

Table of Contents

Preface	xix
About the Authors and Editors	xxi
Part 1	
General Overview: Balancing Interests of IP Owners and the General Public	1
Chapter 1	
Right Holders' Control over Repair and Reconditioning	3
<i>David Llewelyn and Veronica Barresi</i>	
I. Introduction	3
II. The EU Regime: Registered and Unregistered Design	4
A. The Design Directive	5
B. The Community Design Regulation	8
C. The Proposal for Amending the Design Directive	8
III. The UK Regime	10
A. The UK Registered Design Act	10
B. Unregistered Designs	11
IV. Spare Parts and Trademarks	15
V. Patents	18
Chapter 2	
Repair and Recycle between IP Rights, End User License Agreements and Encryption	21
<i>Estelle Derclaye</i>	
I. Introduction	21

II.	Preliminary Questions	22
A.	Notions of 'Repair' and 'Recycle' and Their Legal Effects	22
B.	Intellectual Property Laws' Limits in Relation with Repair and Recycle	24
1.	Copyright Law	24
a.	Europe	24
b.	The United States	25
2.	Patent Law	28
a.	Europe	28
b.	The United States	29
3.	Design Law	31
a.	Europe	31
b.	The United States	32
4.	Trademark Law	32
a.	Europe	32
b.	The United States	35
III.	Blocking Repair through End User License Agreements and Technological Protection Measures	36
A.	Copyright Law	37
1.	Europe	37
2.	The United States	39
B.	Patent Law	42
1.	Europe	42
2.	The United States	42
C.	Design Law	42
1.	Europe	42
2.	The United States	42
D.	Trademark Law	43
1.	Europe	43
2.	The United States	43
E.	Use of EULAs or TPMs to Prevent Repair When a Product Is Protected by Several IPRs at the Same Time	43
IV.	Is It Lawful to Block Recycle through EULAs and TPMs?	45
A.	Europe	45
B.	The United States	46
1.	Patent and Design Law	46
2.	Trademark and Copyright Law	49
V.	Should Limitations to Repair and Recycle Be Allowed?	49
A.	Blocking Repair	49
B.	Blocking Recycle	50
C.	Additional Safeguards	51
1.	Europe	51
2.	The United States	52
VI.	Conclusion	56

Part 2**Issues under Patent Law****57****Chapter 3****Repair and Recycle as Direct Patent Infringement?****59***Mineko Mohri*

I.	Introduction: Patent Exhaustion on Repair and Recycling	59
II.	Repair and Recycling in Different Jurisdictions: The US, Japan, the UK and Germany	61
A.	The US	61
1.	The Origins of Patent Exhaustion in the US Supreme Court	61
2.	Replacement of Unpatented Parts of Combination Products	62
3.	Multiple Factors and Extrinsic Conditions	63
4.	Not ‘Repair’, but ‘Akin to Repair’	64
5.	Overview: Permissible Repair in the US	66
B.	Japan	66
1.	Japanese Cases and Patent Exhaustion	66
2.	<i>Canon</i> as Decided by the Supreme Court	68
3.	<i>Canon</i> before the IP High Court	69
4.	Other Early Cases	71
5.	Overview: Permissible Repair in Japan	72
C.	Germany	73
1.	‘Intended Use’ and the Exhaustion Doctrine	73
2.	No Protection in Case of Replacement of Consumable Spare Parts	74
3.	Alteration of the ‘Identity’ of Products: The <i>Flügelradzähler</i> Case	75
4.	Overview: Permissible Repair in Germany	76
D.	The UK: Denial of Implied License Theory in the <i>United Wire</i> Case	76
III.	International Comparison: Single-Use Camera Case as the Touchstone	77
IV.	A Possible Solution: Single-Use Restrictions?	80
V.	Synthesis and Thoughts on the Road Ahead	82

Chapter 4**Repair and Refill as Indirect Patent Infringement****85***Christopher Heath*

I.	Introduction	85
A.	Direct and Indirect Infringement	85
B.	Senseo’s Coffee Machine as an Example	86

II.	The Concept of 'Indirect' or 'Contributory' Infringement in Different Jurisdictions	88
A.	Europe: Germany, the Netherlands and the UK	88
1.	The CPC	88
2.	The Netherlands	88
3.	Germany	90
4.	The UK	94
B.	Asia: Japan and Korea	95
1.	Japan	95
2.	Korea	96
C.	The US	96
1.	Inducement	96
2.	Contributory Infringement	98
III.	Analysis	99
A.	Essential Element versus State of the Art	99
B.	State of the Art and Staple Products	100
C.	Objective Limits (Exhaustion) and Implied Permission	100
D.	Separation of Direct and Indirect Infringement	101
E.	Conclusion	101

Part 3

Issues under Copyright Law	103
----------------------------	-----

Chapter 5

Blocking Repair or Fair Use of Software? The U.S. Perspectives on Anticircumvention	105
---	-----

Andy Y. Sun

I.	Introduction	105
II.	The Legislative Structure	107
A.	Types of Prohibitions	107
B.	Liabilities	108
C.	Exemptions	108
III.	The Judicial Interpretations	113
A.	<i>Universal City Studios, Inc. v. Corley</i>	113
B.	<i>The Chamberlain Group, Inc. v. Skylink Technologies, Inc.</i>	114
C.	<i>Lexmark International, Inc. v. Static Control Components, Inc.</i>	116
D.	<i>Storage Technology Corp. (a/k/a StorageTek) v. Custom Hardware Engineering & Consulting, Inc.</i>	118
IV.	Analyses and Comments	120
V.	Conclusion: The Good, the Bad, and the Ugly	122

Part 4**Issues under Trade Mark and Design Law 125****Chapter 6****Trademarks and Reconditioned Goods in Greater China and at Common Law 127***Michael D. Pendleton*

I.	Introduction	127
II.	Hong Kong	128
	A. Trade Marks Ordinance (Cap 43) LHK	128
	1. Refilling, Repackaging, and Repair	128
	2. Establishing Infringement under Section 18 of the Trade Mark Ordinance	130
	3. Section 19(3): Honest Practices in Industrial and Commercial Practices	132
	4. Infringement by Use	132
	5. Comparative Advertising	135
	6. Exceptions to Infringement	137
	B. Ownership of the Badge of Recognition: Manufacturer, Dealer, or Distributor	138
III.	Mainland China	142
	A. Trademark Law and Implementing Regulations	142
	1. Infringement of Registered Trademarks	142
	2. Administrative Actions	143
	3. Criminal Liability for Trademark Counterfeiting	143
	B. Unfair Competition Act	144

Chapter 7**Repairs, Interconnections, and Consumer Welfare in the Field of Design 147***Alison Firth*

I.	Introduction	147
II.	Lack of Treaty Constraints and Variety of Design Laws	151
	A. Paris, Berne, TRIPs	151
	B. Defences	152
	C. Hague	153
	D. Locarno	153
	E. Scope for Experiment	154
III.	Cumulation	155
IV.	The Spare Part Non-problem	157
V.	In, Out, or Halfway House: Design Law Strategies and Their Impact on the Protection or Non-protection of Spare Parts	158

A.	Require Ornamental Aspect as a Pre-requisite for Protection and Set High Threshold	158
B.	Exclude Functional Design from Protection	160
C.	Allow Functional Design To Be Protected, at Least Where There Is Design Freedom, but Still Focus on the Product's Appearance	162
D.	Protect Only Whole Articles (Cars, Vacuum Cleaners)	163
E.	Exclude Certain Industrial Sectors from Design Protection	164
F.	Protect Designs Only for Specific Articles and Exclude Spare Parts from the List of Articles That May Be Protected	165
G.	Reduce the Duration of Protection for Spare Parts	166
H.	Specifically Exclude Spare Parts from Protection by Reference to Their Desiderata: Fitting, Matching, Permitting Re-assembly	166
I.	Create Defences for Spares and Repairs	168
J.	Compulsory Licensing/Licenses of Right	170
K.	Limit the Remedies Available for Infringement	171
L.	Make Available a 'Threats' Action to Deter Overweening Use of Rights	172
M.	'Internal' or 'External' Limits to Design Law Protection?	173
N.	'Non-derogation from Grant'	174
O.	Subject the Exercise of Design Rights to the Doctrine of <i>Abus De Droit</i> , or 'Patent Misuse', Where This Is Available	174
P.	Leave Spare Parts Protected, with Competition Laws Providing a Backstop against Abuse	176
Q.	The Context of Other Relevant Laws	177
VI.	Review in Europe: What have the European Commission and the European Parliament Proposed?	179
Part 5		
Issues under Competition Law		181
Chapter 8		
Antitrust Considerations: Refusal to License Intellectual Property in the U.S. and EC		183
<i>Valentine Korah</i>		
I.	Introduction	183
II.	U.S. Law	184
III.	EC law	186
A.	Commercial Solvents	187
B.	Volvo	187
C.	Magill	188
D.	Oscar Bronner	190
E.	Microsoft	191

1. Dominant Position	191
2. Extending Dominant Position to Server Market	192
3. Microsoft's Alleged Justification	192
4. Remedy	193
a. To Supply Whom	193
b. FRAND Prices	194
F. IMS	194
1. Conditions in <i>Magill</i> Cumulative: Novelty	194
2. Conditions in <i>Magill</i> Exhaustive	195
3. Access Must Be Essential To Prevent All Competition Being Eliminated	195
4. Secondary Market May Be Potential or Hypothetical	196
5. No Justification	196
6. Level of Compensation	197
7. Conclusion on <i>IMS</i>	197
G. Syfait	197
H. Subsequent Developments	200
1. The Judgment of the Full Court of the CFI in <i>Microsoft</i>	200
2. <i>Syfait II v. GSK Aeve</i>	201
3. The Commission Guidance on Enforcement Priorities	202
I. Industry Standards	203
J. Conclusion	204
 Subject Index	 207
 Case Index	 209