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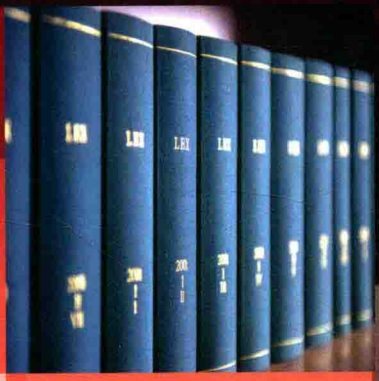
Intellectual Property and General Legal Principles

Is IP a *Lex Specialis*?



ATRIP Intellectual Property Series

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Edited by

Graeme B. Dinwoodie

Professor of Intellectual Property and Information Technology Law, University of Oxford, UK

ATRIP INTELLECTUAL PROPERTY SERIES

Cheltenham, UK • Northampton, MA, USA

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Intellectual Property and General Legal Principles

ATRIP INTELLECTUAL PROPERTY SERIES

Series Editor: Graeme B. Dinwoodie, *Professor of Intellectual Property and Information Technology Law, University of Oxford, UK*

The ATRIP series presents the fruit of annual meetings held by the International Association for the Advancement of Teaching and Research in Intellectual Property (www.atrip.org). Yielding unique opportunities for IP scholars from a global community to explore together the different facets of one overarching topic, the essence of those meetings is captured in the edited compilation of selected contributions contained in the volumes. Rather than employing a traditional, compartmentalized view of the different areas of IP, the ATRIP series typically follow a horizontal approach, cutting across the usual boundaries of legal categorization, with the aim to uncover hidden commonalities, and accentuate the need for differentiation where that is called for. As ATRIP counts among its members leading IP scholars from all parts of the world, and actively encourages the participation of highly talented young researchers, the panel of authors contributing to the volumes not only guarantees excellence, but also represents a full and vibrant picture of contemporary, high-level IP research in an international setting.

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Introduction

Graeme B. Dinwoodie*

As part of the maxim *Lex specialis derogat legi generali*, the rule of *lex specialis* typically serves as an interpretative canon to determine which of two competing norms should govern.[1] Even within this narrow rubric, consideration of the maxim throws up some difficult questions: most fundamentally, what is the scope of this thing called 'intellectual property law' that constitutes a *lex specialis*, and which is the body of general law against which possible displacement by special rules is to be considered? As to the former, the vintage of the term 'intellectual property' has been the subject of some scholarly exploration.[2] At the international level, it might be thought to represent some amalgam of 'industrial property' (patents, designs and marks) dealt with by the Paris Convention and 'literary and artistic property' addressed by the Berne Convention.[3] But that undoubtedly is too simple an explanation. Even with a definition of 'intellectual property' now contained in the TRIPS Agreement, there remains debate about the borders of the concept, let alone its essence.[4] Thus, the narrow task of applying the maxim *lex specialis derogat legi generali* to such matters as copyright, patent, trade mark and their allied

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[1] *See* International Law Commission, *Fragmentation of International Law: Difficulties Arising from the Diversification and Expansion of International Law: Report of the Study Group on the Fragmentation of International Law*, Finalized by Martti Koskenniemi, UN Doc. A/ CN.4/L.682 (April 13, 2006).

[2] *See, e.g.*, Justin Hughes, A Short History of 'Intellectual Property' in Relation to Copyright, 33 Cardozo Law Review 1293 (2012).

[3] Paris Convention for the Protection of Industrial Property, July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305; Berne Convention for the Protection of Literary and Artistic Works, July 24, 1971, 1161 U.N.T.S. 3.

[4] *See, e.g.*, Appellate Body Report, United States – Section 211 Omnibus Appropriations Act of 1998, WT/DS176/AB/R (August 6, 2001).

regimes (to pick a non-definitional phrase) would present plenty of opportunities for disagreement.

In this volume, the *lex specialis* label is used even more broadly, however, to connect a whole series of possible questions, including at the most abstract level: what is the relationship between intellectual property law and general legal principles? But this broader inquiry inevitably mimics some of the questions that would be at the heart of the narrower interpretative task. Most basically, to what extent are intellectual property laws exceptional? There is tendency – perhaps found in any area where a community of scholars and legal practitioners specialise – to think that what we do is special, advanced and not accessible to those not part of the specialist community. But when intellectual property comes to assume as prominent a social and economic role as it now does on a worldwide basis, it is especially important to question the costs and benefits of treating it apart from general principles of law.

Thus, several authors in this volume consider the extent to which intellectual property laws displace or conflict with generally applicable legal rules. This inquiry has perhaps been most developed in the private law sphere and that is reflected in the book. Giuseppina D'Agostino, Charles R. McManis and Brett Garrison, and Caroline Ncube each consider (in different ways) the interaction of intellectual property (especially copyright) law with principles of contract law. Branislav Hazucha, Hsiao-Chien Liu and Toshihide Watabe do the same as regards consumer protection principles in Japan.

Underlying much of the discussion in these chapters is a debate about the normative force of intellectual property principles, and the extent to which those norms should be impervious to alteration by market actors. That too is a tension underlying the contribution by Begoña Otero.

The centrality of intellectual property to contemporary society also brings it potentially into conflict with public law commitments, and such conflicts are addressed as part of a broader analysis by Gustavo Ghidini. The same is true of procedural law. Is it appropriate that disputes about intellectual property are increasingly adjudicated by specialist courts and judges, and how does it alter the development and interpretation of intellectual property law? In the US Supreme Court *Myriad* case, Justice Antonin Scalia joined the judgment of the Court, 'except,' he wrote, '[the portions] going into fine details of molecular biology. I am unable to affirm those details on my own knowledge or even my own belief.'[5] One

[5] *See* Ass'n for Molecular Pathology v. Myriad Genetics, Inc., 133 S. Ct. 2107 (2013).

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wonders what this means for the rational development of patent law, or indeed for the standing of judicial decisions generally? Kimberlee Weatherall and Torsten Bjørn Larsen explore such adjectival and enforcement issues, areas where nation states have traditionally assumed greater sovereignty. If some convergence or harmonisation of such traditionally local principles is required or appropriate, is that easier if confined to matters of intellectual property law, rather than essayed with respect to procedure or enforcement generally?[6]

Exploring the purported exceptionalism of intellectual property sometimes provokes insights about the essence of intellectual property, or the need to revisit a precept that was thought to help define intellectual property (and perhaps set it apart). This lies at the heart, in particular, of the chapters by Severine Dusollier, Irene Calboli, and Abbe Brown and Charlotte Waelde.

Finally, in addition to helping us to look inward as intellectual property scholars, examining the interaction between intellectual property law and other bodies of law and critically assessing the exceptional nature of our regime allows us to look outwards and ask whether exceptionalism sacrifices law generally, learning the potential lessons of intellectual property law. Does its purportedly special nature preclude intellectual property law from contributing as fully as it might to the development of general legal principles, which may of course reinforce that suggestion that this is a narrow field, known only to, and requiring, specialists?

The question at the heart of this volume is thus a conduit for a number of different inquiries. They address the essence of intellectual property law, the role of intellectual property within broader legal institutions, and hopefully invite an engagement by legal scholars generally with a field of law that – for all its purported exceptionalism – is too significant socially and commercially to be considered only by specialists.

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[6] *Cf.* TRIPS Agreement, art. 41(5) ('this Part does not create any obligation to put in place a judicial system for the enforcement of intellectual property rights distinct from that for the enforcement of law in general, nor does it affect the capacity of Members to enforce their law in general. Nothing in this Part creates any obligation with respect to the distribution of resources as between enforcement of intellectual property rights and the enforcement of law in general.').

1. Contract *lex rex*: Towards copyright contract's *lex specialis*

Giuseppina D'Agostino

INTRODUCTION

Intellectual property regimes, of which copyright law is generally perceived as a constitutive part, create entitlement interests, whereas contract law manages these entitlements. Copyright is thus inextricably bound to contract law. In practice, this relationship is one of subordination: contract law trumps the various entitlements copyright creates. As a result, the aims of copyright law must constantly confront the law of contract and the values on which it is premised. When this confrontation leads to tension between these two domains of law, legislatures and courts ensure that the law of contract reigns supreme, and is the *lex rex*. It may be tempting to reduce this issue to an inevitable consequence of having a *lex generalis*, such as contract law, refuse to cede ground to a *lex specialis* like copyright; indeed, one might thus question the *lex specialis* nature of copyright vis-à-vis contract law. Perhaps copyright law is the *lex generalis*, with contract law being *lex specialis* on matters of contract. But, as this speculation suggests, to engage in this kind of categorization does little to advance a solution to the tension. Ultimately, defining copyright's *specialis* status is much less consequential than explaining its relationship to contract law, and it is that hierarchical relationship that has the most bearing on creators who fuel the cultural industries, especially freelance authors. A more integrative approach is therefore vital.

I argue that there is a need for a more copyright-contract-centric *lex*: contract law should be more fully integrated into copyright in order to adequately serve the aims of copyright law, specifically those that center on providing creators with effective management and remuneration for their copyright-protected works. Indeed, without the workings of contract law, copyright law has little relevance to the needs of creators (or anyone else for that matter). From this perspective, whether copyright is a *lex*

specialis seems rather beside the point. Contract law is predicated on freedom of contract, and my analysis must necessarily start to showcase the emphasis placed on this doctrine, and how it has been enshrined in both domestic legislation and jurisprudence (especially in common law countries) as well as internationally to copyright's detriment. On the international front, I discuss Berne's preoccupation in ensuring the sanctity of freedom of contract, especially as it purports to be an authors' rights statute. To further analyze the domestic shortcomings of freedom of contract, I then apply the *lex rex* status of contract law and its reliance on freedom of contract to consider the plight of the freelance author in new media as a case study. In this context, copyright law is inadequate and its objectives undermined as authors go unrewarded and unprotected, left to their own devices to engage in protracted litigation with symbolic results. Ultimately, I propose a series of mechanisms rooted in contract law, to keep freedom of contract restrained and to improve copyright law's inadequacies. Perhaps this way, copyright law or better, copyright contract can truly become a governing *lex specialis*.

A. COPYRIGHT AND CONTRACT

Copyright statutes assume a *specialis* character in that they establish a particular set of rights for authors of works: they provide entitlement interests to protect authors' "expression of their ideas".[1] Copyright law typically grants authors protection to a number of categories of works, including literary works, whether in print or digital form. Authors are the first owners of copyright in the works that they create.[2] The author is an individual who is solely responsible and exclusively deserving of the credit for the creation of a work.[3] If an author creates a work in the

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[1] Of course, for Lord Hailsham, defining the term "the expression of ideas" depends on what is meant by an "idea." See *LB (Plastics) Limited v Swish Products Limited* (1979) RPC 551 (HL) where copyright in production drawings for knock-down furniture drawers prevented one company from copying the commercial furniture produced by a competitor. The idea/expression dichotomy may not be very useful if the concept of idea is not fully understood.

[2] Canada *Copyright Act*, RSC 1985, c C-42, s 13(1) [CCA].

[3] M. Woodmansee 'The Genius and the Copyright: Economic and Legal Conditions of the Emergence of the "Author"' Eighteenth-Century Studies 425–48, 426. Here there is no shortage of debate on who is an author; indeed many are critical of the singular classification of authorship; e.g. C.J. Craig 'Locke, Labour and Limiting the Author's Right: A Warning against a Lockean Approach to Copyright Law' (2002) 28 Queen's LJ 1.

course of his or her employment, copyright in the work vests in the employer, unless there is a contract between the two parties stating otherwise.[4] And so, via contract law, authors who are the first owners of copyright (or their stand-ins), manage their rights either via licenses or assignments, which can be made in whole or in part. The validity of these kinds of contracts is contingent on them being signed and in writing.[5] The more *generalis* body of contract law manages these entitlements. The law of contract was designed to facilitate the enforcement of private bargains arranged between parties. Without contract law, copyright law has little meaning. Copyright law is often said to be mindful of balancing a variety of interests in the public interest, among which is protecting the author.[6] Ensuring that copyright and contract law are properly working together is important to meeting copyright's objectives, especially when protecting authors' entitlement interests.

1. Contract's Freedom of Contract: The Sacred Doctrine Legally Enshrined

Contract law is premised on the doctrine of freedom of contract, which posits that individuals and organizations are free and independent to enter into private agreements within a market economy. Adam Smith in his *Wealth of Nations* (1776) offered the first sustained account of economic affairs, heralding the cause of freedom of trade against that era's prevalent economic protectionism: freedom of contract was embraced as

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[4] CCA, *supra* note 2 at s 13(3).

[5] *Ibid.* at s 13(4). A mere license which does not grant an interest in the copyright need not be in writing. See JS McKeown Fox Canadian Law of Copyright and Industrial Designs (3rd edn Carswell Scarborough 2000) 388 and *Robertson v Thomson Corp*, 2006 SCC 43, [2006] 2 SCR 363, [*Robertson SCC*] interpreting this issue at para 135.

[6] There is no purpose clause available in the various domestic copyright statutes, and courts have over the course of the years made different pronouncements on what copyright's purpose is; see, for instance, the often cited *Théberge v Galerie d'Art du Petit Champlain inc.*, [2002] 2 S.C.R. 336,2002 SCC 34 [30] stating, "The *Copyright Act* is usually presented as a balance between promoting the public interest in the encouragement and dissemination of works of the arts and intellect and obtaining a just reward for the creator (or, more accurately, to prevent someone other than the creator from appropriating whatever benefits may be generated)". WF Grosheide 'Copyright Law from a User's Perspective: Access Rights for Users' (2001) 23(7) EIPR 321–5, 321 discussing copyright's once idealistic "golden triangle" of interests.

an ideal of classical economic theory and classical contract law.[7] Freedom of contract featured two closely interlinked yet distinct ideas: (1) contracts were based on mutual agreement, and (2) the creation of a contract was the result of a free choice unhampered by external control such as government or legislative interference.[8] In other words, there should be no liability without the consent embodied in a valid contract. This second and negative aspect of freedom of contract narrowed the scope of the law of obligations dealing with liability imposed by law.[9] The assumption was that the parties were independently willed and sophisticated and had equal opportunity to enter such bargains to maximize their individual interests. Besides the obvious categories for which the nineteenth-century law made special provisions, such as persons below the age of capacity and lunatics, the law assumed that if a person entered into a burdensome contract, "he had only himself to blame because there was freedom of contract and he could have gone elsewhere."[10] Freedom of choice as manifested through the intention of the parties was thus at the root of freedom of contract in its classical form. And individualism was at the root of the justifications commonly advanced for freedom of contract.[11]

The ability to enter into agreements with others was thus considered a fundamental dimension of human freedom in Western liberal democracies. This private ordering played a crucial role in wealth maximization, to make commercial ventures possible. Failing to provide an individual with the ability to freely contract with others was perceived as an affront to that individual dignity. Jessel MR epitomizes this conviction in his decision for *Printing & Numerical Registering Co v Sampson*:

> [I]f there is one thing which more than another public policy requires it is that men of full age and competent understanding shall have the utmost liberty of contracting, and that their contracts when entered into freely and voluntarily should be held sacred.[12]

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[7] J Beatson *Anson's Law of Contract* (28th edn Oxford University Press Oxford 2002) 4.

[8] PS Atiyah and S Smith *Atiyah's Introduction to the Law of Contract* (6th edn Clarendon Press Oxford 2005) 9–11.

[9] As in tort and restitution; see Beatson, *supra* note 7 at 4.

[10] Atiyah, *supra* note 8 at 16.

[11] S Wheeler and J Shaw *Contract Law* (Clarendon Press Oxford 2001) 36.

[12] *Printing & Numerical Registering Co v Sampson* (1875), LR 19 Eq 462 at 465.

While contemporary liberal democracies may not abide by as strict a commitment to freedom of contract as Jessel MR exemplifies, freedom of contract still remains a fundamental value within the law of contract, and by extension copyright law.

Modern day copyright courts still seem to echo Jessel MR's conviction. In the Supreme Court of Canada (SCC), Lebel and Fish JJ asserted that at the end of the day no matter what the law says, "parties are, have been, and will continue to be free to, alter by contract the rights established by the *Copyright Act*."[13] The *Robertson* decision, which merits attention later, as it cuts through the heart of these issues, illustrates the reverence placed on freedom of contract. And so, when contemporary courts are asked to step in and interpret copyright issues, courts should not be seen as meddling with parties' freedoms to contract.[14] Contract is the *lex rex*.

This sacrosanct status afforded to freedom of contract is not limited to courts but is also present in copyright legislation, and is most pronounced in common law jurisdictions. For instance, the UK and Canadian copyright statutes merely mandate that a contract conveying a proprietary interest must be signed and be in writing.[15] Contrast this *laissez-faire* approach with civilian statutes that impose more copyright-contract-centric restrictions.[16]

Significantly, international copyright treaties, to which states adhere, pay similar homage to freedom of contract. As an example of this preoccupation is the making of the Berne Convention for the Protection of Literary and Artistic Works[17] and ensuring that authors could contract away their rights to successors in title. In 1886, sustained pressure on the part of creators culminated with the signing of the Berne Convention.

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[13] *Robertson SCC supra* note 5 at para 58.

[14] Canadian courts' equitable jurisdiction provides the judicial capacity to strike down contracts in whole, or in part, on the basis of unconscionable terms or conduct, though equity has seldom been used. See Giuseppina D'Agostino, *Copyright, Contracts, Creators: New Media, New Rules* (Cheltenham: Edward Elgar Publishing Ltd, 2010) at 72–75, 135–137 [*Copyright, Contracts, Creators*]; Giuseppina D'Agostino, "Canada's *Robertson* Ruling: Any Practical Significance for Freelance Authors?" [2007] 2 EIPR 66 [*Canada's Robertson Ruling*].

[15] In the UK *Copyright, Designs and Patents Act* 1988 c 48 as amended [CDPA]; s 92(1), in CCA, *supra* note 2, s 13(4).

[16] For instance, see a host of provisions in Québec and Continental Europe which are discussed at length in ch 6 at 121–129 in *Copyright, Contracts, Creators, supra* note 14.

[17] Berne Convention for the Protection of Literary and Artistic Works 9 Sept 1886 168 Consol TS 185 [*Berne*].

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