

Intellectual Property in the New Millennium

Essays in Honour of William R. Cornish

Edited by David Vaver and Lionel Bently



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INTELLECTUAL PROPERTY IN THE NEW MILLENNIUM

Intellectual property law is a subject of increasing economic importance and the focus of a great deal of legislative activity at an international and regional level. This collection brings together contributions from some of the most distinguished scholars in this exciting and controversial field, covering the full breadth of intellectual property law, that is, patents, copyright, trade marks and related rights. The contributions examine some of the most pressing practical and theoretical concerns which intellectual property lawyers face. These include: expanding the boundaries of IP in the face of new challenges, such as appropriate legal responses to digitisation and new technologies; relations between developed and developing worlds; the relationship between different legal traditions in a world of increasingly shared international norms; and the relationship between intellectual property rights and other areas of law, such as contract and criminal law.

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FOREWORD

Lord Mustill once observed that ‘some of the most penetrating legal minds, both on and off the bench, have directed themselves to the evolution of patent law’ (*Genentech Inc’s Patent* [1989] RPC147, 258). He put this down to the fact that ‘the industrial revolution happened where and when it did’, or, putting the matter another way, the tendency for brains to follow money. Bill Cornish’s contribution to the development of patent law (and intellectual property law generally) certainly supports the first proposition, although (academic salaries being what they are) I am not sure that it supports the second. At any rate, whatever the motivation, he has been one of the small band of brilliant academic intellectual property lawyers who have made the subject a fascinating and demanding branch of study.

Bill’s contribution has been remarkable not only for the penetration on which Lord Mustill remarked, for the breadth of his learning (demonstrating that a taste for the history of the subject is never a disadvantage in understanding the present law), and for its easy lucidity, but also for the wry irony (one can almost see the slight lift of the Australian eyebrows) which permeates the work and makes it such fun to read. Occasionally one feels that a concession to academic propriety has driven him to decide that the better jokes should be kept in the footnotes and not allowed to break out into the text, but one way or another solemnity is kept at bay.

For my part, I am honoured to have been asked to contribute a foreword to this collection of essays to mark Bill’s retirement and thereby to have the opportunity to acknowledge both the assistance and the pleasure which I have had from his work. The word ‘retirement’ itself has some ironic overtones, since although it is no doubt true that Bill will shortly cease to be in full-time paid employment as a law teacher at Cambridge, the possibility that one will plausibly be able to describe him as retired seems very remote. As far as the development of intellectual property law is concerned, the more remote the better.

Leonard Hoffmann
House of Lords

PREFACE

This collection brings together contributions from some of the most distinguished scholars in the field of intellectual property law, that is, patents, copyright, trade marks and related rights. The possibility to assemble so impressive an array of authors in a single volume is provided by the retirement of Professor William Cornish from the Herchel Smith Chair in Intellectual Property at the University of Cambridge.

William Cornish was born and educated in South Australia. He came to the UK in 1960, initially to study for the BCL degree at Oxford, and immediately afterwards began lecturing at the London School of Economics. There he spent the bulk of his early career. After a brief interlude at Queen Mary, he was made a Professor in 1970. In 1990 Professor Cornish moved from the LSE to Cambridge University, where he became a Professor and Director of the Centre of European Legal Studies. In 1995 he was appointed the Herchel Smith Professor of Intellectual Property Law.

Professor Cornish's achievements in a career which has lasted over forty years are simply too numerous to review here other than selectively and briefly. Readers wishing to gain a full appreciation are referred to his *curriculum vitae*, which we publish herein.

He is widely, and rightly, regarded as the father of intellectual property teaching and scholarship in the UK. In 1967, while at the LSE, he, Robin Jacob (now Jacob LJ, and a contributor to this collection) and Richard Lloyd, established the first course in Intellectual Property Law on the University of London LL.M. In due course he published his groundbreaking textbook, *Intellectual Property: Patents, Trade Marks and Allied Rights* in 1981, and, despite the emergence of a number of imitators, it remains – in its fifth edition – the most intellectually sophisticated work of its kind. His careful and subtle thought, informed by an acute awareness of history, of comparative experience abroad, and by a real appreciation of the subtleties of legal reasoning, impressed all who encountered it, whether from academia, the profession or the judiciary. In recognition of his immense contribution to the development of understanding of the law,

in 1997 he was made an honorary QC and is attached to the fine set of intellectual property specialist chambers at 8 New Square, Lincoln's Inn.

Professor Cornish's contribution extends well beyond the walls of the universities, and well beyond the UK. For example, he has been involved in policy-making within the UK: in the 1980s, advising the House of Lords' sub-committee on European Community legislation; in the 1990s, as chairman of the National Academies Policy Advisory Group (NAPAG) on Intellectual Property and the Academic Community; and, more recently, in his work (with Margaret Llewelyn and Mike Adcock) on IPRs and genetics for the Department of Health. Professor Cornish has also come to be regarded as the pre-eminent British voice in the international arena, researching at the Max Planck Institute in Munich in 1979, joining the editorship of its publication, *IIC*, and becoming an External Academic Member in 1989. He was also President of ATRIP, the international association of researchers and teachers of intellectual property, in the 1980s and has been Vice-President of ALAI (Association Littéraire et Artistique Internationale) since 1990.

For those who have encountered Professor Cornish only through his work on intellectual property law, it may be a surprise to learn that he is also a specialist in civil law and legal history. In fact, his first book, published in 1967, was on *The Jury*. 1989 saw the publication of his phenomenal survey of modern British legal history, *Law and Society in England 1750–1950*, written with the late Geoffrey de N. Clark. In addition, he has written on fields as varied as the history of land mortgages and various aspects of the law of restitution. He is a scholar with a remarkable breadth of interests in an era of increased specialization. It was doubtless in recognition of this that he was made a Fellow of the British Academy in 1984.

Despite Professor Cornish's many interests, this festival of writing is an appreciation of his work on intellectual property law. The contributions reflect some of the most pressing practical and theoretical concerns which intellectual property lawyers face today. These include the adaptation of intellectual property law to meet the new challenges of digitization and biotechnology; conflicts between developed and developing countries over the appropriate level of intellectual property protection; the relationship between different legal traditions in a world of increasingly shared international norms; and the relationship between intellectual property rights and neighbouring areas of law. Thanks to the work of Professor Cornish, there is today a body of intellectual property scholars who are well equipped to understand these issues, to assess the nature of the problems

they confront, and to offer solutions. These essays are offered as a small token of their gratitude.

LB
DV

Postscript to Chapter 5

The Community Patent proposal has once again come off the rails. In March 2004 the EC Competitiveness Council was unable to finalize it because of problems relating to the legal effect of translated claims, the time for filing translations, and jurisdictional issues. I am only a little sorry about the failure, as the proposals contained deep flaws. The time has come to revive the proposal for a European Patent Litigation Protocol ('EPLP'), whereby such countries as wish to may form a single Patent Court to litigate parallel European patents. The EPLP proposal is quite advanced and is unfettered by complex constitutional questions (e.g., the Patent Court's relationship with the European Court of Justice and any need to be located in Luxembourg). It can be driven more by practical considerations. Although the proposal lacked some impetus whilst the Commission was pressing for the Community Patent, that impetus should now be restored. If established, such a Court could very well form the basis of a future Community Court. The latter would then be formed round a working system rather than one frustrated by impractical criteria. It could be staffed by national patent judges, use the language or languages most practicable for the case, sit where most convenient, and have a headquarters somewhere suitable (perhaps Paris?). A nucleus of states such as France, Germany, the UK, and a few others would be enough to get the scheme going. In concluding the EPLP, however, politicians would do well to remember that the patent system is there for industry and the public, and not for patent lawyers, patent agents or even patent judges.

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General intellectual property

International intellectual property jurisprudence after TRIPs

MICHAEL BLAKENEY*

A. International law and intellectual property rights

As in many other fields of intellectual property law, Professor Cornish was a pioneer in the way in which his commentaries and treatises on British intellectual property law were the first to locate that law in its European jurisprudential context. As the counterpart Herchel Smith Professor at the University of London, this contribution attempts to broaden that perspective to take account of the international law impact following the promulgation of the TRIPs Agreement.

Intellectual property rights exist primarily by virtue of national laws. So-called global intellectual property rights are a bundle of nationally enforceable rights. However, it is true to say that in most countries, those national rights exist not only as a consequence of domestic legislation or jurisprudence, but also because of international, multilateral, bilateral and regional obligations. In a number of regional associations, such as the European Union, there is the possibility of regional legislation either with direct national effect, or which prescribes national intellectual property norms. International intellectual property laws play an important role in harmonizing national substantive and procedural rules. This is particularly the case with the WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs), which prescribes domestically enforceable norms for the protection of intellectual property rights as a condition of membership of the WTO.

Thus, international law plays an important constitutional role both in providing procedures and modalities for negotiating the norms and standards of domestically enforceable intellectual property rights and in the harmonization of national and regional intellectual property norms.

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The adoption of common intellectual property standards is facilitated when countries can be assured that the same regulatory standards will prevail in competitor states.

1. *The legal sources of international intellectual property law*

The legal sources of international law which are applicable to the international intellectual property regime, as well as all other fields of international law, are conveniently set out in Article 38 of the Statute of the International Court of Justice. This Article provides that the Court, in resolving the disputes which are referred to it, shall apply:

1. international conventions, whether general or particular, establishing rules expressly recognised by the contesting states;
2. international custom, as evidence of a general practice accepted as law;
3. the general principles of law recognized by civilized nations;
4. subject to the provisions of Article 59 [which, *inter alia*, allows the court to call witnesses and experts] judicial decisions and the teachings of the most highly qualified publicists of the various nations, as subsidiary means for the determination of rules of law.

This Article, which became part of the Statute of the Permanent Court of International Justice of the League of Nations, was incorporated into the 1945 Statute of the International Court of Justice. It lists the principal contemporary sources of international law, although without indicating a formal hierarchy of sources. International intellectual property law is largely derived from treaty law; however, with the increasingly central significance of dispute settlement, general principles of law are becoming more important. Assertions of the primacy of human rights principles above intellectual property law are compelling a re-examination of the traditional international sources of intellectual property law.

(a) Treaty law

The international intellectual property regime is grounded upon the Paris Convention for the Protection of Industrial Property 1883, and the Berne Convention for the Protection of Literary and Artistic Works 1886. The gradual development of the international intellectual property regime commenced through the promulgation of special treaties under these two treaties. Two important departures from this process were the formulation of the Universal Copyright Convention in parallel