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Book Review: Information Technology and Intellectual Property Law

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This book has evolved with the rise of information technology from focusing on exclusive rights in computer software to covering the numerous points of intersection between intellectual property law (IP) and information technology (IT). This results in a highly informative package that transcends traditional divides, and instead seeks to map the issues from the perspective of reaching practical solutions to the constant and pressing need for more information about information technology law. As the extensive Table of Cases (20 pages) reflects the book references UK, EU and international cases both from other nations and international organizations. The alphabetically organized TBC could perhaps have distinguished the cases based on jurisdiction, but the author has made reference to jurisdiction in the text. As undoubtedly, the author has been the go-to-guy on all IT/IP matters for quite some time, the topics included follow technological and legal trends in a way that may perhaps seem random from a non-computer software perspective. The book reflects the author's growth process and ever broadening expertise which corresponds with the developments in the information society over the last two decades. It approaches the IT/IP intersection as follows:

“This book is concerned with the interaction between information technology and intellectual property law. Central to this is computer software, widely defined, its protection by intellectual property laws and how its availability and dissemination on the internet, websites and social media may have implications for both intellectual property laws and other areas of law such as competition law and rules on jurisdiction. Information technology has other legal consequences and may be relevant to computer misuse offences, license agreements, privacy and data protection and defamation. It is however, intellectual property laws with which this book is primarily concerned and how these laws apply in relation to information technology. These laws include copyright and related rights, design laws, patent law, trademarks and the law of passing off, and malicious falsehood.”

Chapter 1 is useful in understanding how the author links these fields together. It is a novel way of connecting the fields, which seems logical from the perspective of a lawyer practicing in a field, where most issues are unsettled and in some way challenging existing normative frameworks. Perhaps in an effort to be brief there is some layman use of specific legal concepts (e.g. patents as monopolies), but overall, the chapter is essential to understanding how the IP/IT field of law has evolved in the first place. The issue is no longer merely protecting single computer programs that form a specific function, but regulation of a whole new

societal infrastructure built on intricate networks of computer software. A concluding chapter may have been warranted in discussing the ways forward for the various fields of IP/IT law.

As is evident from the description above, the core of the book reflects UK intellectual property law infused with EU or international intellectual property law. Chapters 2, 11 and 13 give good overviews (app. 30 pages) of the essentials of UK copyright, patent and trade mark law respectively, adequately reflecting the areas of overlap of national, EU and international jurisdiction. It is quite odd however, to see a reference to the IP clause of the US Constitution in describing the essential drivers of international, EU or UK copyright law. After all, the United States only joined the international copyright community by signing the Berne Convention in 1989, some 100 years after the beginning of international cooperation in the field of copyright law. This distinction is particularly important, since it is common knowledge that the copyright systems in Continental Europe start from the premise of securing author's rights (noted on p. 25), not the publisher/distributor of works/employer (copier's right), as is the case in common law jurisdictions such as the UK and the US. The difference resurfaces frequently in contemporary IP/IT disputes (what efforts merit protection) and could be used as valuable tool in seeking to understand the ratio behind seemingly contradictory decisions within the copyright realm in the EU. It is true that the systems are emerging *de facto*, however, the systemic differences are frequently informative of where in the field of copyright and related rights realm, one should look for implementations of a solution *de jure*. A good example relates to whether databases should be protected by copyright or the *sui generis* database right (Chapters 5 and 6), which constitutes an EU-infusion into UK copyright law. The author notes (p. 155) the limited applicability of US-developed tests in Europe (including the UK), but cannot resist including frequent references or comparisons throughout the book nonetheless. To the expert reader, the comparison between US and UK cases on non-textual copying is very interesting (although the European angle remains thin), which may lead a reader less advanced in international IP law astray as to the current state of the law in the UK. It seems that the author equates the lack of European cases on a specific test with the lack of law, thus neglecting the role of principle-based statutory interpretation entirely.

Chapters 3 (copyright and computer programs), 4 (functionality exception), 8 (computer graphics), 9 (semi-conductor typography) and 12 (computer-implemented inventions) are truly expert contributions. The above, as well as, Chapter 7 entitled Copyright in the Information Society mirroring the name of the INFOSOC Directive, truly grasp the essence of the challenges technology presents to law. The author's choice of approach really works in de-complicating the very complicated issues that have been laid before the courts. True to the approach following contested issues the book reports on *any* cases uncovered, included national cases in third countries, before the European Court of Human Rights side-by-side with domestic and binding ECJ rulings. Although informative, the jurisdictional mixed-salad may not reflect the law anywhere, on a given issue. From a practical point of view, a practicing attorney may find new arguments and angles, however, the selection is still random, which results in overrepresentation of cases from common law jurisdictions (US) and those crossing the global news threshold in English-speaking international IP forums. The author has done an excellent job in covering the various issues and solutions in the parallel and overlapping jurisdictions of IP/IT law *de facto*, which may rub a formalist the wrong way, but nonetheless, constitutes an accurate description of how information about IP/IT law crosses borders, is shared and takes part in all decision-making in national, EU or international forums. Nevertheless, increasing knowledge of foreign law should not be confused with adoption or influence of foreign law.

Chapter 15 (competition law) and 16 (jurisdiction) are new to the sixth edition and work well in focusing on relevant and practical information. Chapter 15 covers the rules against restrictive trade agreements and abuse of dominant position (e.g. the *Microsoft* -case) and are written in a concise and pleasant manner. The figure on page 602 depicting the available forums for bringing an IP/IT infringement case is useful for any practicing lawyer.

Chapter 10 (breach of confidence) and 14 (trademarks & goodwill) are perhaps most nationally and common law flavored of all the chapters in the book. The former is well written and highly informative. The latter is new to this edition and discusses trademarks, passing off and malicious falsehood in the context of the internet, web sites and search engines. While true to the book's mission on covering contested IP/IT issues, the random selection of material (UK & US) does not work in the field of trade mark law or e-commerce, where EU harmonization is far along and the normative premise for solving contested issues (also in the UK) lie in the interpretation of EU directives, not common law doctrines. While Chapter 13 on the essentials of trademark law is accurately and reliably reflecting the current state of the law, Chapter 14 is simply astonishing in its lack of any normative premise. Granted, the case law of the European Court of Justice is a mess on many issues, but this is hardly a basis for down-grading 20 years' worth of case law

entirely, in favor of more neatly packaged US tests, which the author himself grants are misleading and not applicable in the UK (p. 537). Contrary to the established practice of discussing trademark infringement from the perspective of a limited right to exclude certain uses of identical or confusingly similar marks in commerce, the section starts with the unclear contours of trademark protection, and emphasizes those parts of the EUCJ judgments that reference US dilution terminology or discuss functions that fit within the contours of the common law actions of passing off. Amazing is also the reference to the US test for confusion (*Sleekcraft* factors), which applies to ordinary trademark infringement, instead of the *contents of the* established case law of the European Court of Justice (cited on 535), and instead of the provisions of the Lanham Act amended by the Federal Trademark Dilution Act of 1995 and the Trademark Dilution Revision Act of 2006, which regulate the cause of action against dilution of trademarks in US trademark law. Mechanically repeating the facts and outcomes of specific cases on internet issues without regard for the normative context in which they operate, simply fails when the author operates outside his comfort zone. After all, many issues in IP/IT law are simply not falling into virgin ground, but are fitted into existing normative contexts.

Although, the sixth edition includes a large amount of EU law and material relating to the European Patent Convention this material is viewed through the – perhaps not always focused – lenses of a British common law lawyer. The book exposes its Achilles’ heel in its critique of the Boards of Appeal of the EPO;

accusing it of “behaving in such a way that could be described as decision-making on the hoof with scant regard for precedent and with little concern for the frustration of national courts in trying to respond....Not so long ago, the Enlarged Board of Appeal at the EPO declined to set out principles which could be applied both by national courts and its own Boards of Appeal on a particularly weak argument that the Convention did not allow to do so.”

The Foreword’s call for clearer guidance on contested matters is undoubtedly valid, however, it is questionable whether one should call for international organizations to intentionally transcend their own jurisdiction and solve contested issues without normative backing. The author is certainly not alone in confusing jurisdictional powers of the European Patent Office (EPO) with the European Union (or worse UK courts), but such basic mistakes should have been caught in the editing process.

Seeking to understand the law is a two-way process, and scant regard for the role, jurisdiction and procedure of foreign courts or administrative authorities that are based on the civil law system, is, again, although frightfully common in UK legal literature, hardly an acceptable point for criticism after the many years of co-existence and *fait accompli* as to the current state of the law. Civil law courts, not to mention, registration authorities differ from common law courts, it is as simple as that. Any valid criticism should start from a recognized and shared normative premise. International conventions – like the EPC – are based on the agreement of the Member States which they express in the text of the convention. The authority which is established to interpret such text, must, under established principles of international law (Vienna Convention on the Law of Treaties) stay within the corners of the agreement. What is acceptable amendment through re-interpretation in the common law system is breach of hard law in the civil law system. The criticism should be directed to Member States (representatives), who have the power to amend the EPC. All else, is simply barking up the wrong tree!

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