

Book Review

INTELLECTUAL PROPERTY LAW IN PRACTICE

Thomas E. Hays and Claire C. Milne

Thomson W. Green, 2004, ISBN 0 414 01474 X, 543 pages (including appendices), £ 69.

A Scottish academic and a practitioner have combined forces to produce a guide to Intellectual property from a Scottish perspective. The book aims to provide legal practitioners with the necessary tools to untangle any intellectual property dilemma a business entity may come across. The authors rightly believe that intellectual property, “the currency of the 21st century”, affects every modern business and warn that “intellectual property should be at the forefront of strategic thinking for all businesses”. As a consequence, lawyers cannot ignore the impact that intellectual property has on their clients. William Nimmo Smith, in the foreword to the book comments: “this is an expanding area of practice, and one of which no practitioner, whether or not a specialist, can afford to be ignorant”. I could not agree more. But to understand the key issues that a business will face and be able to cope with the unexpected, one needs a clear and practical guide to refer to in moments of need. This book provides a good starting point.

The book has a logical structure and offers many insightful developments on the main forms of intellectual property rights as well as on emerging forms of protection. From the outset any practitioner new to the field can get a real feel for the challenges ahead, and ways to go about dealing with them for a successful resolution. The introduction lays down the foundations, illustrating the reasons why intellectual property is such an important area (for example, stating that in 2002, 17,656 trade marks were registered in the UK alone) and providing a snapshot of intellectual property rights. A table is inserted detailing: the forms of intellectual property rights; their subject matter; whether or not they need formal registration to exist; the term of protection; and the principal legislation applicable to it. Even for the experienced practitioner such a handy table has to be a tool that one carries everywhere.

The book is then split in different parts focusing each on the main types of intellectual property rights in existence: patent, trade mark, copyright, industrial design. Each of those sections offer a clear account of the law stated as at November 2003, and some useful examples (sometimes illustrations) helping the less experienced to fully grasp the concepts. The sections looking at EU and international instruments offer a more advanced approach to wider issues. This is particularly well executed with regards to copyright where the notions of moral rights and performers’ rights are addressed in their international context, given the resistance of UK law to acknowledge such a separate body of rights. From a more pragmatic point of view, the book could have benefited from more practitioner’s tips in all areas and more analysis of the trends in litigation in Scotland as well as in England. However, the Patent procedure chapter is very well executed and offers a clear step-by-step guide of this area governed by complexity and rigid administrative procedures.

Separate chapters are dedicated to key areas of knowledge, such as passing off, mainly in the context of trade mark protection, and the law of confidentiality as it

relates to commercial and industrial matters. Additional chapters on free movement of goods and exhaustion of rights at EU level as well as on competition law rules and its implication for intellectual property right owners are particularly recommended for their clarity and ability to put the importance of the issues into context. The book closes with two chapters on emerging forms of protection including databases and protection for semi-conductors and usefully draws on US law. It also includes thoughts on the future developments of intellectual property rights reflecting on the global nature of intellectual property rights and the impact of the Internet.

Finally, with an important set of appendices (occupying ¼ of the book), practitioners are provided with a useful tool kit, although an incomplete one. One can find Patent and Trade mark licence agreements, Patent, Trade mark and copyright assignments, a publishing agreement, software development agreement and even a US form Copyright License Agreement. All these have useful examples of the boilerplate clauses a practitioner will need. Perhaps the only regret is that such a useful section could have benefited from a clause-by-clause guide pointing out the essential functions of each clause and insights into potential litigation emerging from the use of different types of wording. In addition, the Patent Office forms for patent, trade marks and design are provided, as are the European and US applications. There ensues a section containing European Legislation relevant to the “free movement” of trade marks (including the Directive on the approximation of the laws relating to trademarks and the Council Regulation on the Community Trade mark). The WIPO trade mark use classification is also included. Finally a set of useful web addresses and a list of membership to the relevant international bodies and international treaties is provided.

Overall, although the book is aimed at Scottish practitioners, due to the nature of intellectual property legislation in recent years (mainly of European and international descent), any practitioner would in fact benefit from reading this book. As a practitioner new to this area, it seems to me that Hays and Milne will rapidly become a “must have”.

Christine Riefa
Brunel University

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