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LANDMARK INTELLECTUAL PROPERTY CASES AND THEIR LEGACY

IEEM International Intellectual Property Conferences

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Law & Business

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IEEM and International Intellectual Property Law

The involvement of the Institute of European Studies of Macau (IEEM) in matters of intellectual property is based on annual conferences that take up topical issues of intellectual property from a comparative perspective with a particular focus on Asia and Europe. The first of these conferences was held back in 2000, and has meanwhile become an annual event complemented by an Intellectual Property School and IP Master Classes. All three venues serve as a platform for academic teaching and discussion on intellectual property awareness and the proper place and function of intellectual property law in the context of society and public interest.

From the very start, the intellectual property conferences, the IP Law School and the Master Classes have enjoyed the support, assistance and commitment of Mr Gonçalo Cabral, who is an advisor to the Government of Macau, of Ms Maria do Céu Esteves, past president of the IEEM, and the IEEM's current president Dr José Luís de Sales Marques. The latter was also instrumental in setting up an IEEM chair for intellectual property law at the University of Maastricht, currently held by Anselm Kamperman Sanders, thereby further contributing to IEEM's academic commitment to the field of intellectual property law.

The conference papers, as revised and updated, are edited by Christopher Heath and Anselm Kamperman Sanders as an IEEM Intellectual Property Series the volumes of which are listed at the end of this book.

Preface

This is a book dedicated to landmark cases in the field of Intellectual Property, and their legacy. Throughout the book, the contributors in turn deal with a case or a series of cases that have made an impact on legal theory or critical thinking about the scope and purpose of the protection of intellectual and industrial creativity. By definition, this means that the cases discussed in this book deal with extraordinary circumstances that have prompted judicial action.

And extraordinary circumstances make bad case law – or do they? Most of the cases selected in this volume have been decided based on unusual facts that, at least in the eyes of the court, required unusual and novel solutions. In some cases, subsequent developments made these cases appear 'misleading' rather than 'leading'. The US Supreme Court case of United Press (1918) is one of these cases that in the context of US jurisprudence can be considered a one-off. But then again, other jurisdictions have found this case helpful in developing a doctrine of slavish imitation or misappropriation beyond confusion. For other, more recent case, the verdict of history is still out, and it is too early to say whether their approach will become mainstream.

The first two cases represent the divide about what *copyright law* should be: A protection of the author's rights in his creative expression, or a protection of copyright on behalf of its owner. Ultimately, the two cases concern the question of who should be master over the reputation, esteem and legacy of authors and their works. The two decisions of French courts have clearly held in favour of authors and their heirs, and against subsequent copyright owners.

The following two cases concern aspects in continental law that dealt with under the heading of *unfair competition prevention*: What, if any, protection should be granted to achievements in the absence of confusion? Should it, in the famous words of Rudolf Callmann, be a tort to 'reap what one has not sown'? Should we protect commercial investment beyond the scope of defined intellectual property rights? Should it be considered a tort to use well-known marks in a way that may

dilute its repute and distinctive character? These are fundamental questions that have resulted in haphazard codification, but to which no definite answers have yet been found, although both decisions, one from the US Supreme Court of 1918 and the other from the German Landgericht Elberfeld in 1924, have affirmed such an approach and received praise from academics such as Frank Schechter and Rudolf Callmann, no less.

In the *patent* field, discussion has always centred around the social benefit of a system effectively granting monopolistic rights: What kinds of monopolies should be protected, if any? Does the patent system in its current form allow us to question the assumption that technological progress is good per se, and that novel and inventive solutions should thus be protected? Should extraneous considerations such as public good and social usefulness be considered at the stages of grant and enforcement of patent rights? These questions have been asked by the courts in the UK as early as 1602, and much later by the Taiwanese courts in the various Philips decisions.

Academic and judicial interest in intellectual property *enforcement* is relatively recent and marked by the recognition that the rules developed for the enforcement of property rights are often unsuited for intangible rights where proof of infringement, infringer and damages are often hard to come by – peculiarities that led to the Anton Piller order invented by then Hugh Laddie QC and granted by the then Master of the Rolls, Lord Denning, in 1978. Yet efficient enforcement, particularly by way of injunctive relief, may have its drawbacks when running counter to the basic idea that intellectual property rights should stimulate rather than stifle innovation – submarine patents, patent thickets and standards come to mind. Would it be more appropriate in such cases to limit a patentee's remedies to appropriate damages, thereby effectively granting a compulsory license? Such position was taken by the US Supreme Court in the recent *MerckExchange v. eBay* case – an overdue development to some, a deeply worrying precedent to others.

The book concludes with two case clusters that are not remarkable for any single decision, but for the world-wide dimension of the dispute: *Lego* in about thirty jurisdictions litigated over its 'brick of the century', allowing IP lawyers to toy with patent law, copyright law, design law, trademark law, passing-off and unfair competition in order to adequately protect (or perpetuate?) investment in an invention that has given joy to millions of children. And *Budweiser*, the case of two very different beers, one from the Bohemian town of Budweis (or Ceske Budejovice), the other from the United States. And although one should not discuss over matters of taste, litigation in over forty jurisdictions dealt with issues of contract, trademarks, trade names, geographical indications, property rights in general, human rights, and various international and bilateral treaties, enriching both lawyers and legal doctrine along the way.

Admittedly, there could have been many more cases in this book. These landmarks, however, tower higher than others, because they deal with fundamental issues and their legacy is not at all crystallized. Exceptional cases may make bad case law, but they do make a good story, and their story continues.

Christopher Heath and Anselm Kamperman Sanders

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André R. Bertrand (1952) studied at the Universities of Dijon, Paris and California, Berkeley (PhD Paris 1978 & 1995, LL.M. Berkeley 1978). In-house counsel for various companies, he joined the Paris Bar Association as an 'avocat' at the end of 1988. Lecturer in the field of 'droit d'auteur' ('authors rights') at the University of Paris I Pantheon-Sorbonne from 1988 to 2002, he is the author of several treaties in the fields of authors rights ('Le Droit d'Auteur', 3rd edn Dalloz 2010), trademarks ('Le Droit des Marques et des signes distinctifs', 3rd edn Dalloz, 2010), industrial property (Delmas 1995), etc. He is the founding partner of André R. Bertrand & Associés a law firm specialized in the field of IP law located in Paris.

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