

# DETAILED CONTENTS

<i>Preface to the fourth edition</i>	xvii
<i>Table of statutes</i>	xix
<i>Table of cases</i>	xxvii
<i>Table of EU legislation</i>	xlvii
<i>Table of International Agreements, Conventions and Treaties</i>	li

## Section A Introduction

---

### 1 Themes in intellectual property 3

---

Preliminary thoughts	3
Introduction	4
A brief historical overview: the origins	5
The origin and the evolution of the patent system	5
Trade marks	8
The origin and the evolution of the copyright system	8
A definition and a justification of intellectual property	11
Property rights	11
Intangible property rights	12
An economic justification	13
Other ways to justify intellectual property	21
Current economic importance of intellectual property	25
International intellectual property conventions	27
Patents	28
Trade marks	29
Design rights	30
Copyright	30
European initiatives	31
Patents	31
Trade marks	32
Industrial designs	33
Copyright	33
Enforcement of intellectual property rights	34
Miscellaneous	34
An overview	34

## Section B Patents

---

### 2 Origin, background and international aspects of the patent system 37

---

History	37
Purpose	39
The international dimension	41
Obtaining a patent	46



---

**3 Patentability** 52

---

- Novelty 53
- Inventive step 64
  - Industrial application 78
- Non-patentable matter 81
- Biotechnology 86
- Patentability—overview 90

---

**4 Use and grant in the UK and Europe** 92

---

- Whose patent is it anyway? 92
- Grant and dealing 97
- Licensing in UK law 97
  - Licences as of right 98
  - Compulsory licences 98
  - Crown rights 101
  - Exclusive licences 103
- Commercial exploitation in European law 103
  - Free movement of goods 105
  - Free movement of goods and patents 108
  - Patents and competition law—introduction 113
  - Patents and competition law—Article 81 113
  - Patents and competition law—Article 82 125
  - Article 82 applied to patents 126
- European law and intellectual property—introduction and patents: an overview 127

---

**5 Infringement and revocation** 129

---

- Revocation 129
- Infringement 132
- Infringement: interpretation of specifications and claims 137
- Infringement: an overview 151

---

**6 Supplementary protection certificates and the proposed utility model and community patent** 153

---

- Supplementary protection certificates 153
  - Background 153
  - Regulation 1768/92 154
  - The extension of the system 156
  - The challenge to the Regulation 157
- Utility models 160
  - Definition 161
  - Rationale 161
  - Do we need it? 162
  - Summary 163
- The Community Patent 163



---

**7 Section B—an overview** 166
 

---

**Section C Copyright and related issues**


---

**8 Introduction to copyright** 171
 

---

The roots 171

Essential elements 172

A work 172

A copyright work 172

The idea–expression dichotomy 172

Fixation 173

---

**9 The various types of copyright and the quality issue** 174
 

---

Original literary, dramatic, musical, and artistic works 175

Literary works 177

Dramatic works 182

Musical works 184

Artistic works 184

Works of artistic craftsmanship 186

Entrepreneurial rights 189

Sound recordings 190

Films 191

Broadcasts 192

Typographical arrangements 195

---

**10 Qualification** 197
 

---

Qualification by the personal status of the author 198

Qualification through first publication 198

---

**11 The term of copyright** 201
 

---

General principles 201

Original works 204

Films 204

Other entrepreneurial works 206

---

**12 Authorship and ownership of copyright** 208
 

---

Authorship 208

Ownership 211



---

**13 Moral rights** 215

---

- General principles 215
- The paternity right 217
- Right to object to derogatory treatment 219
- False attribution of the work 223
- Right to privacy in relation to commissioned photographs 224
- Consent and waiver 226

---

**14 Copyright infringement** 227

---

- Primary infringement 227
- Infringement requires misappropriation 228
  - The causal link 228
  - The intention of the infringer and subconscious copying 230
  - Indirect copying 230
- Substantial copying 231
- Copying the various types of works 235
  - Original literary, artistic, dramatic, and musical works 236
  - Films and television broadcasts 236
  - Typographical arrangements of published editions 236
  - All works 236
- Issuing copies to the public 237
- Rental and lending of the work to the public 237
- Public performance of the work, showing or playing the work in public 238
- Communication of the public 239
- Making an adaptation 240
- Secondary infringement 240
- Technical measures 243
- Future developments 245
- Copyright infringement: an overview 247

---

**15 Defences to copyright infringement** 248

---

- Authorisation or consent of the owner 248
- Public interest 249
- The copyright (visually impaired persons) Act 2002 252
- Making of temporary copies 252
- Fair dealing 253
  - Research and private study 254
  - Review and criticism 256
- Incidental inclusion 260
- Educational use 261
  - Instruction and examination 261
  - Anthologies 262
  - Performing, playing or showing a work 262
  - Recording, reprographic copying and lending 263



Libraries, archives and public administration	263
Miscellaneous	264
Once more the information society directive	266
Copyright infringement and defences: an overview	267

---

## 16 Rights in performances 268

---

The problem	268
Subsistence of rights	269
Term of protection	269
The qualification requirement	270
Content and infringement	271
Defences against alleged infringements	273
The nature of the performer's rights and their transfer	273
Future developments	274

---

## 17 Dealing in copyright 275

---

Crown copyright	275
Commercial exploitation of copyright in the UK	276
Assignment of copyright and copyright licences	278
Collecting societies	280
Licensing schemes	281
The Copyright Tribunal	282
The rental and the lending right	282
Copyright exploitation and free competition	285
Exploitation under European law—copyright and the free movements of goods	285
Non-performance copyrights	286
Performance copyrights	289
Exploitation under European law—Copyright and competition law	291
Article 81	291
Article 82—collecting societies	291
Article 82—does dominance force an undertaking to grant a licence?	295

---

## 18 Copyright—an overview 313

---

### Section D Designs

---

## 19 Design and copyright 317

---

Introductory remarks	317
The wall between design and copyright	317



---

**20 Registered designs** 323

---

Starting points 323

Requirements for the grant of a registered design before the implementation of the design directive 324

A design 324

A design for a product 325

Novelty 326

Individual character 327

Component parts of complex products 328

Grounds for refusal registration 328

Technical function 328

The 'must fit' exception 329

Public policy and morality 330

General exception 330

Ownership of a registered design 330

Rights of the owner and infringement 331

Exclusion from protection—defences to infringement 332

Invalidity 333

Duration of the registered design right 333

Spare parts 334

International commercial exploitation 335

The community design 336

Registered designs—an overview 338

---

**21 Unregistered designs** 339

---

Introduction 339

Subsistence of the (unregistered) design right 340

A design 340

An original design 341

The tangible form requirement 344

Exceptions to the design right 345

Qualification 347

The substance of the design right 348

The person behind the design 348

The term of (unregistered) design protection 349

Infringement and remedies 350

Primary infringement 350

Secondary infringement 353

Defences 354

Commercial exploitation 354

Assignment and licences 354

One design, two design rights 356

Crown use 357

Competition law 357

---

**22 Designs—an overview** 358

---



**Section E Image rights**

---

**23 Trade marks—an introduction** 363

---

Trade marks—development 363  
 The need for reform 364  
 Why trade marks? 367

---

**24 Trade marks—trademarkability and use** 368

---

Trade mark recognition—the UK framework 368  
 Trade marks defined 369  
     Capable of being represented graphically 370  
     Distinctiveness in trade 373  
     Unregistrable marks 377  
 Special marks 394  
 Use of trade marks 396

---

**25 Trade marks—infringement and revocation** 398

---

Infringement 398  
     Section 10(1) 399  
     Section 10(2) 402  
     Section 10(3) 406  
     Further examples and an extension of infringement rules 412  
     Comparative advertising 413  
     Exceptions to infringement 415  
     Exhaustion 417  
     Consequences of trade mark infringement 418  
     Revocation and invalidity 419  
 UK trade marks—an overview 423

---

**26 Trade marks—European and international aspects** 425

---

Trade marks—international aspects 425  
 Trade marks and the free movement of goods 429  
     Towards a definition of the specific subject matter and the essential function 429  
     The repackaging and relabelling saga 431  
     Exhaustion covers publicity 439  
     International exhaustion 440  
     The real context 444  
     The doctrine of common origin 444  
 Trade marks and competition law 446  
     Article 81 446  
     Article 82 446



---

**27 Tortious protection of intellectual property rights** 447

---

Passing-off 448

- Historical development 448
- Passing-off defined 449
- Goodwill 451
- Misrepresentation 466
- Damage 475
- When can action be brought? 477
- Remedies 477
- Passing-off: an overview 478

Defamation and malicious falsehood 479

- Defamation 479
- Malicious falsehood 480
- Tort—an overview 485

Section F **Issues in intellectual property**

---

**28 Confidentiality and trade secrets** 489

---

Historical development and conceptual basis 490

Elements of the action 491

- When is information confidential? 492
- The public interest exception 496
- The obligation of confidence 504
- Unauthorised use of confidential information 514

Remedies for breach of confidence 518

- Injunctions 518
- Damages 518
- Other equitable remedies 520

Information—the international dimension 521

Confidence—an overview 522

---

**29 Computer technology and intellectual property** 524

---

Patent protection for computer technology 524

- Hardware 524
- Software 525

Copyright protection for computer software 527

- Preliminary issues 527
- Computer programs as literary works in copyright 528
- Infringement 530
- Defences 533

Databases 535

- A database 535
- Copyright protection for a database 536
- The database right 538



- The internet 543
  - Existence of copyright and classification 543
  - Infringement issues 545
  - Defences that may come to the rescue 547
- Semiconductor chip protection 550
  - Introduction 550
  - The Design Right (Semiconductor Regulations) 1989 551
- Intellectual property rights in computer technology—an overview 552

---

## **30 Character merchandising** 553

---

- Trade mark law 554
- Design law 556
- Tort 557
  - Passing-off 557
  - Defamation 560
  - Malicious falsehood 560
- Copyright 561
- Character merchandising—an overview 563

---

## **31 Franchising and intellectual property** 564

---

- The concept of franchising 564
- Franchises and trade mark law 565
- Franchising and passing-off 567
- Franchising and other areas of intellectual property law 569
- Franchising and competition law 569
- The vertical agreements regulation 572
- An overview 574

---

## **32 Remedies in intellectual property litigation** 575

---

- Enforcement issues 575
  - Civil actions 575
  - Criminal proceedings 577
  - Administrative procedures 578
  - Self-help 578
- Civil remedies 579
  - Injunctions 579
  - Delivery up 582
  - Damages 583
  - Account of profits 584
- The gathering of evidence 585
  - Search orders 585
  - Abuse of the order and its redress 587



xvi Detailed contents

Search orders and freezing orders 589

The Norwich Pharmacal action 590

Remedies—an overview 591

*Postscript*

593

*Index*

595