Pruning the European Intellectual Property Tree - In Search of Common Principles and Roots

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A few years ago, William Cornish wondered whether the intellectual property had not become “omnipresent, distracting, irrelevant”1. Many others now doubt about the coherence of the intellectual property regime and denounce its excessive development. Taking stock of these sound and always well-reasoned critiques, the conference organised in Strasbourg in the frame of the EIPIN assumed the uneasy task to start working on a reconstruction of the European intellectual property.

This reform of the IP regime ought necessarily to begin with an assessment of the existing rules and their relevance. As the European Union knows a multiplicity of IP rights, from classical ones (copyright, patent, trademark or design) to more marginal ones, in terms of economic sectors concerned (rights in database, in plant varieties, in semiconductors, in geographical indications), the quest for consistency could integrate a reflection on the common core embedded in that diversity. Is there (and should there be) a common ground and uniform principles across all intellectual property rights? And to what extent diversity and specificity of intellectual property rights should give away to a common approach?

This paper aims at identifying and assessing the existing similarities or common principles in the intellectual property rights in the European Union. Despite their apparent diverging functions, subject matter and scope of protection, copyright, trademark, patent and the other intellectual property rights share at least the fact that they belong to a set of rules granting some exclusive rights in intangible assets, whether creation or signs. Their inclusion under the same label ‘Intellectual Property’ should at least count for something and induce some joint ends and means.

I strongly believe that belonging to a broader field of intellectual property matters. It obliges to unified perspectives, questions and answers as to how immaterial resources deserve protection and how limits to that protection should be more central than in tangible property. This common approach has probably vanished in the legislative work of the European Union that tends to separately deal with each IP right on an ad hoc basis, with no permeability with other rights. One could only regret it, for the way Europe conceives its intellectual property regime as a whole will ultimately shape its innovation, economic development and knowledge

wealth. This paper is a very modest attempt to seek overall rules in intellectual property, or at least a more systematised ordering of the many protections, to serve as a first skeleton for a reform of intellectual property.

In 2008, in a conference organised by the university of Helsinki, Andrew Christie sketched a vision of a unified system for intellectual property, where all rights would merge into a single one, protecting diverse subject-matter. To that end, he borrowed the metaphor of a tree from an intervention made the day before by Annette Kur: intellectual property could be portrayed as a tree whose many branches represent all the protections granted by literary and artistic property or industrial property. I will take over this image. Intellectual property is a tree, an old one, a big one, a very luxuriant tree, one that seems to have grown a bit too much, without control and in an anarchic manner. It has many branches, some of them threatening to break under their own weight. The tree looks pretty and rich, but it also seems to suffer from suffocation, from lack of space. Tree specialists all agree that it is time to prune the tree, in order to make it breathe and blossom again. Probably it will require some difficult cuts and removing some lively branches, but it is to make it develop better in the end.

To start the actual work, a preliminary step would be to agree on the common design its many branches should take. It requires identifying within the diverse regimes of intellectual property, what are the common features upon which further convergence could be built. The actual pruning will be however left to others.

The regimes surveyed by this paper will primarily be copyright, trademark, patent and design rights, which can be considered as the sequoias of the IP jungle. The other varieties, i.e. related rights, the sui generis right in databases, the geographical indications or appellations of origin, plant variety rights or even the protection of semiconductors (that is a plant that not so many people can claim to have actually seen), will be addressed only incidentally or for comparison purposes.

Questions that will be successively addressed are the following: the justification of the granted protection (the why of the protection) (II.), the subject matter (the what?), requirements for protection (the how?), as well as the exclusions from protection (the what not?) (III.), the scope of protection (the what for?) (IV.), the limitations and exceptions to such protection (the not for what?) (V.), the duration (the when?) (VI.).

Contractual protection, rules of ownership, management of the rights will be left out, as the analysis is already broad enough. The enforcement or remedies conferred to all intellectual property rights will neither be touched upon as they have been largely harmonised by the directive 2004/48 on enforcement.

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Unfair competition law will not be addressed either, even though it forms a relevant protection of creation, signs or other intangible items. Nevertheless, the choice to omit it is justified by its less structured protection regime (in terms of rights conferred, limitations, conditions) and by its lack of exclusive and exploitable rights, replaced by a rule of liability to be enforced ex post. That does not diminish the evidence that unfair competition, as well as competition law, plays a role in the intellectual property landscape, that I will not have time to develop.

Before addressing the many elements of the protection, a first step will be to underline the variable intensity put by the European lawmaker into each IP right, which influences the level of harmonisation and configuration of the EU intellectual property regime (I.).

I. Level of European intervention

Diversity in IP rights can be partially explained by the many levels of European lawmaking. All rights have not been tackled by the EU lawmaker with the same intensity, and the European gardener has not treated all branches of the IP tree alike.

The more thorough intervention is the creation of a EU-wide right, as it has occurred in trademark, design right and plant variety right. Geographical indications and appellations of origin can also be granted at the EU level, which generates a title superseding the national protection. Such community rights have the desirable effect of granting a title of protection valid on the whole internal market. Provided for by Regulations, they can be said to genuinely construct a European intellectual property regime.

Less integrative are harmonisation efforts that tend to provide common principles to national intellectual property protection, without encroaching upon the national sovereignty and territoriality of the protection. The most successful and comprehensive harmonisation endeavour has arguably occurred in trademark, where only one directive has managed to bring together the laws of Member States on many aspects. The same process of coupling a harmonisation directive with a community right regulation along the same rules has occurred

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for design\textsuperscript{12}. Harmonisation can also be called a success for the protection of unoriginal databases by the \textit{sui generis} right\textsuperscript{13} and of semiconductors\textsuperscript{14}, as two brand new rights have been created on similar principles (even though the latter has not been applied much by courts).

Copyright, despite no less than eight directives, remains a largely national matter\textsuperscript{15}. Harmonisation has occurred on specific points. Technical subject-matter such as computer software or databases has received an harmonised protection within copyright, in terms of definition, criteria of protection, ownership, exclusive rights, exceptions\textsuperscript{16}. But questions of interpretation challenging the actual level of harmonisation have been recently brought to the attention of the Court of Justice of the European Union, as in the \textit{Football Dataco} case for copyright in databases\textsuperscript{17}, or the \textit{Softwarova} case\textsuperscript{18} and the pending \textit{SAS Institute} one\textsuperscript{19} for copyright in software. Those references to the Court indicate that the harmonisation still leaves many questions open.

Other fields for harmonisation in copyright have been the related rights\textsuperscript{20}, the determination of some exclusive economic rights, e.g., the cable and satellite right\textsuperscript{21}s, the \textit{droit de suite}\textsuperscript{22}, the lending and rental rights\textsuperscript{23}, the reproduction, distribution, communication and the making available rights, redefined to fit the digital age\textsuperscript{24}, the duration of copyright and related rights\textsuperscript{25},

\textsuperscript{16} See for databases, the database directive, and for computer programs, the Directive 2009/24/EC of the European parliament and of the Council of 23 April 2009 on the legal protection of computer programs (codified version, hereafter the ‘software directive’).
\textsuperscript{17} Reference for a preliminary ruling from Court of Appeal (England & Wales) (Civil Division) made on 21 December 2010 - \textit{Football Dataco Limited v. Yahoo UK Limited}, C-604/10. The question here is precisely the extent of harmonisation brought by the directive and the freedom that is left to Member States to keep their own national interpretations and rules, in parallel to that of the directive.
\textsuperscript{18} CJEU, 22 December 2010, \textit{Bezpečnostní softwarová asociace}, C-393/09.
\textsuperscript{19} Reference for a preliminary ruling from High Court of Justice (Chancery Division) (England and Wales) made on 11 August 2010 - \textit{SAS Institute Inc. v World Programming Ltd}, C-406/10.
\textsuperscript{20} Directive 2006/115/EC of the European Parliament and of the Council of 12 December 2006 on rental right and lending right and on certain rights related to copyright in the field of intellectual property (codified version), hereafter ‘the rental and lending directive’.
\textsuperscript{23} See the rental and lending Directive’.
the protection of digital management of rights\textsuperscript{26}... The infosoc directive had also the ambition of harmonising copyright exceptions, but everybody would agree that this attempt has failed\textsuperscript{27} as the directive only provides for an exhaustive list of 23 exceptions into which the Member States are free to choose both to adopt the exception and to decide upon its conditions of application. It results in the impossibility to know for sure that an exploitation of a work (for example the use of works in online teaching) across European borders will benefit from exceptions in the whole territory of the internal market.

Still in copyright, a directive on collective management has been announced, which makes the EU lawmaker step into a new territory, formerly reserved to Member States, and a draft directive on orphan works has just been released\textsuperscript{28}. For that latter, it is difficult to talk about real harmonisation as the directive only provides a mutual recognition of the status of an orphan work granted in one Member States and recommends some guidelines to carry out the diligent search of the rights owners, that is the required as a preliminary step to acknowledge a work as orphan.

Patent has been the parent pauvre of the EU legislative efforts. There is no need to recall the unhappy saga of the community patent, still a wishful thinking after more than 30 years of discussion. Besides, no directive has been adopted to harmonise the general rules of patent in the Member States. The only intervention of the European Union in the patent arena has been to sustain the patentability of biotechnological inventions\textsuperscript{29}, hereby enhancing a thriving new industry in Europe. As a result, patent laws remain largely fragmented in the Member States, even though the rules of the EPO patent might have influenced national laws, all Member States being part of the Munich Convention\textsuperscript{30}.

Last but not least, the European Union has tried to better secure the enforcement of its intellectual property by enacting a horizontal directive dealing with enforcement and remedies in all intellectual property rights\textsuperscript{31}.

\textsuperscript{26} Provided for the Software directive for technical protection of the computer programs and by the Infosoc directive for the rest of copyright, related right and sui generis right.


\textsuperscript{30} The TRIPS Agreement and the Paris Convention on Industrial Property also ensure that key rules in patent are similar in all European Member States.

II. The justification and objectives of intellectual property

The quest for a common ground for IP rights proves to be hazardous… The European legal texts applicable in intellectual property refer to diverse grounds for legislation. A common justification could well be found in the article 17 of the EU Charter of Fundamental Rights that solemnly declares that « Intellectual property shall be protected »\(^{32}\). But can it be inferred from that rather blunt formulation that the protection of intellectual property is an end in itself, hence not needing any further justification? Despite the apparent strength and self-confidence of this declaration, many scholars agree that it should not be construed as providing a free rein to IP protection\(^{33}\). The Charter only follows previous qualification of the right to property, as it includes intellectual property, as a fundamental right\(^{34}\), without settling the ultimate justification of this protection.

Beyond this overall affirmation, a common rationale for intellectual protection, whatever its type, is still lacking in the acquis communautaire and in legislative debates. Each directive or regulation tends to offer a series of objectives and foundations to the protection it provides. Justifications that are usually proffered can be categorised in different types.

A classical economy-based rationale is the role of exclusive rights to provide a necessary incentive to creation or innovation. This appears in the enforcement directive that states in its first recital that “the protection of intellectual property is important (…) for promoting innovation and creativity”. The same recital links the achievement of the internal market to the need to create “an environment conducive to innovation and investment”, that can finds satisfaction in the IP protection. Similar objectives are mentioned in the infosoc directive (“to foster substantial investment in creativity and innovation (…) and lead in turn to growth and increased competitiveness of European industry”\(^{35}\)), in the community design regulation (“enhanced protection for industrial design (…) encourages innovation and development of new products and investment in their production”\(^{36}\)), as well as in the database directive\(^{37}\), as well as in the community plant varieties rights regulation (“to stimulate the breeding and development of new varieties”\(^{38}\)).

Closely related to the incentive reasoning, intellectual property rights are also considered as a desirable protection of investment, hereby offering some return on production costs and remunerating the involved actors. This appears in copyright, patent or design protection and is often coupled with innovation-based motives.

\(^{32}\) Article 17 (2), European Charter of Fundamental Rights, O.J., 18 December 2000, C 364/01.


\(^{34}\) See the Opinion of the Advocate General, 14 April 2011, Scarlet Extended SA v. Sabam, C-70/10, §90.

\(^{35}\) Recital 4, directive 2001/29.

\(^{36}\) Community design regulation, Recital 7.

\(^{37}\) See recitals 9-12 of the database directive.

\(^{38}\) Community plant variety rights regulation, recital 5.
For instance, in copyright, the infosoc directive explains that: “if authors or performers are to continue their creative and artistic work, they have to receive an appropriate reward for the use of their work, as must producers in order to be able to finance this work. The investment required to produce products such as phonograms, films or multimedia products, and services such as "on-demand" services, is considerable. Adequate legal protection of intellectual property rights is necessary in order to guarantee the availability of such a reward and provide the opportunity for satisfactory returns on this investment”.

This rationale is explicit in the protection of subject-matter for related rights that merely consists in economic contribution to creation, such as the rights in phonograms, first fixation of films or broadcasts. “The possibility of securing [the income of performers] and recouping [the investment required for the production of phonograms and films] justifies the legal protection conferred to the rightholders concerned by the directive on rental and lending rights that harmonized the protection of related rights in the European Union. Similar justifications are found in the software directive, the biotechnology directive, the database directive and in the resale right directive that insists on the adequate remuneration of artists.

Return on investment is also proffered as a ground for protection of trademarks, as the ECJ has recently admitted the need to protect other functions of trademark, in particular “those of communication, investment or advertising”. The protection of investment in a brand as a publicity signal is now recognised as an objective of trademark, certainly for famous trademarks, but the recent case law does not explicitly limit this objective to the latter.

The diversification of agriculture and its positive effects on the incomes of farmers equally appears in the objectives of the protection of geographical indications. Likewise, protection of investment often results in the protection of a specific economic sector, the agriculture for geographical indications, the information market for the sui generis right, the nascent biotechnology industry for the biotechnology directive.

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39 Infosoc directive, recital 10. The next recital even mentions “safeguarding the independence and dignity of artistic creators and performers”.
40 Rental and lending directive, recital 5.
41 See the software directive, recital 2.
42 See the biotechnology directive, recitals 2 and 3 (“maintain and encourage investment in the field of biotechnology”).
43 See the database directive, recital 12 (“Whereas such an investment in modern information storage and processing systems will not take place within the Community unless a stable and uniform legal protection regime is introduced for the protection of the rights of the makers of databases”).
44 See recital 3 of the Directive 2001/84/EC of the European Parliament and of the Council of 27 September 2001 on the resale right for the benefit of the author of a original work of art (“The resale right is intended to ensure that authors of graphic and plastic Works of art share in the economic success of their original works of art”).
45 ECJ, 18 June 2009, L’Oreal v. Bellure, C-487/08, §58 in fine (I underline).
46 See the recital 2 of the geographical indication regulation.
47 See recital 7 of the database directive.
48 See Recital 1 of the biotechnology directive (“Whereas biotechnology and genetic engineering are playing an increasingly important role in a broad range of industries and the protection of biotechnological inventions will certainly be of fundamental importance for the Community’s industrial development”).
A last type of justification, still rooted in economic considerations, is to prevent free riding and ensure that competition is not distorted, even though that last motive aligns itself on the very objective of harmonisation directives to achieve an internal market by removing the differences of protection amongst the Member States. Trademark protection clearly comes within that scope, but traces of that rationale can be tracked in the protection of databases and software when copies are said to be possible at a fraction of the cost needed for their development.

Each intellectual property right also knows ancillary and specific objectives linked to its own subject-matter. Protection of geographical indications and appellations of origin purports to ensure some product quality, an objective that has been gradually acknowledged also in trademark. The Court of Justice has indeed recently insisted on the protection of the function of guaranteeing the quality of the goods or services, beyond the protection of the function of origin. Here also, it is not certain that the Court wished to limit this function to trademarks with a reputation.

Literary and artistic creation brings with it some cultural aspects. The cultural importance of copyright protection is underlined in many directives, without playing a central role. For instance, the infosoc directive reminds the “great importance from a cultural standpoint” of copyright and related rights, referring immediately to the former article 151 of the treaty mandating the cultural competence of the Community.

All those justifications might look a bit messy and inconsistent. Surprisingly, EU legislative texts do not mention much the balance that is generally taught to be embedded in intellectual property protection. The directive on enforcement of 2004 is remarkable in that regard as it clearly affirms that: “the protection of intellectual property should allow the inventor or creator to derive a legitimate profit from his/her invention or creation. It should also allow the widest possible dissemination of works, ideas and know-how. At the same time, it should not hamper freedom of expression, the free movement of information, or the protection of personal data, including on the internet”. This statement is echoed in the infosoc directive that opposes freedom of expression and the public interest to the fundamental protection of intellectual property. However in many copyright legal texts, it is said that any harmonisation of copyright must take as a basis a high level of protection, which inclines to tilt the balance in favour of one scale only.

49 See recital 2 of the community trademark regulation and the recital 2 of the trademark directive.
50 See the identical formulation in the recital 2 of the Software directive and the recital 7 of the database directive.
51 See the recital 3 of the geographical indication regulation (“a constantly increasing number of consumers attach greater importance on the quality of foodstuffs in their diet rather that to quantity. This quest for specific products generates a demand for agricultural products or foodstuffs with an identifiable geographical origin”).
52 ECJ, 18 June 2009 L’Oreal v. Bellure, C-487/08.
53 Recital 12 of the infosoc directive.
54 see also the recital 3 of the rental and lending directive insisting on the cultural development of the Community.
55 See the recital 9 of the infosoc directive, and particularly the recital 11 of the term directive (“The level of protection of copyright and related rights should be high, since those rights are fundamental to intellectual
The reluctance of the European lawmaker to specifically address the overall objective of intellectual property, beyond classical incentives-based arguments, is puzzling. Recitals about the effect of a high protection on the European competitiveness sound like a well-learnt script. Reforming the intellectual property system and trying to make it more comprehensive and convergent would at least require providing the same roots on all protection of intellectual property under an overall objective of enhancement of creation, innovation and competition.

III. Object of protection

Addressing the object of intellectual property requires to analyse first the type of immaterial content that is liable for protection, i.e. the subject-matter (A.), the fundamental exclusion of ideas from intellectual property (B.), the requirements for protection (C.) and finally, the cases of exclusions and their motives (D.).

A. Subject matter of intellectual property

Each intellectual property right protects a differently defined subject matter: literary and artistic work for copyright, invention for patent right, sign for trademark, the appearance of a product for design right, a database for the sui generis right, the creation of a plant variety for plant variety right, or names of regions or specific places for geographical indications and designations of origin.

The divergence of subject matter seemingly displays the heterogeneous nature of intellectual property and jeopardizes any project trying to put some order in the different branches thereof. Some would say that it is impossible to conceive similar principles and rules to protect so dissimilar objects of protection.

Actually, one can distinguish three categories of subject matter. The first one encompasses all types of “creation”, whether a work in copyright, an invention in patent, the appearance of a product in design or a plant variety in the plant variety right. All those rights protect some activity of innovation or creation, but separate them from each other depending on the field or means of creation. Copyright protects artistic and literary creation, not limited to the arts, but rather conveying expression in a visual, sound or language medium. The related rights of performers are enjoyed in performances, which are another form of creation. Patent protects creation in the technical field expressed in technical means. The plant variety right vests upon botanical variations of plants. As to industrial designs, they are hybrids between artistic and technical creations. Both the directive and the regulation define the ‘design’ as “the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation”. Design cannot be exclusively technical as the right does not subsist in 

creation. Their protection ensures the maintenance and development of creativity in the interest of authors, cultural industries, consumers and society as a whole”).
features of appearance of a product, which are solely dictated by their technical function (see infra). With that limit in mind, a vast range of designs can be protected, from mere artistic shapes with no specific function to appearances of technical components of a product.

A second category includes “signs or denominations”, either protected by trademark or by the right in geographical indications. The notion of “sign” is very broad, for it gathers all forms of expressions conveying some meaning, from words, numbers, sentences, to images, shapes, sounds or colours. A sign is to be set apart from the notion of creation. Trademark does not need the sign to be created specifically to distinguish a product or service in order to enter into function. Existing words, images, colours or sounds can perfectly apply for trademark protection. Instead of a creation, the very focus of the protection in trademark, and incidentally in the protection of geographical indications, is the use of a sign, existing or not, in relationship to products or services.

Aside those two categories of subject matter eligible for IP protection, some productions are protected as mere “investments”. This is the case of non-original databases when protected by the sui generis right or of related rights protecting first fixations of films or phonograms and broadcasts.

Classifying the subject matter of intellectual property in these three key categories (creation – sign – investment) could form three main branches with rules adapted to the type of object to be protected, whether a creation, a sign or an investment. Reasonably, the objectives of regulating creations, whatever their field, would obey to similar considerations and differ from those governing signs or investments. For instance, the economic reasoning about incentives only play a role for creation, and partially for investments, but not for signs whose use does not need to be incentivised. Investments might not even need to be incentivised but need a protection against free-riding. Balancing protection with public interest would also be differently shaped as the effect of protecting a creation or a sign is necessarily different. Another key difference between creation and sign is that the first one should be protected against copying by an absolute protection whereas for signs, it is their use in relationship with products or services that matters, which leads to a relative protection only.

The three big branches of the tree might then be separated again to set up different principles of protection depending, for instance, of the artistic or technical nature of the creation.

B. The exclusion of ideas

Whatever the subject matter of protection, an underlying principle is shared by all intellectual property rights: ideas should remain free. As a rule, no intellectual property applies to abstract ideas or principles, but it appears more clearly in some rights than in others.

It is a key and explicit rule in copyright that is strongly affirmed in many legal texts under the form of the idea/expression dichotomy. It is surprising that almost no community legislative
act—but the software copyright directive\textsuperscript{56}, expressly repeats that foundational principle. Arguably that can be explained by the fact that no directive addresses the subject matter of copyright in a comprehensive way. On the other hand, the idea/expression dichotomy is more visible in international texts, such as the WIPO Copyright Treaty, in its article 2, or the TRIPS Agreement, in its article 9(2).

This paradigmatic criteria for copyright protection is however unsteady in the acquis communautaire. Despite the upfront affirmation in the software directive that ideas and functional elements are not protected, the protection of computer programs hide very badly the difficulty of keeping ideas free from the effect of copyright protection in the expression of the program, as demonstrated by the intricate provision of decompilation, required to uncover mere ideas behind the protection of unavailable source code. The Court of Justice of the European Union is likely to probe soon the fundamental scope of copyright protection for computer software and its application of the idea/expression dilemma when answering questions referred to a UK judge about the infringing nature of the replication of functional aspects of the program that did not require any copying of its source code\textsuperscript{57}. This case will certainly test the boundaries of the exclusion of ideas from intellectual property, and particularly for copyright, and decide what place it assumes in the acquis communautaire.

The exclusion of ideas is a well-known mantra in copyright but it is also valid in other intellectual property rights, yet more implicitly. Patent, for instance does not protect abstraction, but only technical features, as implied by the list of exclusions of the article 52(2) of the European Patent Convention, most of which are explained by their abstract dimension (e.g. discoveries, scientific theories and mathematical methods, schemes, rules and methods for performing mental acts, or presentations of information). An idea, understood as any abstract concept with no concrete application or materialisation in a technical solution or process, is not eligible for patentability.

By its very nature and definition, a design has a material character, concretised by the lines, shapes, texture or materials of a product that form the very object of the protection. The exclusion of idea or abstract feature is here self-evident.

Even in trademark protection, an abstraction or concept is not liable for protection, as clearly reminded by the European Court of Justice in the Dyson case\textsuperscript{58}, which is rarely presented under that aspect. In that decision, the judges have excluded the protection of a transparent bin forming part of the external surface of a vacuum cleaner. The court held that a trademark constituted by all the conceivable shapes of a product, in a general and abstract manner, is not a sign in the meaning of trademark law\textsuperscript{59}. Without clearly considering that such subject-matter would actually be an idea or a concept by nature excluded from IP protection, this decision

\textsuperscript{56} Article 1(2) of the software directive: “Ideas and principles which underlie any element of a computer program, including those which underlie its interfaces, are not protected by copyright under this directive”.

\textsuperscript{57} Reference for a preliminary ruling from High Court of Justice (Chancery Division) (England and Wales) made on 11 August 2010, SAS Institute Inc. v World Programming Ltd, C-406/10.

\textsuperscript{58} ECJ, 25 janvier 2007, Dyson, C-321/03.

\textsuperscript{59} ibidem, §35.
can be construed as admitting the protection of trademark only for specific and determined signs and not to abstract matter.

Pruning the IP tree will require to strongly affirm the principle of exclusion of ideas in all fields of intellectual property and to inscribe it in the *acquis communautaire*. Instead of leaving more or less implicit traces of this fundamental paradigm, a clear statement should ascertain the necessarily freedom of using ideas, principles or methods. That would provide some solidity to resist to attempts of commodification over those building blocks of innovation, creation and industrial or commercial development, as it was witnessed in the computer program area.

C. Requirements for protection

Requirements for protection logically depend on the type of intellectual property right concerned: originality for copyright, a set of three conditions for patent (novelty, inventiveness and industrial application), mainly distinctiveness for trademarks, novelty and individual character for design.

One can however find some common features in those apparently diverging conditions. Indeed, they can be arranged in a continuum comprising four levels: creation – novelty – adequacy – investment. *Creation* includes all conditions that require, in one way or another, some level of intellectual intervention, beyond mere financial or technical contribution. Conversely, *novelty* is strictly objective and means that something that did not exist before has now been produced. What I refer by *adequacy*, by lack of a better term, is the capability to satisfy the objectives of the intellectual property protection, in other words, the fact that the subject matter requesting protection is fit for its purpose. As we will see, trademark, and to some extent, patent law, impose conditions for protection related to the very objective of the right granted. *Investment* is the lower requirement as it only implies a financial contribution in producing the intellectual object.

Copyright is clearly related to the creation criteria. A work has to be original to be eligible for protection. The requirement of originality is only partially harmonised by EU law, for software, photographs and databases, are defined as “the author’s own intellectual creation”. This community definition of originality has been recently extended by the European Court to all copyrighted works\(^\text{60}\). Considering originality as a community notion that needs to receive an uniform interpretation will force to choose which conception of originality will prevail amongst the many comprehensions of that notion in the Member Stats. One often opposes the subjective approach of the civil law countries, focusing more on the imprint of the creator to the objective approach of the UK and Ireland that rather insist on skill and labour\(^\text{61}\). Whatever


the conception, originality belongs to the “creation” requirement in the sense that copyright protection is triggered when there is an intellectual creation emanating of the author.

Design lies between creation-based and novelty-based systems. A first condition is that the design must be new, which is satisfied if no identical design has been made available to the public before the registration. A second condition is that the design must have an individual character, defined as the fact that the overall impression the design produces on the informed user differs from the impression produced by the existing designs. It departs from novelty as the test is not purely objective but integrates some creative involvement of the designer, perceptible by the user, thereby entering into the realm of creation-based requirements.

Plant varieties have to be distinct, uniform, stable and new, which puts them in the category of novelty, the other conditions not revealing any test of creation.

Trademarks do not have to show creation or novelty to get protected. The key requirement of distinctiveness more particularly refers to the fact that signs should be able to perform their function of origin of the product or service. In Community law, the distinctiveness of a trademark has been defined as the “the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings”\(^62\). In other words, trademark must be fit for the purpose of distinguishing goods or services: signs that would be perceived by the consumers as identifying or descriptive qualities of the product or as mere ornamentation of the product or of its packaging are not apt to serve as a trademark.

The requirement of distinctiveness can thus be qualified as a test of adequacy: only signs that can accomplish the very function of the trademark, i.e. distinguishing products or services, are eligible to the protection. Trademark law excludes descriptive, generic or customary signs, which by themselves are inappropriate to operate as trademarks, as the public will not perceive them as indications of origin of the product or service.

There is however a small touch of novelty in trademark conditions for protection in the fact that the sign should not be already registered in an identical or similar form for identical or similar products or services\(^63\). This intervention of novelty is rather limited as it is not absolute but relative in two respects. Firstly, only the owner of a former trademark or other protected sign is entitled to complain about the registration of a sign similar to his own. Second, the protection of sign being limited to similar products or services, by the speciality principle, the trademark does not have to be absolutely new, as in patent law, but should only not have been registered already in the same field of commercial production.

Patent is a very peculiar case, as inventions have to comply with requirements that mix creation, novelty and adequacy. The key criterion is certainly novelty: the invention should be new and not exist already. But there is also some creative aspect in the condition of inventive step: the invention should not obvious to a person skilled in the art, having regard to the state

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63 even for different products in the case of protection of famous trademarks.
of the art, it should not be an obvious step in technical progress, thereby requiring some innovation from the inventor.

And finally, the condition of industrial application relates to the usefulness of the invention, its capacity to serve industry, and can be attached to the notion of adequacy, mentioned above\(^{64}\). Only inventions that can serve to “something” and lead to production of goods or services are fit for protection.

A last type of requirement in intellectual property is investment. It applies to databases that can pretend to the protection of the *sui generis* right if it has necessitated a substantive investment. No creation, novelty of adequacy here, but merely some degree of financial contribution.

Surprisingly, related rights do not obey to any requirements for protection. The rights of performers is granted as soon as there is a performance that has artistic dimension. Arguably, the condition of performance is not even a test for protection but its very subject matter. Deciding that the artistic performance is a condition might to some extent include the right of performers in the “creation” category, as something has to be created by the performer. It is more disturbing that producers of phonograms or films do not have to demonstrate a significant level of investment to enjoy related rights. This is one of the only cases where an intellectual property right is granted with no formalities or specific conditions to fulfil. This explains that their specific rights cannot rejoice the *sui generis* right on databases in the investment category of conditions for protection.

This lack of any qualitative or quantitative threshold, compared to the many requirements applicable to the other forms of intellectual property raises a legitimate concern of overprotection. There is no reasonable ground explaining this lack of any condition for protection, except maybe the presumption that any phonogram or film production requires a high amount of investment. At least some level of investment could be required.

Despite the relative differences in the conditions for protection, all intellectual property rights know a twofold principle of non-discrimination. On one hand, there is no minimal threshold of protection in many IP rights; on the second hand, the protection is applied independently of the type of creation or sign.

On the first element, intellectual property rights generally grant protection to eligible subject matter, even though the satisfaction of the conditions to be met is minimal. For instance, trademark can have a weak distinctive character (but it will have consequences on the degree of their protection to some extent). The originality required for copyright protection does not function quantitatively or qualitatively, and the author’s own intellectual creation, albeit the absence of any precision to that regard in the *Infopaq* case, is generally construed very broadly by national case law. Likewise, the test of non-obviousness in patent seems easily passed, even for mundane inventions.

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\(^{64}\) The condition of industrial application also reflects the technical feature of an invention, thereby excluding abstract matter.
A second factor of non-discrimination lies in the generosity of intellectual property rights that welcome all types of creations or signs. Copyright is not limited to works in the artistic field, but protects, as required by the Berne Convention for that matter, scientific, informational, functional creations. The article 27 of the TRIPS Agreement imposes the patentability of “all fields of technology”, an expression that has been embarked in the article 52(1) of the EPC, in its revised version of 29 November 2000. As to trademark, all imaginable signs have knocked on the door of registration and have been broadly welcomed in, to the extent of the satisfaction of the requirement of graphical representation.

Combined, both refusals to discriminate subject matter in intellectual property result in a very broad protection in the key fields of intellectual property. Copyright, trademark, design and patent rights have gained a catch-all character, which raises concerns of overprotection and in practice, enables overlapping rights in a same subject matter. Categories of IP subject matter might appear as being properly delineated and separated (artistic creations for copyright, technical ones for patent, signs for trademark, appearance of a product for design), the actual munificence of intellectual property tends to multiply the situations where several rights apply to the same object, even though they might protect different aspects thereof. The shape of technical components might be protected by national copyright or design, as the artistic purpose of the creation is not required and the level of originality is very low. Software is now protected by copyright and by patent, despite the formal exclusion contained in the article 52 (2) c) of the EPC. This is probably one of the densest parts of the IP tree that can give an impression of an anarchic and overgrown foliage.

**D. Exclusions from protection**

Exclusions from protection are largely linked to each intellectual property with no overall approach. Two major causes for exclusion can however be systematized.

The first one is justified by public order or ethics considerations and can be found in almost all intellectual property rights. Contradiction with public policy excludes signs from trademark protection. Article 3(1) f) of the trademark directive and article 7(1) f) of the community trademark regulation reject the registration of trademarks which are contrary to public policy or to accepted principles of morality. Two other absolute grounds for refusal or invalidity are related to public policy, i.e. the exclusion of deceptive signs and of trade marks concerned by the Article 6ter of the Paris Convention (official signs, flags, State emblems, of countries or international intergovernmental organizations).

Contradiction with public policy or morality provides a similar ground for exclusion in design.

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65 See for colours (admitted), ECJ, 6 May 2003, Libertel, C-104/01; for sounds (admitted in principle but with a subsisting difficulty of graphical representation), ECJ, 27 November 2003, Shield Mark, C-283/01; for smells (rejected so far), ECJ, 12 December 2002, Ralf Sieckmann, C-273/00.


67 EPO Enlarged Board of Appeal, 19 February 2010, G-2/08.
right, also by the effect of the harmonising directive and by the regulation creating a community protection.

Public order is more articulated in patent protection. The European Patent Convention provides that inventions the commercial exploitation of which would be contrary to "ordre public" or morality will not be patented. The EPO case law has built some interpretation of this notion by specifying that the bar to patentability grounded on public order mainly depends on a careful weighing up of the negative effects of the invention and of its beneficial outcome for humankind. More recently, in a patent application involving embryonic human stem cells, the EPO Enlarged Board of Appeals has pointed out that “it is not the fact of the patenting itself that is considered to be against ordre public or morality, but it is the performing of the invention, which includes a step (the use involving its destruction of a human embryo) that has to be considered to contravene those concepts.”

Grounds for excluding inventions from patent protection based on public order or ethics have also materialised in a list of unpatentable inventions in the directive on biotechnological inventions, encompassing processes for cloning human beings, processes for modifying the genetic identity of human beings, the use of human embryos for industrial or commercial purposes and the modification of the genetic identity of animas without any substantial medical benefit. Equally related to ethical debates about life patenting, the biotechnology directive excludes the patenting of the human body and the simple discovery of one of its elements, plant and animal varieties, and essentially biological processes for the production of plants or animals. But those exclusions can equally be justified by the lack of a technical invention in such subject-matter, that could be described as mere discoveries, and the exclusion for plant does not prevent the grant of a plant variety right. More generally, the exclusion of therapeutic methods can be explained by a strong public policy motive.

Only copyright avoids exclusion based on public policy. Having said that, most Member States exclude official documents from protection, which can also be explained by public policy and the objective to keep legal norms available to citizens. But this exclusion is not included in the acquis communautaire.

A second ground for exclusions is the need to keep some resources available for competitors. This explains many exclusions from trademark protection, such as descriptive signs (trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services), usual signs (signs or indications which have become customary in the current language or in the bona fide and established practices of the trade), and for three-dimensional signs, the exclusion of the shape which results from the nature of the goods themselves and the shape of goods which is necessary to obtain a technical result. A similar competitive

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70 Article 6 (1) of the biotechnology directive. See also, for the European patent, the similar list in Rule 28 of the Implementing Regulations to the Convention on the Grant of European Patents.
consideration lies in the exclusion from protection by design rights of designs dictated by
their technical function and of designs of interconnections.

This is an essential ground for exclusion that responds to the competition dimension of
intellectual property, sometimes evoked in the rationale or context of the legislative action of
the European Union.

Excluding some subject matter is an important policy option, useful to organise competition
or to choose not to protect some matter, for ethical, public order or economic reasons.
Paradoxically, the determination of excluded subject-matter mainly appears as being bound to
each IP right with no real overall perspective. This separated approach is understandable, as
exclusions should also be devised according to the specific subject matter of each protection.
However, it has some side effects, as the categories of subject matter for each intellectual
property right are not perfectly closed or coherent, and some creations or signs are
increasingly protected by overlapping rights. As a consequence, excluded matter can enjoy
protection by other types of right than the one that excludes it. It is not always problematic,
since the ground for exclusion might be the need to properly delineate each intellectual
property field, as it is the case with esthetical presentations, excluded from patent protection,
but protected under copyright. Another example is the exclusion by trademark law of shapes
that give a substantial value to the product, which can be partially explained by the more
adequate protection of such shapes by design right.

The two grounds for exclusion that we have underlined are particularly relevant. They could
be better systematized and cross, when necessary, all IP rights, while taking the specificity of
each right and its subject-matter into account.

E. Formal requirements

With the noteworthy exception of the literary and artistic property, intellectual property rights
are subject to formality requirements. Patent, trademark, design right (even though a reduced
protection exists for unregistered design), plant variety right, geographical indication and
appellation of origin are all governed by a rule of registration-based acquisition of right and
transfer.

Formalities, it is well known, are prohibited by the Berne Convention as a precondition to the
existence and exercise of copyright. The advent of digital environment, that abounds with
creations difficult to retrace to their copyright owners, has revitalized that question\(^7\). Formal
requirements in copyright are not a taboo anymore and parallels are drawn with trademark
and patent law registration systems. If one could liberate copyright from the restraining
anchor of the Berne Convention in one way or another, a common ground could well be
found across the different intellectual property rights to align the regimes of formalities, while
preserving particular interests of copyright, such as the moral right. At least nothing prevents,

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\(^7\) S. VAN GOMPEL, Formalities in Copyright Law – An Analysis of Their History, Rationales and Possible Future, PhD defended at the University of Amsterdam, March 2011, p. 2-8.
under the current international copyright law, that formalities be imposed to make transfer of
devoted to the protection of technological measures and rights management
information against circumvention and removal, despite some proposals to that effect. The
case of the performer set aside, nothing explains that formalities cannot be required from the
industrial and economic entrepreneurs who are the producers of phonograms and films, the
broadcasters, the producers of databases or the providers of works in a DRM-protected
format. Registration of their production or of the application of the technology they deploy in
their business models would in our view be necessary and justified.

IV. Scope of protection / Rights conferred

At first blush, the rights conferred by each intellectual property right appear rather different.
In copyright, moral rights set aside, rights to control reproduction, public communication and
distribution are granted to the right owner.

Patent rights protect against any making and any use of the invention, but for private purpose,
whereas trademark defines its scope of protection as the use of the protected sign in the course
of trade, which includes, but not exhaustively, affixing the sign to the goods or to the
packaging thereof; offering the goods, putting them on the market or stocking them for these
purposes under that sign, offering supplying services thereunder; importing or exporting the
goods under that sign; or using the sign on business papers and in advertising.

The design regulations also refer to a protection against unauthorised use of the design, which
is further defined as “the making, offering, putting on the market, importing, exporting or
using of a product in which the design is incorporated or to which it is applied, or stocking
such a product for those purposes”.

The realm of the rights conferred to each type of IP rights appears rather specific, both in
technical and legal terms. Indeed, what could be similar between the copy of a work, the use
of an invention itself and the use of a trademark in relation to a product? Actually, those
notions are not so distinct as they seem to be. They all fit under a broader notion of
exploitation: whatever the type of intellectual property, the exclusive rights delineate the

72 S. DUSOLLIER, “(Re)introducing Formalities in Copyright as a Strategy for the Public Domain”, in L.
GUIBAULT & C. ANGELOPOULOS (eds.), Open Content Licences from Theory to Practice, Amsterdam University
Press, 2011, p.75.
73 S. DUSOLLIER, “(Re)introducing Formalities…”, op. cit., p.92-94.
74 Registration of DRM could also provide some solution to users wishing to benefit from exceptions, to help the
interoperability and to resist the obsolescence of the lock-ups affixed to digital content.
75 Other exclusive rights in copyright are the rights to control rental, lending, resale for artistic works, and
adaptation.
76 CJEU, 23 March 2010, Google, C-236/08, C-237/08, C-238/08.
77 See the article 9(2) of the Community trademark regulation and the article 5(3) of the trademark directive.
78 Article 9(1) of the Community design directive, as well as the article 12 of the design directive.
power of the owner to take an effective benefit of its property. The scope of her rights cover the uses of the protected subject-matter that presumably tend to achieve the purpose of its protection, which explains that, technically speaking, the definition of the rights slightly differs and are declined according to the type of subject matter.

Exploiting a literary or artistic work means to achieve its circulation in the public, which can be done directly and with no mediation (hypotheses covered by the communication right) or indirectly through a copy (hypotheses of the reproduction right, but also of the distribution, lending and rental rights).

A patent rights entitles its owner to control any making or use of the invention, beyond the private use, which is equivalent to say that the invention is exploited, for the technical solution is put into operation in such use or making. The patent holder’s interest is to capture the benefits of her invention when it is applied in a product, technology or process.

As to trademark, its function and benefit is to serve to distinguish products or services from one undertaking to another. Exploiting a trademark hence covers any use of the mark to designate a product or service, whether in direct relation to a product or service, or in marketing or publicity.

Insisting on this common feature of all intellectual property rights would reinforce the consistency of the intellectual property framework. One could go as far as acknowledging that one single right, called the right of exploitation, could be adopted to encompass all the rights granted to IP owners, whatever the subject matter concerned. The unique umbrella of a right of exploitation would not only be a matter of systematisation and convergence, but it should also, and perhaps more fundamentally, serve as a useful concept to refocus all technical or incidental acts of use that have gradually entered into the scope of the rights, thanks to this unlimited list of rights contained in each intellectual property regime. Let me give two examples.

The copyright case law of the last two years shows some uncertainty, perhaps even a disorienting confusion, when dealing with new technological developments that challenge technically-defined exclusive rights. It has happened with the communication to the public and to the reproduction right. As to the communication to the public, the European Court had put forward a sound criterion in the Rafael Hoteles case: the new public.

Aligning the scope of the communication right to the transmission to a new public arguably follows the notion of exploitation, as works are exploited when they are reaching different publics, that can hence enjoy, view or listen to the content so received. It can also serve to determine, amongst many technical acts that participate to the transmission of a work to its

79 A. CHRISTIE, op. cit.
80 ECJ, 7 December 2006, SGAE v. Rafael Hoteles, C-306/05, § 40.
final public, which ones should be covered by the exclusive right\textsuperscript{81}. Yet, a recent decision has sown confusion by adding a supplementary element to the communication right, that of the possible access by the public to the essential element of the work\textsuperscript{82}. The facts of the case related to the television broadcasting of the graphic user interface of a computer program, which the Court did not consider as an act of communication covered by copyright as the interaction with the user, deemed to be an essential element of such interface, was impossible. Beyond the puzzled reaction that many scholars had when discovering this unattended condition for the communication right and its blatant contradiction with the refusal of the Court to qualify the user interface as a computer program (which conversely could have explained the requirement of an interaction), the only way to understand and accept this element might be to attach the ruling to the notion of exploitation. Should not the communication to the public be restricted to cases where the work is indeed achieving its purpose of being transmitted to the public, and effectively received by the public? The difficulty comes from the fact that the graphic user interface should indeed ensure some interactivity with the user to be properly received, but that the European judges could not consider it as a software. As a consequence, the decision seems to imply that the requirement of interaction applies to all works protected by copyright, whereas what is at stake is rather the communication of the essential elements of the work, in other words that the work is really exploited when communicated, meaning that it is capable of reaching its new public.

I doubt however that this was the implicit intention of the European Court, since, in other decisions dealing with reproduction right, and more particularly the temporary right of reproduction, its approach was rather attached to technical definitions of the act, than on a purpose-bound notion of exploitation. Indeed, in the \textit{Infopaq} case, the European judges did not enter into a discussion of the ultimate purpose of the copies that occurred, but only touched upon their genuine transient nature, by requiring that “the process must be automated so that it deletes that act automatically, without human intervention, once its function of enabling the completion of such a process has come to an end”\textsuperscript{83}.

As a reminder, the Directive 2001/29 includes in principle the temporary copying within the scope of the reproduction right but exempts acts that are only transient or incidental, are an integral and essential part of the technological process of a network transmission or of a lawful use and have no independent economic significance\textsuperscript{84}. Many have denounced the lack of clarity of that demarcation line between unauthorised and authorised copying\textsuperscript{85}. It would be clearer to embrace acts of transitory copying only when they can be qualified as exploitation of the work, meaning that a further circulation of the work can occur from the temporary copy itself. This would rejoice the purpose of the reproduction right that is to grant a control over

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\textsuperscript{81} See an application to technical acts required by broadcasting, the Opinion of the Advocate General, 17 March 2011, \textit{Airfield c. Sabam}, C-431/09 & C-432/09.

\textsuperscript{82} CJEU, 22 December 2010, \textit{Bezpečnostní softwarová asociace}, C-393/09, §57.

\textsuperscript{83} ECJ, 16 July 2009, \textit{Infopaq}, C-5/08, §64.

\textsuperscript{84} ibidem.

the public circulation of the work, not over its mere use. The copy should not in itself enter into the realm of the exclusive rights, but only when it is the means of a further exploitation of the work. Transposed to the temporary copy, the fact that they are technically copies (which is the view of the infosoc directive) does not suffice to make them relevant for copyright: it is also needed that they can trigger a new act of communication. The Advocate General Kokott, in her opinion on the Football Premier League case, seems to follow that reasoning when she considers that the exemption of temporary copying allowed in the article 5(1) of the infosoc directive is precisely “to permit acts of reproduction which are the condition for actual exploitation”\textsuperscript{86}. But her conclusion, according to which a temporary reproduction on the television screen is not exempted under the article 5(1) of the infosoc directive, ruins that hope. Her mistake is to consider that “however, the economic significance of a broadcast is, as a rule, based on its reception”. Reception of a work as a principle eludes the realm of copyright, but providing the possibility for the public to receive and get access to a work does not, as it is the key matter for exploitation. In our view, the notion of “independent economic significance” that has appeared in the \textit{acquis communautaire} to separate controlled temporary copies from exempted ones, can only be understood as “being able to trigger a new exploitation”.

This single notion of exploitation could further simplify the definition of exclusive rights in copyright by not artificially separating the many technical acts of reproduction or communication that follow one another in one exploitation, and require all, under the current state of copyright, a distinct authorisation, and generally an additional remuneration.

A second example of a possible reorientation of intellectual property around the notion of exploitation is the recent evolution of the European case law in trademark that attaches the counterfeiting of the trademark to the verification that the use of the protected sign has infringed one of the functions of the trademark\textsuperscript{87}. By establishing a link between the scope of protection and the very objective of the trademark grant, it indirectly installs the notion of exploitation on the throne of the protection. Indeed, the control of the trademark owner will only be limited to cases where her trademark has been exploited without any authorisation, and not merely used. The difference between exploitation and use in trademark would be that for a trademark to be exploited, the capacity of the trademark to accomplish one of its functions in the use made by a third party would be affected. As in copyright, the notion of exploitation would adapt to the intellectual property right in question and would follow the function of the circulation of the protected subject-matter that the intellectual property protection aims to control. It would be circulation to the public for copyright, and public use of the sign to distinguish products or services for trademark.

\textsuperscript{86} Opinion of the Advocate General, 3 February 2011, \textit{Football Association Premier League Ltd and Others v. QC Leisure and Others}, C-403/08 and C-429/08, §92.

\textsuperscript{87} See, in chronological order, ECJ, 12 November 2002, \textit{Arsenal v. Reed}, C-206/01; ECJ, 25 January 2007, \textit{Adam Opel}, C-48/05; ECJ, 18 June 2009, \textit{L’Oréal Bellure}, C-487/07; CJEU, 23 March 2010, \textit{Google}, C-236/08, C-237/08, C-238/08; CJEU, 8 July 2010, \textit{Portakabin}, C-558/08; and the comment of this evolution in M. SENFTLEBEN, ---, published in this volume.
True, the evolution of the European Court of Justice around the requirement of some harm to one of the functions of the trademark is somewhat bothering, particularly in double identity cases of infringements (i.e. use of a sign similar to the registered trademark for similar products) where no likelihood of confusion is required. Other puzzling consequences of such case law is the extension of the protection of the image of a brand beyond the trademark with a reputation and the difficulty to allow for referential exceptions when some infringement to the functions of a trademark has been proven. However, imposing a single right of exploitation in trademark would not give an autonomous role of the functions of the trademark, and certainly not to the vague functions of investment or publicity. On the contrary it could help drawn a clear line between prohibited use of a protected trademark and referential use that should still be allowed for they are not acts of exploitation of the sign.

The same argument is equally valid for patent: the scope thereof should be limited to acts of use and making that corresponds to a notion of exploitation tailored to technical inventions. Their purpose being the application of technical solutions and process, any use that puts the protected invention into operation is an act of exploitation of the patent that should be exclusively reserved to its owner. One could find traces of this exploitation-based reasoning in one of the rare CJEU decisions in patent law. In the Monsanto case, the CJEU has refused the protection of the patent to “a patented DNA sequence which is not able to perform its function”. Even though the question referred to the court dealt with the object of the protection, not to its scope or to the rights conferred to the patented invention, both are interrelated. One way to interpret this decision is to consider that the patent protection cannot cover inventions when they are not operating as technical mechanisms. In the case of the soy flour fabricated from patented soy, the import thereof was only related to a dead matter, an invention incapable at the moment of the import, to exert its technical function. It follows that the patent owner being only entitled to stop uses of its invention in operation, her control amounts to the exploitation of the invention. The notion of use and making in patent law should be understood in that sense.

I have deliberately left aside the issue of moral right. Specific to copyright protection and performers rights, such a right adds a subjective touch to protection of economic exploitation and cannot be reduced to the notion of exploitation I have just defined.

V. Limitations and exceptions

A. Exceptions to the exclusive rights

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88 For a critique of the CJEU recent case law in that regard, see Max Planck Study, op. cit., p. 103 et seq.
89 A circular reasoning then applies: there is an infringement if the indication of origin is troubled or the image of the brand is prejudiced, and a limitation is only valid if the use was fairly made, which is almost impossible to admit if some prejudice to the trademark has already been proven. See the Portakabin case for a fine example of the dead-end situation when limitations of trademark are invoked.
90 CJEU, 6 July 2010, Monsanto, C-428/08, §49.
91 It also appears in patent law where the paternity of the inventor is guaranteed by the mention of his/her name in the application.
Limitations and exceptions to the protection are amongst the thickest and most entangled branches of the IP tree. It is even difficult to sketch a common picture here.

Copyright knows a long list of exceptions ranging from private copy, exceptions for education and libraries, for disabled people, for social institutions, to news reporting, quotation, parody, use during religious or official celebrations, for the purpose of advertising an exhibition, and so on. Copyright in software and databases have their own list of exceptions, tailored to the technical subject-mater at stake.

Patent is generally limited by private use and use for research, as well as by compulsory licensing that could be granted to manufacturers of the invention in the case of dependent inventions, unexploited inventions, or to cater to the needs of countries with public health problems in the case of pharmaceutical products. The only community legislation in patent, the biotechnology directive, applies the first case of compulsory licensing, by authorising a breeder that cannot exploit a plant variety right without infringing a prior patent, or reciprocally the holder of a patent who cannot exploit a biotechnological invention without infringing a prior plant variety right, to apply for a compulsory license. It also introduces a specific exception that replicates the well-known farmers’ privilege in the plant variety rights legislation, allowing the farmers to use the patented seeds, their harvest or breeding stock for their own farm.

Actually, it is too rapid to say that the biotechnology directive is the sole EU intervention in patent. The European parliament and Council have enacted in 2006 a Regulation organising a system of compulsory licensing of patents permitting the manufacture of pharmaceutical products for export to countries suffering with public health issues, which is a rare case of a EU piece of legislation that only deals with a limitation to intellectual property.

Limitations to trademark protection are mainly referential uses (including the use by a third party of his own name and address, of indications about characteristics of the product or service or to indicate the intended purpose of a product or service), when the rationale of the exception is not more difficult to assess (think only to the use of works during celebrations!).

Design exceptions borrow from copyright and patent and includes private use, experimental use, citations or illustrations for teaching, as well as a right of prior use.

Stand-alone justification can equally explain some limitation such as health consideration in patent or necessary use in copyright (namely justifying the temporary copy, back up copy, ephemeral recordings by broadcasting organisations, incidental inclusion of a work or the normal use in software and database protections and many others), when the rationale of the exception is not more difficult to assess (think only to the use of works during celebrations!).

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92 See article 12 of the biotechnology directive.
93 See article 11 of the biotechnology directive.
95 See article 7 of the trademark directive and article 12 of the Community trademark Regulation.
96 See articles 20 and 22 of the Community design regulation, as well as the more limited exception allowed by the article 13 of the design directive.
The overall impression of the exceptions twigs of the intellectual property tree is that of disorder. Diverse limitations appear to be justified when exclusive rights and subject matter are diverse, but once again, when intellectual property admits many situations of overlapping rights in the same object, a better harmonisation of exceptions across the different rights, might be needed. Efforts to systematize those diverse limitations could draw upon different grounds for allowing exceptions and be organised around key boxes where existing exceptions could be arranged. They would create a sort of Charter of User’s Rights\textsuperscript{97}, benefiting to users, independently of the type of intellectual property right.

Private use could be a first category of limitation, as it is generally acknowledged as a natural boundary of the exclusivity in copyright, patent, trademark and design laws. Maybe it should not even be considered as an exception but as the logical reverse of the notion of exploitation delimitating the rights conferred.

Close to private use, a second category of exceptions would encompass all necessary or incidental uses. It would absorb the normal use of software and database, the temporary reproduction in copyright (that could also disappear thanks to a reorientation of the rights around the notion of exploitation), the incidental use in copyright, the use during repair, and maybe referential uses in trademark.

Then, exceptions pursuing an objective of competition or promoting innovation could form a third block that would already include many existing exceptions (such as the decompilation of software, the compulsory licenses for dependent inventions or unexploited ones, the farmers’ privileges, the rights of prior use in design and patent laws). The referential uses of protection trademark could also belong here, as they are justified under the free movement of goods or freedom of services.

This category could be expanded to introduce new or redefined exceptions in some intellectual property regimes. A good example is the exception pertaining to research that exists in many intellectual property rights but not to the same extent. Design law admits the acts done for experimental purposes, copyright mentions an exception for illustrations of research (aligning blindly this motive with the illustration for teaching, without a more tailored application), and authorises the reproduction of software when conducted to study the program. But an harmonised research exception is still lacking in European patent law, apart from the possibility to get access to deposited biological samples for experimental purposes as laid down by the biotechnology directive\textsuperscript{98}.\textsuperscript{97}

Transformative uses could enter into intellectual property in a more direct way by taking over exceptions based on the right to express oneself or freedom of the press. It would encompass the quotation, parody and news reporting exceptions in copyright but is oddly absent in the other IP rights. This absence can be easily explained in patent where exploitation does not touch upon the expressiveness of an invention (and it is difficult to imagine cases where it would). Conversely, an exception for parody in trademark has recently invited itself in court

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\textsuperscript{97} This expression is taken from A. KUR, \textit{op. cit.}

\textsuperscript{98} Article 13 (3) of the biotechnology directive.
cases, by reason of the increasingly cultural and semantic value of brands. Indeed, trademarks are used to convey meaning in our liberal economies, and constitute signs with an expressive force, that can be used to criticise for political or artistic motives. Rather than relying to the freedom of expression itself, that implies striking a fair balance between the IP rights and the restriction it imposes on the fundamental rights, with uncertain outcome, an overall exception for free speech could be introduced in all IP rights, including trademark. For that matter, such an introduction in trademark has been advocated in the recent study of the Max Planck Institute on the Community Trademark, under a broader exception of ‘honest referential use’\textsuperscript{99}. An exception for free speech would also prove useful in design law to avoid unnecessary litigation such as the case brought by Louis Vuitton against a Dutch artist who had reproduced one of its design-protected bags in a painting denouncing the lack of attention to the Darfur situation (in contrast of excessive attention to show business stars)\textsuperscript{100}. The freedom of speech of the artist has prevailed in the Netherlands but not in France where she was enjoined to stop selling T-shirts reproducing the art work, which illustrates the uncertain results of the direct application of freedom of speech against intellectual property.

Access to knowledge or essential resources would be another important category of limitations. It already pertains to the copyright exceptions enjoyed in teaching, by libraries or persons suffering from a disability. In parallel to knowledge, access to other resources might be essential and justify a limitation to intellectual property, as the access to medicines has created a compulsory licensing in patent. Farmers’ privileges in plant variety rights or biotechnological patent follow a similar rationale, as the access of farmers to seeds of their harvest can be considered as essential to ensure their subsistence. Food security or biodiversity could in a near future give good reason for other cases of compulsory licensing in patent or plant variety rights.

Finally, de minimis exceptions could be admitted, but rather than relying on a closed list of all imaginable cases where countries have exerted enough influence, as in the article 5 of the infosoc directive, it might be useful to introduce in all intellectual property rights a fair use clause, provided that the use does not conflict with normal exploitation of the subject-matter concerned.

One finds here one key element of the three-step test that now applies to all exceptions of copyright according to the article 5(5) of the directive of 2001. Exceptions are only permitted in certain special cases, which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the rightholders. A similar test exists in patent law in the TRIPS agreement that admits limitations in the absence of an unreasonable conflict with the normal exploitation of the invention and with the legitimate interests of the patent owner. Safeguards appearing in trademark limitations are not so far away from such international tests. The case law has construed the obligation to comply with honest practices


in industrial or commercial matters when using the protected sign for referential purpose or comparative advertisement, by aligning it with the absence of any likelihood of confusion\textsuperscript{101}. If the notion of exploitation in trademark amounts to the capacity to control the use of the sign to distinguish products or services, likelihood of confusion harms the normal exploitation.

Some coherence could be gained in using a two-step test or three-step test, including the respect of the normal exploitation of the protected subject-matter and the legitimate interests of the intellectual property owner, not as a limiting device to existing exceptions, but as a further breathing space to assess fair use of the creation or sign\textsuperscript{102}. It would be then a reverse three-step test, allowing some fair use beyond what is explicitly authorised by the law.

B. The rule of exhaustion

The principle of exhaustion is a common limitation to trademark, copyright, patent and design. It prevents the enforcement of an intellectual property right against further commercialisation of goods that have been put on the European market with the consent of the intellectual property owner. Details of the application of exhaustion might slightly differ from one right to another. But the principle is shared by all rights in intellectual property, as well as its rationale rooted in the principle of the free movement of goods within the internal market. What is also common is the geographical scope of the exhaustion that has been determined by the ECJ as covering the European Union territory\textsuperscript{103}.

VI. Duration

IP students generally learn that intellectual property is by nature limited in time, and that inherent quality is what makes it differ from tangible property that is inherently perpetual.

Copyright lasts for 70 years after the death of the author(s), patents are valid for a maximum of 20 years, community design for a maximum of five successive terms of 5 years. Related rights for 50 years and the \textit{sui generis} right applies to databases for 15 years.

This last duration can be extended for a renewed term each time a substantial investment is made to the database. This possibility to renew protection upon each substantial change, begs the question of the target of this lengthened duration: would it only vest in the contents

\textsuperscript{101} ECJ, 11 September 2007, \textit{Céline}, C-17/06, §34 (“The issue of whether that condition has been satisfied must be assessed by, inter alia, taking account of the extent to which the use by the third party is understood by the relevant public, or at least by a significant section of that public, as establishing a link between the third party’s goods and those of the trade mark proprietor or a person authorised to use the trade mark, and of the extent to which the third party ought to have been aware of that”). See also CJEU, 8 July 2010, \textit{Portakabin}, C-558/08, §67; concerning comparative advertising see ECJ, 12 June 2008, \textit{O2 Holdings}, C-533/06.

\textsuperscript{102} This proposal has been made by some scholars for copyright, see C. Geiger, “The Role of the Three-Step Test in the Adaptation of Copyright Law to the Information Society”, \textit{e-Copyright Bulletin}, January-March 2007, and the Wittem Code, article 5.5.

\textsuperscript{103} In copyright the community exhaustion, rather than an international one, has been confirmed in ECJ, 2 September 2006, \textit{Laserdisken}, C-479/04; in trademark, see ECJ, 16 July 1998, \textit{Silhouette}, C-355/96.
resulting from the new investment or in the database as a whole? Opting for the second interpretation would offer a protection potentially unlimited in time to databases.

Trademarks enjoy a specific situation as the protection lasts as long as the sign is genuinely used as a trademark and remains distinctive. However the effect of this limitless duration is relative as the protection only pertains to determined products and services and the protection, in opposition to other intellectual property right, does not vest in a creation whose access to by the public after some time would be essential.

The principle of a limited duration has been implicitly reasserted by the General Court of the European Union in the Astra Zeneca case. On the basis of competition law, the Court has found an abuse of dominant position in the false information given by a pharmaceutical firm to patent office in order to get longer period of supplementary protection certificate. This decision tends at least to safeguard the rule of a limited duration strictly determined by the law, and dares to have recourse to the arm of competition law to enforce it.

However, this decision appears to run against the current, conveyed by the tendency to prolong when possible the duration of protection. A notable example is the proposal for a directive lengthening the duration of performers’ and producers’ right in music, which does not give sufficient account to the principle of a limited duration.

Beyond this principle, what is at stake is the immutability of the public domain. Rarely mentioned in intellectual property legislation, the public domain is mainly conceived as the repository of works or inventions whose term of protection has lapsed. The European Union has not developed a strong position on the public domain, for all efforts focus on development of intellectual property. Consequently, the public domain is what is left after the intellectual property has taken its toll, and extending duration of a right is only analysed through the lens of economic development, not through the impoverishment of the public domain. Such a biased approach underlines cases where restoration of rights is admitted on purely technical application of legal provisions, without any consideration of the effect of such renewal of rights on the public domain where such creations stood. The ECJ has namely restored related rights in a phonogram, for a country where this phonogram was never protected by virtue of the article 10(2) of the term directive.

Pruning the intellectual property tree would require to leave breathing space for the leaves to fully blossom. Public domain, comprising unprotected resources (such as ideas or abstract matter) but also resources whose term of protection has ended, gives to subsequent creation the raw material to build upon. The total absence of public domain as a common principle of

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104 On that question, see E. Derclaye, The legal protection of databases – A comparative analysis, Edgar Elgar, 2008, p. 139-140.
107 For a broader conception of the public domain, see S. Dusollier, Scoping Study on Copyright and Related Rights and the Public Domain, WIPO, 2010.
European intellectual property is unfortunate. It is time for the public domain to justify in itself some legislative attention and be addressed for it is, and not only as a unintended counterpart of intellectual property\textsuperscript{109}.

**Conclusion**

At the end of this journey, the realities and principles common to all intellectual property rights are rather scarce. There is the overarching principle, laid down in the EU Charter of Fundamental Rights, that protection of intellectual property should be. The fact that ideas should remain free is another important motto in European intellectual property. The principle of exhaustion applies across all exclusive rights, and enforcement and remedies are almost similar whatever the right infringed.

Beyond these common lines, traces of similarities can maybe be detected in formalities (save for copyright and related rights), in exclusive rights conferred, or in the rule of a limited duration. However, justifications, subject-matter, rights and exceptions largely remain fragmented and leave ample manoeuvre for uncontrolled extension of intellectual property and overlapping of rights.

What tree would we like in intellectual property? Should we focus on a unitary system, valid for all subject matters? Or should we admit a hybrid mix of commonalities and diversity? My choice would be to have at least common roots in the form of an overall foundation sustaining intellectual property and based on innovation and promotion of knowledge, including a necessary balance, and a solid trunk based on some overarching principles. Those principles should be a proper limitation of subject matter\textsuperscript{110}, a registration-based grant of the protection, a unitary right of exploitation for all intellectual property rights, though adjustable to the subject-matter concerned, a common catalogue of exceptions and limitations, as well as an effective public domain.

The branches of intellectual property could develop under their own rules and specificity to cater to the needs and mechanics of the diverse subject-matter concerned.

It is time to start pruning the tree. Gardeners know quite well that the very objective of pruning, however radical and destructive it might seem, is to get a blossoming tree that, after its forced reduction for some time, will grow bigger and in a more harmonious fashion.


\textsuperscript{110} The objective would be to see what deserves exclusive protection and what, on the contrary, could develop under the normal conditions of market with no protection, but that of unfair competition.