INTELLECTUAL PROPERTY LAW IN THE UNITED KINGDOM

COLIN DAVIES TANIA CHENG



Intellectual Property Law in the United Kingdom

Colin Davies Tania Cheng

This book was originally published as a monograph in the International Encyclopaedia of Laws/Intellectual Property Law.





Published by: Kluwer Law International PO Box 316 2400 AH Alphen aan den Rijn The Netherlands

Website: www.kluwerlaw.com

Sold and distributed in North, Central and South America by:
Aspen Publishers, Inc.
7201 McKinney Circle
Frederick, MD 21704
United States of America
Email: customer.service@aspenpublishers.com

Sold and distributed in all other countries by: Turpin Distribution Services Ltd. Stratton Business Park Pegasus Drive, Biggleswade Bedfordshire SG18 8TQ United Kingdom Email: kluwerlaw@turpin-distribution.com

DISCLAIMER: The material in this volume is in the nature of general comment only. It is not offered as advice on any particular matter and should not be taken as such. The editor and the contributing authors expressly disclaim all liability to any person with regard to anything done or omitted to be done, and with respect to the consequences of anything done or omitted to be done wholly or partly in reliance upon the whole or any part of the contents of this volume. No reader should act or refrain from acting on the basis of any matter contained in this volume without first obtaining professional advice regarding the particular facts and circumstances at issue. Any and all opinions expressed herein are those of the particular author and are not necessarily those of the editor or publisher of this volume.

Printed on acid-free paper.

ISBN 978-90-411-3790-6

This title is available on www.kluwerlawonline.com

© 2011, Kluwer Law International BV, The Netherlands

All rights reserved. No part of this publication may be reproduced, stored in a retrieval system, or transmitted in any form or by any means, electronic, mechanical, photocopying, recording, or otherwise, without written permission from the publisher.

Permission to use this content must be obtained from the copyright owner. Please apply to: Permissions Department, Wolters Kluwer Legal, 76 Ninth Avenue, 7th Floor, New York, NY 10011-5201, USA. Email: permissions@kluwerlaw.com

Printed in Great Britain

The Authors	3
List of Abbreviations	15
General Introduction	17
Chapter 1. Copyright and Neighbouring Rights	23
\$1. Sources – Legislation \$2. Subject Matter of Protection I. Different Categories of Protected Works A. Literary Work 1. Tables and Compilations 2. Computer Programs 3. Preparatory Design Material for a Computer Program 4. Databases B. Dramatic Work C. Musical Work D. Artistic Works 1. Graphic Work 2. Photograph 3. Sculpture 4. Collage 5. A Work of Architecture 6. A Work of Artistic Craftsmanship E. Films F. Sound Recordings G. Broadcasts 1. Encryption 2. Satellite Broadcasts 3. Internet Transmissions H. Typographical Arrangements of Published Editions \$3. SUBSTANTIVE REQUIREMENTS	24 25 26 26 27 28 29 30 31 32 32 32 33 33 34 35 35 36 37 39 40 40 41 42 42
I. Originality	42 44
II. Fixation III. Idea/Expression Dichotomy	44

§4.	WORKS EXCLUDED FROM PROTECTION	44
	I. Excluded Subject Matter	45
	II. Public Interest Defence	45
§5.	FORMAL REQUIREMENTS	46
	I. Qualification by Reference to Author	47
	A. Human Authorship	47
	B. Corporate Authorship	47
	C. Joint Authorship	48
	II. Qualification by Reference to Country of First Publication	49
	III. Publication Right	49
	IV. Crown and Parliamentary Copyright	50
	V. Copyright in International Organizations	50
§6.	AUTHORSHIP/OWNERSHIP	51
	I. The Author (Initial Authorship)	51
	II. Joint Works/Works Created by Several Persons	53
	III. Publication Right	54
§7.	THE COPYRIGHT OWNER'S RIGHTS	55
	I. Reproduction Right	57
	A. Infringement of a Copyright Work by Copying	57
	B. Infringement of Copyright in Computer Programs	58
	II. Issuing Copies of the Work to the Public	62
	III. Renting or Lending Copies of a Work to the Public	63
	IV. Performing Right	64
	A. Infringement of Copyright in a Work by Performing,	
	Showing or Playing the Work in Public	64
	V. Communication to the Public Right	65
	VI. Adaptation Right	66
§8.	SECONDARY INFRINGEMENT	69
	I. Importing Infringing Articles	69
	II. Possessing or Dealing With Infringing Copies in the Course	
	of a Business	70
	III. Providing Means to Make Infringing Copies	71
	IV. Permitting the Use of Premises for Infringing Performances	71
	V. Providing Apparatus for Infringing Performances	72
§9.		73
	I. Making of Temporary Copies	74
	II. Fair Dealing for the Purposes of Non-commercial Research	
	and Private Study, Criticism or Review and News Reporting	74
	III. Incidental Inclusion of Copyright Material	76
	IV. Educational Use	79
	V. Libraries and Archives	80
	VI. Public Administration	82
	VII. Miscellaneous: Literary, Dramatic, Musical and Artistic Works	82
	A. Use of Notes or Recordings of Spoken Words	82
	B. Public Reading or Recitation	82
	C. Abstracts of Articles D. Reconstruction of Buildings	83
	D. Reconstruction of Buildings	83

	E. (Copies of Artistic Works for Advertisement Purposes	83
		ncidental Recording for Purposes of Broadcast	83
		Representation of Artistic Works on Public Display	84
		Articles Made to Designs	84
		Exceptions to Copyright Infringement in a Computer Program	84
		Databases	86
	K. 7	Time-Shifting	86
	L. F	Recording for Supervision of Broadcast Content	86
	M. F	Free Public Showing	86
	N. F	Provisions for the Deaf	87
	O. A	Anti-circumvention	87
§10.	TRANS	MISSION OF TITLE AND LICENCES	88
	I. Tr	ansfer on Death	88
	II. Tr	ansfer on Bankruptcy	89
	III. As	ssignment and Licensing – General	89
	IV. As	ssignment of Copyright	89
	V. As	ssignment of Copyright in Computer Programs	90
	VI. Pr	esumption of Transfer of Rental Right in Film	
	Pr	oduction Agreements	91
	VII. Ri	ght to Equitable Remunerations where Rental Right	
	Tr	ansferred	91
		oral Rights	91
	IX. Li		92
		Voluntary Licences	92
		Compulsory Licences and Licences of Right	93
		Collective Licensing	94
	D.	The Copyright Tribunal	95
		1. References of Licensing Schemes and Entitlement to	
		Licences under Licensing Schemes	96
		a. The Terms of the Licensing Scheme	96
		b. Disputes	96
		c. Refusals to License	97
		2. References or Applications in Relation to Licensing	0.00
		by Licensing Bodies	97
	E.		000
		Tribunal on Application and Reference	98
	F.		99
	G.	Sound Recordings, Broadcasts and Cable Programme	101
	II	Services	101
		Listings Made Available by Broadcasters	102
	I.	Cable Re-transmission Right	103
211		Certification of Licensing Schemes	
§11.		LANEOUS RIGHTS i Generis Protection under the Database Regulations	105 105
		Authorship and Ownership	105
		The Exclusive Rights of the Owner	105
	D.	Term of Protection	105

	D. Qualification for Protection	107
	E. Overlap Between Copyright and Sui Generis Protection	107
	II. Moral Rights	108
	A. The Paternity Right	109
	B. The Right of Integrity	110
	C. False Attribution of Authorship	112
	D. Duration of Moral Rights	115
	E. Remedies for Infringement of Moral Rights	116
	III. Public Lending Right	116
	IV. Performer's Rights	118
	A. Conditions for Protection	119
	B. Infringement of Performer's Rights	119
	C. Rights of Persons Having Recording Rights	120
	1. Infringement	120
	2. Permitted Acts	121
	3. Term of Protection	122
	4. Remedies for Infringement	122
	5. Performers Rights and the 1996 Regulations	123
	6. Infringement and Remedies	124
	7. Licensing Schemes	125
	8. Moral Rights	125
	V. Works Made for Hire	126
	VI. Artist's Resale Right	128
§12.		129
§13.		132
3	I. Injunctions	133
	II. Damages	133
	III. Account of Profits	134
	IV. Orders for Delivery Up	135
	V. Criminal Sanctions	136
	VI. Commissioners of Customs and Excise	136
	The Commissioners of Customs and Entire	150
Cha	apter 2. Patents	120
Clia	ipier 2. I atents	138
§1.	Sources – Legislation	138
§2.	PATENTABLE SUBJECT MATTER	138
52.	7 37 1	138
	I. Novelty II. Inventive Step	140
	III. Industrial Application	140
§3.	CONDITIONS OF PATENTABILITY	141
	FORMALITIES (PROCEDURE FOR GRANT AND OBTAINING	171
3	PROTECTION)	144
§5.	OWNERSHIP AND TRANSFER (ASSIGNMENT – LICENCES)	148
	SCOPE OF EXCLUSIVE RIGHTS	151
§7.	LIMITATIONS OF THE SCOPE OF PROTECTION – COMPULSORY LICENCES	152
§8.	DURATION OF PROTECTION	154
89.	INFRINGEMENT AND REMEDIES	155

		haustion of Rights nreats' Proceedings	157 158
		minal Offences	159
	IV. Op		159
810		PPING RIGHTS AND RELATION TO OTHER INTELLECTUAL	137
810		TY LAWS	160
	I KOLEK	TI LAWS	100
Cha	apter 3.	Trade Marks	161
§1.	SOURCE	S – LEGISLATION	161
	I. The	e 1994 Act	161
	II. The	e Function of a Trade Mark	161
	III. Bro	oad Outline of the 1994 Act	162
	IV. Wh	at Is Not Covered by the 1994 Act	162
		tters Covered under the 1994 Act in Addition to UK	
	Reg	gistration	162
	VI. Con	mmon Law of Passing Off	163
§2.	SUBJECT	MATTER OF PROTECTION	164
	I. Sig	ns Which May Serve as Trade Marks	164
		A Sign	165
	B.	Capable of Being Represented Graphically	165
		Capable of Distinguishing Goods or Services of One	
		Undertaking from Another Undertaking	166
	D.	Service Marks	167
	II. Diff	ferent Categories of Marks	167
§3.	CONDITI	ONS OF PROTECTION	168
	I. Abs	solute Grounds for Refusal of Registration	169
		Section 3(1)(a)	169
		Section 3(1) Proviso	169
		Section 3(1)(b) of the 1994 Act	170
		Section 3(1)(c) of the 1994 Act	170
		Section 3(1)(d) of the 1994 Act	171
	F.	Section 3(2) of the 1994 Act: Absolute Grounds for	
		Refusal Relating to the Shape of the Goods	172
	G.	Section 3(3) of the 1994 Act: Absolute Grounds for	
		Refusal Relating to Marks Contrary to Public Policy	
		and Morality and Deceptive Marks	172
	H.	Section 3(4) of the 1994 Act: Absolute Grounds of	
		Refusal because the Use of the Mark is Prohibited by	
		UK or EU Law	173
	I.	Sections 3(5), 4, 57 and 58 of the 1994 Act: Absolute	
		Grounds for Refusal – Protected Emblems	173
	J.	Section 3(6) of the 1994 Act: Applications Made in	
		Bad Faith	174
	K.	Sections 5–8 of the 1994 Act: Relative Grounds for	
		Refusal of Registration	174
		1. Section 5(1) of the 1994 Act	175

	2. Section 5(2) of the 1994 Act	175
	3. Section 5(3) of the 1994 Act	176
	4. Section 5(4) of the 1994 Act	177
	5. Section 5(5) of the 1994 Act	178
	6. Section 7 of the 1994 Act	178
84.	FORMALITIES (PROCEDURE OF OBTAINING PROTECTION,	
0	ESTABLISHING AND MAINTAINING TRADE MARKS)	179
	I. Filing the Application	180
	II. Request for Registration	181
	III. Classification of Goods and Services	181
	IV. Statement that the Mark Will Be Used	181
	V. Examination and Registration	181
	VI. Appeals	184
	VII. Collective and Certification Trade Marks	185
	VIII. The Cost of Applying for a Trade Mark	186
§5.	OWNERSHIP AND TRANSFER (ASSIGNMENT – LICENCES)	186
00.	I. Ownership	186
	II. Assignments	187
	III. Licences	188
	IV. Registration of Assignments and Licences	189
§6.	SCOPE OF EXCLUSIVE RIGHTS	190
§7.	LIMITATIONS OF THE SCOPE OF TRADE MARK PROTECTION	191
§8.	USE REQUIREMENTS	191
89.	DURATION OF PROTECTION – RENEWAL – TERMINATION	193
	I. Duration of Protection and Renewal	193
	II. Surrender	193
	III. Grounds for Invalidity of Registration	194
	IV. Invalidity on Absolute Grounds	194
	V. Invalidity on Relative Grounds	196
§10.		197
	I. Section 10(1) of the 1994 Act	199
	II. Section 10(2) of the 1994 Act	200
	III. Section 10(3) of the 1994 Act	201
	IV. Counterfeiting	201
	V. Defences to an Action of Infringement or Limits on the	
	Effect of a Registered Trade Mark	202
	VI. Section 11(1) of the 1994 Act	203
	VII. Section 11(2) of the 1994 Act	203
	VIII. Section 11(3) of the 1994 Act	204
	IX. Section 12 of the 1994 Act	205
	X. Remedies	206
	A. Section 14 of the 1994 Act	206
	B. Sections 15, 16, 18 and 19 of the 1994 Act	207
	C. Section 17 of the 1994 Act	207
	D. Section 21 of the 1994 Act	207
	E. Section 89 of the 1994 Act	208

§11	. OVERLAPPING AND RELATION TO OTHER INTELLECTUAL PROPERTY LAWS	208
§12		209
Ch	apter 4. Trade Names	212
§1.	Sources – Legislation	212
	I. International	212
	A. The Paris Convention for the Protection of Industrial	
	Property 1983	212
	B. Madrid Agreement 1981	213
	C. Agreement on Trade-Related Aspects of Intellectual	
	Property Rights (TRIPS)	213
	II. Regional – European Community Protection	213
	III. United Kingdom	214
	A. Trade Marks Act 1994	214
	B. United Kingdom Consumer Protection	215
	C. United Kingdom Common Law	215
§2.	THE PROTECTION OF TRADE NAMES	216
Cha	apter 5. Industrial Designs	217
§1.	Sources – Legislation	217
§2.	DESIGN COPYRIGHT	219
§3.	SUBJECT MATTER OF PROTECTION	220
35.	I. Registered Designs	220
	A. Registered Designs Act 1949 (Pre-2001) Amendments	221
	1. Article	221
	2. Exclusions from the Definition	224
	a. Method or Principle of Construction	224
	b. Functionality	225
	c. 'Must Match' Exclusion	225
	3. The Requirement of Novelty	226
	4. Prior Applications	229
	a. Prior Applications in Convention Countries	229
	b. Prior Publication in the United Kingdom	229
	B. Registered Designs Act (Post-2001)	231
	1. Definition of Design	231
	a. Designs of Parts	231
	b. Complex Parts	231
	2. Substantive Grounds for Refusal	232
	a. Public Policy and Morality	232
	b. Must Fit	232
	c. Miscellaneous Grounds for Refusal	233
	3. Novelty and Individual Character	233
	4. Prior Art	234
	5 Term of Protection	235

II. Unregistered Design Right	235
A. Unregistered Design Right: Design	236
B. Originality	236
C. The 'Must Match' and 'Must Fit' Exceptions	237
§4. CONDITIONS OF PROTECTION	239
I. Registered Designs	239
II. Unregistered Design Right	239
§5. FORMALITIES – PROCEDURE FOR OBTAINING PROTECTION	241
I. Registered Design Right	241
II. Unregistered Design Right	242
§6. Ownership and Transfer (Assignment and Licences)	242
I. Registered Design Right	242
II. Unregistered Design Right	244
§7. Scope of Exclusive Rights	245
I. Registered Designs	245
II. Unregistered Design Right	246
§8. LIMITATION OF SCOPE OF PROTECTION	246
§9. DURATION OF PROTECTION	246
I. Registered Design Right	246
II. Unregistered Design Right	248
\$10. Infringement and Remedies	248
I. Registered Design Right – Infringement	248
II. Unregistered Design Right – Infringement	249
III. Registered Design Right – Remedies	251
IV. Unregistered Design Right – Remedies	251
A. Threats	251
	232
§11. OVERLAPPING AND RELATION TO OTHER INTELLECTUAL	252
Property Laws	253
Chapter 6. Plant Variety Protection	255
§1. Sources – Legislation	255
§2. SUBJECT MATTER OF PROTECTION	255
§3. CONDITIONS OF PROTECTION	256
I. Distinct	256
II. Uniform	256
III. Stable	257
IV. New	257
§4. FORMALITIES (PROCEDURE FOR GRANT AND OBTAINING	
PROTECTION)	258
§5. OWNERSHIP AND TRANSFER OF RIGHTS (ASSIGNMENTS	
AND LICENCES)	258
§6. SCOPE OF EXCLUSIVE RIGHTS	258
§7. LIMITATION OF THE SCOPE OF PROTECTION – COMPULSORY	
LICENCES	259
§8. DURATION OF PROTECTION	260
§9. Infringement and Remedies	260

§10.	OVERLAPPING RIGHTS AND RELATIONSHIP TO OTHER	
	INTELLECTUAL PROPERTY LAWS	261
Cha	apter 7. Chip Protection	262
§1.	Sources – Legislation	264
§2.		264
	I. Exceptions to the Definition	265
§3.	CONDITIONS OF PROTECTION	266
§4.	FORMALITIES (PROCEDURE FOR GRANT AND OBTAINING	
	PROTECTION)	267
	I. Qualification by Reference to Designer	268
	II. Qualification by Reference to Commissioner or Employer	269
	III. Qualification by Reference to Marketing	269
	IV. Registration	269
§5.	OWNERSHIP AND TRANSFER (ASSIGNMENT – LICENCES)	270
	I. Ownership	270
	II. Transfer	270
	III. Assignment and Licences	271
	SCOPE OF EXCLUSIVE RIGHTS	272
	LIMITATIONS ON THE SCOPE OF PROTECTION	272
	DURATION OF PROTECTION	274
89.	INFRINGEMENT AND REMEDIES	274
	I. Remedies	276
	II. Injunctions	277
	III. Damages and Account of Profits	277
	IV. Order for Delivery Up	277
010	V. Criminal Sanctions	278
310.	OVERLAPPING PROTECTION AND RELATIONSHIP TO	270
	OTHER INTELLECTUAL PROPERTY LAWS	278
Cha	pter 8. Trade Secrets/Confidential Information	280
§1.	Sources – Legislation	280
	THE PROTECTION OF TRADE SECRETS/CONFIDENTIAL INFORMATION	280
	I. Confidential Information	281
	II. The Duty of Confidence	282
	III. Unauthorized Use of the Information	285
§3.	DEFENCES AND REMEDIES	286
	I. Defences	286
	II. Remedies	287
Inde	ex	289

Intellectual Property Law in the United Kingdom

diff of ward strong of the properties of

The Authors



Colin Davies, MA (Education) (Glamorgan), LL.B (Hons) (Aberystwth), Solicitor (England & Wales), Consultant (Florida Bar) is Director of the Intellectual Property Law Unit at the University of Glamorgan, Wales. He has had almost 20 years experience in law practice in both the UK and Florida, USA. He currently leads the IP Law Unit at the University of Glamorgan, where he has been teaching since 2001. He has been teaching Patent and Trade Mark Law on an LL.M in Intellectual Property Law programme at the UK Patent Office since 2002. At the university, he teaches IP Law at undergraduate and postgraduate level. He also trains newly appointed Patent Examiners in Patent Law and Practice annually. Colin has published extensively in

the EIPR, Trademark World, JILT, Journal of Criminal Law, The Law Teacher and Business Law Journal among others. Colin was Visiting Lecturer in Intellectual Property at the Riga Graduate School of Law in 2005 and in the same year, was a judge at the European IP Leaders Awards.

Tania Cheng, LL.M (Merit) (UCL), LL.B (Hons) (Leicester), Barrister (England & Wales), Advocate & Solicitor (Singapore) is a Lecturer in Intellectual Property Law and Information Technology Law at the University of Glamorgan. Prior to her current appointment, she practiced law in Singapore for several years, specializing in Intellectual Property litigation. Currently she teaches IP law and IT law at the university at undergraduate and postgraduate levels. She has been teaching at the Patent Office since 2003 on its LL.M in Intellectual Property Law, principally in Copyright & Design Law and IT Law. She has written and published articles in several journals, including the EIPR, JILT and Computer Law & Security Report. In 2005, she was Visiting Lecturer in Intellectual Property at the Riga Graduate School of Law.

The Authors

The Authors	3
List of Abbreviations	15
General Introduction	17
Chapter 1. Copyright and Neighbouring Rights	23
\$1. Sources – Legislation \$2. Subject Matter of Protected Works A. Literary Work 1. Tables and Compilations 2. Computer Programs 3. Preparatory Design Material for a Computer Program 4. Databases B. Dramatic Work C. Musical Work D. Artistic Works 1. Graphic Work 2. Photograph 3. Sculpture 4. Collage 5. A Work of Architecture 6. A Work of Artistic Craftsmanship	24 25 26 26 27 28 29 30 31 32 32 32 33 33 33 34 35
E. Films	36
F. Sound Recordings G. Broadcasts 1. Encryption 2. Satellite Broadcasts 3. Internet Transmissions	37 39 40 40 41
H. Typographical Arrangements of Published Editions §3. SUBSTANTIVE REQUIREMENTS I. Originality II. Fixation III. Idea/Expression Dichotomy	42 42 42 44 44