** or symbol used in the course of trade to indicate the origin of goods or services. It is an integral part of consumer society, enabling customers to distinguish one product from another and to choose between competing brands, returning to those which have given satisfaction and avoiding those which have not. Under United Kingdom law, a trader can choose between two means of protection, either registration, or bringing an action in tort for **passing off**. In relation to registration, there are further choices, either obtaining a United Kingdom registration from the Trade Marks Registry under the provisions of the Trade Marks Act 1994 ('TMA'), or by obtaining an **EU trade mark** from OHIM (valid for all the Member

cross reference

The definition of 'trade mark', and the absolute and relative grounds for refusal are explained in sections 14.3, 14.4 and 14.5 respectively.

cross reference

Revocation and invalidity of trade marks are dealt with in section 15.5, infringement in section 15.3.

cross reference

Passing off is considered in chapter 13.

States of the EU) under the terms of the Community Trade Mark Regulation. Again, this book will concern itself with the United Kingdom system.

In the case of registered trade marks, the criterion for protection (identical under both domestic and EU law) is that there must be a sign which is capable of graphic representation and capable of distinguishing the goods or services of one undertaking from those of another. It must not fall within the list of **Absolute Grounds** for refusal (that is, objections which relate to the inherent nature of the mark itself), nor must it fall within any of the **Relative Grounds** for refusal (that is, it must not conflict with any prior rights).

Once registered (by whichever route is taken to obtain protection), a trade mark is capable of lasting indefinitely, subject only to the payment of renewal fees every 10 years. Registration does not mean that the mark is safe from counter-attack. Where the proprietor has failed to look after the mark, the mark is vulnerable to an action for **revocation** by any third party, and like any other registered intellectual property right, a third party can always seek to have the registration declared **invalid** because it does not comply with the statutory requirements. Registration gives the proprietor the exclusive right to prevent others from using the same or similar sign in the course of trade in relation to the same or similar goods or services (or, in some instances, dissimilar goods or services) for which the mark is registered.

However, it is not compulsory for a trader to register the brand name they wish to use in the course of trade. Protection for unregistered trade marks (sometimes called 'common law' trade marks) is available through the tort of passing off. Passing off is entirely judge-made law. At times the cases appear to be contradictory. The inconsistencies may in part be explained by the fact that passing off is highly dependent on the circumstances of each case and on the quality of evidence put forward by the claimant.

case close-up**Reckitt & Colman v Borden (JIF LEMON)** [1990] 1 WLR 491

It is generally accepted that the basic ingredients of passing off are as stated by Lord Oliver in *Reckitt & Colman v Borden (JIF LEMON)* [1990] 1 WLR 491. To be successful, the claimant must prove that:

- his name, trade mark, logo or other visual symbol has, through use, acquired a reputation which has generated business **goodwill**;
- that the defendant, by using this symbol, has made a misrepresentation in the course of trade to customers that his goods or services are in some way 'connected with' the claimant; and
- that the claimant has suffered or will suffer damage to his business goodwill as a result.

The onus is on the claimant to prove each element of the *JIF LEMON* definition. If any one of these ingredients is missing, the passing off action will fail. This may help to explain why registering a trade mark is preferable to relying on the vagaries of the passing off action.

cross reference

Breach of confidence is dealt with in chapter 3.

1.1.5 Confidential information

The action for **breach of confidence** is the means of protecting trade secrets. It can also be used to protect personal and state information, but not information already known to the

public ('in the public domain'). It is the one area of intellectual property providing protection for ideas themselves, as opposed to their tangible embodiment in **inventions, works**, brand names or the appearance of products. The action for breach of confidence is another area of intellectual property law which does not depend on statute, but on case law.

case close-up

Coco v AN Clark (Engineers) Ltd [1969] RPC 41

The accepted ingredients of the action for breach of confidence were set out by Megarry J in *Coco v AN Clark (Engineers) Ltd* [1969] RPC 41 at p. 47. They require the successful claimant to prove that:

- there existed confidential information;
- the defendant owed the claimant a duty of confidence (which may be inferred from the circumstances, such as the parties being in a joint venture); and
- there has been breach of that duty by the misuse or wrongful disclosure of that information by the defendant.

example

Imagine that Household Appliances plc is about to launch a new type of toaster. The toaster is to be marketed under the name BROWNIE. Its shape is unusual, and its sides are decorated with pictures of country landscapes. A special safety feature is that the outside walls of the toaster are made from a new metal alloy which is very light but which does not conduct heat, so that the outside remains cool to the touch. The metal alloy is obtainable only from certain specialist suppliers, the identity of whom is known only to the company.

From this information, the intellectual property rights relevant to the features of the toaster are as follows:

- the name BROWNIE, could be protected as a trade mark. Dependent on the size of its business, the company could register the name just in the United Kingdom or throughout the EU; alternatively, once the name has been used so that goodwill has been established, it could seek protection under the tort of passing off;
- the shape of the toaster could be protected as a design. Again, the company has a choice whether to seek registration either nationally or under the EU system, or rely on national or EU unregistered design protection. The toaster is unlikely to be treated as an artistic work in its own right, so copyright protection would not be available;
- the picture on the side of the toaster, however, could be protected as an artistic work under copyright law;
- the metal alloy used in the outer wall could be protected by a patent, provided the invention satisfies the requirements of patentability in the Patents Act 1977; and
- the list of suppliers of the alloy could amount to confidential information.

1.2

The absence of any protection against unfair competition in United Kingdom law

1.2.1 The Paris Convention obligation

Despite the wide range of items protected by intellectual property law, there appears to be a gap in the United Kingdom régime. There is no protection for a business against **unfair competition**. By 'unfair competition' we mean conduct which, whilst not amounting to infringement of a specific intellectual property right, involves taking advantage of or benefiting from the effort, skill and investment of another enterprise in such a way as to affect that enterprise's ability to compete. It may conveniently, if emotively, be described as 'free-riding' or 'reaping without sowing'. Unfair competition should be distinguished from competition law, which seeks to regulate the conduct of businesses who seek to restrict competition from others by means of cartels or monopoly power.

Many other EU Member States, for example France and Germany, have specific laws against unfair competition. As Gerhard Schricker explains (in 'Twenty-five Years of Protection against Unfair Competition' (1995) 26 *IIC* 782), these derive from provisions in the **Paris Convention** for the Protection of Industrial Property 1883. The Paris Convention principles on unfair competition came at a relatively late stage of the development of industrial property and can be regarded as no more than a basic outline. Besides giving redress to businesses affected by unfair conduct (the main thrust of unfair competition is to protect competitors), action may be brought to protect consumers and even the public interest in general. Examples include misleading advertising, price discounting and loss-leading. Schricker & Henning-Bodewig (in 'New Initiatives for the Harmonisation of Unfair Competition Law in Europe' [2002] *EIPR* 271) point out that within those countries which do have protection against unfair competition considerable divergences exist and that the United Kingdom and Ireland stand out as EU Member States who do not have such protection.

Article 10*bis* of the Paris Convention contains the basic obligation for its Contracting States to provide effective redress against unfair competition. 'Unfair competition' is defined as being 'any act of competition contrary to honest practices in industrial or commercial matters'. The Article gives a non-exhaustive list of examples, including creating confusion with the activities of a competitor, making false allegations in the course of trade such as to discredit a competitor, and misleading the public as to the nature of goods.

It has been argued that there *ought* to be effective redress against unfair competition under United Kingdom law. At least three unsuccessful attempts have been made since 1994 to introduce this by statute, but the official Government response in blocking such proposals has always been that the existing law of passing off is adequate. In 2006, the *Gowers Review of Intellectual Property* received a number of submissions calling for the introduction of a general unfair competition law. It noted that the EU had legislated to regulate unfair business-to-consumer transactions by means of Directive 2005/29/EC of the European Parliament and of the Council of 11 May 2005 [2005] OJ L 149/22 (the 'Unfair Commercial Practices Directive') but added that the Directive might not provide sufficient redress for

cross reference

The Paris Convention is explained at section 1.5.1.1.

unfair 'business-to-business' anti-competitive practices (although Wadlow in 'The Emergent European Law of Unfair Competition and its Consumer Law Origins' [2012] *IPQ* 1 argues to the contrary). The Gowers Review identified (in para 5.82) one area of activity where legislation might be desirable, namely copycat packaging of famous brands by supermarkets, recommending that the Government should monitor whether current measures to combat unfair competition were effective and if need be consult on appropriate changes. No action has so far been taken.

1.2.2 The judicial view: free competition is to be preferred

United Kingdom courts have traditionally adopted a robust attitude: any form of business conduct is regarded as fair, provided that it does not breach the criminal law (*Crofter Hand Woven Harris Tweed v Veitch* [1942] AC 435; *Mogul v McGregor Gow* (1889) LR 23 QBD 598) and provided there is no conspiracy to injure the claimant by unlawful means (*Lonrho Ltd v Shell Petroleum Co Ltd* [1982] AC 173). Therefore there should *not* be a law of unfair competition in the United Kingdom. Intellectual property is divided into discrete rights and where a claimant seeks protection for something falling outside such categories, the action should fail. The judiciary (as befits the common law tradition) are reluctant to expand the boundaries of the existing rights, particularly those which are statute based. Indeed, there are powerful *dicta* against the introduction of a general tort of unfair competition, for example the views expressed in *Victoria Park Racing v Taylor* (1937) 58 CLR 479 at p. 509 (*per* Dixon J) (Australian HC) and *Moorgate Tobacco v Philip Morris* [1985] RPC 291 at pp. 236–240 (*per* Deane J) (also Australian HC). In the former case it was said that generalised protection should not be given to intangible elements falling outside the traditional areas of intellectual property which resulted from the exercise by an individual in the organisation of a business, or the use of ingenuity, knowledge, skill or labour.

These *dicta* should be compared with the thinking of the US Supreme Court in the case of *International News Service v Associated Press* (1918) 248 US 215 (the *INS* case), where the majority of the court held that taking news stories of World War I collected by the **claimant** and telegraphing them from the East Coast to the West Coast of the USA in order to publish the news there first before the claimant's own newspapers could do so amounted to an act of unfair competition. There are, however, two powerful dissenting judgments in the case (by Justices Holmes and Brandeis), and the case has since been criticised and confined. Libling, however, (in 'The Concept of Property: Property in Intangibles' (1978) 94 *LQR* 103) argues that Justice Brandeis misunderstood earlier United Kingdom case law. Further, he says, Justice Brandeis was used as authority by Dixon J in the *Victoria Park Racing* case, so the latter decision is unsound. Libling argues that the remedy in the *INS* case was correctly granted to protect the claimant's property right, not in the copyright in the newspaper stories, but to the commercial exploitation of its investment in gathering news.

thinking point

Should the claimant in the *INS* case have been given protection in respect of the time and trouble taken to organise its news gathering service?

1.2.3 Passing off as a possible mechanism

In the United Kingdom, breach of confidence, copyright and passing off are the categories of intellectual property most likely to be utilised in litigation in an attempt to provide protection against unfair competition. In particular, it is possible to identify passing off cases where the

judges seem more willing to expand the boundaries of protection. An early example is *Vine Products v MacKenzie* [1969] RPC 1 where Cross J (as he then was), when allowing Spanish sherry producers to enjoin the use of the term 'British Sherry', referred to the 'new-fangled tort of unfair competition'. The high-water mark of such expansionism is the opinion of Lord Diplock in *Erven Warnink BV v Townend & Sons* [1979] AC 731 at pp. 741–743, where he argued that the common law should follow Parliament's lead and impose a higher standard of commercial conduct than envisaged in the early days of passing off, founded as it was on the narrow basis of the action of deceit.

Equally, there are cases where the judges declare that existing forms of redress should not be expanded to encompass unfair competition. An instance is the decision of the Privy Council in *Cadbury-Schweppes v Pub Squash Co* [1981] RPC 429, where Lord Scarman (who ironically had concurred with Lord Diplock in *Erven* two years earlier) was adamant that competition must remain free, and that free competition is best safeguarded by requiring the claimant to establish all the ingredients of the passing off action in its orthodox form.

At first glance the views of Lord Diplock and Lord Scarman cannot be reconciled. Lord Diplock argued that the common law, through the tort of passing off, must develop and remain flexible to deal with changing business practices. He commented that passing off is a 'protean' tort, that is, one that can change its shape to suit the needs of the case. Lord Scarman, on the other hand, contended that passing off must stay within its traditional boundaries, adding that if the key elements of the action were not present, there should be no redress simply because it was felt intuitively that the defendant's conduct was 'unfair'. In the instant case, the defendants had not committed passing off by taking the underlying theme of the claimant's advertising campaign nor by copying the rather common colour scheme of the claimant's product (green and yellow for cans of lemonade was not unusual), even though they had set out quite deliberately to 'free-ride' on the claimant's success.

Despite these differences of attitude about the response of the common law to unfair trading, the two cases can be reconciled at a factual level. In the *Pub Squash* case, the Privy Council were constrained by Powell J's finding that the defendant's conduct had not caused any customer confusion. The facts as found did not even meet the list of ingredients for passing off suggested by Lord Diplock in *Erven Warnink* (and Lord Diplock himself pointed out that just because all the elements of the tort were established did not guarantee redress for the claimant—though why that should be so he did not explain). By contrast, in *Erven Warnink*, Goulding J had held that the claimants had sustained damage to goodwill as a result of the defendant having called its 'egg flip' drink 'Advocaat'. The contrasting outcomes emphasise how small differences in evidence can have a disproportionate effect in passing off cases.

1.2.4 An alternative solution

Hazel Carty (in 'The Common Law and the Quest for the IP Effect' [2007] *IPQ* 237) identifies a number of areas in current law where protection is said to be weak against the theft (or misappropriation) of investment. The creation of a general action for unfair competition is one solution; another would be to adopt the notion of unjust enrichment; another would be to use misappropriation. Arguably, this last is what happened in *Irvine v Talksport* [2002] 2 All ER 414 at [38–45], where Laddie J hinted that passing off has moved on (perhaps influenced

by the Human Rights Act 1998) and can indeed protect against the value of the claimant's investment in their name or image. Davis (in 'Why the United Kingdom Should Have a Law against Misappropriation' [2012] *CLJ* 561) considers whether such an extension to passing off is appropriate, as does Carty in 'Passing Off: Frameworks of Liability Debated' [2012] *IPQ* 106.

Others, too, have debated whether misappropriation *should* be used as the basis of a new tort of unfair competition. Libling argues that there are property rights in intangibles, particularly where there has been investment resulting from the expenditure of effort: such investment should be protected against taking by others. Equally, Ricketson (in "'Reaping without Sowing": Unfair Competition and Intellectual Property Rights in Anglo Australian Law' (1984) 7 *UNSWLJ* 1) argues that although the traditional categories of intellectual property rights have been expanded over the years to deal with many instances of unfair competition, there is scope for a general doctrine of misappropriation. This is particularly so, he says, where there is an actual or potential competitive advantage to the defendant or an actual or potential competitive disadvantage to the claimant. By contrast, Spence (in 'Passing Off and the Misappropriation of Valuable Intangibles' (1996) 112 *LQR* 472), having outlined four possible justifications for the recognition of misappropriation (causing harm to the creator, the fact that the creator deserves to own their creation, unjust enrichment of the defendant, and the autonomy of the creator) concludes that passing off is best confined within its traditional boundaries.

Relying on misappropriation as the basis for protection against unacceptable business practices is not without difficulty. The courts or Parliament would have to define what is capable of protection (a matter not addressed by Libling), and whether protection should have a proprietary or tortious basis. If the basis of protection is the investment which a company has made, would that not simply lead to monopoly power, so that the law would be protecting the large enterprise rather than the individual innovator? Further, how to draw the boundary between acceptable and unacceptable behaviour in business? Lastly, why should competition, indeed imitation, not be encouraged?

1.2.5 Recent judicial views

It has been suggested that passing off *ought* to be regarded as unfair competition by Aldous LJ in two cases, *BT plc v One in a Million* [1999] FSR 1 at p. 18 and *Arsenal Football Club v Matthew Reed* [2003] RPC 696 at [70]. This view is diametrically opposite that of Jacob J (as he then was) in *Hodgkinson & Corby v Wards Mobility Service* [1995] FSR 169: 'there is no tort of copying. There is no tort of taking another man's market or customers. Neither the market nor the customers are the plaintiff's to own.' Subsequently, Jacob LJ (as he had become) observed in *L'Oréal SA v Bellure NV* [2008] RPC 196 at [141] that,

the basic economic rule is that competition is not only lawful but a mainspring of the economy. The legislator has recognised that there should be exceptions. It has laid down the rules for these: the laws of patents, trade marks, copyrights, and designs have all been fashioned for the purpose. Each of them have rules for their existence and (save for trade marks) set time periods for existence. Each has their own justification. It is not for the judges to step in and legislate into existence new categories of intellectual property rights. And if they were to do so they would be entering wholly uncertain territory.



thinking point

Should 'free-riding' on the efforts and investment of others be permitted? If not, in what circumstances should the right to object to unfair competition arise?

Interestingly, when the case reached the European Court of Justice (ECJ) in Case C-487/07 *L'Oréal SA v Bellure NV* [2009] ECR I-5185 civil law notions of unfair competition are evident. The Court stated that there can be liability in the law of trade marks for taking unfair advantage of another's mark, even though the senior mark's distinctive character is not harmed and even though there is no damage to the reputation of the senior mark. In appropriate circumstances, 'free-riding' on another's investment can be prevented. The same Court had previously stated (again in the context of trade mark law) that unfair competition involves 'the duty to act fairly in relation to the legitimate interests of the trade mark proprietor' (Case C-100/02 *Gerolsteiner Brunnen GmbH v Putsch GmbH* [2004] ECR I-691). When *L'Oréal SA v Bellure NV* returned to the Court of Appeal ([2010] RPC 687), the ECJ's ruling was accepted with marked reluctance. Not only are there diverging judicial views within United Kingdom courts, there is a cultural divide between those EU Member States which recognise unfair competition as a form of actionable harm, and the common law tradition.

1.3

The principal characteristics of intellectual property rights

1.3.1 Property rights

Intellectual property rights are, self-evidently, proprietary in nature. They can be bought and sold, mortgaged and **licensed**, just like any other type of property. A valuation can be put on them for contractual or accounting purposes. Nevertheless, it is important to distinguish between property rights in a tangible item and the intangible intellectual property rights which may be embodied in that item. For example, if A writes a letter to B, the piece of paper received by B will belong to B as it was intended as a gift by the sender. However, the copyright in the words contained in the letter will belong to the creator, A. Further, A may use a pen to write the letter. The pen will be A's personal property, but there may be a patent for the pen belonging to C Ltd, or perhaps, if the pen is of an unusual shape, C Ltd might own a design right in respect of the pen. The fact that there are intellectual property rights over the pen does not prevent the use or ownership of the tangible item by A, just as A's ownership of copyright in the letter does not affect B's ownership of the piece of paper on which the letter is written. However, were B to attempt to do something falling within the scope of A's copyright (such as to include it in his autobiography which is about to be published in a newspaper) then A's copyright may (depending on the circumstances) be infringed.

1.3.2 Territorial nature

Intellectual property rights are territorial in nature, that is, they arise as a result of national legislation which authorises an official 'grant' of the right by a national intellectual property office. In the case of copyright, which does not depend on registration, the 'grant' of the right by United Kingdom law is automatic, providing the conditions in the CDPA are fulfilled. For actions in passing off or breach of confidence, the 'grant' of the right is as a result of a judicial decision in favour of the claimant.

cross reference

These conventions are explained in section 1.5.1.2.

'Territorial nature' means that an intellectual property right is only effective in the territory of the state granting that right. A patent granted by UKIPO only has effect for the territory of the United Kingdom. It does not give the patentee any rights outside the United Kingdom and can only be infringed by conduct which occurs within the territory of the United Kingdom.

There are various consequences. First, where protection is required for a patent or trade mark or registered design in more than one country, it is necessary to obtain separate registration for that right in each country. Various international conventions exist which assist an **applicant** to make multiple simultaneous applications in several countries. Also, one of the developments of EU law has been the creation of pan-European rights, so that it is possible to obtain a single registration for a plant variety, trade mark or design effective in all 28 Member States of the EU.

Next, the content of a particular intellectual property right may vary from country to country. Despite the existence of international conventions attempting to standardise intellectual property laws, differences do exist between the laws of those conventions' Contracting States. These differences may relate to the detailed rules concerning the creation or infringement of a particular intellectual property right, or to the legal systems within which the right is enforced, or to the social and cultural values which that legal system seeks to uphold.

One final consequence of the territorial nature of intellectual property rights must be mentioned at this stage. The various statutory provisions setting out what conduct infringes intellectual property rights (for example, the TMA s.10(4)(c)) entitle the proprietor to prohibit the importation of goods (there are similar provisions for patents, designs and copyright). Staying with trade marks as one example (because almost all the case law involves trade marks), what if trade marked goods have been sold by the trade mark owner in another country? Does the United Kingdom registration entitle the trade mark owner to sue the importer for infringement, so as to keep legitimate (as opposed to pirated) goods out of the country? Such a right would enable the trade mark owner to protect their United Kingdom distributors from price competition, as the importer may have acquired the branded goods more cheaply elsewhere. The answer is, 'it depends'. If the trade mark owner first sold the goods in a Contracting State of the **European Economic Area ('EEA')** (the 28 EU Member States plus Iceland, Norway and Liechtenstein) then EU law provides that the trade mark owner's rights are exhausted (or spent). No objection can be made to further dealing in these parallel imports within the EEA unless the importer does something to undermine the value of the trade mark. However, if the goods were first sold by the United Kingdom trade mark owner outside the EEA (for example, in Japan), then under EU law the principle of **exhaustion of rights** does not apply, and national trade mark rights enable the owner to sue for trade mark infringement (Case C-414/99 *Zino Davidoff SA v A & G Imports Ltd* [2001] ECR I-8691). National trade mark rights can therefore be used to prevent parallel imports of non-EEA goods, insulating the trade mark owner against price competition.

cross reference

Exhaustion of rights is dealt with in chapter 16.

1.3.3 Monopolistic nature

The descriptions of the various categories of intellectual property rights discussed in preceding paragraphs used the phrase 'exclusive right'. This embodies two important concepts. First, that intellectual property rights are negative in nature, because the owner is given the right to

exclude others. To go back to the example given earlier, A's copyright in the letter written to B does not give A any positive rights of ownership over the physical medium of the piece of paper. Rather, it gives A the right to prevent B (or anyone else) from infringing any one of the particular rights conferred on the copyright owner by statute, for example, the right to stop the letter being copied or communicated to the public. Second, the phrase 'exclusive right' means that the owner of the intellectual property right is the *only* person who can exploit the right. In the case of a patent, the patentee is the only person who can make the patented product, offer it for sale, dispose of it, keep it, or use it by way of trade. In the case of a registered trade mark, the owner is the only person who can apply the mark to goods, sell goods bearing the mark, import or export the goods, or advertise goods bearing the mark. In other words, an intellectual property right gives rise to a legal monopoly. Whether such a right gives rise to a monopoly in the sense understood by economists is a different matter, and unfortunately one rarely discussed by the courts.

Whether monopolies (in the economic sense) are good or bad is the subject of much debate. At common law, since the case of *Darcy v Allin (Case of Monopolies)* (1602) 11 Co Rep 84b, all monopolies are viewed as contrary to public policy. Such policy was confirmed by Parliament in the Statute of Monopolies 1623, to which patents are declared to be an exception in s.6. Arguably, therefore, United Kingdom intellectual property law can be viewed as an exception to a general principle prohibiting monopolies. Indeed, case law contains numerous instances where the judges have been reluctant to find in favour of the claimant on the ground that this would create an 'unfair monopoly' (see, for example, the decision of the House of Lords in *Re COCA COLA Trade Marks* [1986] RPC 421). Add to this the assumption that free competition is a good thing, and it is easy to see why at times the Patents Court gives the impression of being against intellectual property owners.

Present-day intellectual property legislation contains many built-in safeguards to ensure that a balance is struck between the rights of the intellectual property owner and free competition. Some of these safeguards require the owner to pay renewal fees regularly (in the case of patents, registered designs and trade marks). Others require the owner to make effective use of the intellectual property right. Failure to exploit a patent may result in **compulsory licensing**; failure to use a trade mark for more than five years means that the registration may be revoked for non-use at the instance of any third party. In the case of copyright and designs, the competition authorities may intervene in the case of the owner's abuse of the right, and in the case of the unregistered design right, **licences of right** can be demanded during the last five years of the term of protection. With the exception of trade marks, all intellectual property rights are of finite duration. Finally, in the case of all registered intellectual property rights, statute provides for the right to be declared invalid in certain instances, so unlike real property and tangible personal property, intellectual property rights are always vulnerable to destruction.



thinking point

Is it correct to state that intellectual property rights are monopolistic in nature? If they are, is that such a bad thing?

1.4

The theoretical justifications for intellectual property rights

Intellectual property rights ultimately protect information. Assuming that property rights over real and personal property can themselves be justified (and certain philosophies deny this),

is it correct to treat information in the same way? Should information be the subject of private rights or should it be regarded as public property? Further, if private property rights are allowed to exist over information, what safeguards should be created to ensure the protection of the public interest in such information, so that it is left free for others to enjoy?

1.4.1 Possible justifications

William Fisher has argued (see 'Theories of Intellectual Property', in Munzer *New Essays in the Legal and Political Theory of Property* (ed) (2001), Cambridge University Press) that there are potentially four different theoretical justifications found in current academic literature. The arguments which follow are rarely articulated in United Kingdom case law (although for an exception, see *Dranetz Anstalt v Hayek* [2003] FSR 561 at [25]). As Fisher says, the theories are not as helpful as might be supposed in assisting legislators and the judiciary to determine the precise limits of intellectual property law in the information age. Each is hampered by internal inconsistency, and by the lack of empirical evidence to support it. No one theory is sustainable across the entire range of intellectual property rights. Moreover, the extensive literature supporting the various theories can be viewed as a product of a particular era or a particular society.

First, influenced by the writings of Jeremy Bentham, is the utilitarian theory of intellectual property. Bentham's ideal was to achieve 'the greatest good of the greatest number' by the maximisation of net social welfare. In the context of intellectual property, utilitarianism propounds that authors and inventors be given a limited monopoly, either as an incentive to create or as a reward for their efforts, because society will be improved and enriched by their resultant endeavours. The theory requires a balance to be struck between the exclusive rights of the owner and the rights of public enjoyment over what has been created.

Next, there is the natural law theory attributed to the writings of John Locke. Locke's arguments (often referred to as the 'labour theory' or the 'desert theory' and advanced in an era when society was largely agrarian) state that a person may legitimately acquire property rights by mixing his labour with resources held 'in common' provided that there is enough left in common for others. So if a worker ploughs a field and grows a crop of wheat, the wheat belongs to him.

Third, derived from the writings of Kant and Hegel, there is the argument that private property rights are essential to the satisfaction of human need. Intellectual creations are seen as an extension of the individual's personality. Last, and encountered less often, there is the theory that property rights in general should be shaped so as to achieve a desirable society. Fisher calls this the 'social planning' theory, arguing that it is different from utilitarianism.

An alternative structure is put forward by Merges (in *Justifying Intellectual Property* (2011), Harvard University Press). He argues that there are three first order principles which justify the existence of intellectual property, Lockean appropriation, Kantian individualism and Rawlsian distributive effects of property, with utilitarianism ('efficiency') being a second-tier rather than foundation principle.

1.4.2 Criticisms of the theories

Utilitarianism (which permeates US law because of the constitutional foundations for patent and copyright protection) holds that the law should provide incentives for those creative

efforts which benefit society as a whole. What evidence is there that the availability of legal protection actually provides an incentive? Consider how the computer software industry developed in the 1970s despite the absence of any form of legal protection. Henry Ford refined the system of mass-producing motor cars long before the US Patent Office granted patents for 'methods of doing business'. Even if it is concluded that society is better off if authors and inventors are rewarded, is an intellectual property régime necessarily the best means of providing that reward? The founders of the US Constitution contemplated, but eventually abandoned, the idea of state-funded rewards for creativity. If intellectual property law is deemed the best solution, how far should the rights of authors and inventors extend? Should the owner of a copyright work be entitled to control all subsequent works based on it? Should a patentee be able to prevent others from conducting experiments on his invention? If protection is taken too far, then monopoly power is created. Monopoly power in turn creates inefficiency as the patentee's competitors waste time and money trying to 'invent around' the earlier patent without being liable for infringement.

Similar problems occur with the labour theory. It is by no means clear that Locke's writings do support any sort of protection for intellectual property rights: they were certainly not within his contemplation at the time of writing. Even if this obstacle is overcome, what should count as 'labour' in the context of intellectual property rights, when it is very easy to think up a brand name or when the threshold for copyright protection is so low? In the information society, what are the 'commons': is it facts, or culture, or ideas? To quote Fisher's example, granting a patent on a better mousetrap prevents others from making *that* mousetrap, but not from reading the patent document and using the information which it contains to make an even better one. Finally, how should intellectual property legislation ensure that enough is left from 'the commons' for others to enjoy?

Reliance on property rights as an aspect of personality to justify intellectual property equally causes problems. Which rights should be treated as capable of individual ownership and which should be left to the public? Even if it is possible to identify which rights can be privately owned, should they be capable of alienation? How much autonomy should an individual have? How much public property should they be able to monopolise? And what conduct should amount to infringement? Last, the social policy theory begs the question what sort of society we want, and who should make that decision? Should society's values be based on consumer welfare, the artistic tradition or distributive justice? Here, an individual's political vision will affect the answer to the question, on which there is accordingly little consensus.

Further, it is impossible to apply a particular theory to every single type of intellectual property right. Can copyright be supported by the same arguments as patents? Does the same reasoning apply to the protection of designs or trade secrets? The odd one out here is clearly the trade mark right. The reasons for having trade mark law are much more to do with the workings of consumer society rather than rewarding creativity or protecting an individual against theft. However, the pro-competitive benefits of brand names still have to be balanced by the need to avoid anti-competitive behaviour by large, multi-national brand owners.

Next, there is no empirical evidence that a society with intellectual property protection is any better or worse than a society without it. If intellectual property rights are accepted as a good thing, one would expect that the protection conferred on their owners would reflect the justifications for such rights. Regrettably, the law does not distinguish between 'good' and 'bad' intellectual property rights. There is no difference in the scope or duration of protection accorded to a patent for a new life-saving drug and one for a very minor modification to the

**thinking point**

Which theoretical justification for granting intellectual property rights do you find the most convincing? Which is the least?

internal combustion engine. The composer of a great choral work receives no better protection than the person who writes a jingle for a television advertisement. Ironically (depending on one's point of view) the latter may receive far more royalties for the performance of their work than the former.

Finally, if intellectual property rights are accepted as beneficial to society, there remains the question of how to strike the balance between the interests of the owner and the interests of society. Should the task of striking this balance fall to the discretion of the judges, or should it be built into the legislation creating the intellectual property rights, or should it be left to those with authority to administer competition law? Whichever is preferable (and again there is no consensus), as Sir Robin Jacob has argued (in 'The Stephen Stewart Memorial Lecture: Industrial Property—Industry's Enemy' [1997] *IPQ* 3), intellectual property rights continue to expand and strengthen, with little attention being paid to protecting the interests of others.

1.5

Sources of intellectual property law

We now consider the origins of United Kingdom intellectual property law. It should not be assumed that intellectual property law is purely domestic. External influences in the shape of international conventions have played a major role in deciding the contents of United Kingdom law since the late nineteenth century. In the last three decades, the EU's harmonisation programme in the form of Regulations and Directives has led to a stream of further revisions. Whatever reforms the *Gowers and Hargreaves Reviews of Intellectual Property* eventually produce will be at the margins, as any room for manoeuvre is constrained by the United Kingdom's international and European obligations.

In terms of hierarchy, the sources of United Kingdom intellectual property law can be classified as international conventions, EU legislation, domestic legislation and case law, both European and domestic. In principle, no international convention is part of United Kingdom domestic law unless and until it is enacted by Parliament. It used to be said that once enacted, United Kingdom courts would refer to the implementing legislation rather than the convention itself in determining the rights of the individual, as international agreements are not capable of direct effect: see *Lenzing AG's European Patent* [1997] RPC 245, dealing specifically with the effect of the EPC. Less than a decade later, however, United Kingdom courts hearing intellectual property disputes refer directly to the original source in the interests of clarity: see *Aerotel Ltd v Telco Holdings Ltd/Macrossan's Application* [2007] RPC 117 where the Court of Appeal looked to the wording of the EPC rather than s.1(2) of the Patents Act 1977.

cross reference

Section 1(2) of the Patents Act 1977 is explained in section 5.3.

cross reference

The significance of complying with ECJ guidance is explained at section 1.5.4.

In contrast, many of the **Articles of the Treaty on the Functioning of the European Union (TFEU)** (formerly the Treaty of Rome 1957) together with those Regulations creating pan-European intellectual property rights will have direct effect in United Kingdom law; harmonisation Directives have prompted much domestic legislation. United Kingdom courts must therefore apply the guidance of the ECJ as to the meaning of the TFEU, the Regulations and Directives.

1.5.1 International conventions administered by WIPO

Most, but not all, international intellectual property conventions are administered by the **World Intellectual Property Organisation ('WIPO')**, an agency of the United Nations. WIPO's chief objectives are to encourage and assist countries to establish effective protection for intellectual property rights, and to work towards an international consensus on the standardisation of national laws. According to WIPO's own description, its conventions are subdivided into three main types, namely protection treaties, global protection systems and classification treaties.

1.5.1.1 WIPO protection treaties

Protection treaties specify the types of right which are to be recognised, the criteria for their protection, and the minimum standards to be applied to each type of right. Contracting States are obliged to adhere to these criteria and standards in their domestic legislation.

The Paris Convention

The prime example of a protection treaty is the Paris Convention for the Protection of Industrial Property 1883 (as revised at Stockholm 1967). The Paris Convention deals with those intellectual property rights obtainable by registration (patents, trade marks and designs). It also requires Contracting States to provide protection against unfair competition. Membership of the Convention obliges a Contracting State to establish its own patent office, and, once established, for that Office to issue certain publications (for example, a *Patents Journal* and a *Trade Marks Journal*). There are, however, two particular substantive rights created by the Convention, **priority** claiming and **national treatment**, which deserve particular mention.

Priority claiming (Article 4) enables an applicant for a patent, trade mark or design, once they have filed an application in one of the Contracting States, to backdate all subsequent national filings made within a specified period to the date of that first national filing, provided the later filings relate to the same subject matter. The specified periods are 12 months for patents, and six months for trade marks and designs. The ability to backdate a patent application by up to 12 months is of great practical importance in 'the race to the patent office door'.

National treatment (Article 2) is the cornerstone of the Paris Convention and of many other international intellectual property conventions. Any state which becomes a signatory to the Convention is required to provide the same protection under domestic law to foreign nationals as it does to its own nationals. So, for example, the fact that the United Kingdom is a Contracting State to the Paris Convention means that it must offer nationals from other Contracting States (for example Japan) the same treatment under United Kingdom law as it gives to United Kingdom nationals. However, because intellectual property laws differ from state to state, national treatment does *not* mean that in our example, United Kingdom law must offer Japanese nationals the same protection as they receive under Japanese law. Japanese law might provide better (or worse) protection than United Kingdom law, but that can have no bearing on the duty of the United Kingdom under Article 2 not to discriminate against those from other Contracting States.

WIPO copyright conventions

Besides the Paris Convention, WIPO oversees conventions concerned with rights which are not registrable, namely copyright and related rights (these latter are sometimes referred to as 'neighbouring rights'). The chief of these conventions is the **Berne Convention** for

cross reference

Patent application procedure is dealt with at section 4.4.

cross reference

How the Berne and Rome Conventions are implemented in United Kingdom law is explained in chapter 8.

the Protection of Literary and Artistic Works 1886 (as revised at Paris in 1971). The Berne Convention deals with literary, dramatic, musical and artistic works, and films. It sets out the criteria for the existence of each one of these rights and the extent of protection conferred on the owner. Two key features deserve a brief mention. First, the Convention, just like the Paris Convention, contains the principle of national treatment in Article 5, and, second, in the same Article, declares that copyright protection is not dependent on registration. The consequence is that copyright protection arises automatically once a work comes into existence.

The remaining categories of copyright and related rights are dealt with by another WIPO Convention, namely the **Rome Convention** for the Protection of Performers, Record Makers and Broadcasting Organisations 1961 (sometimes called the 'Neighbouring Rights Convention'). The Rome Convention sets out the obligations of Contracting States with regard to the protection of sound recordings (called 'phonograms' in the Convention), broadcasts and performances. Like the Berne Convention, it specifies the criteria for the existence of each right and the scope of protection accorded to the owner. Similarly, it contains the principle of national treatment and declares that protection is not dependent on registration. It does, however, provide for the formality of a copyright notice to be affixed to each copy of the work, but only in the case of sound recordings (the © symbol).

Lastly, in relation to copyright and neighbouring rights, in 1996 WIPO concluded two further treaties, namely the WIPO Copyright Treaty ('WCT') and the WIPO Performers and Phonograms Treaty ('WPPT'). The objective of these two Conventions is to spell out more clearly the rights of the copyright owner in the digital era, especially with regard to the exploitation of copyright works on the internet. They build, respectively, on the Berne Convention and the Rome Convention. Their main impact in United Kingdom law is in relation to copyright infringement. The WPPT has also prompted recent revisions to the law on **moral rights**.

1.5.1.2 WIPO global protection systems

Global protection systems exist because of the territorial nature of intellectual property rights and the consequent need to assist businesses who want to obtain registration for their rights in more than one country. Essentially these systems provide procedural shortcuts to enable an applicant to make multiple national filings in respect of patents, trade marks and designs. The two principal global protection systems operated by WIPO are the Patent Co-operation Treaty 1970 ('PCT') (which provides for the multiple filing of patent applications) and the Madrid Agreement for the International Registration of Marks 1891 (revised Stockholm 1967) as amended by the Protocol to the Madrid Agreement 1989 (the '**Madrid System**' which provides a mechanism for filing multiple applications for trade marks). These will not be discussed further in this text.

1.5.1.3 WIPO classification treaties

Last, classification treaties exist primarily to standardise the internal workings of national patent offices, and trade marks and designs registries, by providing (for example) a standard classification for the subject matter of patents or designs. The one most commonly encountered is the **Nice Agreement** for the International Classification of Goods and Services 1957, incorporated into United Kingdom law by means of Sch. 4 of the Trade Marks (Amendment) Rules 2001.

cross reference

See further chapter 14.

1.5.2 Conventions administered by other international organisations

1.5.2.1 The World Trade Organization: TRIPs

The World Trade Organization ('WTO') was established in 1995, replacing another international organisation known as the General Agreement on Tariffs and Trade ('GATT'). The WTO has a much broader scope than GATT, in that it is not concerned simply with trade in goods. The principal objective of the WTO is to promote free trade between states by overseeing and enforcing the rules of international trade. One of its underlying assumptions is that free trade helps to raise living standards. Nevertheless, it has come to be associated with the perceived evils of globalisation.

One of the conventions concluded under the auspices of the WTO is the Agreement on the Trade Related Aspects of Intellectual Property ('TRIPs'). Membership of the WTO obliges a Contracting State to sign up to TRIPs. TRIPs contains provisions setting out a minimum 'floor of rights' for all major categories of intellectual property. It builds on what has gone before by incorporating the fundamental principles of the Paris and Berne Conventions, and requires its Contracting States to accede to the latest versions of these (and other) treaties. Like them it adopts the principle of national treatment.

The most significant feature of TRIPs is that where a state is in breach of its obligations, another dissatisfied state may initiate the WTO dispute settlement procedure. If a complaint is upheld, then the complainant may (once all the lengthy procedures have been exhausted) impose trade sanctions on the defaulting state (including import quotas and duties). These sanctions can be imposed on products other than those which were the subject matter of the complaint. Arguably, the enforcement mechanism makes the WTO a more powerful force for change than WIPO. However, WIPO can hardly be considered a spent force, because since the advent of the WTO it has secured the two 1996 Conventions detailed earlier, as well as the ICANN dispute resolution system for domain names.

WIPO or WTO?

Some have asserted (see Arup, 'TRIPs: Across the Global Field of Intellectual Property' [2004] *EIPR* 7) that WIPO is the better organisation to advance global standards in intellectual property because of its extensive experience (over five decades) and because it strives to be more balanced in its approach, preferring education and persuasion to coercion. The drawback is that its consultation procedures are more formalised and protracted. As Samuelson points out (in 'Challenges for WIPO and TRIPs in Regulating Intellectual Property Rights in the Information Age' [1999] *EIPR* 578), TRIPs was in part adopted because of dissatisfaction with WIPO, in particular its inability to enforce change on its Contracting States and the fact that its conventions allow states to enter reservations, thereby 'opting out' of certain obligations. Ultimately, it was felt, WIPO deferred too much to its members and left too much to their discretion. The absolute nature of the obligations in TRIPs together with the WTO enforcement mechanism was perceived by some as the more effective régime.

Criticisms of TRIPs

TRIPs is not without its critics. As Samuelson contends, there is a cultural difference between the language of free trade and that of authors' rights. Further, as May argues (in 'Why IPRs Are a Global Political Issue' [2003] *EIPR* 1), the 'one size fits all' approach of TRIPs does not accord



with reality for less-developed nations. Ironically, 500 years ago developed countries were in the same position as less-developed countries are today and have spent the intervening years establishing a workable balance between the rights of the author or inventor and 'the commons'. Conversely, as Arup comments, TRIPs itself is 'backwards looking' as it builds on existing WIPO treaties, themselves a product of nineteenth-century industrialisation.

The most trenchant criticisms of TRIPs are to be found in *Integrating Intellectual Property Rights and Development Policy* (the Report of the Commission on Intellectual Property Rights, London, 2002). Amongst other things, the Report considers the impact of granting patents for animals and plants, the relationship between patents and health care, bio-prospecting, the protection of traditional knowledge, and how the standards of patentability ought to be applied. Many of the Report's underlying assumptions are challenged by Crespi (in 'IPRs under Siege: First Impressions of the Report of the Commission on Intellectual Property Rights' [2003] *EIPR* 242). He argues that the Commission failed to keep in mind the difference between an intellectual property right *per se* and the use made of it. Crespi questions whether intellectual property rights should be an instrument of public policy, as such rights on their own do not have an economic impact unless and until they are exploited.

1.5.2.2 The Council of Europe

Next, there are intellectual property conventions promulgated by the Council of Europe. Although often considered as dealing only with the European Convention on Human Rights, the Council has since its foundation in 1949 concerned itself with a wide range of scientific and cultural issues, and has created two conventions dealing with patents, the most important of which is the EPC. Membership of this is open to any state which belongs to the Council of Europe. Consequently, the membership of the EPC is far broader than that of the EU. It should be remembered that the EPC is *not* a legal instrument of the EU, and so is not subject to the jurisdiction of the ECJ.

The EPC established the EPO in Munich. In contrast to the PCT mentioned earlier (which enables an applicant to make multiple national patent filings worldwide), the EPC is a regional intellectual property system providing centralised grant. One application to the EPO will, if successful, result in the grant of national patents in all the Contracting States of the EPC (at present there are over 30) unless the applicant indicates otherwise. A European patent bypasses national patent offices. A European patent has the same effect in a Contracting State as a national patent granted by that state's own patent office. So, in the United Kingdom, there are in force national patents granted by UKIPO, and European Patents (UK) granted by the EPO in Munich. Each type of patent has exactly the same effect and confers exactly the same type of rights once granted.

1.5.2.3 UNESCO and the Universal Copyright Convention

An alternative route designed to assist citizens of developing countries obtain copyright protection in developed countries is the **Universal Copyright Convention ('UCC')**. The UCC was initially agreed in Geneva in 1952 and revised in Paris in 1971. It is unusual in that it is administered not by WIPO but by the United Nations Educational, Scientific and Cultural Organisation ('UNESCO'). The scope of the UCC is the same as the Berne Convention, in that it deals with literary, dramatic, musical and artistic works, and films. Just like the Berne Convention, it contains the principle of national treatment, but in contrast it does require the use of a copyright

notice on a work as a precondition to protection (the © symbol). The intention of its creators was that when former colonies obtained their independence, membership of the UCC would ensure national treatment for their citizens in the countries which had previously governed those territories. Since the advent of the TRIPs Agreement, the number of new accessions to the UCC has declined noticeably. This is because membership of the WTO obliges Contracting States to adhere to the Berne Convention. The UCC could therefore be regarded as something of an anachronism.

1.5.3 European Union legislation

At a fairly early point in the development of the European Economic Community (as it was then called), it was realised that intellectual property rights were one of the main non-tariff barriers to trade and an obstacle to the creation of what is now known as the internal market. The internal market means the 28 Member States are regarded as a single territory without internal boundaries. National intellectual property rights are an obstacle to attaining the internal market because of their territorial nature. Another obstacle was that Member States had enacted different criteria for the protection, duration and scope of the various intellectual property rights. The EU Commission therefore adopted a two-pronged strategy designed to overcome these problems, namely a series of harmonisation directives, addressed to Member States, requiring them to standardise their national laws, and the creation of pan-European rights by means of directly applicable Regulations.

1.5.3.1 Harmonisation Directives

Harmonisation Directives in the field of intellectual property have had a significant effect on United Kingdom law (and indeed the law of other Member States) in relation to trade marks, designs and copyright, but so far have had only a limited effect in relation to patents.

Trade marks

The *First Trade Marks Directive* (Council Directive 89/104/EEC of 21 December 1988 on the approximation of the laws of Member States relating to trade marks [1989] OJ L 40/1) (now codified as Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 [2008] OJ L 299/25) is declared to be a partial harmonisation measure, dealing only with those aspects of trade mark law which directly affect the functioning of the internal market. It deals with what signs can be trade marks, the absolute and relative grounds on which a trade mark application may be refused, the scope of protection afforded by registration to the proprietor of the mark to prevent infringing conduct by others, the defences to infringement, and provisions dealing with the licensing of marks and the loss of registration. All of these key provisions are reflected in the wording of the TMA, though in some instances, it must be said, the enactment of the Directive in the United Kingdom has been less than perfect. Other aspects of trade mark law, such as registration procedure, ownership and enforcement, are left to the domestic laws of Member States.

One way in which a registered trade mark can be used by a competitor is in comparative advertising. The Trade Marks Directive did not deal with whether comparative advertising was a form of trade mark infringement. Subsequently, the EU adopted the Comparative Advertising Directive (Directive 97/55/EC of the European Parliament and of the Council of 6 October 1997 amending Directive 84/450/EEC concerning misleading advertising so as to include

cross reference

The implementation of the Directive in the TMA is discussed further in chapters 14 and 15.

cross reference

Comparative advertising as a defence to trade mark infringement is considered in section 15.4.7.

The impact of the proposed changes to the Trade Marks Directive is considered throughout chapters 14, 15 and 16.

cross reference

The impact of the Directive is considered in chapter 11.

cross reference

Duration of copyright is dealt with in chapter 8; duration of performers' rights in chapter 10.

comparative advertising [1997] OJ L 290/18, now consolidated as Directive 2006/114/EC of the European Parliament and of the Council of 12 December 2006 [2006] OJ L 376/21) (the 'CAD'). The CAD has been implemented into United Kingdom law by means of administrative regulation (the Business Protection from Misleading Marketing Regulations 2008), with enforcement being by way of complaint to the Advertising Standards Authority. No change was made to the provisions of the 1994 Act. Subsequently, however, the ECJ in *Case C-533/06 O2 Holdings Ltd v Hutchinson 3G Ltd* [2008] ECR I-4231 has read the two Directives together.

In March 2013, the EU Commission published a proposal to modernise and improve the Trade Marks Directive. Its wording codifies the ruling in *O2*.

Designs

In relation to registered designs, the Designs Directive (Council Directive 98/71/EC of 13 October 1998 on the legal protection of designs [1998] OJ L 289/28) has had a major impact on the content of United Kingdom law on registered designs. Again, it is declared to be a partial harmonisation measure only, leaving Member States to decide on ownership, registration procedure and remedies. The Directive therefore deals with those aspects of the law of registered designs which most affected the functioning of the internal market, namely the conditions for acquiring protection (including the definition of a design and the key criteria of novelty and individual character), the exclusions from protection, and the scope of the infringement action. The Directive allows Member States to provide other legal methods of protecting designs (such as copyright and unregistered design right).

Copyright

It is in relation to copyright that the EU has adopted the most number of Directives. However, their impact has been in relation to specific aspects of copyright, and in contrast to trade marks and designs, there has been no attempt to standardise the core criteria for protection. Whether a 'work' meets the minimum standards for protection is therefore left still to the domestic laws of the Member States.

General copyright Directives

Two Directives have had an impact on general copyright principles. First, the Rental Rights Directive (Council Directive 92/100/EEC of 19 November 1992 on rental right and lending right, and on certain rights related to copyright in the field of intellectual property [1992] OJ L 346/61, now codified as Directive 2006/115/EC of the European Parliament and of the Council of 12 December 2006 [2006] OJ L 376/28) clarified that the copyright owner has the right to control the hire and rental of copies of the work. Second, the Copyright Term Directive (Council Directive 93/98/EC of 29 October 1993 harmonising the term of copyright protection [1993] OJ L 290/9, now codified as Directive 2006/116/EC of the European Parliament and of the Council of 12 December 2006 [2006] OJ L 372/12) standardised the duration of protection for the various categories of copyright work throughout the EU. So, for example, in respect of those works covered by the Berne Convention, the term is to be the duration of the author's life plus 70 years, provided the author is a national of one of the EEA Contracting States or the work's 'country of origin' is an EEA Contracting State. The 2006 Directive has been amended by Directive 2011/77/EU of the European Parliament and of the Council of 27 September 2011 [2011] OJ L 265/1 with regard to the duration of copyright in sound recordings and of performers' rights.

The impact of technology

Another group of Directives has, over the years, endeavoured to deal with the impact of new technology on copyright and related rights. The first, and most specific, of these was the Semiconductor Directive (Council Directive 87/54/EEC of 16 December 1986 on the legal protection of topographies of semiconductor products [1987] OJ L 24/36), which, in response to legislation in the USA, provided protection for the three-dimensional layout of computer chips. The Computer Programs Directive (Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs [1991] OJ L 122/42 now codified as Directive 2009/24/EC of the European Parliament and of the Council of 23 April 2009 [2009] OJ L 111/16) provided that computer programs were to be accorded copyright protection 'as literary works'. Lastly, the Database Directive (Directive 96/9/EC of 11 March 1996 on the legal protection of databases [1996] OJ L 77/20) created a two-tier system of protection for collections of works, data and other materials.

cross reference

Computer programs and databases are treated as literary works, explained at section 8.2.1.

New media

Two further Directives attempted to ensure that the owner of a copyright work is protected against exploitation of the work in new forms of communication. First, the Copyright Broadcasting Directive (Council Directive 93/83/EEC of 27 September 1993 on the co-ordination of certain rules concerning copyright and neighbouring rights applicable to satellite broadcasting and cable retransmission [1993] OJ L 246/15) established the principle that the rights of owners of existing copyright works were to be protected when the works became the subject of satellite or cable broadcasts. Next, the Information Society Directive (Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society [2001] OJ L 167/10) implemented the WCT and the WPPT by declaring the rights of authors to control the reproduction, issuing and communication of their works in the digital era.

cross reference

The Directive is explained in chapter 10.

Miscellaneous

Lastly, two recent Directives have dealt with specific problems. The Droit de Suite Directive (Directive 2001/84/EC of the European Parliament and of the Council of 27 September 2001 on the resale right for the benefit of the author of an original work of art [2001] OJ L 272/32) implemented a particular provision of the Berne Convention, namely the right of an artist to be remunerated when the original version of his/her work is sold. By contrast, the worldwide problem with counterfeiting (which of course is not confined to copyright, but applies equally to trade marks) is dealt with by the Enforcement Directive (Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights [2004] OJ L 157/45) which requires Member States to harmonise the civil remedies available to the intellectual property owner.

cross reference

Remedies are considered in chapter 2.

Patents

The tortured history of the **EU Patent** (its title since the Lisbon Treaty) shows that creating pan-European rights is not easy. The original twin-track approach was to leave the EPC to deal with the issuing of patents, whilst the EU Patent ensured that the post-grant rights of patentees throughout the EU with regard to infringement, licensing, renewal and invalidity were harmonised. The intention was to have a **unitary patent** for the whole of the EU, as a special type of European patent granted by the EPO. So little progress was made in the ratification of the draft Community Patent Convention 1975 that the EU Commission decided in 2000 to

restart the process by using a different legal instrument, namely a Council Regulation under what was then Article 308 EC (now Article 352 TFEU) (the implied powers provision). Again, little progress was made.

The ratification of the Lisbon Treaty in December 2009 reactivated the process yet again. Article 118 TFEU provided for the creation of European intellectual property rights in the context of the internal market. The 2009 proposal for the EU patent envisaged the enactment of a Regulation so that the EU itself would accede to the EPC thereby becoming a 'Contracting State' for which a European patent having unitary effect throughout the Union would be granted. There was to be a European and EU Patents court system with exclusive jurisdiction in respect of validity and infringement issues concerning European and EU patents, consisting of a Court of First Instance and a Court of Appeal. The establishment of such a system required an agreement between EU Member States and non-EU Member States of the EPC but in March 2011 the ECJ ruled that this was not compatible with the EU Treaties. Meanwhile, in the same month, 25 of the then 27 Member States (the exceptions being Spain and Italy) decided to go ahead with 'enhanced co-operation' in the matter of the EU Patent under Title III of the TFEU. Subsequently, the EU Parliament and the Council of Ministers agreed two Regulations: No 1257/2012 (OJ [2012] L 361/1) implementing enhanced co-operation in the area of the creation of unitary patent protection; and No 1260/2012 (OJ [2012] L 361/89) implementing enhanced co-operation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements. The Regulations entered into force on 20 January 2013. However, they will only apply from 1 January 2014 or the date of entry into force of the Agreement on a Unified Patent Court, whichever is the later. The Agreement on the Unified Patent Court was published on 11 January 2013 and was formally signed on 19 February 2013. It has to be ratified by 1 November 2013 with a minimum of 13 states required, including France, Germany and the United Kingdom (at the time of writing 25 Member States have signed the agreement; Poland, Croatia and Spain have not signed, but only Austria has ratified). It was intended that the new system would be ready for business early in 2014, although the Unified Patent Court Preparatory Committee believes that early 2015 would be a more 'realistic target date for the entry into operation of the Court'. The net result is the creation of a patent for the EU which despite its name, is not unitary, in that it will not have effect in those Member States who did not participate in the enhanced co-operation procedure. It does seem, however, that the thorny issue of translation has been resolved, because the unitary patent will have the same working languages as the EPC, namely English, French and German.

There has only been one EU Directive in the field of patent law, namely the Biotechnological Patents Directive (Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions [1998] OJ L 213/13) ('the Biotech Directive'). It was passed in response to the practice of the United States Patent and Trademark Office of granting patents in relation to genetically engineered plants and animals, and because Member States' national patent offices had adopted varying attitudes to such patents. It declared that, provided the normal criteria for patentability are met, inventions consisting of biological material shall *in principle* be patentable. There are a number of exceptions, concerned primarily with ethical objections to such inventions, and the Directive also spells out the rights of the owner of such an invention against infringers.

cross reference

The Directive is considered further in chapter 5.

1.5.3.2 Pan-European rights

In three areas, the EU has seen fit to create an EU-wide system whereby the intellectual property owner can, in a single registration procedure, obtain protection throughout all Member States. Such rights are unitary in nature, that is, the rights are valid for the whole of the EU, but equally, if they are invalid in one part of the EU (for example, because the right in question does not meet all the criteria for protection or because of an earlier conflicting right) then they are invalid for the whole (an 'all or nothing' system). The three systems are: the Council Regulation on Plant Variety Rights (Council Regulation (EC) 2100/94 of 27 July 1994 on Community Plant Variety Rights [1994] OJ L 227/1); the Community Trademark Regulation (Council Regulation (EC) 40/94 of 20 December 1993 [1994] OJ L 11/1, now consolidated as Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark [2009] OJ L 78/1); and the Council Regulation on the Community Design (Council Regulation EC 6/2002 of 12 December 2001 on Community Designs [2002] OJ L 3/1). It is beyond the scope of this book to deal with these three Regulations, but as indicated earlier, there are parallel Directives which seek to harmonise national laws. One result of these parallel systems (applicants can still elect to seek only national registration for their trade mark or design) is that the case law on the Directives can be interchanged with the case law under the Regulations. The role of the ECJ in this aspect of harmonisation should not be underestimated.

1.5.4 United Kingdom legislation

There are four principal statutes governing intellectual property law in the United Kingdom. All were enacted or have been modified to take account of international or regional conventions, or EU secondary legislation.

1.5.4.1 Summary of domestic legislation

- The RDA, as amended by the Design Regulations 2001, incorporates the Designs Directive.
- The Patents Act 1977, as amended by the Patents Act 2004, was enacted to fulfil the United Kingdom's obligations under the EPC 1973, whilst the 2004 Act takes account of the revisions in the EPC 2000.
- The CDPA was initially a domestic measure (although it did enable the United Kingdom to ratify the 1971 version of the Berne Convention). It has since been amended on a number of occasions in order to implement EU Directives dealing with copyright and related rights. The latest changes (intended to come into force in October 2013) will give effect to some of the proposals in the *Hargreaves Review of IP and Growth* (2011).
- The TMA was passed so that the United Kingdom could implement the EU Trade Marks Directive and the Community Trade Mark Regulation.

Because of these outside influences, United Kingdom tribunals are constrained in their interpretation of domestic legislation. The Patents Act 1977 s.130 declares that key provisions in the Act (specifically those dealing with **patentability**, infringement and revocation) are intended to have the same effect as the corresponding provisions in the EPC, the EU patent and the PCT have in other states which are members of these conventions. In particular, the

section imposes an obligation on United Kingdom tribunals to take note of the case law of the Boards of Appeal and the Enlarged Board of Appeal of the EPO (that is, the EPO's internal judicial organs) with regard to the interpretation of the criteria for patentability: see *Merrell Dow v Norton* [1996] RPC 76 at p. 82 (HL) and *Kirin Amgen Inc and others v Hoechst Marion Roussel Ltd and others* [2005] 1 All ER 667 at [101] (HL), in each case *per* Lord Hoffmann.

Where domestic law has been enacted or amended to give effect to EU harmonisation Directives, then the position of United Kingdom tribunals is even more constrained. It is a principle of EU law that the tribunals of a Member State are obliged to interpret national legislation adopted in implementation of a Directive in such a way that the objectives of a Directive are achieved (Case 14/83 *Von Colson and Kamann v Land Nordrhein-Westfalen* [1984] ECR 1891). Even where there has been non-implementation or mis-implementation of a Directive, national law must, after the deadline for implementation has passed, be interpreted in such a way as to comply with the wording and purpose of the Directive (Case C-106/89 *Marleasing* [1990] ECR I-4135 at [8] and Case C-91/92 *Faccini Dori v Recreb* [1994] ECR I-3325 at [26]). These principles of EU law should be remembered when considering those provisions in the RDA, the TMA and the CDPA based on the wording of EU Directives. Further, the only court which can give an authoritative ruling on the meaning of a provision in such a Directive is the ECJ.

1.5.5 Case law

When reading intellectual property cases it is important to understand two key points: which tribunal dealt with the matter and in which context. Dealing with the latter point first, intellectual property case law can arise in the context of an application to register a patent, trade mark or design. Here, the tribunal (ie a national or regional patent office, design registry or trade mark registry) will be concerned only with whether the application complies with the relevant statutory criteria. Second, case law can arise in the context of an action to restrain the infringement of any intellectual property right. It is important to remember that in the United Kingdom (in contrast to some other countries), the tribunal hearing the infringement action can also deal with any counterclaim that the registered right is invalid. Such a case may therefore discuss the criteria to be met by the successful claimant when suing for infringement, as well as the criteria for the validity of the claimant's right.

In the United Kingdom, decisions concerned with applications in respect of registrable intellectual property rights will be handed down by UKIPO, or, when dealing with applications to register trade marks or designs, the Trade Marks Registry or the Designs Registry or their respective appellate tribunals. Infringement actions are dealt with either by the Patents Court (a specialist court within the Chancery Division) or the Patents County Court.

As will have become apparent from the material already discussed, intellectual property rights effective in the United Kingdom can be granted by bodies other than UKIPO. In respect of patents, therefore, the decisions of the EPO are relevant, as are the decisions of OHIM in respect of trade marks and registered designs.

Lastly, there is an increasingly large body of case law being handed down in intellectual property cases by the ECJ, particularly in relation to trade marks. The ECJ's case law has two bases. First, where a national court in any Member State of the EU is required to apply a provision originating in one of the EU harmonisation Directives, a definitive interpretation of



thinking point

Is it correct to say that the United Kingdom does not really have a domestic law of intellectual property?

that Directive may only be given by the ECJ under the preliminary ruling mechanism set out in Article 267 TFEU (formerly Article 234 EC). Second, where OHIM has made a decision relating to the registrability or otherwise of an EU trade mark or design application, appeal from OHIM lies initially to the General Court (formerly the Court of First Instance of the European Community), with a further appeal (on a point of law only) to the ECJ. The ECJ thus acts in two capacities: as the final appellate body for the registration of pan-European rights and as the only judicial body which can interpret harmonisation Directives.



Summary

This chapter has explained:

- the range of rights available under United Kingdom law to protect the product of the intellect, together with their characteristics;
- the theoretical reasons why such rights might be protected; and
- the sources, both internal and external, from which United Kingdom law is derived.



Reflective questions

- 1 Would United Kingdom law benefit from the introduction of protection against unfair competition or would the doctrine of misappropriation be a better means of protecting the interests of other traders?
- 2 Which is likely to be more effective as a means of changing domestic intellectual property law, WIPO or WTO?



Annotated further reading

Arup, C. 'TRIPs: Across the Global Field of Intellectual Property' [2004] *EIPR* 7
Compares the WTO with WIPO.

Carty, H. 'The Common Law and the Quest for the IP Effect' [2007] *IPQ* 237

Considers those areas of intellectual property law where there are gaps in protection and discusses whether unfair competition or misappropriation could provide a solution.

Carty, H. 'Passing Off: Frameworks of Liability Debated' [2012] *IPQ* 106

Argues that passing off should remain firmly based in Lord Oliver's 'classic trinity'.

Crespi, S. 'IPRs under Siege: First Impressions of the Report of the Commission on Intellectual Property Rights' [2003] *EIPR* 242

Argues that the Report fails to understand the nature of IP rights, particularly as they affect developing countries, and relies heavily on emotive language when so doing.

Davis, J. 'Why the United Kingdom Should Have a Law against Misappropriation' [2012] *CLJ* 561

Argues that trends in passing off show that remedies for misappropriation are necessary to protect investment in the attractiveness of brands.

Fisher, W. 'Theories of Intellectual Property' in Munzer (ed) *New Essays in the Legal and Political Theory of Property* (2001), Cambridge University Press

Sets out in detail the various theories put forward to justify the protection of intellectual property.

Jacob, R. 'The Stephen Stewart Memorial Lecture: Industrial Property—Industry's Enemy' [1997] *IPQ* 3

Argues that the continued expansion of intellectual property rights is unjustified.

Libling, D.F. 'The Concept of Property: Property in Intangibles' (1978) 94 *LQR* 103

Argues on the basis of the *INS* case that there should be a property right in intangible property arising from effort and investment.

May, C. 'Why IPRs Are a Global Political Issue' [2003] *EIPR* 1

Argues that there needs to be a global mechanism to deal with the balance between IP owners' interests and social need.

Merges, P. *Justifying Intellectual Property* (2011), Harvard University Press

A wide-ranging synthesis of three philosophies which he argues are the true, workable foundations for intellectual property protection.

Ricketson, S. "'Reaping without Sowing": Unfair Competition and Intellectual Property Rights in Anglo Australian Law' (1984) 7 *UNSWLJ* 1

Argues that there should be protection against misappropriation on the ground either that the defendant has gained a competitive advantage or the claimant has suffered a competitive disadvantage.

Samuelson, P. 'Challenges for WIPO and TRIPs in Regulating Intellectual Property Rights in the Information Age' [1999] *EIPR* 578

Considers the background to the TRIPs Agreement.

Schricker, G. 'Twenty-five Years of Protection against Unfair Competition' (1995) 26 *II C* 782

Explains how unfair competition actions can be classified and gives a summary of key cases (mainly from Germany).

Schricker, G. and Henning-Bodewig, F. 'New Initiatives for the Harmonisation of Unfair Competition Law in Europe' [2002] *EIPR* 271

Discusses what areas might be the subject matter of EU harmonisation of unfair competition law.

Spence, M. 'Passing Off and the Misappropriation of Valuable Intangibles' (1996) 112 *LQR* 472

Considers four arguments in favour of adopting misappropriation as a basis for protection but concludes that none is viable.

Wadlow, C. 'The Emergent European Law of Unfair Competition and its Consumer Law Origins' [2012] *IPQ* 1

Argues that the Unfair Commercial Practices Directive could form the basis of an EU law against unfair competition.

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