

# Index

abstract (patents) 363-64, 367-71, 375-81 objective of protection 217-18 advertising rightholders and beneficiaries of advertisements as commercial speech protection 220-21 26 - 27celebrity as advertisement 25-27 commercial speech doctrine 24, 26-27 evoking image of celebrity as violation of modern publicity right 26-27 parodies 24, 27 pure advertising uses resolved in favour of celebrity 24, 26 comparative advertising as nonconfusing 423 culturally offensive advertising 212 disguised commercial advertisements 31 keyword advertising purchases of rival's trademark 98-100, 406 marks, advertising function of 94-95, 98 newsworthy uses 29 non-advertising meriting stronger protection 25 objecting to use of name or likeness to advertise products 17, 19-20 allusive (marks) 415-16 anti-circumvention 257, 259, 264 anti-circumvention provision/modchips 259-62 Information Society Directive 253, 391-92, 431 opposition to anti-circumvention provisions 253 anti-dilution see dilution anti-trust 36-37, 171 appellation controlée 107-8, 110-11, 124-26, 147 authors' rights 216 authorship 55, 203, 218-19 traditional knowledge, and 217-24 form and content of legal protection limitations of protection 223-24

subject matter of protection 218-20 sui generis approach to protection required 224 Berne Convention 218-19 moral rights 437 'blurring' 77-80, 84, 87, 89-90, 94-95 celebrity rights alienable legal right in value of celebrity images recognised 17, 22-24 celebrity image in relation to advertisements/celebrity as advertisement 25-27 commercial speech doctrine 24, 26 - 27evoking image of celebrity as violation of modern publicity right 26-27 parodies 24, 27 pure advertising uses resolved in favour of celebrity 24, 26 celebrity image in relation to products/ celebrity as product 27-37 access to celebrity identity as tool of expression 27-28 antitrust laws 36-37 celebrity merchandise violating right of publicity 29-31 expressive commentary' cases/ traditional expressive products 28-29, 36 expressive works between 'expressive commentary' and merchandise 31 - 35First Amendment balancing test 32 new-media uses of celebrity images/ video games 34-36 parodic or critical purposes 33, 35 'predominant use' test 32

441



More information

Cambridge University Press 978-1-107-03400-6 - Intellectual Property at the Edge: The Contested Contours of IP Edited by Rochelle Cooper Dreyfuss and Jane C. Ginsburg Index

## 442 Index

celebrity rights (cont.) negotiating boundary between right of publicity presumptively innovation norms and patent system violated 24-25, 27-28 336-41 Rogers v. Grimaldi test 31 patentable subject matter as matter of social consequences 35-37, 56 future patent scope 373-80 'transformativeness' test 31-35 collective goodwill 138, 140-41 evolution of publicity as a legal right 17-24 certification marks codifying 132 champagne, in 118, 120-22, 131-32 extension of publicity rights to use of higher value of 150-51 image as product/in product 19-20 goals/purposes served by right of innovation 154-55 publicity 27-28, 35, 37, 54 notion of 131-32 nature of right of publicity 22-24, passing off, protected by 129 35-37, 55 representing collective owners 135, right of publicity as right with few 143-44 trademark law accommodating 154 internal limits 17-18, 23-24 exploitation of celebrity continually confidentiality evolving 54 choice between patents and reliance on First Amendment, and 17-18, 20, 24, 54 breach of confidence law 295 disclosure 316-17 advertisements as commercial speech protecting information of 'relative commercial speech doctrine 24, 26-27 secrecy' 295 non-advertising meriting stronger see also trade secrets protection 25 copyright 211-12, 391 publicity and free speech 27-33, 38 apparel, copyright protection for limits on right of publicity, need for 38 182-83 objecting to use of name or likeness to Copyright Directive, EU 254-57 advertise products 17, 19-20 definition of technological measures privacy rights 17 253, 255-56 evaluation report on Directive 257 right to one's image as exclusive exploitation right akin to copyright Explanatory Memorandum 256-57 Information Society Directive 253 certification marks 132, 135-36, 139-41 infringement 391 certification mark owner controlling parody 431-32 certification standards 142, 145 peer-to-peer sharing of copyright collective goodwill 132, 138, 140-41 397 definition 132, 135-36 safeguarding exceptions provision GIs, and 132, 141-42 254 legacy issues with use of European and technology protecting see technological other GIs 153-55 protection measures, EU nature of 134 fair dealing 398-99, 424 owner acting as representative of mark parody, for 434, 439-40 user 141 fair use see fair use GIs as 141-50 image rights 55 historically 139-41 infringement of copyright 391 nature of 134 meaning of 390 claims (in patents) 291, 296-97 innovation, promoting 217 cost of broad claims to future innovation modchips 259-61 379 - 80moral rights 435-36 discerning laws of nature from parody 431-32 as an exception to copyright 431 'applications' of laws of nature 363 - 71not an exception to copyright inventive concept approach 368-69 428 - 31laws of nature and medical diagnostic patent scope, constraints on 390-95, tests 369-71 400 - 1morality 372-73 peer-to-peer sharing of copyright 397



Index 443

protection against circumvention 257,	dilution 59-102, 406, 416-17
259, 264 anti-circumvention provision/	antidilution protection, adopting 76, 90 causes of action in dilution provisions
modchips 259–62	87–88
Information Society Directive 253, 391–92, 431	cloaking concept of dilution in legal realism 72–73
statutory limitations 406	definition of dilution 77
'substantial part', meaning of 390–91	dilution protection as reaction to narrow
technology protecting see technological	available protection 84
protection measures trademark protection, and 405–6, 425	function of marks in development of dilution protection 93–95
transformativeness 411–12	'functions' used to interpret Trademark
criticism and review 223	Directive 93–95
use of celebrity name/likeness for critique 33, 35	functions used to limit trademark rights 93
cultural resources see traditional knowledge	kinds of marks qualifying for antidilution protection 78–79, 93
damage	misappropriation
amour propre damage as reason to sue 433	dilution law as misappropriation regime 82
difficulties of proving 105, 119	dilution as weapon against 85, 87
intentional 65, 69, 71–72	formalist misappropriation approach,
moral damage 41-42	functionalist analysis modifying
moral violation, and 68–69	98–101
passing off 117, 127	part of dilution, as 88–90
trademark dilution 66-67, 71-72	objection to assimilation of functions
damages, statutory 409–10, 426	protected by Trademark Directive
description (in patents) 289, 296–97,	95–96
314–16, 373–74, 383–84	preservation of uniqueness of a
descriptiveness geographical signs 119–20	trademark as basis for its protection 61, 84
misdescriptiveness 138	protecting ability of mark itself to sell
passing off 119, 126	product 84
design rights	suppressing link between dilution/
Community Design Regulation 180–81,	misappropriation 63, 71–72, 76
186–87	transatlantic comparativism 82–83
copyright protection for apparel	whether blurring link between mark/
182–83	good or mark/producer 77-78, 84,
design protection 159-90	94–95
acceptance that design efforts worthy	disclosure
of protection 180	confidentiality 316–17
fabric designs 178	patents 271, 281–83, 289, 293–95, 373
fashion design lacking protection	trade secrets 271, 286–89
159–60	distinctive character 85–87, 99–100,
proposals to provide protection 159–60, 177–78	188–89 distinctiveness
self-help measures 178–79	acquired distinctiveness or secondary
style versus design 166–67, 172,	meaning 119–21, 188
178	blurring 417
European Design Directive 186–87	diluting 66–68
harmonization 185–87	geographical signs 119–20
protection from unfair competition	inherent distinctiveness 75
provisions 180, 182–85, 187–88	taking advantage of 87
Unregistered Community Designs	DRM (digital rights management) 253,
180–81, 187	264, 266–67



More information

## 444 Index

economic justification for IP rights 393, free riding 96, 100-1 439 - 40anti-free riding cause of action 87-88, enablement requirement 289, 293-94, 373–74, 376, 379–80 dilution as form of 64 trade secret's relative secrecy standard nature of 70, 95 compared 289-90 pure free riding 105, 117-18, 124 European Convention on Human Rights right against misappropriation 95, 105, (ECHR) 117-18, 124 Article 10(1)/freedom of expression 435, freedom of expression 259 438-39 ECHR 435, 437-39 parody 437-38 expressive uses, clear protection for 424 moral rights 438 fair dealing 398-99 exhaustion 93 right to one's image not violating 52 expressive products/high value expression trademarks 415 28-31, 36 freedom of speech 52 authorial works/expressive autonomy ECHR 435, 437-39 393 expression, value of 421 'extended' passing off 105-6, 124-28, First Amendment, US 17-18, 20, 24, 32, 141 - 4254, 373, 419 collective goodwill/goodwill 126-29, 141, parody 435 publicity and free speech 27-33, 38 154 conceptual and institutional divergences trademarks, and 415, 421, 424 between two approaches gatekeeper theory 370-72, 395 124 - 29definition of ingredients and method of novelty/non-obviousness concepts serving 'gatekeeper' function 368 production 128 definition of product 126-28 geographic indications (GIs) appellation controlée 107-8, 110-11, initiating common law approach to GI protection 128-29 124-26, 147 limits to protection 124 certification marks principal response for GI protection, as GIs as 141-50 105-6 historically 139-41 nature of 134 registration-based regimes 125-29 uncertainty creating 105-6 US, in see under United States (US) unfair competition approach 124-25, definition in TRIPS 132 127-29 geographical names 122 GIs as certification marks 141-50 fair dealing 398-99, 424 cultural resources and traditional knowledge 148-50, 154-55 parody, for 434, 439-40 fair use 263, 398 greater value of GIs 147-48 role of the state in protecting GIs affirmative defense, as 410-11 controlling access via technology 250 142-46 Digital Millennium Copyright Act, and transferability 146-47 236-37, 248, 250 goodwill see goodwill fair use, nominative 413-14, 421-23 nature of GIs 142-43 four-factor fair use test 406-7, 410-11 higher sui generis protection for GIs natural severability 420 not harmful 151-52 parody and satire 211-12, 411, 419 registration based/terroir approaches 107, predictability and flexibility 406, 424-26, 125-29 product specification as basis for traditional knowledge, and 207-9, registration 108, 125-26 211 - 12status of geographical signs in passing off transformativeness 406, 411-12, 420 119 - 20famous marks 56, 65-66, 71-72, 75-77, unfair competition approach 106-9, 148-49 127-29



More information

Index 445 prioritising prevention of misuse celebrity merchandise violating right of 124 - 25publicity 29-31 unfair competition statute, recognition expressive commentary' cases/ within 107 traditional expressive products goodwill 28-29,36certification marks 139-41 expressive works between 'expressive collective goodwill 138, 140-41 commentary' and merchandise champagne, in 118, 120-22, 131-32 31 - 35First Amendment balancing test 32 certification marks codifying 132 higher value of collective goodwill new-media uses of celebrity images/ 150–51 video games 34-36 innovation 154-55 parodic or critical purposes 33, 35 'predominant use' test 32 notion of collective goodwill 131-32 passing off protecting 129 right of publicity presumptively representing collective owners 135, violated 24-25, 27-28 143–44 Rogers v. Grimaldi test 31 trademark law accommodating 154 social consequences 35-37, 56 transformativeness' test 31-35 defining ingredients and method of production 128 distinctive signs akin to trademarks, defining the product 126-27 images as 44, 55-56 goodwill traditionally belonging to First Amendment, and 17-18, 20, 24, 54 individual commercial entity non-advertising meriting stronger 117-18, 121 protection 25 nature of goodwill 117-18, 144 publicity and free speech 27-33, 38 certification marks, owning 139-41 privacy rights 17 Fashion Originators Guild of America right to one's image as exclusive 159-79 exploitation right akin to copyright harmonization industrial applicability 344-45, 347-48 infringement 82-83, 185-87, 247-48, copyright 254-57 255-56 design rights 185-87 copyright 234, 391, 400-1 European harmonization, path to 185-87 internal harmonization of boundaries 432 copyright management information proportionality, and 397-98 230, 234-41 human rights 438 expansive test of infringement 391 Charter of Fundamental Rights 397 fair use 410-11, 426 illicit temporary copying 261 image rights meaning of infringement 390 parody 429-40 alienable legal right in value of celebrity images recognised 17, 22-24 preventing infringement 235, 246-48, celebrity image in relation to 251, 253, 256-57 threats of infringement 426 advertisements/celebrity as advertisement 25-27 dilution 89 commercial speech doctrine 24, 26-27 patents 176, 321, 338-39, 348-49, 383, evoking image of celebrity as violation 388, 400-1 of modern publicity right 26-27 implied licence to repair inventions parodies 24, 27 389-90 pure advertising uses resolved in favour indirect infringement 370 of celebrity 24, 26 research exemptions 379-80 celebrity image in relation to products/ right of personality violations 53 trademarks 41, 93, 100-1 celebrity as product 27-37 access to celebrity identity as tool of certification marks 138-39 expression 27–28 multifactor tests 406

antitrust laws 36-37

threats of infringement 426



## 446 Index

innovation 108	novelty
abstract ideas doctrine 375-76	design/fashion 180-81, 183-88
collective goodwill 154–55	patents 296, 362, 364, 366-69, 371, 395
copyright protection promoting	requirement of novelty 385
innovation 217	
fashion 166-67, 183	ordre public 372–73
future innovation, protecting 369-70,	originality 163
375–77, 379–80	copyright, low originality standard in 405
medical device innovation 323-24, 330,	design protection 185–86
340, 355	as basis for 179
nature of innovation in applicable	fashion, in 166–68, 178
industry 378	lack of 218–19
patents	Men 01 210 19
cost to future innovation of broad	paracopyright
claims 379–80	EU see technological protection
disclosure of information supporting	measures, EU
innovation 280–81, 287, 312–16,	US see technological protection
375	measures, US
incentives/spurring new technologies	Paris Convention (1883)
372, 380	Art 10/indication of source 109, 115
whether patent claims foreclose future	parody 427–40
innovation 363	celebrity images
speed of innovation 378–79	celebrity image in relation to
trade secrecy protection encouraging	advertisements/as advertisement
innovation 280	24, 27
traditional knowledge 154–55, 196–97,	celebrity image in relation to products/
205–7, 218	as product 33, 35
user innovation see user innovation	celebrity name/likeness for parody, or
inventive step 392, 395	critique, use of 33, 35
inventive step 392, 393	copyright 431–32
Madrid Agreement (1891) 109, 115-16	fair dealing for parody proposals 439–40
misappropriation 75–76	fair use 211–12, 411, 419
cause of action, as 89–90	parody as exception to copyright 431
dilution law as misappropriation regime	parody not an exception to copyright
82	428–31
dilution as weapon against 85, 87	
formalist misappropriation approach,	damage to <i>amour propre</i> as reason to sue
functionalist analysis modifying 98–	deceptive works 434
101	free speech 435
part of dilution, as 88–90	objectively defined rhetorical device, as
suppressing link between dilution/	419
misappropriation 63, 71–72, 76	permissibility of parody, difficulties of
trade secrets 279	legislating for 431
'true functions' and misappropriation as	satire and parody 411
formalism 93–101	tolerance for 409–10
moral rights 435–36	trade marks 432
Berne Convention 437	traditional knowledge, parodying 211–12
ECHR 437–38	passing off 434
parody, allowing for 436–37	'extended' passing off 105–6, 124–28, 141–42
mamas 42 51 52	
names 43, 51–52	collective goodwill/goodwill 126–29,
distinctive signs akin to trademarks,	141, 154
names as 44, 55–56	conceptual and institutional
inalienability of names 43–44 non-obviousness 296, 364, 367–69, 371	divergences between two approaches
11011-00110u311c33 230, 304, 301-03, 311	124–29



More information

Index 447

definition of ingredients and method of production 128 definition of product 126-28 initiating common law approach to GI protection 128-29 limits to protection 124 principal response for GI protection, as 105-6 registration-based regimes 125-29 uncertainty creating 105-6 unfair competition approach 124-25, 127-29 geographical signs, status of 119-20 limitations on tort of passing off 117-18 limits to protection 124 misrepresentation central to passing off 124 preventing new forms of unfair competitive conduct 121 requirements of passing off 117 wrongful conduct in passing off 117 pastiche 431-32, 438-39 patents 280-83, 295-317, 401 Bayh-Dole Act 324-25 biotechnology advances, patents facilitating 324-25 Community Patent Convention 400-1 disclosure 271, 281-83, 289, 293-95, 373 effect of maintaining a trade secret on obtaining patent protection 292-93 eligibility and patent scope 361-401 application of a law of nature must itself be novel 364-68 contextual reading of patent claims 384, 391, 400-1 discerning laws of nature from 'applications' of laws of nature 363-67 equivalents, doctrine of 393-94 eschewing policy limits on patent scope to maximise protection 383, 386-90, factors to test abstract ideas' patent eligibility/analyze laws of nature 377-81, 393 future innovation, foreclosing 363 gatekeeper theory 370-72, 395 generative nature of new technology/ natural law application 377-78 impact of patent scope ought to inform determination, whether 385-87 invention, meaning of 383-84 inventions, purposes served by 394-95

inventive concept test 363-64, 368-69, 387-89, 393, 400 inventor's contribution as pioneering or merely incremental in nature 380 issues around patent eligibility from decision in Funk Brothers 361-63 judicial approaches to patent scope 383-87 medical diagnostic tests 369-71 mixing up doctrines 367-73 morality/ordre public creating exceptions to patentability 372-73 multi-factored, policy-driven test for patentable subject matter 375-81 nature of innovation in applicable industry 378 'normative characterization' 385-86 normative interpretation by the courts, appropriateness of 385-87 novelty/non-obviousness concepts serving a 'gatekeeper' function 368 number of specific practical applications disclosed in patent application 379-80 patent scope linked to what merits subject matter its protection 394-95 patent system influence on genesis of discoveries 369 patent system's underlying policy aims, consideration of 385-87 patentable subject matter as matter of (future) patent scope 373-80 process of claim interpretation as explicitly normative 385-86 proportionality-based test 397-99 purposes of interpreting patent claims 385 purposive determination of patent claims 384 risk of patent eligibility being dependent on drafting 367-68 scope of patent protection defined according to type of invention 383 scope theory of patentable subject matter 374-75 secondary patentability requirements 395-96 setting 'edges' of patent system 382 speed of inventions/dissipation of invention value in a given industry 378-79 statutory context, claims to be construed in 384-85 subject matter-based constraints on patent scope 390-95, 400-1



More information

### 448 Index

patents (cont.) medical devices, physicians permitted to patent 323-24, 330, 340 'substantial part' test in patent law, adopting 391–93, 400–1 medical procedure patents becoming widely contested and misunderstood available 324-25, 330, 346 395-96 negotiating boundary between enablement requirement 289, 293-94, innovation norms and patent system 373-74, 376, 379-80 336 - 41trade secret's relative secrecy standard opposition of physicians to medical compared 289-90 procedures patents 321-22, 325, European Patent Convention (EPC) 329-31, 336-41 345–49, 386, 400 patent office rejecting patents for exception for medical procedures, medical procedures 324 providing 346, 355 policy rationales justifying medical case law on defining boundaries of treatment exception 347-48 exception 347, 355 reasons why not patentable 344-45 criticism of exception 348-49 social norms against patenting medical impact of 389, 401 technologies 344 policy rationales justifying medical patent appeals centralized in central treatment exception 347-48 forum 325 Protocol on the Interpretation of patent protection preferred to trade Article 69 384-86 secrecy protection, reasons why 282 restricted role of domestic courts since physicians' immunity against introduction 389 enforcement of patent claims 321-23, historical protection of secrets 344 325, 338-39, 341, 346, 362, 367 innovation restricted role of domestic courts since cost to future innovation of broad introduction of EPC 389 claims 379-80 rights designed to be limited in time and disclosure of information supporting scope 280-81 innovation 280-81, 287, 312-16, 375 secondary liability 341-42 incentives/spurring new technologies secrecy 372, 380 accepted as alternative to patenting 317 whether patent claims foreclose future permitted about inventions 271, 282-83, 293-94 innovation 363 medical patents 342, 344-45 stimulating productivity 281 approaches compared 346 user innovators see user innovations biotechnology advances, patents utilitarianism as purpose 280-81, 394-95 facilitating 324-25 personality, right of controversy over medical procedure personality rights not regulated 40 patents 324 property rights in personality as new form evolution of medical treatment of intellectual property 52-56 exceptions in Europe 344-49 compensation for transfers of property exceptions provided for medical rights 53 procedures 346-48, 355 exceptions to property rights 52-53 general patent systems exempting exploitation of celebrity continually medical procedures from evolving 54 patentability 343 proof of violations of rights of industrial applicability grounds, personality 53-54 patents for medical treatment property rights in personality/right of refused on 345 publicity 39-56 judicial/patent office rejecting patents Bordas initiating development of for medical procedures 324 43-45, 51 laws of nature and medical diagnostic exclusive nature of right to one's image tests 369-71 medical device innovation 323-24, no equivalent to Haelan decision 39 330, 340, 355 personality rights, nature of 47



More information

Index 449

property rights in personality, Ducasse personality rights, nature of 47 recognizing 45-47, 51-52 property rights in personality, Ducasse property rights in personality as new recognising 45-47, 51-52 property rights in personality as form of intellectual property 52-56 property rights in personality not new form of intellectual property subject to a coherent regime 52-56 51 - 52property rights in personality not violation of grant of exclusive image subject to a coherent regime 51-52 violation of grant of exclusive image rights as unfair competition 47-52 'predominant use' test 32 rights as unfair competition 47-52 privacy 55 see also celebrity rights celebrities 17, 22-23 inalienable personal right, as 41-42 repair (inventions) 387-89 private parties 22 implied licence 389-90 protection of 39-40 reputation 66 right to one's image distinct from 50-51 collective goodwill, evidencing 141–42 proportionality 397-99 copyright and protection of reputation fair dealing 398-99 moral rights 435-37 harmonization, and 397-98 parody 439-40 nature of 397 ECHR 435 peer-to-peer sharing of copyright 397 eschewing patenting in favour of public policy 344, 372-73, 395, 421 reputation rewards 322, 340 publication 276-77 geographical designations 106-8, 113-14, 127, 132, 148-49 banning 373 patents 295 certification marks 134, 141-42 harm to reputation 18, 22-24, 26 publication credit 340, 350, 352 publicity, right of 17-56 right of publicity avoiding 27-28 evoking image of celebrity as violation of low threshold for 102 modern publicity right 26-27 passing off claim, protecting reputation evolution as a legal right 17-24 by 117-20, 122 extension of publicity rights to use of publications enhancing 350 image as product/in product 19-20 reward, as 322 goals/purposes served by right of tarnishment of reputation 66 publicity 27-28, 35, 37, 54 trademarks 82, 85-88, 99 nature of right of publicity 22-24, reverse engineering 236, 283-86, 290-91, 35-37, 55 296–97 right of publicity as right with few rights management 253, 264, 266-67 internal limits 17-18, 23-24 limits on right of publicity, need for 38 satire 411 property rights in personality as new form specification (of goods) 107-8, 125-26 specification (patents) 276-77, 291, 297, of intellectual property 52-56 compensation for transfers of property 314-16 function of specification 312-14 rights 53 exceptions to property rights 52-53 nature 312 exploitation of celebrity continually publication 295 evolving 54 requirement for 295-96, 383-84 proof of violations of rights of personality 53-54 tarnishment 87 'blurring', and 79-80, 89-90 property rights in personality/right of publicity 39-56 tarnishment of reputation 66 Bordas initiating development of technological protection measures, EU 43-45, 51 253 - 67exclusive nature of right to one's image case law 258-62 expected and unexpected cases 258-59 no equivalent to Haelan decision 39 modchips and video games 259-62



More information

### 450 Index

technological protection measures, EU new cause of action, controversy over (cont.) 230 - 31effect of technological protection providing legal support for use of measures in controlling use of works technology 228 265 - 67unauthorized copying copyright shifted from public banning technologies that enabled exploitation control to reception of circumvention/DMCA 228 works 267 problem of unauthorized copying/ EU Copyright Directive see enforcement of copyright 227 under copyright technological solutions subject to interface between technology circumvention 227-28 protection measures and exceptions terroir 262-65 GIs, and see under geographic indications absence of complaints 264-65 (GIs) Article 6(4) Copyright Directive traditional knowledge 149, 154-55 262-63 trade secrets 271-317 fragmented solutions within Member choice between patents and reliance on States 263-64 breach of confidence law 295 opposition to anti-circumvention common law right of trade secrecy 271 provisions 253 disclosure 271, 286-89 technological protection measures, US effect of maintaining trade secret on 227-52 obtaining patent protection 292-93 access, law of 235-50 historical protection of trade secrets 271 complicated issue of 'access', innovation 280 failure to anticipate 231-32, 235, mechanisms developed for adjudicating 250-52 on secrets 316-17 controlling access to facilitate misappropriation 279 copyright enforcement 235-38 nature of a trade secret/secret information controlling access to meter access/ 283-87, 293-94 enforce licensing provisions perfect secrecy not needed to retain 239-42 protection 286-87, 289-90, 293-94 controlling access to prevent initial purposes of trade secrecy laws 279-80 access 238-39 relative secrecy standard/patent's controlling access to prevent 'misuse' enablement standard compared 289-90 242 - 44secrecy accepted as alternative to controlling access to websites and computers 244-47 patenting 317 hardware and software tying 247-50 trade secrecy protection, current 279-80 trade secrecy protection preferred to new access right invoked in unintended areas 231, 242-44, 247-50 patent protection, reasons why troublesome nature of access 250-52 281-82 Digital Millennium Copyright Act trademarks (DMCA) 232-34 advertising function of 94-95, 98 anti-trafficking provisions 228-29, anti-dilution see dilution 233 - 34apparel, registrations of 188-89 copyright extension facilitating price basis of trademark protection 61 discrimination/market efficiency 'blurring' and 'tarnishment' 79-80, 87, 229-30 89-90 copyright management information causes of action in dilution provisions 230, 234-41 87 - 88facilitating enforcement of copyrights certificates of label approval 130-31 in digital works 228-29 certification marks see certification new cause of action against marks circumvention of technologies Community trademarks 41-42, 85-86, 228-29, 233



More information

Index 451

copyright protection, and 405-6, 425 dilution dilution law as a misappropriation regime 82 dilution provisions 83-90 formalism 90 GIs as certification marks 141-50 cultural resources and traditional knowledge 148-50, 154-55 greater value of GIs 147-48 role of the state in protecting GIs 142 - 46transferability 146-47 see also geographical indications (GIs) goodwill see goodwill higher sui generis protection for GIs not harmful 151-52 keyword advertising purchases of rival's trademark 98-100, 406 misappropriation as cause of action 89-90 multifactor tests to identify infringements 406, 413 names and images as distinctive signs akin to trademarks 44, 55–56 nature of 144 parody, no provision for 432 quality control 145 registration-based systems 144 reputation 82, 85-88, 99 similar and dissimilar goods 86-87 'tarnishment' 87 Trademark Directive 76, 85-87, 91-95 Trademark Regulation 85-86, 91, 150-51 transferability 146-47 'true functions' and misappropriation as formalism 93-101 unfair competition protection 85, 90-92 use-based systems 144, 152 traditional knowledge 193-224 definition of traditional knowledge 196 Europe, in 215 GIs 148-50, 154-55 haka in New Zealand 199-201 innovation 154-55, 196-97, 205-7, 218 intellectual property and traditional knowledge, debate about 193-97 compatibility of traditional knowledge and intellectual property 193-95 Ka Mate, use of 200-1, 212-13 land rights 216 mātauranga Māori/ Māori culture 196, 202-3, 207-8 objections to extraction of value from 195, 197, 212, 216

nature of Ka Mate Ka Mate 193 Ngāti Toa seeking ownership of haka 198, 200-1, 204-5 parodying Ka Mate 211-12 reasons to protect traditional knowledge 195, 197, 205–13 fair use/research use norms and TK exclusive rights, balancing 211-13 objectives of according protection 206 - 7protection of culture and encouragement of creativity 205 protection by traditional IP rights/other means 209-11 who should benefit from protection/ hold rights to protection 207-9 registered trademark, application to register Ka Mate as 201 taonga works and kaitiaki 208-9, 220 - 22Te Rauparaha and Ka Mate Ka Mate 198 traditional cultural expressions (TCEs) 195-96 beneficiaries of protection, guardians of TCEs as 220-22 form and content of legal protection 221 - 23function of 219-23 Māori protecting 218 sharing TCEs with outsiders 223 subject matter of protection 218-20 sui generis approach to protection required 224 Waitangi Tribunal and Ngāti Toa's claims 201-5, 213, 215, 220 aspect of Ngāti Toa's culture/ intellectual property, claim as 203-5 beneficiaries of protection, kaitiaki as 207-8, 220-22 commercial exploitation /offensive treatment objections 211-13, 221 - 23new standards of legal protection and expert commission 209-11 Ngāti Toa rights/land rights 203 recording authorship/significance of haka to Ngāti Toa 203 relationship of kaitiaki with taonga works, protection of 218 sui generis approach to protection required 209-11, 224 WIPO protection of traditional knowledge 194-96, 214, 216 investigation into traditional

knowledge 195-96



More information

#### 452 Index

traditional knowledge (cont.) examples of user innovations 322 objectives of according protection factors determining whether community 206-7, 217-18 opposition to treaty proposals 195, 197, 207-9 354-56 transformativeness fair use 406, 411-12, 420 transformativeness test in use of celebrity identity 31-35 TRIPS Agreement establishing minimum requirements for international IP protection 325 GIs 131, 144, 152 definition of 132, 141-42 wines and spirits 153 349-57 intellectual property in a trade setting, placing 194 patents 346 unfair competition 90-92 356 transatlantic comparativism 82-83 'true functions' and misappropriation as formalism 93-101 349-50 uniqueness destruction by dilution 77-78 trademarks 61, 84 user innovation utilitarianism boundary between innovation norms and patent system 336-41 empirical evidence 351-54 394-95 research raising doubts about 372-73 perception of medical progression 351–53

norms preferable to IP 341 implications for patent policy importance of collective learning and institutional regimes 354 patents contributing to progress of medical treatment methods sharing/collaboration norms threatened by availability of patent rights 354-55 physicians as user innovators 322, benefiting directly from norm of sharing inventions 339-40 codes of ethics 349-50 reward structures for physicians 350, sharing norms 339-40, 350 social norms in the medical profession reputation as reward 322 eschewing patenting in favour of reputation rewards 322, 340 copyright protection 217 patent systems 280-81, 372, ethics overriding utilitarian concerns utility 178