

Constructing Intellectual Property

Alexandra George



CAMBRIDGE

Constructing Intellectual Property

Alexandra George

University of New South Wales



CAMBRIDGE
UNIVERSITY PRESS

CAMBRIDGE UNIVERSITY PRESS
Cambridge, New York, Melbourne, Madrid, Cape Town,
Singapore, São Paulo, Delhi, Mexico City

Cambridge University Press
32 Avenue of the Americas, New York NY 10013-2473, USA

Published in the United States of America by Cambridge University Press, New York

www.cambridge.org
Information on this title: www.cambridge.org/9781107691773

© Alexandra George 2012

This publication is in copyright. Subject to statutory exception
and to the provisions of relevant collective licensing agreements,
no reproduction of any part may take place without the written
permission of Cambridge University Press.

First published 2012
First paperback edition 2013

A catalogue record for this publication is available from the British Library

Library of Congress Cataloguing in Publication Data

George, Alexandra.
Constructing intellectual property / Alexandra George.
p. cm.
Includes bibliographical references and index.
ISBN 978-1-107-01461-9 (hardback)
1. Intellectual property – Philosophy. I. Title.
K1401.G46 2012
346.04'8–dc23 2011030302

ISBN 978-1-107-01461-9 Hardback
ISBN 978-1-107-69177-3 Paperback

Cambridge University Press has no responsibility for the persistence or
accuracy of URLs for external or third-party internet websites referred to in
this publication, and does not guarantee that any content on such websites is,
or will remain, accurate or appropriate.

CONSTRUCTING INTELLECTUAL PROPERTY

What is 'intellectual property'? This book examines the way in which this important area of law is constructed by the legal system. It argues that intellectual property is a body of rules, created by the legal system, that regulates the documented forms of abstract objects, which are also defined into existence by the legal system. Intellectual property law thus constructs its own objects of regulation, and it does so through the application of a collection of core concepts. By analyzing the metaphysical structure of intellectual property law and the concepts the legal system uses to construct 'intellectual property', this book sheds new light on the nature of this fascinating area of law. It explains anomalies between social and intellectual property uses of concepts such as authorship – here dubbed 'creatorship' – and originality, and it helps to explain the role of intellectual property from a structural (rather than the traditional normative) perspective.

Dr. Alexandra George is a Senior Lecturer in Law at the University of New South Wales, Australia. She is the editor of the book *Globalization and Intellectual Property* (2006), and her works have been published in numerous journals, including *Oxford Journal of Legal Studies*, *Res Publica*, *Archiv für Rechts- und Sozialphilosophie*, *Santa Clara Journal of International Law*, *UTS Law Review*, *Journal of Brand Management*, and *Sydney Law Review*. Her main areas of scholarly interest are the applied legal philosophy of intellectual property, globalization, and international intellectual property law and policy, as well as issues concerning copyright piracy and trademark counterfeiting.

*To my parents,
Charles and Elizabeth George*

Acknowledgements

The debts I have incurred in writing this book are numerous and deep. I would here like to thank all of those people who have assisted me.

Infinite thanks to my family and friends for being unwavering in their support for me. I appreciate it more than I can express.

My sincere thanks to Derek Jones, Dave Lexton, and Jeff Duckett, who acted with kindness, selflessness, and honour to combat gross injustice.

I am greatly indebted to Chris Birch SC, Ralph Melano, Dennis Patterson, Matt Rimmer, Daniel Stoljar, Wojciech Sadurski, and Tom Campbell for their support and feedback on drafts of this work. Thank you also to Lionel Bently and Roger Shiner for helpful comments on an early draft chapter, to all of those who offered suggestions on papers that became parts of the work, and to Cambridge University Press's insightful and supportive anonymous reviewers.

Tremendous thanks to John Berger at Cambridge University Press. Thank you also to David Jou and the copy editor, Mary Becker, and to Bindu and the team at NewGen Publishing for their careful editorial work.

Thank you also to Tony Antoniou, Bruce Ayling, Philip Baker QC, Linda and Graham Christian, Susanna and Dicky Clymo, Monika and John Cutts, Graham Dutfield, Brendan Edgeworth, Richard Gallifant, John Gardner, Tibor Gold, Paul Gwynne, Jose and Jim Harris, Patsy Hay, Paul Huehnergard, Andrew Karney, Dimity Kingsford-Smith, Nicola Lacey, Bruce Landesman, Kathleen Mastrogiacomio, Margaret McKercher,

James Rigney, Leon Trakman, Michael Williams, and Alex Ziegert, for their kindness, friendship, advice, feedback, mentoring, and encouragement along the way.

Above all, to my parents, who invested so much in my education and supported so many years of my studies, and to my grandparents, who always encouraged and believed in me, I will be eternally grateful.

Of course, any errors, oversights, or omissions are mine alone, and entirely my responsibility.

Authorities

CONVENTIONS AND TREATIES

Agreement on Technical Cooperation between ISO and CEN (1991);
passed as ISO Council resolution 18/1990 and CEN General Assembly
resolution 3/1990

Agreement on Trade Related Aspects of Intellectual Property Rights
(1984)

Australia–United States Free Trade Agreement (1994)

*Berne Convention for the Protection of Literary and Artistic Works of
9 September 1886*, completed in Paris on 4 May 1896 (as revised and
amended)

Convention on the Control and Marking of Articles of Precious Metals
(1972)

Convention Establishing the World Intellectual Property Organization
(1967)

General Agreement on Tariffs and Trade (1947)

*Nice Agreement Concerning the International Classification of Goods and
Services for the Purposes of the Registration of Marks* (1957)

*Paris Convention for the Protection of Industrial Property of March 20,
1883* (as revised and amended)

Universal Copyright Convention (1952)

Universal Declaration of Human Rights (1948) (UN)

STATUTES AND CASES ORGANIZED BY JURISDICTION**AUSTRALIA****Statutes and Regulations:**

Brands Act 1918 (Qld)

Brands Regulation 1998 (Qld)

Copyright Act 1968 (Cth)

Copyright Amendment Act 1984 (Cth)

Copyright Amendment (Moral Rights) Act 2000 (Cth)

Crimes Act 1900 (NSW)

Interpretation of Legislation Act 1984 (Victoria)

Patent Act 1990 (Cth)

Road Safety (Traffic Management) Regulations 2009 (Victoria)

Trade Marks Act 1995 (Cth)

Trade Practices Act 1974 (Cth)

US Free Trade Agreement Implementation Act 2004 (Cth)

Cases:

Apple Computer Inc v Computer Edge Pty Ltd (1983) 50 ALR 581

Doodeward v Spence (1908) 6 CLR 406

Federal Commissioner of Taxation v United Aircraft Corp (1943) 68 CLR 525

IceTV Pty Ltd v Nine Network Australia Pty Ltd (2009) 239 CLR 458

Nine Network Australia Pty Ltd v IceTV Pty Ltd [2007] FCA 1172

John Bulun Bulun & Anor v R & T Textiles Pty Ltd (1998) IPR 51

Opposition by Claude Ruiz Picasso to registration of trade mark application 754587(42) – PIZZA PICASSO PIZZAS OF ART and device – filed in the name of Robyn Thomas (7 September 2001), available at the IP Australia website: <http://www.ipaustralia.gov.au/pdfs/trade-marks/hearings/754587.pdf> [accessed 10 May 2010]

Prior v Lansdowne Press Pty Ltd (1975) 12 ALR 685

R v Jagamara (Unreported, Northern Territory Supreme Court, 28 May 1984)

Rescare Ltd v Anaesthetic Supplies Pty Ltd (1992) 25 IPR 119

Row Weeder Pty Ltd v Nielsen (1998) IPR 400
Shell Co of Australia Ltd v Rohm & Haas Co (1949) 78 CLR 601
Smith Kline & French Laboratories (Australia) Ltd v Secretary, Department of Community Services and Health (1990) 17 IPR 545
Taco Co (Aust) v Taco Bell (1982) 42 AR 177
Universal City Studios v Zeccola (1982) 46 ALR 189; 67 FLR 225
Victoria Park Racing and Recreation Grounds Company Limited v Taylor (1937) 58 CLR 479

EUROPEAN UNION

Directives and Regulations:

The Convention for the Protection of Human Rights and Fundamental Freedoms (1950) (Council of Europe)
Council Directive 93/98/EEC of 29 October 1993 Harmonizing the Term of Protection of Copyright and Certain Related Rights, Official Journal L 290, 24/11/1993 P. 0009–0013
Council Regulation (EC) No. 207/2009 of 26 February 2009 on the Community Trade Mark

European Court of Justice Cases:

Canon Kabushiki Kaisha v MGM [1999] RPC 117
Lloyd Schuhfabrik Meyer & Co GmbH v Klisjen Handel BV [2000] FSR 77
Ralf Sieckmann v Deutsches Patent-und Markenamt [2003] ETMR 466
Reckitt & Colman Products v Borden Inc [1990] All ER 873
Sabel BV v Puma AG, Rudolf Dassler Sport [1998] RPC 199
Sieckmann v Deutsches Patent-und Markenamt [2003] RPC 38

UNITED KINGDOM

Statutes and Regulations:

An Act Declaring the Rights and Liberties of the Subject and Settling the Succession of the Crown 1689
Adventure Activities Licensing Regulation 2004
Copyright Act 1709, 8 Anne c.19

- Copyright Act 1775*
Copyright Act 1911, s.22
Copyright, Designs and Patents Act 1988
Duration of Copyright and Rights in Performances Regulations 1995
 (Statutory Instrument 1995, No. 3297)
Hallmarking Act 1973
Patent Law Amendment Act 1852 (15 & 16 Vict. c.83)
Patents Act 1835 (5 & 6 Will. 4 c.83)
Patents Act 1886 (49 & 50 Vict. c.37)
Patents Act 1902 (2 Edw. 7 c.53)
Patents Act 1949 (12, 13 & 14 Geo. 6 c.87)
Patents Act 1977
Patents and Designs Act 1907 (& Edw. 7 c.29)
Patents and Designs Act 1919 (9 & 10 Geo. 5 c.80)
Patents and Designs Act 1932 (22 & 23 Geo. 5 c.32)
Patents and Designs (Convention) Act 1928 (18 Geo. 5 c.3)
Patents, Designs and Trade Marks Act 1883 (46 & 47 Vict. c.57)
Patents, Designs and Trade Marks Act 1885 (48 & 49 Vict. c.63)
Registered Designs Rules 1995 (SI 1995/2912 and SI 2001/3950)
Statute of Anne, 8 Anne, ch.19 (1710)
Statute of Monopolies 1623 (21 Jac. 1 c.3)
Theft Act 1968
Trade Mark Registration Act 1875 (38 & 39 Vict. c.91)
Trade Marks Act 1994
- Cases:**
- Arsenal Football Club Plc v Reed* [2001] RPC 46
Ashdown v Telegraph Group Ltd (2001) 3 WLR 1368
Ashmore v Douglas Horne [1987] FSR 533
BBC v Talksport [2001] FSR 53
Clothworkers of Ipswich Case Godbolt, tit. 351, p. 25; reported (1653) 78 ER 147
Criminal Clothing Ltd v Aytan's Manufacturing (UK) Ltd [2005] EWHC 1303
Darcy v Allin, 77 Eng. Rep. 1260 (Queen's Bench, 1602)

- Designers Guild v Williams* [2000] 1 WLR 2416.
Donoghue v Allied Newspapers Limited (1938) Ch. 106
Exxon Corporation v Exxon Insurance Consultants International [1982]
 1 Ch. 119
Francis Day and Hunter v 20th Century Fox [1940] AC 112
Hyde Park Residence Ltd v Yelland [2000] Ch. 14; EMLR 363
Lion Laboratories v Evans [1985] QM 526
MacMillan v Cooper (1924) 40 TLR 186
Philips v Remington (1998) RPC 283
Powell v Birmingham Vinegar [1897] 14 RPC 720
Reddaway v Banham [1896] AC 199
Redwood Music v Chappell [1982] RPC 109
University of London Press Ltd v University Tutorial Press Ltd [1916] 2
 Ch. 601
Walter v Lane (1900) AC 539
Warnink v Townend [1979] AC 731
Wood v Boosey (1868) LR 3 QB 223
ZYX Music GmbH v King [1995] 3 All ER 1

UNITED STATES

Statutes:

- Constitution of the United States of America
Copyright Act 1976; Pub. L. 94–553; 90 Stat. 2541 (1976) (17 U.S.C. §§
 101–810) (amending 44 U.S.C. §§ 505 & 2113; 18 U.S.C. § 2318)
Copyright Term Extension Act 1998; S 505, Pub. L. 105–298, 11 Stat. 2827
 (1998) (amending 17 U.S.C. §§301–304)
 Declaration of Independence (4 July 1776)
Digital Millennium Copyright Act 1998; Pub. L. 105–304.112 Stat. 2860
 (1998)
Food and Agricultural Code, s.20661–20672 (California)
Lanham (Trademark) Act 15 USCA §1051–1127 (2000)
Omnibus Trade and Competitiveness Act 1988

Cases:

- Bridgeman Art Library v Corel Corp.*, 36 F. Supp. 2d 191 (S.D.N.Y. 1999)

- Burrow-Giles Lithographic Co. v Sarony*, 111 U.S. 53 (1884)
- Calhoun v Lillenas Publishing*, Civ. Nos. 01-11413, 01-11415 (11th Circuit, 2002)
- Campbell v Acuff-Rose Music*, 510 U.S. 569 (1994)
- CDN Inc. v Kapes*, 197 F.3d 1256, 1261 (9th Circuit, 1999)
- Dallas Cowboys Cheerleaders, Inc. v Pussycat Cinema, Ltd.*, 604 F.2d 200 at 2005 (2d Cir. 1979)
- Diamond v Chakrabarty*, 447 U.S.303 (1980)
- Durham Industries, Inc. v Tomy Corp.*, 630 F.2d 905 (2nd Circuit, 1980)
- Emerson v Davies*, 8 F.Cas 615 at 619 (CCD Mass, 1845)
- Ets-Hokin v Skyy Spirits Inc.*, 225 F.3d 1068 (9th Circuit, 2000)
- Feist Publications, Inc. v Rural Telephone Service Co.* (1991) 499 U.S.340
- Folsom v Marsh*, 9 F.Cas. 342 (Circuit Court of Massachusetts, Oct Term 1841)
- Gracen v Bradford Exchange*, 698 F.2d 300 (7th Circuit, 1983)
- Harper & Row Publishers, Inc. v Nation Enters.*, 471 U.S. 539, 556 (1985)
- Herman v Youngstown Car Manufacturing Co.*, 191 F. 579, 112 CCA 185 (6th Cir. 1911)
- Jacobellis v Ohio* (1964), 378 US 184
- Mattel, Inc v MCA Records*, 28 F.Supp. 2d 1120 (C D California, 1998), *affirmed* 296 F.3d 894 (9th Circuit, 2002)
- Moore v Regents of University of California* 215 Cal.App.3d 709 (1988); *affirmed* in part, reversed in part, 51 Cal.3d 120, 793 P.2d 479 (1990)
- Panduit Corp v Stahlin Bros Fibre Works Inc*, 575 F.2d 1152 at 1159, 197 USPQ (BNA) 726 (6th Circuit, 1978)
- Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v Utah Div. of Travel Dev.*, 170 F.3d 449 at 459 (4th Cir. 1999)

OTHER JURISDICTIONS

Zimbabwe:

- Armorial Bearings, Names, Uniforms and Badges Act* [Acts 12/1971, 40/1977, 29/1981 (s.59), 7/198, 22/2001 (s.4); S.I. 490/1981 (s.3)], Ch. 10:01

Abbreviations

ACCC	Australian Competition and Consumer Commission
AWI	Australian Wool Innovation Limited
<i>Berne Convention</i>	<i>Berne Convention for the Protection of Literary and Artistic Works</i> (1886)
BSI	National Standards Body (UK), formerly known as the British Standards Institution
CEN	European Committee for Standardization
Cth	Commonwealth of Australia
CTM	Community Trade Mark (EU)
IAAO	International Association of Assay Offices
IPC	Intellectual Property Committee
IPRs	intellectual property rights
ISO	International Organization for Standardization
NIAAA	National Indigenous Arts Advocacy Agency
<i>Nice Convention</i>	<i>Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks</i> (1957)
NSW	New South Wales, Australia
<i>Paris Convention</i>	<i>Paris Convention for the Protection of Industrial Property</i> (1883)
Qld	Queensland, Australia

<i>Sonny Bono Copyright Term Extension Act</i>	<i>Copyright Term Extension Act (1998) (US)</i>
TCEs	traditional cultural expressions
TK	traditional knowledge
<i>TRIPS Agreement</i>	<i>Agreement on Trade Related Aspects of Intellectual Property (1994)</i>
USPTO	United States Patent and Trademark Office
<i>Vienna Agreement</i>	<i>Agreement on Technical Cooperation between ISO and CEN (1991)</i>
WIPO	World Intellectual Property Organization
WIPO Convention	<i>Convention Establishing the World Intellectual Property Organization (1967)</i>
WTO	World Trade Organization

Brief Contents

1. Introduction	<i>page</i> 1
2. The Difficulty of Defining 'Intellectual Property'	31
3. The Metaphysics of Intellectual Property	81
4. Intellectual Property's Core Criteria	137
5. 'Family Resemblance' and Intellectual Property	255
6. Concluding Remarks	329

Contents

<i>List of Figures</i>	page xvi
<i>Acknowledgements</i>	xix
<i>List of Authorities</i>	xxi
<i>List of Abbreviations</i>	xxvii
1. Introduction	1
1.1. An Intellectual Property Fairy Tale	2
1.2. Drawing Analogies and Questioning Assumptions	7
1.2.1. Assumptions About the Existence of Intellectual Property	8
1.2.2. Assumptions About the Authority of ‘Intellectual Property’	9
1.2.3. Compliance with Assumptions and Social Norms	11
1.3. Exploring the Nature of Intellectual Property	15
1.4. Structure of This Book	15
1.4.1. Overview of the Argument	15
1.4.2. Introduction	17
1.4.3. What Is ‘Intellectual Property’? (Chapter 2)	17
1.4.4. The Metaphysics of Intellectual Property (Chapter 3)	18
1.4.5. Intellectual Property’s Core Criteria (Chapter 4)	18