Contents

| Pr | reface | | | xii |
|----|---|-------------|---|---------------|
| Ta | ble of | cases | | xiv |
| Ta | ble of | legislation | on | XXXIII |
| Ta | ble of | treaties, | conventions and other international instruments | xlv |
| 1 | Intro | duction | | 1 |
| 2 | Copyright and related rights | | | |
| | 2.1 Introduction | | | |
| | 2.2 | Internat | tional conventions | 8 |
| | | 2.2.1 | Early bilateral agreements | 8 |
| | | 2.2.2 | The Berne Convention | 9 |
| | | 2.2.3 | The Universal Copyright Convention | 13 |
| | | 2.2.4 | The Rome Convention | 14 |
| | | 2.2.5 | TRIPS | 17 |
| | | 2.2.6 | The WIPO Internet Treaties | 19 |
| | 2.3 The influence of the European Union | | | |
| | | 2.3.1 | An early survey: the Commission's 1988 Green | |
| | | | Paper | 24 |
| | | 2.3.2 | The Computer Programs Directive | 27 |
| | | 2.3.3 | The Rental Directive | 29 |
| | | 2.3.4 | The Satellite and Cable Directive | 34 |
| | | 2.3.5 | The Term Directive | 38 |
| | | 2.3.6 | The Database Directive | 41 |
| | | 2.3.7 | The E-Commerce Directive | 47 |
| | | 2.3.8 | The Information Society Directive | 49 |
| | | 2.3.9 | The Resale Right Directive | 57 |
| | | 2.3.10 | Future Reforms | 61 |
| 3 | Patents and related rights | | | |
| | 3.1 Introduction | | | 69 |
| | 3.2 The global patent environment | | | 74 |
| | | • | The Paris Convention | 74 |
| | | 3.2.2 | The Patent Cooperation Treaty | 75 |
| | | 3.2.3 | TRIPS | 77 |

| | 3.2.4 | The Cor | nvent | ion on Biological Diversity (CBD) | 85 |
|-----|----------|-------------|--------|---|-----|
| | 3.2.5 | | | aw Treaty | 88 |
| 3.3 | The Eur | ropean pa | tent e | environment | 91 |
| | 3.3.1 | The Eur | opea | n Patent Convention | 91 |
| | | 3.3.1.1 | Hist | ory | 91 |
| | | 3.3.1.2 | EPC | 2000 – major changes | 92 |
| | | 3.3.1.3 | EPC | 2000: overview and procedure | 94 |
| | | 3.3.1.4 | Opp | osition proceedings | 100 |
| | | 3.3.1.5 | Sub | stantive harmonisation – limits and | |
| | | | defi | nitional challenges | 101 |
| | | 3.3.1.6 | Arti | cle 69 – interpretation of claims | 102 |
| | | 3.3.1.7 | Euro | opean patent – substantive | |
| | | | requ | irements | 104 |
| | | | (1) | Novelty – Article 54 | 105 |
| | | | (2) | Inventive step – Article 56 | 111 |
| | | | (3) | Industrial application – Article 57 | 117 |
| | | | (4) | Excluded subject matter – | |
| | | | | Article 52(2)–Article 53 | 118 |
| | | | | (i) The boundary between discoverie | S |
| | | | | and inventions | 120 |
| | | | | (ii) Computer-related inventions | 122 |
| | | | | (iii) Biological subject matter – | |
| | | | | Article 53(b) | 127 |
| | | | | (iv) Methods for treatment of the | |
| | | | | human or animal body – | |
| | | | | Article 53(c) | 132 |
| | | | | (v) Morality – Article 53(a) | 133 |
| | | | (5) | Sufficiency of disclosure | 141 |
| | 3.3.2 | Other le | gisla | tive initiatives in European patent law – | |
| | | | the] | London Agreement and the EPLA | 142 |
| | | 3.3.2.1 | The | London Agreement | 143 |
| | | 3.3.2.2 | The | European Patent Litigation Agreement | |
| | | | (EPI | LA) | 144 |
| | 3.3.3 | Commu | nity i | nitiatives in the field of patent law | 148 |
| | | 3.3.3.1 | The | Community patent: context and | |
| | | | histo | ory | 148 |
| | | 3.3.3.2 | Sup | plementary protection certificates | 158 |
| | | 3.3.3.3 | | Biotechnology Directive: the legal | |
| | | | prot | ection of biotechnological inventions | 159 |
| | | | | ity models | 169 |
| 3.4 | Plant va | ariety righ | its | | 170 |
| | 3.4.1 | History | of pr | otection | 170 |

| | • |
|------------|-----|
| Contents | 1X |
| Controlles | ~~~ |

| | | 3.4.2 | The UPOV Convention | 172 | |
|---|--------------------------------|---------|---|-----------|--|
| | | 3.4.3 | The Community plant variety right | 174 | |
| 4 | Desi | ons | | 180 | |
| | 4.1 | _ | action – the concept of design | 180 | |
| | 4.2 | | eps towards EC harmonisation | 181 | |
| | 4.3 | | ered Community Design | 184 | |
| | 4.4 | - | ommunity definition of 'design' | 189 | |
| | 4.5 | | ds of invalidity | 192 | |
| | | | Novelty | 193 | |
| | | | Individual character | 195 | |
| | | 4.5.3 | Complex products – special requirements | 196 | |
| | | 4.5.4 | Relative grounds of invalidity | 197 | |
| | 4.6 | The de | sign proprietor's rights | 200 | |
| | | 4.6.1 | Initial entitlement | 200 | |
| | | 4.6.2 | Assignment and licences | 201 | |
| | | 4.6.3 | Duration | 202 | |
| | | 4.6.4 | Rights conferred by the design right | 203 | |
| | | 4.6.5 | Exceptions and defences | 205 | |
| 5 | Trade marks and related rights | | | | |
| | 5.1 | Introdu | | 210 | |
| | 5.2 | | s administered by WIPO | 213 | |
| | ų. | | The Paris Convention | 213 | |
| | | 5.2.2 | The Madrid Agreement | 214 | |
| | | 5.2.3 | The Madrid Protocol | 216 | |
| | | 5.2.4 | The Trademark Law Treaty | 218 | |
| | | 5.2.5 | The Singapore Treaty on the Law of Trader | narks 219 | |
| | 5.3 | TRIPS | | 219 | |
| | 5.4 | Comm | unity trade mark legislation | 220 | |
| | | 5.4.1 | Overview | 220 | |
| | | 5.4.2 | Applying for a Community trade mark | 222 | |
| | | 5.4.3 | Criteria for registration | 224 | |
| | | | (a) What is a registrable mark? | 225 | |
| | | | (b) The absolute grounds for refusal | 233 | |
| | | | (i) Signs which do not conform to t | he | |
| | | | requirements of a trade mark | 233 | |
| | | | (ii) 'Devoid of any distinctive charae | cter' 233 | |
| | | | (iii) Descriptive marks | 239 | |
| | | | (iv) Customary and generic marks | 242 | |
| | | | (v) Acquired distinctiveness | 243 | |
| | | | (vi) The shape exclusions | 245 | |
| | | | | | |

| | | | (vii) The remaining absolute grounds for | | | | |
|---|-------|----------------|---|------------|--|--|--|
| | | | refusal | 249 | | | |
| ` | | | (i) Public policy and morality | 249 | | | |
| | | | (ii) Deceptive marks | 251 | | | |
| | | | (iii) Special emblems and marks | | | | |
| | | | prohibited by law | 252 | | | |
| | | | (iv) Bad faith | 253 | | | |
| | | | (c) Relative grounds for refusal | 253 | | | |
| | | | 1 Earlier trade marks | 254 | | | |
| | | | (i) Identical trade mark and identical | | | | |
| | | | goods | 254 | | | |
| | | | (ii) Confusingly similar marks and goods | 255 | | | |
| | | | (iii) Marks with a reputation | 263 | | | |
| | | | 2 Earlier rights (non-trade mark) | 268 | | | |
| | | 5.4.4 | Cancellation of a mark | 269 | | | |
| | | 50 1 | Infringement | 274 | | | |
| | | 5.4.6 | Defences | 279 | | | |
| | | 5.4.7 | Other EU harmonisation initiatives relevant to | | | | |
| | | | trade marks | 283 | | | |
| | | | (a) Misleading advertising | 283 | | | |
| | | | (b) Unfair Commercial Practices Directive | 286 | | | |
| | | · - 1 0 | (c) Domain names | 287 | | | |
| | | | Community trade marks as objects of property | 288 | | | |
| | 5.5 | | phical indications of origin | 290 | | | |
| | | 5.5.1 | Introduction | 290 | | | |
| | | | International treaties TRIPS | 290 | | | |
| | | 5.5.3 5.5.4 | | 292 294 | | | |
| | | | The EU regime Traditional specialities guaranteed | 305 | | | |
| | | 5.5.5 | Traditional specialities guaranteed | 303 | | | |
| 6 | Intel | lectual pr | roperty and free movement of goods | 310 | | | |
| 0 | 6.1 | _ | Introduction | | | | |
| | 0.1 | 6.1.1 | Overview of the problem – three typical cases | 310 310 | | | |
| | | 6.1.2 | Intellectual property rights – different rights | 010 | | | |
| | • | | have different purposes | 317 | | | |
| | 6.2 | Intellect | tual property in the Community – the free | | | | |
| | | | ent of goods | 319 | | | |
| | | 6.2.1 | The treaty: the basic legal framework | 319 | | | |
| | | 6.2.2 | Early case law: the distinction between existence | 1 | | | |
| | | | and exercise of rights | 320 | | | |
| | | 6.2.3 | Specific subject matter: definitions | 322 | | | |
| | | | | | | | |

| | | 6.2.4 | What is 'consent' for the purposes of exhaustion | |
|-----|---|---------|---|-----|
| | | | of rights? | 327 |
| | 6.3 | Repack | caging: balancing the principle of free movement | |
| | | against | the trade mark owner's rights | 337 |
| | | 6.3.1 | Pharmaceuticals | 337 |
| | | 6.3.2 | Repackaging principles – application to other | |
| | | | products? | 350 |
| | 6.4 | Use of | another's trade mark in advertising | 351 |
| | 6.5 | Goods | in transit are not 'on the market' | 356 |
| | 6.6 | Exhaus | stion: national, Community-wide or international? | 359 |
| | 6.7 | Compe | etition law and intellectual property | 373 |
| | | 6.7.1 | Article 81 | 374 |
| | | | Assignments | 375 |
| | | | Licensing agreements | 376 |
| | | | Copyright licensing – individual and collective | 378 |
| | | | Unilateral action and Article 81(1) | 382 |
| | | | Dual pricing | 383 |
| | | | Block exemptions – the Technology Transfer | |
| | | | Regulation | 386 |
| | | 6.7.2 | Article 82 | 391 |
| 7 | Enforcement of intellectual property rights | | | |
| | 7.1 | TRIPS | | 404 |
| | 7.2 | Europe | ean Community measures | 407 |
| | | 7.2.1 | The Enforcement Directive | 408 |
| | | 7.2.2 | The Draft Criminal Enforcement Directive | 412 |
| | | 7.2.3 | Counterfeiting: future measures | 416 |
| | | 7.2.4 | Jurisdiction – the Brussels Regulation | 417 |
| Inc | dex | | | 419 |
| | | | | |