

## Book Review

### ***INTELLECTUAL PROPERTY Omnipresent, Distracting, Irrelevant?***

*William Cornish*

*Clarendon Law Lectures. Oxford University Press. London. 2004. ISBN 0199263078, £35*

#### ***Introduction***

Intellectual property itself, in its historical and dialectical foundation, presents an intriguing persona - that which bestrides the two spheres of the esoteric and the mundane. Having evolved from relative obscurity, its tentacles are ever stretching whilst its tenets have remained steadfast. The creative enterprise in its various genres has always managed to thrive within the paradigm of intellectual property, though in some instances not without agitation. It can be safely asserted that WR Cornish's 114 page Clarendon Law Lecture explores this dynamic in rich and vivid detail. In a characteristically clear narrative, devoid of the rigidly textual framework that other authors sometimes tend to use, Cornish conducts a comprehensive discourse on the many important issues in intellectual property. He adopts a conceptual framework expressed in a tripartite structure - "Inventing" for patents, "Creating" for copyright and "Branding" for trademark- that captures the entire breadth of intellectual property. Cornish states that 'Intellectual property may now be a convenient genus, but its various species remain distinct'<sup>1</sup>. Keeping with that analogy, the author explores and contrasts the trajectory of the three realms and provides an invaluable insight into the development and current landscape of intellectual property law in the emerging global order. He traverses important landmarks: the pressure for increased protection as the by-product of globalization; the impact of the expanding frontiers of biotechnology and genetics; the aesthetics and functions of the new branding patterns; and the impact of digital technology. More than ever, the developmental and policy concerns which these issues raise shape the evolution of the law. The author obviously appreciates that intellectual property stands at a threshold in its contemporary importance, a state of affairs which he elucidates in the three major Parts of this book.

#### ***'Inventing' in Patents***

The first Part of the book deals with patenting. Interestingly, it is in this part that the history of intellectual property is traced. The learned author discusses the importance of intellectual property and its role in the emergence of the developed economies. This development has resulted in the internationalisation of protection and increased pressure for acceptable global standards of intellectual property protection, which has led to the TRIPS Agreement. Cornish situates the prosperity of the patent-intensive industries within the 'omnipresence' of inventive activity since Chief Justice Burger's famous (or some may say infamous) protestation that patents can be available for "everything under the sun made by man".<sup>2</sup> Intellectual property and the

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<sup>1</sup> William Cornish, *Intellectual Property Omnipresent Distracting Irrelevant*, at page 5

<sup>2</sup> Diamond V. Chakrabarty, 100 S. Ct. 2204 (1980) at 2208.

patent system have not known better days, but the bitter side is that developing countries have yet to see better days with the promise of development associated with TRIPS. Affirming the boom of patenting activities and the dynamics of patent policy, Cornish identifies what he calls the “Six observations” on the objectives of patent systems.<sup>3</sup> Patents and the accompanying exclusive rights of exploitation have fostered major advances in pharmaceutical and agro-chemical industries and in the treatment for cancer, the HIV/AIDS pandemic and other debilitating human conditions. The development of gene research with the progress in human genomics and biotechnology has found expression in the patent system, and the leading pharmaceutical and biotech firms have emerged as the ultimate benefactors. The compulsory licensing regime has offered a window of opportunity for the less developed countries and the victims of AIDS, the world’s most dreaded virus. The dictates of compulsory licenses have not been altogether compelling with the notorious Article 40 of the TRIPS Agreement and problems in implementing paragraph 6 of the Doha Declaration.<sup>4</sup> It is well known that most developing countries lack pharmaceutical manufacturing capacity, with imports dominating consumption. Access to life-saving medicaments remains a major problem to the large population who cannot afford the cost of the drugs. Whether the patent system is directly responsible or not, it should play a role in the amelioration of the situation. Therefore, strong patent protection may not be desirable in poor and developing countries. Perhaps Cornish’s realisation of the inequity underscores his blaming patenting for the impossible prices in developing countries. He reminds us how the rules of competition against the abuse of dominant position have imposed compulsory licenses over intellectual property rights.<sup>5</sup> However, despite TRIPS’ advances at Doha, the ultimate hold of the world’s patent owners has remained largely unchecked. Cornish asks rhetorically “who can tell what the present wave of discontents over the power generated by the most successful IP will bring”.<sup>6</sup> On that note, Cornish laments the unflinching grip of the intellectual property regime.

Comparing European patent law with the US, he examines the scope of the experimental use exception and its impact on the research-commercialization dichotomy. Acknowledging the often intensive levels of investment in experimentation, particularly in biotechnology, Cornish attempts to strike a balance between avoiding ‘clogging the advance of knowledge’ by patents and presenting a ‘strong case for IPRS’ as a market incentive on investment. Though tendentious, Cornish nevertheless wears the cap of a ‘generalist’. The author also notes the triumph of commercial prospecting for exclusive market rights in all the industrial fields which rely most heavily on patenting; pharmaceuticals, genetics, biotechnology. The question of who determines patent policy, like the whole intellectual property field, has always been of central importance. Cornish examines the question in the context of the capacity of the patent system to reinvent itself in the world of competing interests. He identifies the roles of different elements that make up the System – legislation, litigation, technology and examination (administration) within their

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<sup>3</sup> Pages 7-10

<sup>4</sup> See Reference Article 40 of the TRIPS Agreement and paragraph 6 of the Doha Declaration on TRIPS and Public Health.

<sup>5</sup> Page 26 – 28.

<sup>6</sup> Page 28.

respective sentiments in a way that would make an archetypal ‘world patent’ an illusion.<sup>7</sup> The European problem in forging a homogeneous patent system is a polite microcosm of the North-South debacle in the TRIPS. One cannot therefore agree more with Cornish that ‘we are still stuck with national systems, governed by local interest.’ Though this may appear pessimistic, it paints a true and fair picture of the current situation.<sup>8</sup> In the last section, the author examines the second – tier protection with respect to petty patents (otherwise known as ‘Utility Models’) and Database rights, which have featured prominently in the intellectual property laws of European countries (with the UK as the leading exception), Cornish justifies the underlying rationale for petty patents and databases, but suggests that we exercise caution in their implementation.

Understandably, considering their amorphous nature in the sphere of genetics and biotechnology, the author concludes this Part of his lecture with more questions on the overall socio-economic utility of patents. Citing the Malchup model, Cornish’s pro-patent advocacy is measurably sustained, yet balanced by his argument for a careful and systematic demarcation of the boundaries of patent law in the face of the current genetic and digital revolutions.<sup>9</sup> Indeed, in view of the many concerns discussed, this writer agrees with Cornish’s assertion that ‘patents now deserve a somewhat more sanguine appraisal’ if they are to fulfill their utilitarian promise.

### ***‘Creating’ in Copyright***

Cornish begins his discussion of the subject of copyright with a historical survey and an elucidation of the challenges posed by modern technologies and the Internet to industries which rely extensively on copyright. He escorts the reader along a comparative discourse of the copyright-patent synthesis, advocating a convergence of protection in the light of today’s digital revolution through the calibration of the terms of protection in proportion to the strength of commercial use. In the metamorphosis described by Cornish, copyright has an enviable heritage hidden in the deification of the Author - a ‘Romantic Hero’ of sorts - whose ‘personhood’ or rights have managed to emerge from the centuries of rapacious incursions by both man and machine. Though, he has emerged, he has nevertheless been scratched and bruised by the “harsh realities” of modern technology-driven exploitation. Tracing the historical impact of industrial players on the development of the law, Cornish observes that the old English stationers, printing, copying technologies, record and film producers, have all affected the artery of Anglo-Saxon and Continental copyright traditions. In a similar fashion in the modern age, the titans of Hollywood, Silicon Valley and their leading industrial powerhouses like Microsoft and OALTimeWarner have also worn the robes of the law maker on a number of key occasions.

The relatively stable copyright and media industries – publishing, music, entertainment whilst still grappling with the recent audio-visual technologies - are now endangered by the omniscience of the Internet and its exponential potential for the distribution of information, entertainment and even knowledge,<sup>10</sup> The fact that

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<sup>7</sup> Page 35.

<sup>8</sup> Ibid.

<sup>9</sup> See pages 39 – 40.

<sup>10</sup> Page 41.

copyright today faces the threat of the digital revolution engages the attention of the author throughout the length of the discourse. Of course, this is where the allusion to the term “distraction” comes in. Cornish lists the litany of “digitized works” culminating in the Internet and asserts their threat to the future and furtherance of copyright.<sup>11</sup> Indeed, the digital revolution is personified in the face of the Internet. Cornish revisits the Napster and KazaA stories and compares the US position with the UK, drawing an interesting parallel with the much earlier UK decision in CBS Songs. v. Amstrad.<sup>12</sup> Indeed, it could be said that the major casualty lies in the threshold of ‘authorising’ or ‘contributory’ liability that has been greatly impaired in the “anarchic flow” of the virtual environment. Copyright law has not yet found the answer to this problem. Under the subheadings “Answers within the Technology”, “Legitimate Materials”, “Unlicensed provisions of copyright material” and “Permissible uses of Copyright Material”, Cornish weaves an unending paradox between copyright and the Internet. In it, he lays a foundation for the answer to his thematic question “Will copyright become irrelevant?” Part of his answer with respect to the Internet problem is technical control or anti-circumvention technology, wherein he expounds two principles, namely, the “technology of legitimate access” and the ‘technology of policing’.<sup>13</sup> Cornish advocates the amalgamation of the legal process and technology as part of the ‘digital agenda’ that would help save copyright from the brink of irrelevance. Citing the Digital Millennium Copyright Act of 1998 in the United States, the European Directive on Copyright in the Information Society of 2001 and the two WIPO treaties of 1996 as veritable legal instruments, he balances the calculus of anti-circumvention between the rights of protectors of digitised copyright materials and the users entitled to access information. In the same breath, he examines what he terms the ‘blanket of liability’ that has enveloped the field of content providers, service providers, the line of servers as well as end users, though with exemptions, to show how ‘traumatised’ the copyright-based industries are by the Internet. Cornish also discusses the most intriguing aspect of the nature of the Internet - the absence of government. His critical evaluation of salient issues – the virtues of free movement and access, and the removal of the monopolisation of digitised programs - compels him to lend measured support to legal protection for technical control which has an embedded potential for optimal efficiency. It is in the balance of property ownership, a hallmark of intellectual property protection, and open access, one of the Internet’s clichés, that Cornish locates the omniscience of the law. Cornish’s survey of the functions and powers of collecting societies has not exactly helped revive the commercial sustenance of copyright in the digital environment. His concluding remark clearly reveals where his sympathy lies – with the cause of the author in the midst of this ‘new and perfect’ highway called the Internet.

### ***‘Branding’ in Trade marks***

The last Part of the book deals with “Branding” where the author traverses the foundations of trademark jurisprudence. Indeed, trademark on the one hand has been

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<sup>11</sup> *Op. cit.*

<sup>12</sup> (1988) AC 1013.

<sup>13</sup> In the former, we find encryption techniques and all the measures to restrict access to sites containing authorized copyright material, and the latter are the presence of electronic watermarks and identifiers deployed for digitized recordings of music, films and multimedia.

viewed as conferring economic monopolies on their owners with the accompanying incidence of limitation on the freedom of traders, whilst on the other hand has proved to be a useful instrument of consumer protection by shielding the unwary public against the imperialist tendencies of trademark owners.<sup>14</sup> Yet in its historical evolution, trademark law has somehow managed to bestride those two postulates which epitomise the dual rationale for trademark protection. It is from this point that Cornish's discourse deals with the very different matters that have arisen in the development of trademark law: registration systems; trademark function analysis; trading and marketing ethos; and structure of trademark rights. With the categorisation of two schools of thought – 'Red-lighters' and the 'Green lighters'-representing the two ends of trademark protectionism, Cornish, somewhat dramatically captures the full horizon of some of the legal and policy concerns that have shaped current development. While Green-lighters argue for more extensive protection, Red-lighters argue for limited and controlled protection. Although, right from the outset, Cornish is quick to point out that he belongs to the Red corner, in many specific instances the author nevertheless assumes the role of umpire.<sup>15</sup> Viewing branding as an economic co-efficient in the marketplace which contributes significantly to business functioning and general welfare, Cornish discusses the culture of branding with all its platonic trappings and the much trodden function analysis in trademark legal thinking. Cornish proceeds with a critical examination of the role of trademark registers that have been established in most jurisdictions, deriding the registered trademark as a mere contrivance of convenience. He explores the tension and the burdens of protection that exist in the penumbra of rights in the mark by 'trading', those which arise by 'registering' and the interaction between the general law of unfair competition and trademark law properly so called. Cornish examines the growing practice of branding and advertising through trademark as part of the driving force in current free-market economies. From the analysis, trademark has been strongly linked with the trends in monopoly and invariably features in any commercial regulatory process.<sup>16</sup> Cornish cites the case of Coca Cola's trademark, where Lord Templeman refused registration for the shape of the coca cola bottle - an important Red lighter's authority - to curb the monopoly that trademarks could engender.<sup>17</sup> It was in that case that Lord Templeman's famous remark was made on that issue, that "This is another attempt to expand the boundaries of intellectual property and to convert a protective law into a source of monopoly". However, the counter argument, which has been fairly settled is that the nature of the trademark right is only to exclude others from using the same or similar name as trademark and does not prevent another entity from putting its own product or services on the market. Therefore, the registration system as part of the potentially monopolistic tendencies in branding immediately engages the author's attention.<sup>18</sup> According to

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<sup>14</sup> In this sense, the role of trademark in regulating behaviour in the consumer society is admitted. The author cites Neil McCormick, "On the very idea of Intellectual Property: An Essay according to the Institutional Theory of Law"(2002) IPQ1.

<sup>15</sup> Page 77, Footnote 13, with respect to rights that exists to stop trade rivals or competitors from doing certain things or that is, between rights between competitors, Cornish belongs to the Green corner because of his choice for wider protection against each competitor.

<sup>16</sup> See also "Holly Hobbie" TM [1986] RPC 421, HL.

<sup>17</sup> However, the shape of coca cola had been accepted as registrable under the Patent & Designs Act 1909.

<sup>18</sup> See pages 83-88, 105-110 where Cornish devote considerable length of space in discussing the issue.

Cornish, the two extreme views are: first, that all marks should be registrable without prior use, reflecting the Green light opinion; and second, that prior registration is useful, representing the Red light standpoint. Hence, the rules for the functioning of trademark registers – registrability of mark, use vis-à-vis non-use, maintenance by renewal etc - that have evolved under different systems including the EC, US Lanham Act, UK and other jurisdictions have significantly helped in regulating the monopoly-competition calculus in trademark protection, particularly in problematic cases involving descriptive, laudatory or geographical words.<sup>19</sup> ‘Proportional Geometry’ is the term which Cornish adopts to reflect upon the balance of confusion vis-à-vis association in the subsistence of trademark rights.<sup>20</sup> Cornish acknowledges how unsettled and unsettling the state of the law is both in the courts and the Registries.<sup>21</sup>

Cornish’s discussion of function analysis strikes at the very core of the much trodden subject. He examines the three theories of trademark functions, namely, origin/source, quality/guarantee and advertising/investment. He further extracts two important postulates: first, that the three functions, though distinct, are interwoven; and second, that consumer expectations play a primary role in legal protection, particularly in the quality-via-source axis. In a sense, his functional synthesis of the trademark function has the unanticipated effect of reducing the traditional distinctions of the functions to a moot point. Irrespective of the Red or Green or the Ruiz-Jabaro arguments, the main thrust of Cornish’s extrapolation tends toward a controlled proliferation of trademark rights. Registrations involving colours, smells, sounds even surnames and shapes therefore must require clear evidence of distinctiveness. However, when it comes to enforcing validly registered marks, Cornish examines the change of scheme that ensues. He contends that, there is a paradigm shift from the question “what should be registered” to the question “for what is it registered” which strikes at the underlying purpose the function analysis is meant to achieve. Arsenal FC v. Reed<sup>22</sup> provides a convenient but controversial exemplification of that shift. Cornish’s critical discourse of Arsenal underscores the juridical validity of the interplay of trade mark functions in the scheme of protection, as much as the questions Mr Justice Laddie referred to the European Court of Justice, whether the use of mark, other than as an indication of source, constituted an infringement. Or better still, whether or not to limit trademark function primarily to that of indication of trade origin reflects the correct status of the law.<sup>23</sup> Origin function may appear to be the primary function, but Cornish’s articulation of five compelling factors for legal protection broadens the horizon of an otherwise narrow analysis.<sup>24</sup> Cornish uses the Australian Dunedin’s Duff case,<sup>25</sup> and once again the Baby-Dry case, to further bring out some of the important factors in

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<sup>19</sup> Or “stockpiling of marks” to use Cornish’s own words. See Page 86 where Cornish cites the famous “Perfection” “Chiemsee” and “Baby-Dry” cases.

<sup>20</sup> Page 86-88.

<sup>21</sup> Ibid. @ 86.

<sup>22</sup> [2003] ETML 227, ECJ.

<sup>23</sup> at page 92-94.

<sup>24</sup> See pages 97-101. The following five factors are enumerated; protection against parallel import, protection of exclusive distributorships, protection against specific comparative advertising, protection of image promotion of celebrities and their organization and protection against association and dilution, all of which are eminently capable of aligning trademark principle with the wider economic issues.

<sup>25</sup> Twentieth Century Fox v. South Australian Brewing [1996] ATPR 42,004.

defining the legal protection of trademark - factors such as: competitive freedom among traders; consumer interest such as intellectual property in their brands; correct information about source and qualities of goods or services; and promotion and market definition. In drawing the line from the multiplicity of critical factors, Cornish posits that appropriate legal protection is that which “confines the exclusive rights within the limits of what are necessary for honest practices”.<sup>26</sup> The author finally draws the curtain with a brief discussion of the tensions that have ensued in the notion of cummulation and convergence of intellectual property rights vis-à-vis the creation of *sui generis* rights. The relationship between trademark registration and passing off which precedes it presents that tension within the trademark sphere. Cornish acknowledges the coincidence of the two forms of liability. However, he treats trademark registration as a ‘preferred category’.<sup>27</sup>

Cornish’s lecture comprehensively addresses the influence of the rapid socio-economic and technological development that has taken place in the last four or five decades on intellectual property, challenging as it were, the development of the law as a creation of positive law. The Lecture undoubtedly makes an invaluable contribution to legal science and to both policy and normative debates in intellectual property jurisprudence.

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DOI: 10.2966/scrip.010204.350

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<sup>26</sup> See page 105.

<sup>27</sup> Page 107.