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Registration, Notice and Property Definition in Intellectual Property Rights

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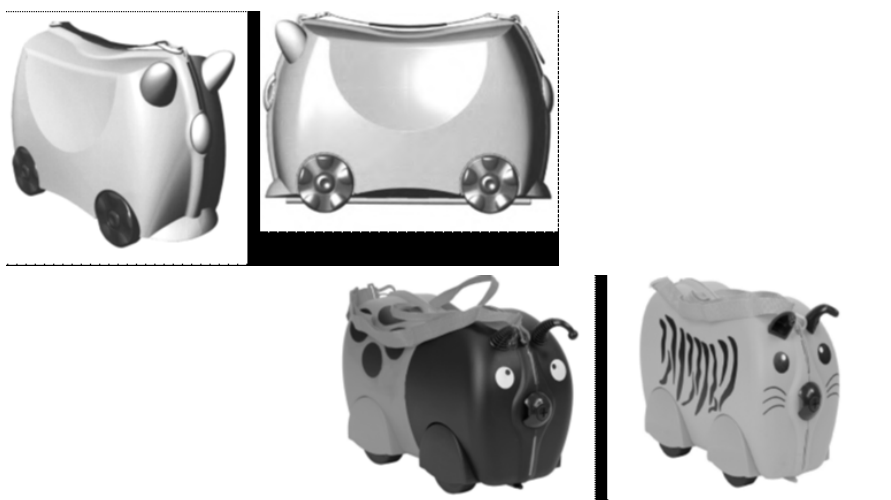
Plan

- Relationship Between Registration and Infringement: A Persistent Source of Concern eg in Patent Law: How far should claims delimit scope of protection?
- Goal of Registration: the Provision of Certainty to Third Parties
- Does Registration Really Offer Certainty?
- What are implications from recognising this 'Certainty' is largely illusory?

Part 1: Recent Cases Highlight Relationship Between Registration and Infringement

- *Trunki* (2016): was the uncluttered representation of the Trunki ride-on suitcase, infringed by D's tiger-striped ride-on suitcase?
- *Eli Lilly* (2017): was claim directed at "pemetrexed disodium" (administered together with vitamin B12) infringed by use of pemetrexed diacid or dipotassium?
- *Specsavers* (2013): was black and white mark infringed by use of mark in colour? Did it matter that Specsavers mark had been used in colour?

PMS Intl v Magmatic [2016] UKSC 12



Specsavers v Asda, Case C-252/12 (CJEU, 2013)

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Part 2: Interpretation and Scope: Assumptions about Representation

- Representation defines property
- Main goal is to indicate “metes and bounds” of property to third parties
- Therefore should be clear and precise
- Applicant chooses representation – or representations
- With advice.

The Goals of Representation

- To offer notice to the public (a) *that* protection is claimed and (b) *what* protection is claimed
- To identify the subject matter entitled to protection: what is new and inventive; what (is intended to) operate as an indication of origin; what is new and individual in appearance.
- P chooses how and how many representations/claims

EPO Guidelines

- “The requirement that the claims must be clear applies to individual claims, i.e. to independent and dependent claims alike, and also to the claims as a whole. The clarity of the claims is of the utmost importance in view of their function in defining the matter for which protection is sought. Therefore, the meaning of the terms of a claim should, as far as possible, be clear for the person skilled in the art from the wording of the claim alone”

Electric and Musical Industries Ltd v Lissen Ltd
(1938) 56 RPC 23, 39 (Lord Russell)

“The function of the claims is to define **clearly and with precision** the monopoly claimed, **so that others may know the exact boundary of the area within which they will be trespassers**. Their primary object is to limit and not to extend the monopoly. What is not claimed is disclaimed. **The ... forbidden field** must be found in the language of the claims and not elsewhere.”

Cited in *Kirin-Amgen*, [20]

Kirin Amgen [2004] UKHL (Lord Hoffmann)

[34] As a number of judges have pointed out, the specification is a unilateral document in words of the patentee's own choosing. Furthermore, the words will usually have been chosen upon skilled advice. The specification is not a document *inter rusticos* for which broad allowances must be made.

- Concluded claims determine scope: what person skilled in art would understand claims to mean?

Trade Marks

- *Sieckmann*, Case C-273/00 (2002) (CJEU), [46]-

[55] ‘the function of the graphic representability requirement is...to define the mark in order to determine the precise subject matter of the protection afforded...to its proprietor’

Designs

- EUIPO Guidelines on CDR [3.3.1] “The purpose of the requirement is to allow third parties to determine with accuracy all the details of the Community design for which protection is sought.”
- Commission Regulation (EC) No 2245/2002 (“the Implementing Regulation”) Article 4(1)(e) provides that the images accompanying an application to register a design “shall be of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished ... for entry in the Register of Community Designs”

T16/16 *Mast-Jägermeister SE* (9 Feb 2017; AG Opinion in C-217/17P)

[45] That phrase refers to the requirement inherent in any registration, that is, to enable third parties to determine with **clarity and precision** all the details of the design for which protection is sought [citing *Sieckmann & IP Translator*]

[46] Thus, imprecise representations would not enable third parties **to determine unequivocally** the matter to be protected by the design under consideration.

[47] ...clarification is necessary not only for **the purposes of ensuring legal certainty for third parties**, who need to know precisely what the subject of the protection conferred on the design is...

Trunki [2016] UKSC 12

[30] So, when it comes to deciding the extent of protection afforded by a particular Community Registered Design, the question must ultimately depend on the proper interpretation of the registration in issue, and in particular of the images...

[31] Accordingly, it is right to bear in mind that an applicant for a design right is entitled, within very broad limits, to submit any images which he chooses. Further, in the light of article 36(6), an applicant should appreciate that it will almost always be those images which exclusively identify the nature and extent of the monopoly which he is claiming. As Dr Martin Schlötelburg has written, “the selection of the means for representing a design is equivalent to the drafting of the claims in a patent: including features means claiming them” ...

Trunki [2016] UKSC 12

- [32] Over and above these considerations, it is also worth remembering that an applicant is entitled to make any number of applications. More broadly, it is for an applicant to make clear what is included and what is excluded in a registered design, and he has wide freedom as to the means he uses. It is not the task of the court to advise the applicant how it is to be done. That it may be said is a matter of practice rather than law, and if further guidance is needed it can be sought from other sources, such as OHIM.

Conclusion

- Clarity and precision recognised as crucial requirement of “representation”
- Idea behind is that this is necessary to provide notice
- Less consideration is given on questions: to whom? When does notice matter? In relation to what tasks?

Part 3: Questioning the “Notice” Assumption

- Burrell & Handler [2003] IPQ 388
- “Ultimately, however, the attempt to find a bureaucratic solution to the identificatory problems of intellectual property law was only partially successful. Courts and registries have at various points been called upon to look behind the documentation in order to discover what the property “is”.”

Patents versus designs/trade marks

- Patent Claims. ‘Preamble’ and ‘characterising portion’. (EPC, Implementing Regs, Rule 29(1)).
- The latter delineates precisely what is new.
- Design and trade mark registrations: identify object *that* is claimed as distinctive/new but not *what* is distinctive or new about it. Non distinctive, non novel elements are not filtered out. Former practice of **disclaimers (Art 37(2))**.
- That said, can claim parts using eg visual disclaimers

Trade Marks and Designs

- Representation does not identify the object with same precision (excluding unprotected matter): so design and trade mark representations if taken at face value, are likely to confer *too much*
- Highlights importance of the filtration/scope inquiry.

Used Trade Marks: Where is the Certainty?

- Confusing similarity: depends on reputation of mark; influence of “actual confusion”; *Specsavers* – importance of how mark is used.
- Dilution: depends on reputation. Specification of goods is (almost) irrelevant.
- With used marks, the representation and specification hardly “define” the property (yet alone clearly or precisely)

Burrell & Handler [2003] IPQ 388

- “although, on some level, it is clearly true to say that the requirement of graphic representation performs a *definitional* function, the ECJ's assertion that it is the representation of the sign on the register that determines the scope of the property is deeply problematic.” (398)
- “the success of the bureaucratic enclosure of trade marks is illusory--there is pressure to look behind the register.”

Even worse...

- Trade marks are only one component of the system
- Whatever the register indicates, third parties also need to take account of the possibility of right based purely on goodwill
- Any claim that the notice role of the trade mark register is vital seems hugely over-stated

Patent Claims: How Much Value in Terms of Notice?

- Multiplicity of Claims
- Hierarchical organisation: I either own the UK or Lincolnshire or South Kesteven or Little Bytham or Church Lane, Little Bytham or 14 Church Lane, Little Bytham...
- Many couched in highly abstract terms
- Potentially subject to Amendment, or “Auxiliary requests” (perhaps from “neuropathic pain” to “peripheral neuropathic pain”?)

Patent claims: Intrinsic Limitations

- Language. “Claim construction may be inherently indeterminate: it may simply be impossible to cleanly map words to things” (Burk and Lemley, 1745)
- Defining in language something which is hitherto unknown in a way that captures future unknown uses

Protocol on the Interpretation of Article 69

On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patentee with **a reasonable degree of certainty for third parties.**

Burk & Lemley, 'Fence Posts or Sign Posts?
Rethinking Patent Claim Construction' (2009)
157 U Penn LR 1743, 1745

- “The key feature of peripheral claiming, setting out clear boundaries to warn the public of what is and is not claimed—the “notice function” of patents that has received so much attention in recent years—
increasingly seems to be an illusion”

Robin Feldman, *Rethinking Patent Law*
(HUP: 2012)

(2) “Rather than delineating a patent holder’s rights, a patent creates no more than an opportunity to bargain. It is an invitation to enter into the process of negotiating a definition of rights.”

Design Claiming: The Notice Function

- Multiplicity of (unexamined) registrations (via single application)
- Don’t just rely on representation after all (see next slide)
- Parallel unregistered Community and UK rights – possibly also copyright (albeit subject to derivation requirement) – where no notice of *what* is protected

PepsiCo, Inc. v Grupo Promer Mon Graphic SA, Case C-281/10P ECLI:EU:C:2011:679, [77] (CJEU, 4th Ch)

- “since in design matters the person making the comparison is an informed user who – ... – is different from the ordinary average consumer, it is not mistaken, in the assessment of the overall impression of the designs at issue, to take account of the goods actually marketed which correspond to those designs.”

Part 4. Implications that Flow from Recognising the Limits to “Certainty”

- Probably different for different IP rights
- Improve certainty for third parties (i) by changing procedures; (ii) other mechanisms (eg defences)
- Reconsider some of the expectations for registration
- Legitimise other sources for definition of scope: eg prosecution history

Improving Certainty for Third Parties

- Property definition not only source of certainty: consider eg prior use defence (PA s 64), Unitary Patent defence. What about a litigant defence?
- Procedural mechanisms: monetary incentives (cp. Current EP rule where 16-50 or over 51 claims)?
- Procedural mechanisms: file wrapper disclaimers
- Improve certainty: recognise that more “precision” is not always more “notice”
- Improve certainty: eg create explicit “codes” for representation of designs.
- Give significance to explanations and product definition. CDR Art 36(6)

Reconsider Expectations at Time of Registration

- Some US patent scholars advocate a return to central claiming.
- In trade mark registration, where mark has been used (or perhaps if the applicant foregoes the 5 year non-use rule), take recognition into account: *Cadbury Application* [2013] EWCA Civ 1174; *Mattel v Zynga* [2013] EWCA Civ 1175

If certainty not a real benefit, focus on ensuring
“fair protection”

- Recognise problems that applicants face in drafting
- That expanding protection of “equivalents” (in *Eli Lilly v Actavis*) is not as damaging to third parties as might seem at first
- “fair” not just “more”: prosecution history (*Eli Lilly*, [88])?